

United States District Court,
D. Delaware.

ST. CLAIR INTELLECTUAL PROPERTY CONSULTANTS, INC,
Plaintiff.

v.

SONY CORPORATION, Sony Electronics, Inc., and Sony Corporation of America,
Defendants.

No. CIV. 01-557-JJF

Sept. 3, 2002.

Frederick L. Cottrell, III and Thomas H. Kovach, Esquires of Richards, Layton & Finger, Wilmington, Delaware. Of Counsel: Ronald J. Schutz, Jake M. Holdreith, Becky R. Thorson, and Carrie M. Smith, Esquires of Robins, Kaplan, Miller & Ciresi, L.L.P., Minneapolis, Minnesota. Attorneys for Plaintiff.

Josy W. Ingersoll and Adam W. Poff, Esquires of Young Conaway Stargatt & Taylor, L.L.P., Wilmington, Delaware. Of Counsel: Sidney David, Joseph S. Littenberg, Jonathon A. David, Jeffrey S. Dickey, and April M. Mayo, Esquires of Lerner, David, Littenberg, Krumholz & Mentlik, L.L.P., Westfield, New Jersey. Attorneys for Defendants.

MEMORANDUM OPINION

FARNAN, District J.

Plaintiff, St. Clair Intellectual Property Consultants, Inc. (hereinafter "St. Clair") filed this action against Defendant, Sony Corporation, Sony Electronics, Inc., and Sony Corporation of America (collectively "Sony") alleging willful infringement of United States Patent Nos. 5,138,459 (the " '459 Patent"), 6,094,219 (the " '219 Patent"), 6,233,010 (the " '010 Patent"), and 6,323,899 (the " '899 Patent") (collectively the "patents-in-suit"). FN1 Sony responds to these allegations asserting defenses of noninfringement, invalidity and laches. Sony also asserts counterclaims, including patent misuse and unfair competition. (D.I. 56 at 1).

FN1. St. Clair initially alleged infringement of United States Patent No. 5,576,757 but subsequently withdrew that patent from the litigation. (D.I. 51 at 1).

Currently before the Court is the issue of claim construction. The parties briefed their positions on claim construction and the Court held a *Markman* hearing on August 14, 2002.

I. BACKGROUND

The patents-in-suit relate to digital camera technology, specifically the asserted claims cover electronic

cameras that can save digital photographs in one of at least two file formats on a memory element. Each of the patents-in-suit has a common specification, whereby each patent claims different variations of the multiple inventive aspects and embodiments of the technology.

St. Clair is asserting the following independent claims of the patents-in-suit: the '459 Patent, claim 16; the '219 Patent, claims 1, 10, and 16; the '010 Patent, claim 1; and the '899 Patent, claims 1 and 3. (D.I. 51 at 14). The parties dispute whether the asserted claims are limited to cameras that can select among different "computer formats" associated with different manufacturer's computers, or whether the asserted claims cover cameras that allow the user to select among different "image file formats."

II. THE LEGAL PRINCIPLES OF CLAIM CONSTRUCTION

Claim construction is a question of law. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 977-78 (Fed.Cir.1995), *aff'd*, 517 U.S. 370, 388-90 (1996). When construing the claim of a patent, a court considers the literal language of the claim, the patent specification and the prosecution history. *Markman*, 52 F.3d at 979. A court may consider extrinsic evidence, including expert and inventor testimony, dictionaries, and learned treatises, in order to assist it in construing the true meaning of the language used in the patent. *Id.*, at 979-80 (citations omitted). A court should interpret the language in a claim by applying the ordinary and accustomed meaning of the words in the claim. *Envirotech Corp. v. Al George, Inc.*, 730 F.2d 753, 759 (Fed.Cir.1984). However, if the patent inventor clearly supplies a different meaning, the claim should be interpreted accordingly. *Markman*, 52 F.3d at 980 (noting that patentee is free to be his own lexicographer, but emphasizing that any special definitions given to words must be clearly set forth in patent). If possible, claims should be construed to uphold the validity of a patent. *In re Yamamoto*, 740 F.2d 1569, 1571 & n.* (Fed.Cir.1984) (citations omitted).

III. DISCUSSION

In this case, the parties dispute the meaning of the word "format." To resolve the dispute, the Court must determine whether, as Sony contends, the asserted claims are limited to cameras that can select among different "computer formats" associated with different manufacturer's computers, or whether, as St. Clair contends, the asserted claims cover cameras that allow the user to select among different "image file formats."

After considering the claim language, patent specification, and hearing the attorneys' arguments, the Court concludes that the patents-in-suit teach the selection of different image file formats. (D.I.52, Ex. A, B, C, D). The Court believes that two paragraphs of the common specification support its conclusion:

(1) The compressed digital frame is then formatted into either an *IBM PC/Clone* (*such as GIFF*) or *Apple Macintosh such as PICT II*) image file format depending on the setting selected by the operator for a user switch 17 (Fig.6) position on the control panel 2. *After formatting*, the file is written into the temporary memory buffer within the disk input/output (I/O) interface circuit 13 which, under the command of the digital control unit 9, controls the high density (1.4 Mbyte storage capacity) disk drive unit 5.

(D.I.52, Ex. D, col.4, ln.61-col.5, ln.2) (emphasis added).

(2) As shown in FIG. 7, the output of the image compression processor 12 is routed to the RAM memory 24 where the compressed image is formatted for either the *PICT II* or *GIFF* format depending on the setting of

format switch 17 (FIG.6). It should be noted that a large number of image formats for PCs exist, PICT and GIFF are the most common for the Apple and IBM PC's and therefore the preferred formats for the present invention although other formats can be easily incorporated into the design by changing the software format routines.

(D.I.52, Ex. D, col.11, ln.1-10) (emphasis added).

From the paragraphs quoted above, as well as the claim language and remaining patent specification, the Court concludes that Switch 17 allows the user to select a particular image file format, such as PICT, GIFF, or JPEG, compatible with operating systems, such as Apple and IBM, and their required memory formats. (D.I.52, Ex. D, col.4, ln.61-col.5, ln.2, col.11, ln.1-10). After the image file is formatted, per the user's selection, the image file is then written onto the memory device. In sum, the Court concludes that the term "format" relates to the image signal, and not the computer hardware.

An appropriate Order will be entered.

ORDER

At Wilmington this 3 day of September, 2002, for the reasons set forth in the Memorandum Opinion issued this date, IT IS HEREBY ORDERED that:

1. The terms "file format," "data file format," and "data format" mean "the arrangement of digital data in a file, including image, audio, text or other data and includes, at least, MPEG, JPEG, GIF, TIFF, PICT, BMP, JFIF, DCF, TXT, DOC, WPD and WAV."
2. The term "image file format" means "an arrangement of digital image data in a file and includes, at least, the file formats JPEG, GIF, TIFF, PICT, MPEG, BMP, JFIF and DCF."
3. The term "formatting said digital signal in one of a plurality of computer formats" means "arranging digital image data into one of a plurality of image file formats, including, at least, JPEG, GIF, TIFF, PICT, MPEG, BMP, JFIF and DCF."
4. The term "output data format code" means "a code stored in the camera that corresponds to a data file format."
5. The term "computer apparatus" means "a computer and any operating system or application software loaded on the computer."
6. The terms "information handling apparatus" and "information handling systems" mean "a collection of hardware and software for the purposes of handling information that includes that includes both computers and peripheral devices."

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