

United States District Court,
W.D. Texas, Austin Division.

GOLDTOUCH TECHNOLOGIES INC,
v.
MICROSOFT CORPORATION.

No. A99CA336SS

Jan. 14, 2000.

David J. Beck, Eric J.R. Nichols, Beck Redden & Secret, Houston.

Gary W. Hamilton, James W. Carmon, Jr., Akin Gump Strauss, Hauer & Feld, LLP, Austin.

ORDER

SPARKS, District J.

BE IT REMEMBERED that on the 22nd day of November 1999, the Court, in accordance with *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995), *aff'd*, 116 S.Ct. 1384 (1996), held a hearing at which the parties appeared by representation of counsel and made oral arguments on their proposed claims construction. After considering the briefs, the case file as a whole, and the applicable law, the Court enters the following opinion and order.

The plaintiff's patent, referred to as the '683 patent, concerns an alleged ergonomically superior computer mouse that minimizes the amount of stress placed on the user's fingers, wrist, and hand while working at the computer. The invention is intended to conform as closely as possible to the user's neutral hand position, also referred to as the position of repose. The plaintiff claims the defendant is infringing claims 1, 6-10, and 18-22 of the '683 patent.

The construction of claims, or the definition of the terms used in the claims, is unfortunately a matter of law for the Court. When adopting a claims construction, the Court should first consider the intrinsic evidence, which includes the claims, the specification, and the prosecution history. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996) (stating that intrinsic evidence is "the most significant source of the legally operative meaning of disputed claim language"). Words in a claim are generally given their ordinary and customary meaning unless a patentee has chosen another definition which is clearly stated in the patent specification or file history. *See id.* Claims should also be construed, when possible, in a manner that will sustain their validity. *See Harris Corp. v. IXYS Corp.*, 114 F.3d 1149, 1153 (Fed.Cir.1997) ("[C]laims should be read in a way that avoids ensnaring prior art if it is possible to do so ..."); *ACS Hosp. Sys., Inc.*, 732 F.2d at 1577 (rejecting a district court's overly broad construction of claims that rendered the patent invalid).

When a term is defined in the specification, that definition is usually dispositive. *See Vitronics Corp.*, 90 F.3d at 1582 (describing the specification as the "single best guide to the meaning of a disputed term"); *Markman*, 52 F.3d at 979 (explaining that the specification may act as a dictionary when it defines terms used in the claims either expressly or by implication). However, the Court should also consider the language used in the preamble because this language can provide limitations on the invention described by the patent. *See Bell Communications v. Vitalink Communications*, 55 F.3d 615, 620-21 (Fed.Cir.1995) (citing cases); *In re Paulsen*, 30 F.3d 1475, 1479 (Fed.Cir.1994) ("[T]erms appearing in the preamble may be deemed limitations of a claim when they give meaning to the claim and properly define the invention."). The parties agree that the terms at issue may be defined exclusively by considering the intrinsic evidence; thus reliance on extrinsic evidence is not necessary. *See Vitronics Corp.*, 90 F.3d at 1583 ("In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper.").

I. Top surface having a negative slope from left to right (Claims 1, 6-10, 18-21)

The plaintiff's proposed definition is "the top surface slants downward from left to right such that the highest point is left of center." The defendant's proposed definition is "the entire top surface slopes downwardly from the left wall to the right wall so that no arch is present when viewed from the rear." The defendant objects to the plaintiff's definition because it would encompass an arch on the top of the mouse. The defendant points to the prosecution history, in which the patent examiner distinguished the '683 patent from the prior art.

In October 1996, the PTO rejected the plaintiff's application based in part on the prior art—the Gart mouse, the Bacon mouse, the Kaneko mouse, and the Maynard mouse. *See Joint Appendix ("JA") 77-78*. In January 1997, the plaintiff filed an amendment addressing the examiner's concerns. *See JA 81-89*. The plaintiff argued that "the top surface of the Gart mouse does not have a negative slope from left to right" as recited in the plaintiff's claims, but a gentle, clearly distinctive arch. *See JA 85*. The plaintiff distinguished the Bacon, Kaneko, and Maynard mice on the same grounds. *See JA 87* ("The Bacon mouse and the Kaneko mouse both have an arched top surface, not a top surface having a negative slope from left to right.").

In March 1997, the PTO again rejected the plaintiff's application in view of the prior art. *See JA 99-104*. The examiner found the slope of the Gart mouse from left to right in the range of 20 to 30 degrees to be "negative enough" to preclude the plaintiff's application. *See JA 102*. In April 1997, the plaintiff submitted another amendment, which was rejected by the PTO. *See JA 112*.

On May 21, 1997, the plaintiff had a personal interview with the examiner to discuss all pending claims. In the record of the interview, the examiner described the general nature of the meeting: "Applicant and his representative discussed the difference between the instant invention and the prior art device (including the negative slope from left to right and the curved bottoms) and the criticality of these features for operation of the invention." *JA 113*.

In its summary of interview and request for reconsideration, the plaintiff emphasized that its invention requires a negative slope from left to right in a range of 20 to 30 degrees in contrast to the Gart patent, which shows a top surface with a negative slope from center to right but a positive slope from left to center. *See JA 117*. The examiner subsequently issued an amendment which permitted certain of the plaintiff's claims. The examiner noted that although the Gart mouse had a negative slope on the top surface, the slope "is not *entirely* negative as shown in the present invention." *See JA 122* (addressing Figure 2 of the

plaintiff's invention) (emphasis added). The examiner explained that "the negative slope claimed in the present invention is critical" to obtaining the positive results intended by the patent.

Based on this history, the defendant argues the examiner only permitted the plaintiff's patent after she was convinced that the plaintiff's invention avoided the prior art by requiring an entirely negative slope from left to right. The plaintiff responds that if the examiner meant to require the slope to be entirely negative, then the examiner would have required the plaintiff to amend the patent language before awarding the patent. The plaintiff argues that the claim language itself does not require an entirely negative slope. The plaintiff further points to the drawings in the specifications, which do not show an entirely negative slope.

After considering the prosecution history, the Court finds that the defendant's definition is correct. The plaintiff avoided the prior art before the examiner by claiming the slope was entirely negative from left to right and should not be permitted to change those representations now. *See Southwall Tech, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed.Cir.1995) ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution."). If the plaintiff disagreed with the examiner's characterization of the invention as having an entirely negative slope, then the plaintiff had an obligation to correct it. FN1 The plaintiff will not be permitted to benefit from the examiner's characterization and then try to disclaim that characterization in the above-styled cause.

FN1. The record reveals that the plaintiff did file a comment on the examiner's reasons for allowance, but failed to address the examiner's conclusion that the plaintiff's invention had an entirely negative slope. *See JA 131-32.*

This same interpretation-requiring an entirely negative slope-will be applied to the definition as it applies to a negative slope from front to rear.

II. A flattened surface adjacent to said one or more buttons ... such that the user's ring finger receives support from the flattened surface (Claims 18-21)

The plaintiff's proposed definition is "a substantially flat surface on the right side of the mouse." The defendant criticizes this definition as incomplete because it would include a totally vertical surface which would be inconsistent with the purpose of the flattened surface. The defendant further argues that a wholly vertical surface is precluded by the plaintiff's representations to the Patent and Trade Office ("PTO") during the prosecution of the patent. *See JA 87* (stating that the Kaneko mouse's recessed wall cannot support the user's thumb because wall is totally vertical).

The Court is persuaded by the defendant's argument. During the prosecution, the plaintiff distinguished its invention from the prior art, specifically the Kaneko mouse, by explaining that the Kaneko mouse's recessed front wall could not support the user's thumb because it was totally vertical. This representation precludes the plaintiff from arguing here that the right side wall of the '683 patent could be totally vertical because the language of the claim itself requires the side wall to provide support to the user's ring finger. *See Southwall Tech., Inc.*, 54 F.3d at 1576. The Court will adopt the definition of "a surface that is sufficiently flat, wide, and horizontal to support a user's ring finger without the finger touching the mouse button."

III. At the front of the top surface a phalanx support (Claims 1, 6-10, 18-21)

The plaintiff's proposed definition is "an area that provides support for fingers." The defendant proposes a

significantly wordier definition: "a lateral ridge located at the front of the mouse's top surface, and on the front half of the mouse, from which the mouse's top surface slopes downwardly to the rear. This ridge supports the weight of at least the index and middle fingers so that the user need not tense those fingers to avoid accidentally activating the mouse's buttons." The majority of the defendant's proposed definition is contained in the claim language itself. The Court finds that appropriate definition to be "an area behind the buttons that provides support for the fingers."

IV. Buttons curving from the front of the top surface to the top of the front surface (Claims 1, 6-10, 18-21)

The plaintiff's proposed definition is "curved buttons that run from the forward area of the top of the mouse to the upper area of the front of the mouse." The defendant's proposed definition is "the mouse buttons extend upwardly to a ridge from which the mouse's top surface slopes downwardly to the rear."

The Court finds the claim language to be sufficiently clear and self-explanatory, especially considering the detailed drawings contained in the specification, so that no further definition is necessary.

V. Means for controlling movement of the computer cursor in a Y plane (claim 6)

The plaintiff's proposed definition is "a structure responsive to forward and backward movement of a user's finger to move the cursor in the third dimension." The defendant's proposed definition is "a structure that provides for three-dimensional control of the cursor, specifically a pointing nib and a forward/back button."

A means-plus-function element should be construed to cover only the precise structure described in the specification for performing the specified functions and the equivalents of those described structures. *See* 35 U.S.C. s. 112 para. 6; *Valmont Indus., Inc. v. Reinke Mfg., Inc.*, 983 F.2d 1039, 1042 (Fed.Cir.1993). An "equivalent" results from an insubstantial change which adds nothing of significance to the structure, material or acts disclosed in the patent specification. *See id.* at 1043. Equivalents do not include structure that were disclaimed during the prosecution proceedings. *See Apex Computer Corp. v. Nintendo Co. Ltd.*, 102 F.3d 1214, 1221 (Fed.Cir.1996), *cert. denied*, 521 U.S. 1104 (1997).

The defendant argues that the definition should expressly limit the means for performing this function to a pointing nib or a forward/back button because these are the means described by the specification. The defendant argues the claim language should not be construed to apply to a wheel, which is the means used by the defendant and other prior art.

The Court finds that the appropriate definition is "a structure that provides for three-dimensional control of the cursor, specifically a pointing nib and a forward/back button and its structural equivalents."

VI. Means for supporting the hand in a state of repose while manipulating the computer mouse (Claim 22)

The Court will adopt the definition agreed to by the parties: "the negative slope from front to rear, the negative slope from left to right, the phalanx support, and the buttons curving from the front of the top surface to the top of front surface."

VII. Means for reducing stress in wrist extensors and finger extensors while manipulating the computer mouse (Claim 22)

The parties agree that the negative slope from front to rear and from left to right are appropriate means. The plaintiff argues that the phalanx support is also an appropriate means, while the defendant argues the flattened surface adjacent to one or more said buttons is the appropriate means. The Court finds that all four are appropriate means.

VIII. Means for supporting, raising and allowing curling of the user's fingers thereby reducing tension of tendons (Claim 22)

The parties agree that the phalanx support and the buttons curving from the front of the top surface to the top of the front surface are appropriate means. The plaintiff argues that the negative slope from front to rear is also an appropriate means, while the defendant argues that the flattened surface adjacent to one or more said buttons is the appropriate means. The Court agrees with the defendant's proposed definition.

IX. Means for activation of a plurality of buttons by movement substantially perpendicular to the plane of the buttons of the user's fingers said movement in line with finger travel without lateral movement (Claim 22)

The plaintiff argues the appropriate means are the buttons curving from the front of the top surface to the top of front surface and also rotated counterclockwise when viewed from the front of the mouse. The defendant has offered no suggested means. The Court accepts the plaintiff's proposed definition.

X. Means for allowing the heel of the hand to rest and pivot on the desk (Claim 22)

The plaintiff argues the appropriate means are the negative slope from front to rear, and the negative slope from left to right. The defendant has offered no suggested means. The Court accepts the plaintiff's proposed definition.

Accordingly, the Court enters the following order:

IT IS ORDERED that the attached construction of the patent claims will be incorporated into any jury instructions given in the cause and will be applied by the Court in ruling on the issues raised in summary judgment.

CONSTRUCTION OF CLAIMS

U.S. PATENT 5,726,683

A "top surface having a negative slope from left to right" means the entire top surface slopes downwardly from the left wall to the right wall so that no arch is present when viewed from the rear.

A "top surface having a negative slope from front to back" means the entire top surface slopes downwardly from the front wall to the back wall so that no arch is present when viewed from the side.

A "flattened surface adjacent to said one or more buttons ... such that the user's ring finger receives support from the flattened surface" means a surface that is sufficiently flat, wide, and horizontal to support a user's ring finger without the finger touching the mouse button.

"At the front of the top surface a phalanx support" means an area behind the buttons that provides support

for the fingers.

The "means for controlling movement of the computer cursor in a Y plane" is a structure that provides for three-dimensional control of the cursor, specifically a pointing nib and a forward/back button and its structural equivalents.

The "means for supporting the hand in a state of repose while manipulating the computer mouse" are the negative slope from front to rear, the negative slope from left to right, the phalanx support, and the buttons curving from the front of the top surface to the top of front surface.

The "means for reducing stress in wrist extensors and finger extensors while manipulating the computer mouse" are the negative slope from front to rear, the negative slope from left to right, the phalanx support, and the flattened surface adjacent to one of more said buttons.

The "means for supporting, raising and allowing curling of the user's fingers thereby reducing tension of tendons" are the phalanx support, the buttons curving from the front of the top surface to the top of the front surface, and the flattened surface adjacent to one or more said buttons.

The "means for activation of a plurality of buttons by movement substantially perpendicular to the plane of the buttons of the user's fingers said movement in line with finger travel without lateral movement" are the buttons curving from the front of the top surface to the top of front surface and also rotated counterclockwise when viewed from the front of the mouse.

The "means for allowing the heel of the hand to rest and pivot on the desk" are the negative slope from front to rear, and the negative slope from left to right.

W.D.Tex.,2000.

Goldtouch Tech. Inc. v. Microsoft Corp.

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