

United States District Court,
D. Oregon.

COLLEGENET, INC., A DELAWARE CORPORATION,
Plaintiff.

v.

APPLYYOURSELF, INC., A DELAWARE CORPORATION,
Defendant.

Nos. CV-02-484-HU, CV-02-1359-HU

Sept. 3, 2003.

John D. Vandenberg, Scott E. Davis, Kristin L. Cleveland, Klarquist Sparkman, LLP, Portland, Oregon,
Robert A. Shlacter, Stoll Stoll Berne Lokting & Shlacter, P.C., Portland, Oregon, for Plaintiff.

Kathleen C. Bricken, Garvey Schubert Barer, Portland, Oregon, Lawrence E. Carr III, Raymond C. Jones,
Timothy Feely, Carr, Morris & Graeff, P.C., Washington, D.C., for Defendant.

OPINION

HUBEL, Magistrate J.

In a July 7, 2003 Opinion and Order on the parties' cross-motions for summary judgment in this patent infringement case, I interpreted a particular claim phrase of the '042 patent regarding processing user information and making that information available to the institution. Although the parties had not requested that the particular claim language be interpreted, I found it necessary to interpret the language in order to resolve both invalidity and infringement issues that arose in the context of the motions for summary judgment.

Plaintiff moved for reconsideration of the claim construction. In an August 20, 2003 Order, I denied that motion. I also rejected an argument pertaining to that construction that plaintiff made in opposition to defendant's motion for reconsideration.

The summary judgment opinion analyzed the disputed claim phrase in accordance with Federal Circuit rules by examining the claim language and then the specification in order to determine the proper meaning of the claim phrase. July 7, 2003 Opinion & Order at pp. 12-13. Plaintiff seeks further clarification of the claim construction and additional reasoning. I write here in response to plaintiff's request.

I. The Phrase At Issue

The claim phrase at issue first appears in claim 1 of the '042 patent. It provides:

processing by the third party forms servicer the user information in accordance with the preferences of the institution of higher education to which the form is directed to make the user information available to the institution in a format specified by the institution, the third party forms servicer thereby providing to public users customized forms identified with institution [sic] of higher education and providing to the institutions custom-formatted data, while relieving the institution of the administrative burden of processing forms and payments.

35:34-44. As explained in the summary judgment opinion, I concluded that this claim language and part of the specification supported the following construction:

... the claim language indicates that the processing of the user information is by the third party forms servicer and is done in a format specified by the institution. Further, the claims suggest that the processing will relieve the institution of the administrative burden of performing the processing itself. 35:42-43; 36:55-56; 38:7-9; 38:60-61. The specification states that the invention "allows the information submitted by the applicant to be transmitted to each institution in any data format that the institution requests so the institution is not required to convert the data to a useable format." 8:22-26.

Given the claim language and the specification, the claim phrase at issue is interpreted to mean that the user information provided to the institution by the third party forms servicer is available in an unlimited number of formats and is processed wholly by the third party forms servicer and not the institution. The claims of the '042 patent describe a function of limitless formats with the formatting done by the third party forms servicer and requiring no additional formatting or "mapping" by the institution.

July 7, 2003 Opinion & Order at pp. 12-13. I also noted this construction again in slightly different language later in the Opinion:

user information provided to the institution by the servicer is available in an unlimited number of formats and is processed wholly by the third party forms servicer and not the institution. That is, the function is one of providing limitless formats for the transfer of user information from the servicer to the institution with no additional formatting or mapping performed by the institution.

Id. at p. 57.

On reconsideration, I modified the construction by first adding an additional sentence as follows:

the user information provided to the institution by the third party forms servicer is available in an unlimited number of formats and is processed wholly by the third party forms servicer and not the institution. The claims of the '042 patent describe a function of limitless formats with the formatting done by the third party forms servicer and requiring no additional formatting or "mapping" by the institution. *This construction does not preclude formatting, mapping, or other manipulation of the user information data by the institution once it is received by the institution in a format the institution specified.*

Aug. 20, 2003 Order on Reconsideration Mtns. at p. 3. I then clarified that any reference to "unlimited number of formats" and "limitless formats" should be interpreted to mean that the third party forms servicer provides the user information to the institution in any format specified by the institution. *Id.* at p. 4.

Finally, in granting defendant's motion for reconsideration, I rejected plaintiff's interpretation of the word

"format" as used in the disputed claim phrase. *Id.* at pp. 5-6. There, I indicated that "format" in the disputed claim phrase means "file format" and not "display" or "presentation" "format." *Id.*

Plaintiff contends that my construction is wrong in several respects. First, plaintiff contends that it goes against the ordinary meaning of the word "format." Second, in adopting a different construction than that presented by the ordinary meaning, plaintiff argues that I failed to cite to any part of the patent where the patent applicants acted as their own lexicographer and defined the claim terms in question in a manner contrary to their ordinary meaning. Plaintiff also contends that I failed to discuss whether there was a "clear disclaimer" of subject matter overcoming the heavy presumption in favor of the ordinary meaning of the claim language. Finally, plaintiff contends that I failed to discuss how my claim construction can withstand scrutiny when the claim as construed renders the patent unable to meet the enablement standards of 35 U.S.C. s. 112, para. 1.

II. Claim Construction Standards

In construing a claim, the court should first look to the intrinsic evidence, that is, the claims themselves, the written description portion of the specification, and the prosecution history. *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 705 (Fed.Cir.1997). Generally, claim construction begins with the words of the claim. *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed.Cir.1999).

It is standard practice that in determining the proper construction of an asserted claim, the court looks first to the intrinsic evidence—the patent specification, including of course the written description, and, if in evidence, the prosecution history. Absent an express definition in the specification of a particular claim term, the words are given their ordinary and accustomed meaning; if a term of art, it is given the ordinary and accustomed meaning as understood by those of ordinary skill in the art.

Zelinski v. Brunswick Corp., 185 F.3d 1311, 1315 (Fed.Cir.1999); *see also Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1332 (Fed.Cir.1999) ("The specification of the patent in suit is the best guide to the meaning of a disputed term."), *amended*, 204 F.3d 1359 (Fed.Cir.2000).

Terms in a claim are given their ordinary meaning to one skilled in the art unless it appears from the patent and prosecution history that the inventor used them differently. A patentee may be his own lexicographer, but any special definition given to a word must be clearly defined in the specification or file history. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996).

While examining the patent specification is appropriate, it is improper to import, or "read in" to a claim, a limitation from the specification's general discussion, embodiments, and examples. *See, e.g., Intel Corp. v. United States Int'l Trade Comm'n*, 946 F.2d 821, 836 (Fed.Cir.1991) ("Where a specification does not *require* a limitation, that limitation should not be read from the specification into the claims.") (internal quotation omitted); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed.Cir.1988) ("Although the specification may aid the court in interpreting the meaning of disputed language in the claims, particular embodiments and examples appearing in the specification will not generally be read into the claims.").

It is also improper to eliminate, ignore, or "read out" a claim limitation from a claim in order to extend a patent to subject matter disclosed, but not claimed. *See, e.g., Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 1582-83 (Fed.Cir.1996) (court cannot read a limitation out of a claim); *see*

also Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1562 (Fed.Cir.1991) (patentee cannot be allowed to expressly state throughout specification and claims that his invention includes a limitation and then be allowed to avoid that claim limitation in infringement suit by pointing to one part of specification stating an alternative lacking the specification).

Claims are not limited to the preferred embodiment. *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1158 (Fed.Cir.1997) ("as a general matter, the claims of a patent are not limited by preferred embodiments."); *see also Amhil Enters., Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1559 (Fed.Cir.1996) ("A preferred embodiment ... is just that, and the scope of a patentee's claims is not necessarily or automatically limited to the preferred embodiment.").

III. Discussion

A. Ordinary Meaning

The key terms at issue in the disputed claim phrase are "processing," "user information," "in accordance with the preferences of the institution," "make the user information available to the institution," "a format," "specified by the institution," "providing," "custom-formatted data," "relieving the institution of the administrative burden of processing forms and payments."

The primary focus of plaintiff's argument is on the word "format ." Plaintiff contends that "format" has a broad meaning, encompassing several different formatting functions, and that my construction inappropriately narrowed the meaning in this claim phrase to "file format."

I do not dispute plaintiff's assertion that "format" carries a broad meaning, including display format, print format, and/or file format. Thus, I agree with plaintiff that the ordinary meaning of format is broad and includes several different formatting functions.

As to this claim limitation, however, I conclude that the ordinary meaning, while including display or print or other types of formats, must include file format. I reach this conclusion based on the ordinary meaning because other parts of the claim phrase would be left with no meaning if "format" did not include at least file format.

The claim provides that the user information must be processed by the third party forms servicer in accordance with the preferences of the institution. This part of the claim phrase indicates that the third party forms servicer performs a "processing" function according to the institution's preferences. The next phrase, "make the user information available," indicates that the third party forms servicer will provide the institution with the processed applicant information in some manner.

"[I]n a format specified by the institution," means that the user information which has been processed by the third party forms servicer is provided to the institution by the third party forms servicer in a format specified by the institution. Here, it is important to note that the institution specifies the format. It is also important to note that there appears, at least in the claim language, to be no limitation on the formats available. For example, the claim does not state that the processed user information will be made available to the institution in one of three, five, or ten formats provided by the servicer and specified by the institution. Nor does the plain language of the claim limit the institution to a selection of display or print formats. Rather, the claim plainly puts the institution in control of designating the format that will be provided.

Next, the "thereby ... providing ... custom-formatted data, while relieving the institution of the administrative burden of processing forms and payments," clause acts as a summary of the function of the claim and indicates that by providing the processed user information to the institution as custom-formatted data in a format specified by the institution, the claim will relieve the institution's burden of processing forms. This last phrase is critical to my construction for it is the relief of the burden to the institution that instructs my reading of the term "format" to include, but not be limited to, "file format."

The only way to meet the claim limitation of relieving the institution of the burden of processing forms is if the servicer makes the user information available to the institution in a file format. While "format" is not restricted to "file format," and may include other format functions, it is only by providing a file of user information to the institution in a file format specified by the institution, that the institution is actually relieved of its burden of processing forms. While there may be print or display formats specified by the institution, if the data is not provided to the institution in a file format specified by the institution, the institution will be required to further process the data to make it useable with the institution's own information system. This is contrary to the object of the claimed function.

Construing the term this way is not contrary to the ordinary meaning of "format" because the construction acknowledges the breadth of the term and allows for other format functions to be included in the claim. Additionally, ordinary meaning is not determined in a vacuum; rather, the assessment of the ordinary meaning of a particular term is done by examining the text and context of the surrounding claim language. *See E-Pass Techs., Inc. v. 3Com Corp.*, No. 02-1593, 2003 WL 21976381, at (Fed.Cir. Aug. 20, 2003) (when determining a claim term's ordinary meaning, court looks to the usage of the disputed claim term in context); *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed.Cir.1999) (surrounding words of disputed claim language must also be considered in determining the ordinary and customary meaning of that language).

B. Specification

The specification supports my interpretation. First, as noted in the summary judgment opinion, the specification states that the invention "allows the information submitted by the applicant to be transmitted to each institution in any data format that the institution requests so the institution is not required to convert the data to a useable format." 8:22-26. Here, "format" is modified by the requirement that the institution not have to convert the data to a useable format. With this language, the servicer must transmit the user information data in a file format requested by the institution. If not, the institution will be obligated to convert the data, no matter what display format it is in, to a format it can use in its own information system.

Another part of the specification provides that:

The completed application is transmitted to the institution with the data in any format that the institution prefers. The institution can therefore upload the data directly into its applicant or student information system database, merging the information seamlessly into their existing work flow, thereby avoiding the additional expense and errors of rekeyboarding the information. The forms engine thus has the capability of outputting application information universally across platforms.

9:4-13. This part of the specification supports the interpretation of "format" as necessarily including, but not limited to, file format, and of "a format specified by the institution," as "any file format." First, it expressly states "any" format that the institution prefers, not just "a" format the institution might be forced to select.

Second, it explains that the claims specify a limitation regarding the forms engine's capability to "output" information "across platforms." Read in context, this shows that the forms engine must be able to provide the user information data in any file format specified by the institution. If not, the forms engine would not have the capability disclosed in the specification-to output information universally across platforms. Furthermore, this capability is not an improper "reading in" of a limitation from the specification into the claims. Rather, it is simply a more expansive recitation of what the claim already discloses: providing the user information data to the institution in any format the institution specifies.

Third, it is only by providing the user information in any file format specified by the institution that the institution is relieved of the burden of processing forms itself, the burden being the expense and error associated with re-keyboarding the information. This is a key point. This part of the specification supports the construction of "format" as necessarily including "file format." If the claim were satisfied by the institution being able to specify a display format or a print format, the institution would not necessarily be relieved of the additional expense and error of re-keyboarding. It is only by transmitting the information in a file format specified by the institution that the institution is relieved of these burdens. If the institution does not receive the information in a file format it specified, it does not avoid re-keying. If the institution does not avoid re-keying, then the claim limitations of relieving the institution of processing the information is not satisfied.

Fourth, this claims construction does no violence to plaintiff's preferred embodiment. Indeed, the specification language cited above in support of this construction comes from the preferred embodiment.

In summary, both the ordinary and plain meaning and the specification support an interpretation that the phrase "in a format specified by the institution," the key phrase in the disputed phrase limitation, means "any file and other formats specified by the institution." Because this interpretation is consistent with the plain and ordinary meaning and the specification, I need not address plaintiff's "lexicographer" and "clear disclaimer" arguments.

C. Enablement

Plaintiff suggests that the claim construction I have rendered regarding this disputed claim language is in error because it requires performance of a function that the specification of the '042 patent does not enable. *See Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1572, 1577 (Fed.Cir.1998) ("If the claim is susceptible to a broader and narrower meaning, and the narrow one is clearly supported by the intrinsic evidence while the broader one raises questions of enablement under s. 112 para. 1, we will adopt the narrower of the two.").

A patent application is required to "contain a written description of the invention, and of the manner and process of making and using it ... 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." 35 U.S.C. s. 112, para. 1. "To be enabling, the specification of the patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation." *Genentech Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed.Cir.1997) (internal quotation omitted).

Other than simply stating that the description of the '042 patent does not enable the performance of the claim limitation where the servicer provides user data to the institution in "any file and other format

specified by the institution," plaintiff does not support this argument with any citation to the written description or any other evidence or argument in the record. Even assuming that there is support for plaintiff's position that the written description does not allow for enablement of this function, as construed, I cannot vary from what I view as the plain and ordinary meaning of the claim language which also finds support in the specification.

CONCLUSION

For the reasons articulated in this Opinion, I adhere to my previous rulings regarding the "processing by a third party forms servicer the user information" claim language in claim 1 of the '042 patent.

IT IS SO ORDERED.

D.Or.,2003.

Collegenet, Inc., a Delaware Corp. v. Applyyourself, Inc., a Delaware Corp.

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