United States District Court,
E.D. Pennsylvania.

**APPLIED TELEMATICS, INC,**
Plaintiff.
v.
**SPRINT COMMUNICATIONS COMPANY, L.P,**
Defendant.

**July 23, 1996.**

***MEMORANDUM***

KELLY**, J.**

The following matters are presently before the Court:

1. The Motion for Summary Judgment on Non-Infringement of Defendant Sprint Communications Company, L.P. ("Sprint's Motion") [doc. number 91];

2. Plaintiff Applied Telematics, Inc.'s Combined Brief in Opposition to Defendant's Motion for Summary Judgment and Cross-Motion for Partial Claim Construction ("ATI's Brief") [doc. number 104];

3. Sprint Communications Company, L.P. Reply Brief in Support of Defendant's Motion for Summary Judgment on Non-Infringement and Defendant's Brief in Opposition to Plaintiff's Cross-Motion for Partial Claim Construction ("Sprint's Reply") [doc. number 113]; and

4. Applied Telematics, Inc.'s Reply Brief ("ATI's Reply") [doc. number 118].

For the reasons that follow, Sprint's Motion for Summary Judgment will be denied. ATI's Cross-Motion for Partial Claim Construction will be granted in part. The Court will construe the claims of the patent at issue in this case as a matter of law, pursuant to the recent United States Supreme Court decision in Markman v. Westview Instruments, Inc., 116 S.Ct. 1384 (1996).

***BACKGROUND***

**A.** The '267 Patent

Applied Telematics, Inc. ("ATI") is the owner of United States Patent No. 4,757,267 (" '267 Patent"), originally issued to Bernard N. Riskin ("Riskin") on July 12, 1988. The '267 Patent, Exhibits B FN1 and C FN2 to Sprint's Motion, recites a telephone system for connecting a customer to a supplier of goods. Generally, the function of the system is to route potential customers that call a central "800" or "800-type" number to the one dealer or distributor of the desired product or service that is located the shortest

geographic distance from the caller. ATI instituted this patent infringement action against Sprint Communications Company, L.P. ("Sprint"), alleging that Sprint offers two services to its customers, Sprint TeleMedia and Enhanced 800, that infringe on Claims 1, 11, 14, 43, and 44 of the '267 Patent.

FN1. Original Patent, issued July 12, 1988.

FN2. Reexamination Certificate, issued May 21, 1991.

Claim 1 of the '267 Patent sets forth a "system" for routing a telephone call to a supplier of the desired product or service "who is located geographically nearest to the first party [or caller]." The elements of the claim are as follows:

[ (a) ] first routing means for routing said telephone call to a telephone service center relatively near said first party;

[ (b) ] location determining means including information associating each second party [dealer] with a geographic location for determining the location of said one second party which is located the shortest geographic distance from the location of the first party based at least in part on the telephone number dialed by said first party; and

[ (c) ] second routing means for routing said telephone call from said first party through said telephone service center to said one second party who can supply said item based upon the geographic location of the second party.

Claim 11 sets forth a "method" for routing a telephone call to a supplier of the desired product or service "who is located geographically nearest to the first party [or caller]." The elements of the claim are as follows:

(a) first routing of said call to a telephone service center;

(b) determining the location of said one second party based on information associating each second party with a geographic location which is located the shortest geographic distance from the location of the first party based at least in part on the telephone number dialed by said first party; and

(c) second routing of said call to said one second party who can supply said item based upon the geographic location of the second party.

Claim 14, like Claim 1, identifies a "system" for routing the call of a potential customer to a dealer that can supply the desired item and "who is located geographically nearest to the potential customer." The system identified in this claim includes the following elements:

[ (a) ] first routing means for routing the originating telephone number of said telephone call to a telephone service center relatively near said potential customer:

[ (b) ] location determining means located at said telephone service center including information associating

each second party with a geographical location for determining the location of said one dealer which is located the shortest geographic distance from the location of the potential customer based at least in part upon the telephone number dialed by said potential customer; and

[ (c) ] second routing means for routing said telephone call from said potential customer to said one who can supply said item based upon the geographic location of the second party.

Claim 43, a claim added to the '267 Patent on reexamination, discloses a "system" for routing a telephone call to a supplier of the desired product or service "who is located geographically nearest the first party [or caller]." The elements of this claim are as follows:

[ (a) ] first routing means for routing said telephone call to a telephone service center relatively near said first party;

[ (b) ] determining means for determining a location of the first party;

[ (c) ] means including information associating each second party with a geographic location for determining a second party out of said group of second parties who can supply said item and who is located geographically nearest to said first party based at least in part upon said determined location of said first party and the telephone number dialed by said first party; and

[ (d) ] second routing means for routing said telephone call from said first party through said telephone service center to said determined second party based upon the geographic location of the second party.

Finally, Claim 44, also added on reexamination, identifies a "system" for routing a potential customer's call to a "nearby" dealer. The elements of this claim are as follows:

[ (a) ] first routing means for routing said telephone call to a telephone service center relatively near said first party;

[ (b) ] means for determining the original area code (NPA) and the local central telephone office code (NNX) of said first party; [and]

[ (c) ] location determining means for determining the location of said nearby second party based at least in part on the telephone number dialed by said first party and the area code and local central office code of the first party, the location determining means comprising:

[ (1) ] a second party database representing at least some of said group of said second parties including information associating each second party with a geographic location;

[ (2) ] comparing means for comparing the area code (NPA) and the local central office code (NNX) of said first party against said second party database to identify the second party located the shortest geographic distance from said first party: and

[ (3) ] second routing means for routing said telephone call from said first party through said telephone service center to said identified second party who can supply said item based upon the geographic location of the second party.

**B. Prosecution History of** the '267 Patent

### *1. The December 27, 1990 Office Action*

In 1990 ATI petitioned the U.S. Patent and Trademark Office ("PTO") for reexamination of the '267 Patent, in order to overcome allegations by competitors that the claims in the '267 Patent were invalid in light of prior art, primarily in the form of patents owned by AT & T ("AT & T Patents" or "AT & T system"). In a December 27, 1990 Office Action in Reexamination, the PTO rejected Claims 1 through 42 of the '267 Patent. Sprint's Ex. DD. Regarding the claims at issue in this matter, the Examiner rejected Claims 1, 11, and 14 as unpatentable under 35 U.S.C. s. 102(b), which provides:

A person shall be entitled to a patent unless-

...

(b) the invention was patented or described in a printed publication in this or a foreign county or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States....

The Examiner noted that the prior art, specifically the AT & T Patents, disclosed the principle of routing

a telephone call dialed by a first party to the nearest of a group of second parties who can supply a desired service based upon the dialing of a number representing a special service required by the caller. The number dialed is routed to a center determined by the location of the callers [sic] telephone. The request for service is then forwarded to the nearest provider of that service.

Sprint's Ex. DD at 4-5. This, the Examiner determined, made the claims in the '267 Patent unpatentable. The Examiner also determined that Claim 11 was unpatentable because "it would be an obvious modification to [the prior art] by an artisan to route calls to a company location nearest the caller." Id. at 2; *see* 35 U.S.C. s. 103.

### *2. ATI's Amendment*

ATI responded, in a February 28, 1991 Amendment ("Amendment"), with the following statements:

It is respectfully submitted that the prior art as a *whole* does not suggest the presently claimed invention to one of ordinary skill in the art.... This AT & T system translates the received 800 number to a POTS number through a straight table look-up based upon the customer supplied information in the data bank and the three digit area code of the caller. That is, the AT & T system *assigns* one party to each area code and routes the call to the one party which is *assigned* to the caller's area code. Thus the AT & T system routes calls based on the *broad* geographic position of the caller by using the area code of the caller.

Sprint's Ex. J at 23-24 (emphasis in original). Differentiating the '267 Patent from the AT & T system, ATI noted that the AT & T system does not route calls to the open reservation center that is geographically closest to the caller, "but to the open reservation which will yield the most inexpensive rate." Id. at 24. ATI continued: "Thus, the AT & T system does not route calls in accordance with the shortest geographic distance between the parties, but in accordance with the most inexpensive routing which may (by

coincidence) or may not be the shortest geographic distance." Id. at 24-25.

ATI further distinguished their invention from the prior art by pointing out that the ATI system, referring specifically to Claim 11,FN3 determines the "location" of the dealer geographically closest to the caller, not the dealer "assigned" to the caller. Id. at 25. By contrast, ATI asserted, "the AT & T system determines which second party[ ] is *assigned* to the area code, or other parameter, of the calling party." Id. (emphasis in original).

FN3. Due to the similarity of the claims, the arguments made by ATI in favor of patentability of Claim 11 apply equally to Claims 1 and 14. Sprint's Ex. J at 34; *see* Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed.Cir.1995) ("[A]rguments made during prosecution regarding the meaning of a claim term are relevant to the interpretation of that term in every claim of the patent absent a clear indication to the contrary."), *cert. denied,* 116 S.Ct. 515 (1995).

ATI also questioned the Examiner's conclusion that the AT & T system could be modified to accomplish the same task as the ATI system. ATI argued:

As mentioned previously, the AT & T system is based on a straight table look-up using the area code of the caller. It is well settled that area codes used in the United States often encompass a significant geographic area....

... [T]he AT & T system cannot accommodate a plurality of second parties for the purpose of determining one second party which is located the shortest geographic distance from the location of the first party.

The present invention is different from the AT & T system in that it is concerned with geographical distances and not with rates.... At the time of the invention, it was realized that a computer could compute the nearest dealer to a caller on-line in real time faster than it could search a large data base of preplanned assignments....

*Id*. at 26-27 (emphasis in original).

Finally, ATI summarized its invention:

As mentioned previously, the present invention uses a nearest neighbor algorithm in combination with the V-H Coordinate System to calculate in real time the geographic distance between the location of the caller and the location of one or more of the dealers. Based upon the calculation, the system selects the dealer which is located the *shortest geographical distance* from the location of the caller. This concept is clearly not taught by the AT & T system which merely utilizes a straight table look-up.

*Id*. at 29-30 (emphasis in original). ATI also noted that "one of ordinary skill in the art would not modify the AT & T system to further include a table look-up based on area code and another portion of the caller's number since the system would be too cumbersome and not economically feasible." *Id*. at 30.

In addition to raising the preceding arguments, ATI amended the claim language of the '267 Patent.FN4 ATI argues that the purpose of these amendments was to maintain coverage of table look-up systems that route calls to the *nearest* dealer. The '267 Patent was modified to substitute the words "nearby" and "relatively

nearby" in the claim language with the phrase "which is located the shortest geographic distance." Sprint's Ex. C. ATI noted that "Claims 1, 11, 14, and 38 [were] amended to indicate that the system determines the location of the one second party out of a group of second parties which is located the *shortest geographic distance* from the location of the first party." Sprint's Ex. J at 12.

FN4. ATI also added new claims, Claims 43, 44, and 45, to the '267 Patent.

### *3. Reexamination Certificate Issued May 21, 1991*

The '267 Patent was amended, and a Reexamination Certificate was issued on May 21, 1991. The Examiner found that Claims 1, 11, and 14 were patentable as amended by ATI. Specifically, on reexamination, the Examiner found that the claims of the '267 Patent, as amended, "teach that the location determining means includes information that gives each second party a geographic location." ATI's Ex. O; Sprint's Ex. Y; *see* Sprint's Ex. CC. According to the Examiner, "[s]uch is not taught in the prior art."

### C. Issues Before the Court

There are two elements to a patent infringement case: (1) construing the patent, and (2) determining whether infringement occurred. Markman, 116 S.Ct. at 1393. In *Markman,* the United States Supreme Court held that the first element, construing the patent, is an issue of law for the court to resolve. The second element, whether there has been infringement, is an issue of fact to be left to a jury. *Id*. Both parties to this action seek construction of the claim language. In addition, Sprint has moved for summary judgment, asking that the Court find that its systems do not infringe on Claims 1, 11, 14, 43, or 44 of the '267 Patent.

## *DISCUSSION*

## I. CLAIM INTERPRETATION

### A. Legal Standard for Claim Interpretation

In construing the claims in a patent, courts look to three main sources: (1) the claim language, (2) the specification, and (3) the prosecution history. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd,* 116 S.Ct. 1384 (1996); Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561 (Fed.Cir.1991); SmithKline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 882 (Fed.Cir.1988). The court may also consider extrinsic evidence when helpful, such as expert testimony, learned treatises, and even sales literature. Markman, 52 F.3d at 979, 980; SmithKline, 859 F.2d at 882. The court should attempt to construe the claims as one skilled in the art would construe them. *Id*. Where a patentee chooses to be his own lexicographer, however, attributing uncommon meanings to common words, the uncommon meaning must be disclosed in the patent. Markman, 52 F.3d at 980; Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387-88 (Fed.Cir.1992).

The specification in the patent is particularly helpful in interpreting claim language. In the opinion of the United States Court of Appeals for the Federal Circuit in *Markman,* the court noted the significance of the patent specification in interpreting patent claims:

Claims must be read in view of the specification, of which they are a part. The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims.

Markman, 52 F.3d at 979 (citations omitted).

The third source for claim interpretation, prosecution history, "limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution." Southwall Technologies, Inc., 54 F.3d at 1576. "Claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers." *Id.*

**B. Methods of Routing Customer Calls**

Before construing the claims of the '267 Patent that are at issue in this case, it is worthwhile, first, to describe the two types of call-routing systems at issue in this case. The first method, which the Court will refer to as the "Real-Time Computation Method," is a means by which incoming calls are routed to the dealer located the shortest geographic distance to the caller by using a mathematical calculation, or algorithm. The first six digits of the caller's telephone number, or NPA-NXX,FN5 are compared to a V-H File, which yields the vertical (latitude) and horizontal (longitude) coordinates ("V-H coordinates" or "V-H Coordinate System") of the LCO that services the caller's line.FN6 The system employing this method then compares the V-H coordinates of the caller to the V-H coordinates of all prospective dealers using a "Nearest Neighbor" algorithm to identify the one dealer closest to the caller. This entire process takes place while the caller is on the line. *See* ATI's Brief at 4; Sprint's Mot. at 10.

FN5. "NPA" is the designation given to the first three numbers, or area code, of a telephone number. The next three numbers, designated "NXX," serve as the code for the local central telephone office ("LCO") that services the line. Each LCO is located approximately 1.5 miles from the telephone that the office serves.

Although the '267 Patent refers to the LCO code as "NNX," the parties consistently refer to this code as "NXX" throughout their filings. Accordingly, except when quoting directly from the '267 Patent, the Court will adopt the parties' position and will refer to this code as "NXX" throughout this Memorandum and accompanying Order.
FN6. ATI obtains the V-H coordinates of the LCOs on electronic media from Bell Communications Research Company. The system is set up so that given the NPA-NXX of a full telephone number, the system will yield the V-H coordinates for the local central office that services that telephone number. Sprint's Ex. B, col. 8, lns. 30-36.

Therefore, by using the V-H Coordinate System, one could determine the geographic location of a potential customer or dealer within a radius of 1.5 miles if the NPA-NXX of the customer or dealer is ascertained. *See supra* note 5.
An alternative method, which the Court will refer to as the "NPA-NXX Table Look-Up Method," routes incoming calls to a preassigned destination, based upon the caller's NPA-NXX. In essence, the system utilizing this method determines the NPA-NXX of the caller, scans a database for the caller's NPA-NXX, and locates the dealer that has been assigned to the caller's NPA-NXX. *See* ATI's Brief at 4-5.

The parties agree that the '267 Patent discloses use of the Real-Time Computation Method to route customer

calls to the nearest dealer. The essence of the claim construction dispute in this case, however, is whether the '267 Patent discloses use of the NPA-NXX Table Look-Up Method, as an alternative embodiment of the invention, to achieve the same goal.

**C. Claims 1, 11, and 14**

Of the three elements that comprise Claims 1, 11, and 14, paragraph (b) of these claims is the most significant in this case. This paragraph discloses a "location determining means," FN7 by which "information associating each second party [dealer] with a geographic location" is used to identify the dealer located "the shortest geographic distance" from the caller. In addition, Claims 3, 12, and 16, each dependant on Claims 1, 11, and 14 respectively, elaborate that the location determining means referred to in Claims 1, 11, and 14 includes a comparison means for comparing the caller's NPA-NXX against a dealer database to find the one dealer located the shortest geographic distance from the caller. Sprint's Ex. C, col. 1, lns. 64-68, col. 2, lns. 32-37 and 65-67, col. 3, lns. 1-2.

FN7. Claims 1 and 14 use the phrase "location determining means," while Claim 11 uses the phrase "determining the location." The Court sees no material distinction between these phrases in the context of the claims and, accordingly, will attribute the same meaning to both.

***1. Claim Language***

Looking solely at the claim language, the first source a court should consider in interpreting a patent claim, the Court cannot say, with any degree of certainty, that these claims exclude the NPA-NXX Table Look-Up Method of routing a caller to the nearest dealer. Indeed, as ATI argues, the plain language of these claims "is broad enough to read on both the real time calculation and table look-up methods." ATI's Reply at 4. However, the Court may not merely consider the possible interpretations of the claims, but must, instead, interpret the claims as a matter of law. The claim language is simply not dispositive of whether Claims 1, 11, and 14 teach the use of the NPA-NXX Table Look-Up Method to route incoming calls to the nearest dealer. Indeed, there is no language in these claims that explicitly refers to either method as a "location determining means." Accordingly, the Court will look to the specification and prosecution history of the '267 Patent for further guidance on this issue.

***2. Patent Specification***

The Court finds nothing in the specification that describes, discloses, or suggests an embodiment of the invention that would utilize the NPA-NXX Table Look-Up Method to route calls to the geographically nearest dealer. Indeed, the specification is rife with references that convince the Court that the location determining means identified in Claims 1, 11, and 14 is comprised of a comparison means, which employs the Real-Time Computation Method, using the V-H Coordinate System and a "Nearest Neighbor" algorithm, to route calls to the geographically nearest dealer.

The '267 Patent specifies as follows:

This invention improves upon all present methods of dealer referral by embodying the following features:

1. The telephone is answered automatically by a computer.... The computer interacts with the caller to acquire ... the callers [sic] TELEPHONE NUMBER. Given the first six digits (termed the NPA-NNX) of

the caller's telephone number, the system can determine the caller's location by reference to a telephone company computerized document called the "V-H" file....

The V-H is a complex transformation of latitude and longitude which is used by long distance telephone companies to compute the distance between a caller and a called party and thereby to assess the charge for the call. *The invention uses the V-H coordinate system to refer a caller to a dealer*.

Sprint's Ex. B., col. 2, lns. 59-end & col. 3, lns. 1-13 (emphasis added). The specification elaborates further:

In essence, the invention provides an improvement over present systems for dealer referral. It answers telephone calls automatically by computer, it employs telephone company Custom Call Routing to distribute the calls to Routing Centers in an economical manner, *it provides further routing according to the V-H coordinate system based on NPA-NXX,* and actually connects the caller to his nearest dealer instead of merely giving the dealer's identification to the caller.

Id. at col. 5, lns. 57-65 (emphasis added). In other words, the '267 Patent specification makes it clear that use of the V-H Coordinate System is the *sine quo non* of the invention. It is the V-H Coordinate System that associates each dealer with a particular geographic location.FN8 Therefore, it is the use of the V-H Coordinate System that distinguishes the '267 Patent from all previous methods of dealer referral. By using the V-H coordinates of the callers and dealers, the ATI system guarantees that every caller will be routed to the geographically nearest dealer, a function that was not necessarily guaranteed by the AT & T system.FN9

FN8. Indeed, as ATI observed in the Amendment, it is not the NPA-NXX alone that identifies the geographical location of the caller. "While admittedly, the references do disclose that the phone number of the first party is determined, this alone is not sufficient to determine the location of the first party." Sprint's Ex. J. at 47.

FN9. As stated by ATI in the Amendment, "the AT & T system does not route calls in accordance with the shortest geographic distance between the parties, but in accordance with the most inexpensive routing which may (by coincidence) or may not be the shortest geographic distance." Sprint's Ex. J. at 24-25.

Additional language in the specification makes it equally clear that the invention utilizes the Real-Time Computation Method, with little or no indication in the specification that the NPA-NXX Table Look-Up Method is an alternative means to achieve the desired result. In the portion of the specification entitled "Summary of the Invention," it is taught that "the computer proceeds to search the product/services-dealers database based upon the V-H coordinates. It *calculates* the distance between several potential dealers and the caller and chooses the closest one to the caller." Id. col. 3, lns. 61-65 (emphasis added). The specification, under the subheading "Detailed Description of the Preferred Embodiment," provides further: "The caller's NPA-NNX is searched in the V-H file and the search yields that caller's V-H coordinate. Then, using a 'Nearest Neighbor' algorithm ..., the *system chooses* a dealer nearby or nearest to the caller." Id. col. 8, lns. 37-41 (emphasis added).

The only reference in the '267 Patent specification that arguably refers to the NPA-NXX Table Look-Up Method is at column 6, lines 13 through 59, which recites how the system can be used for "territorial routing." This portion of the '267 Patent provides, in pertinent part: "The system enters the file with the

caller's NPA-NNX as the argument and retrieves the distributor's telephone number as the function." Sprint's Ex. B, col. 6, lns. 57-59. Sprint argues, however, that ATI's reliance on this portion of the specification is inappropriate, because ATI abandoned the claim in the '267 Patent that related to territorial routing on reexamination. *See* Sprint's Ex. J. at 8.

Reading the specification as a whole, the Court is unpersuaded by ATI's argument that the three-line reference to the NPA-NXX Table Look-Up Method noted above, in the context of a claim abandoned by ATI on reexamination, supports the position that the '267 Patent discloses the NPA-NXX Table Look-Up Method as an alternative location determining means. Moreover, in the portion of the specification that is captioned "Alternative Embodiment of the Invention," Sprint's Ex. B, col. 27-28, there is nothing that would support such a position. Indeed, if ATI contemplated using the NPA-NXX Table Look-Up Method as an alternative location determining means, this portion of the specification would have been the logical place to make its intentions known.

The above references, and others, convince this Court that the location determining means in Claims 1, 11, and 14 does more than merely match the NPA-NXX of a caller with a preassigned dealer. The invention actually determines, from a list of dealers, the one dealer located the shortest geographic distance from the caller. The invention accomplishes this task by employing the Real-Time Computation Method, using a "Nearest Neighbor" algorithm to compare the V-H coordinates of the caller to the V-H coordinates of the dealers. Id. at col. 8, lns. 37-42; Sprint's Ex. C, ABSTRACT.

### *3. Prosecution History*

The prosecution history of the '267 Patent, detailed above, supports the Court's interpretation of Claims 1, 11, and 14. On reexamination, ATI needed to overcome the challenges raised by its competitors. Specifically, ATI's system was challenged as being unpatentable in light of an already existing call-routing system employed by AT & T. As noted above, the AT & T system employs the NPA-NXX Table Look-Up Method to route calls to preassigned locations. The AT & T system, however, does not include a means for assigning specific geographic locations to the dealers, so as to route calls to the dealer located the shortest geographic distance from the caller. This was the reason for patentability of the claims in the '267 Patent noted by the Examiner. ATI's Ex. O; Sprint's Ex. Y; *see* Sprint's Ex. CC.

ATI relies on a portion of the Amendment in which it argued that "the use of the first six digits for the purpose of routing a call was clearly not contemplated at the time of the [AT & T] invention." Sprint's Ex. J at 29. Although ATI acknowledged that the AT & T system contemplates using a "caller's number or a part of a caller's number such as the area code" in routing customer calls, *see* Sprint's Ex. P, col. 2, lns. 46-46; Sprint's Ex. J at 28, ATI insisted that, at the time the AT & T system was invented, routing a call based on the area code and another portion of the caller's number was impracticable-that "one of ordinary skill in the art would not modify the AT & T system to further include a table look-up based on area code and another portion of the caller's number since the system would be too cumbersome and not economically feasible." Sprint's Ex. J. at 30. ATI contends that this portion of the prosecution history supports its argument that the '267 Patent discloses the NPA-NXX Table Look-Up Method as an alternative means of routing customer calls to the nearest dealer. After reading this passage of the prosecution history in context, however, the Court finds ATI's suggestion unpersuasive.

The portion of the Amendment relied upon by ATI was an apparent attempt by ATI to contradict the Examiner's conclusion that, at the time the AT & T system was invented, it was obvious that the system

could be modified to route a call to the nearest dealer, which is the primary function of ATI's system. Sprint's Ex. DD at 2.FN10 If this were the case, as the Examiner concluded, ATI's system would be unpatentable under 35 U.S.C. s. 103. However, nowhere in the portion of the Amendment relied upon by ATI, or in any other part of the prosecution history of the '267 Patent is there any indication by ATI, Riskin, or the Examiner that the '267 Patent teaches the use of the NPA-NXX Table Look-Up Method as a means to route calls to the geographically nearest dealer. On the contrary, on reexamination, ATI consistently maintained that its system "uses a nearest neighbor algorithm in combination with the V-H Coordinates System." Sprint's Ex. J. at 13-15, 29. Accordingly, the Court finds ATI's reliance on this fragment of the prosecution history unpersuasive.

FN10. In summarizing its arguments, ATI stated: "[T]he AT & T system does not include any means whatsoever for *determining the geographic position of the second parties* with sufficient accuracy to locate the one second party which is located the *shortest geographic distance* from the location of the first party." Sprint Ex. J. at 30 (emphasis in original).

### *4. Conclusion*

In short, the Court is satisfied that there is nothing in the specification or the prosecution history of the '267 Patent that would support the broad interpretation of Claims 1, 11, and 14 advocated by ATI. Therefore, it is unnecessary for the Court to look to the many conflicting expert opinions offered by the parties for further guidance in interpreting these claims. *See* Total Containment, Inc. v. Environ Prods., Inc., 921 F. Supp. 1355, 1385 (E.D.Pa.1995).FN11 Claims 1, 11, and 14 shall be construed to recite a "location determining means" that employs the Real-Time Computation Method, using a "Nearest Neighbor" algorithm to compare the V-H coordinates of a caller to the V-H coordinates of the dealers to find the one dealer located the shortest geographic distance from the caller.FN12

FN11. There is uncontradicted extrinsic evidence, however, that clearly supports the Court's legal construction of these claims. ATI's sales literature, referring to its call-routing system as "InstaLink," provides:
Conventional search processes require that a table be created which assigns each of 48,000 telephone exchanges to specific dealers. The information on these tables is static and any changes require revising the table itself. *In contrast,* InstaLink uses a proprietary nearest neighbor algorithm to search the caller's area for "nearest dealer candidates" and to calculate the geographic distance between the caller and each dealer that was identified to determine the closest appropriate location.

Sprint's Ex. M (emphasis added). Clearly, at least in its sales literature, ATI attempted to distinguish its call-routing system from its competitors' systems by disavowing use of the NPA-NXX Table Look-Up Method.
FN12. In reaching this conclusion, the Court rejects ATI's argument that the doctrine of claim differentiation precludes a legal construction of Claims 1 and 14 that would limit these claims to the Real-Time Computation Method. To adopt ATI's argument would be to ignore the clear language in the specification and the prosecution history of the '267 Patent. Accordingly, the Court finds ATI's argument unpersuasive. *See* California Medical Prods., Inc. v. Tecnol Medical Prods., Inc., 921 F.Supp. 1219, 1232 (D.Del.1995) ("[T]he true test must be that claims are defined and construed as they were drafted by the patent holder in light of the claim language, specification, and the prosecution history. Where the specification or

prosecution history provide a basis for reading a limitation into a claim, the presumption provided by the doctrine of claim differentiation may be overcome."); Total Containment, Inc., 921 F.Supp. at 1385 (noting that "[c]laim differentiation is a guide to construction, not an absolute rule).

**D. Claims 43 and 44**

The language at issue in Claims 43 and 44 of the '267 Patent, which were added on reexamination, is virtually identical to that in Claims 1, 11, and 14, and ATI has not persuaded the Court that it should interpret the terms in these claims differently.FN13 The claim language in Claims 43 and 44, like that in Claims 1, 11, and 14, could reasonably be construed as broad enough to read on both the real-time calculation and table look-up methods. However, as the Court noted above, the specification and prosecution history of the '267 Patent do not disclose, describe, or suggest an embodiment of the invention in which the NPA-NXX Table Look-Up Method would be used as a location determining means to route a call to the geographically nearest dealer. The Court is equally satisfied that, on reexamination of the '267 Patent, the Examiner found the added claims patentable because, consistent with the other claims in the '267 Patent, the location determining means in the claims "includes information that gives each second party a geographic location," ATI's Ex. O., which the Court has already determined is the dealers' V-H coordinates, not merely each dealer's NPA-NXX.FN14

FN13. Paragraph (c) of Claim 44, like paragraph (b) of Claims 1, 11, and 14, discloses a "location determining means" substantially similar to Claims 1, 11, and 14. Paragraph (c) of Claim 43 discloses a "means including information associating each second party with a geographic location for determining a second party ... who is located geographically nearest to said first party." The Court sees no material distinction between these phrases in the context of the added claims and the phrase "location determining means," as interpreted by the Court above with respect to Claims 1, 11, and 14.

FN14. *See supra* note 8 and accompanying text.

ATI maintains that added Claim 44 "more narrowly defines the location determin [ing] means as an NP[A]-NXX table look-up, as compared to claims 1, 11, and 14." ATI's Reply at 6. In fact, ATI argues that Claim 44 " *expressly* recites the use of an NPA-NXX table look-up to route calls to the nearest dealer. ATI could not have been any clearer in communicating its intent to the Examiner." Id. at 7 (emphasis in original). The portion of Claim 44 upon which ATI apparently relies is paragraph (c)(2), which teaches that the "location determining means" includes a "comparing means for comparing the area code (NPA) and the local central office code (NNX) of said first party against said second party database to identify the second party located the shortest geographic distance from said first party." A similar comparison means is set forth in dependant Claims 3, 12, and 16 of the '267 Patent.

The Court, however, is no more persuaded that the plain language of added Claim 44 teaches the NPA-NXX Table Look-Up Method as a location determining means than it was with regard to original Claims 1, 11, and 14. As the Court has already observed, neither the specification nor the prosecution history support such an interpretation. Moreover, because this Court has already determined that the location determining means referenced in the original claims of the '267 Patent is limited to use of the Real-Time Computation System, interpreting the same language in the added claims to include the NPA-NXX Table Look-Up Method as a

location determining means would, in effect, enlarge the scope of the '267 Patent to include an embodiment that would not have infringed the original claims. *See* Total Containment, Inc., 921 F.Supp. at 1385-86. Such a result would be contrary to the reasons that a patent owner may add new claims on reexamination, which are "to distinguish the invention as claimed from the prior art ... or [to respond] to a decision adverse to the patentability of a claim of the patent." 35 U.S.C. s. 305.

Accordingly, the Court will not interpret the added claims in the manner advanced by ATI and will construe added Claims 43 and 44 to recite a "location determining means" that employs the Real-Time Computation Method, using a "Nearest Neighbor" algorithm to compare the V-H coordinates of a caller to the V-H coordinates of the dealers to find that one dealer located the shortest geographic distance from the caller.

## II. SUMMARY JUDGMENT: INFRINGEMENT

### A. Standard for Summary Judgment

Under Fed. R. of Civ. P. 56(c), summary judgment "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." The Court is required, in resolving a motion for summary judgment pursuant to Rule 56, to determine whether "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). In making this determination, the evidence of the nonmoving party is to be believed, and the district court must draw all reasonable inferences in the nonmovant's favor. *See* id. at 255. Furthermore, while the movant bears the initial responsibility of informing the court of the basis for its motion, and identifying those portions of the record which demonstrate the absence of a genuine issue of material fact, Rule 56(c) requires the entry of summary judgment "after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986).

### B. Literal Infringement

The second task in a patent infringement suit is to determine whether the accused device infringes on the claims in the patent. In this case, the parties agree that the applicable standard in this inquiry is "whether the single means in the accused device which performs the function stated in the claim is the same as or an equivalent of the corresponding structure described in the patentee's specification as performing that function." FN15 D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1575 (Fed.Cir.1985); *see* Intel Corp. v. United States Int'l Trade Comm'n, 946 F.2d 821, 842 (Fed.Cir.1991). As the patent owner, ATI has the burden of proving infringement by a preponderance of the evidence. SmithKline, 859 F.2d at 889.

FN15. *See* ATI's Brief at 15; Sprint's Reply at 5.

It is undisputed that the Sprint systems at issue in this case utilize the NPA-NXX Table Look-Up Method to route customer calls. *See* ATI's Brief at 8-11; Sprint's Mot. at 22. Sprint would have the Court end its inquiry at this point, arguing that, because the Court has construed the claims of the '267 Patent to recite only the Real-Time Computation Method as a location determining means, Sprint's systems, which exclusively use the NPA-NXX Table Look-Up Method, do not infringe on the '267 Patent. The Court, however, is satisfied that the NPA-NXX Table Look-Up Method could be manipulated to perform the same

function that the Real-Time Computation Method performs in the '267 Patent.FN16 The Court is equally satisfied that resolution of the issue of infringement in this case would necessarily require the Court to resolve material factual issues that remain in dispute. Accordingly, pursuant to *Markman,* the Court will leave this element of the case to the trier of fact, and will deny Sprint's Motion for Summary Judgment.

FN16. Whether a straight table look-up approach based on a caller's NPA-NXX, with preassigned dealers, could be used to determine the dealer located the "shortest geographic distance" to the caller depends on how the tables are created. It is possible that any number of variables may be used to create the tables, including the V-H coordinates of the dealers and potential callers. Sprint's Ex. E at 126.

## *CONCLUSION*

By strenuously distinguishing its system from the prior art, in the specification, prosecution history, and even its own sales literature, ATI has essentially disclaimed use of the NPA-NXX Table Look-Up Method as a location determining means in the '267 Patent. Instead, the '267 Patent purports to be an improvement on the NPA-NXX Table Look-Up Method, as a more efficient and economical way of routing calls to the geographically nearest dealer. By incorporating the V-H Coordinate System, and by using the "Nearest Neighbor" algorithm, the ATI system determines the nearest dealer on the basis of geography, not by preassignment.

The Court finds that the claims of the '267 Patent, specifically Claims 1, 11, 14, 43, and 44, recite a system and method of routing telephone calls to the one dealer that is located the shortest geographic distance from the caller. The claims recite a location determining means that compares the NPA-NXX, and corresponding V-H coordinates of the caller, to the NPA-NXX and corresponding V-H coordinates of each dealer, and, using a "Nearest Neighbor" algorithm, that identifies the one dealer located the shortest geographic distance from the caller. The Court further finds that a system and method of routing telephone calls based on the NPA-NXX Table Look-Up Method is not supported by the specification or claim history.

Finally, because genuine issues of material fact remain with regard to infringement in this case, the Court will deny Sprint's Motion for Summary Judgment.

An appropriate Order follows.

## *ORDER*

AND NOW, this --- day of July, 1996, upon consideration of the Motion for Summary Judgment on Non-Infringement of Defendant Sprint Communications Company, L.P., Plaintiff Applied Telematics, Inc.'s Combined Brief in Opposition to Defendant's Motion for Summary Judgment and Cross-Motion for Partial Claim Construction, and the replies and responses thereto, for the reasons stated in the foregoing Memorandum, it is hereby ORDERED that:

1. Plaintiff's Cross-Motion for Partial Claim Construction is GRANTED in part as follows:

a. The claims of the '267 Patent, specifically Claims 1, 11, 14, 43, and 44, recite a system and method of routing telephone calls to the one dealer that is located the shortest geographic distance from the caller.

b. The claims recite a location determining means that compares the NPA-NXX, and corresponding V-H

coordinates of the caller, to the NPA-NXX and corresponding V-H coordinates of each dealer, and, using a "Nearest Neighbor" algorithm, that identifies the one dealer located the shortest geographic distance from the caller.

c. A system and method of routing telephone calls based on the NPA-NXX Table Look-Up Method, as described by the Court in the accompanying Memorandum, is not supported by the specification or claim history of the '267 Patent.

2. Defendant's Motion for Summary Judgment is DENIED.

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