

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

**NORTHERN PATENT MANAGEMENT, INC,**  
Plaintiff.

v.

**HEALTHION/WEBMD CORPORATION, et al,**  
Defendants.

No. 02-CV-74873-DT

**April 20, 2004.**

Angela M. Davison, Thomas E. Anderson, Gifford, Krass, Birmingham, MI, Mark D. Schneider, Douglas W. Sprinkle, Gifford, Krass, Troy, MI, for Plaintiff.

James E. Deline, Kerr, Russell, Detroit, MI, Robert J. Gunther, Jr., Donna Goggin Patel, Latham & Watkins, New York, NY, for Defendants.

## **CLAIM CONSTRUCTION ORDER**

**ROBERT H. CLELAND, District Judge.**

On April 7, 2004, the court conducted a hearing to address the construction of relevant claims in U.S. Patent Number 5,070,452 ("Patent '452"). In this order, the court will construe the claims of Patent '452 pursuant to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996),

### **I. BACKGROUND**

As described in Patent '452's abstract, the patent covers a "computerized insurance claim processing system link[ing] the physician's office and the provider of insurance coverage by means of a central administration computer." (Patent '452 Abstract.) "The system provides up-to-date information to the provider of health care services as to insurance coverage of a patient. The system also allows real time modification of the information, including the identity of patients covered and the type of insurance benefits." ( *Id.*) The computer system provides information to the health care provider (e.g., doctors, pharmacists, and hospitals) regarding the patient's eligibility for benefits such as treatment and prescriptions. A two-way communication apparatus, such as a data terminal, is used to communicate information to the database so that a determination of whether the patient is eligible for benefits can be made. In addition, a clock function automatically modifies a patient's eligibility status at appropriate times, according to changes in the patient's group membership status. FN1

### **II. STANDARD**

Under *Markman*, a court conducting a patent infringement analysis must undergo a two-step process. First, the court must determine the meaning and scope of the protected patents. This is known as the claim construction phase and is a question of law for the court. *Markman*, 52 F.3d at 976, 979. Once the court has interpreted the claims at issue, the second step requires comparing the properly construed claim and the accused device to determine whether the accused device is infringing. *Id.* at 976. The infringement analysis generally is for the jury.

"The construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims," *Embrex, Inc., v. Serv. Eng'g Corp.*, 216 F.3d 1343, 1347 (Fed.Cir.2000) (internal quotations and citation omitted). In construing the claim, the court should keep in mind that "the language of the claim defines the scope of the protected invention." *Bell Communications Research, Inc. v. Vitalink Communications, Corp.*, 55 F.3d 615, 619 (Fed.Cir.1995). For this reason, "resort must be had in the first instance to the words of the claim, words [which are ascribed] their ordinary meaning unless it appears the inventor used them otherwise." *Id.* at 620 (internal quotations omitted). Further, "it is equally 'fundamental that claims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention.'" *Id.* (quoting *United States v. Adams*, 383 U.S. 39, 49, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966)).

In constructing a claim, the court begins with an analysis of the ordinary meaning of the disputed claim terms. The terms used in the claims bear a heavy presumption that they mean what they say, having the ordinary meaning that would be attributed to those words by persons having ordinary skill in the relevant art. *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed.Cir.2002). The court can then look to other intrinsic evidence, including, the specification, and the prosecution history if in evidence. *Interactive Gift Express, Inc. v. CompuServe, Inc.*, 256 F.3d 1323, 1331 (Fed.Cir.2001).

After exhausting the available intrinsic evidence, the court may also consider extrinsic evidence "to aid [it] in coming to a correct conclusion as to the true meaning of the language employed in the patent." *Markman*, 52 F.3d at 980. Extrinsic evidence consists of all evidence external to the patent and prosecution history, including testimony of inventors or experts, dictionaries, and learned treatises. *Id.* However, extrinsic evidence cannot be used to contradict the established meaning of claim language. *Gart v. Logitech*, 254 F.3d 1334, 1340 (Fed.Cir.2001). In sum, "the ordinary and customary meaning of a claim term may be determined by reviewing a variety of sources." *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed.Cir.2003). These sources "include the claims themselves, dictionaries and treatises, and the written description, the drawings, and the prosecution history." *Id.* (citations omitted); *see also Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378 (Fed.Cir.2002) (dictionaries are often helpful in ascertaining plain and ordinary meaning of claim language).

Although the parties' proposed claim constructions differ, the parties do agree that several of the disputed claims in this case involve "means-plus-function" language permitted under 35 U.S.C. s. 112. It is well established that s. 112 permits inventors to use generic means of expression in claim limitations provided, however, they clearly identify and describe the corresponding structures to perform the stated function in the patent specification. *Atmel v. Info. Storage Devices Inc.*, 198 F.3d 1374, 1381 (Fed.Cir.1999).

Paragraph six of s. 112 permits the use of the means-plus-function language and it provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be

construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. s. 112 para. 6. The court interprets claims written in means-plus-function format to include only the structure set forth in the specification and its equivalents. *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1476 (Fed.Cir.1998).

In construing means-plus-function claim limitations, a court employs a two-step process. First, the court identifies the particular function claimed, often called the stated or claimed function. Second, it identifies the "corresponding structure, material, or acts described [by the claimant] in the specification." 35 U.S.C. s. 112; *Harley Davidson, Inc. v. Budde*, 250 F.3d 1369, 1376 (Fed.Cir.2001); *Kudtacek v. DBC, Inc.*, 25 Fed. Appx. 837, 841, 2001 WL 1646654 (Fed.Cir.2001); *Asyst Technologies, inc. v. Empak, Inc.*, 268 F.3d 1364, 1369-70 (Fed.Cir.2001) (describing the two steps in construing a means-plus-function limitation). Unlike ordinary claims, a party choosing to write a claim in the means-plus-function format is limited to claiming the corresponding structure actually disclosed in the specification and its equivalents. *Kahn*, 135 F.3d at 1476.

Furthermore, a structure disclosed in the specification is only deemed to be "corresponding structure" if the specification clearly links or associates that structure to the function recited in the claim. *B. Braun Med., Inc. v. Abbott Lab.*, 124 F.3d 1419, 1424 (Fed.Cir.1997). As a "quid pro quo" for the convenience of using s. 112 para. 6, the patentee accepts a duty to clearly link or associate corresponding structure to the stated function. *Harley-Davidson, Inc.*, 250 F.3d at 1376. Whether or not the specification sets forth structure corresponding to the claimed function requires consideration of the specification from the viewpoint of one skilled in the art. *See, e.g., id.* (citing *In re Ghiron*, 58 C.C.P.A. 1207, 442 F.2d 985, 991 (USPQ 1971) and noting that functional-type block diagrams may be acceptable corresponding structure if they serve in conjunction with rest of the specification to enable a person skilled in the art to make a selection and practice the claimed invention).

### **III. DISCUSSION**

According to the parties, five claims are at issue in this case—Claims 4, 5, 7, 8, and 9. The parties also agree that the language used in Claims 4, 8, and 9 are nearly identical and that construction of Claim 4 will essentially resolve the construction of Claims 8 and 9, (Pl.'s Br. at 18; Defs.' Br. at 4.) Accordingly, the court need only analyze Claims 4, 5, and 7 in the discussion below, and the construction of the dispute terms in those claims will apply to all claims in the dispute.

#### **A. Preamble**

The primary dispute between the parties is whether the preamble to Claim 4 should be construed to limit the scope of the claim. "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc.*, 55 F.3d at 620, "If the preamble adds no limitations to those in the body of the claim, the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim." *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434 (Fed.Cir.2000) (citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed.Cir.1999)). An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates. However, "preamble language will limit the claim if it recites not merely a context in which the invention may be used, but the essence of the invention without which performance of the recited steps is nothing but an academic exercise." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*,

Generally, "a preamble limits the [claimed] invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Smithkline Beecham Corp. v. Excel Pharm., Inc.*, 356 F.3d 1357, 1363-1363 (Fed.Cir.2004) (citing *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed.Cir.2002)). "Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history." *Applied Materials, Inc. v. Advanced Semiconductor Materials Am., Inc.*, 98 F.3d 1563, 1572-73 (Fed.Cir.1996). For instance, "[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention," and should be construed as a limitation of the invention. *Eaton Corp. v. Rockwell Intern. Corp.*, 323 F.3d 1332, 1339 (Fed.Cir.2003) (citations omitted). Additionally, "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina Mktg. Intl., Inc.*, 289 F.3d at 808-09 (citing *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375 (Fed.Cir.2001) (A preamble may limit the invention when employed to distinguish a new use of a prior art apparatus or process)). "No litmus test defines when a preamble limits claim scope." *Id.* at 808.

### 1. Prosecution History

In this case, Defendants first argue that the preamble should limit Plaintiff's claims because it was relied upon in prosecuting the patent. FN2 The parties dispute whether Plaintiff relied on the preamble in its prosecution of Patent '452. Defendants claim that Plaintiff presented a claim that was similar to Claim 4 in all respects except for the exclusion of part (d), Claim 30 in the application, but the Examiner rejected it as obvious in view of U.S. Patent No. 4,491,725, issued to Lawrence E. Pritchard (the "Pritchard Patent"). Plaintiff abandoned its attempt to patent Claim 30. Defendants argue that "in the absence of the preamble clock function language [part (d) ], the Examiner found that an application claim similar in scope to issued Claim 4[, Claim 30 in the application,] was unpatentable in view of prior art." (Defs.' Br. at 8-9.) Thus, Defendants claim that inasmuch as the absence of part (d) resulted in Claim 30's rejection, inclusion of part (d) was necessary in the claims at issue in this case and if it was not included in the application, the Examiner would have refused to approve Claim 4 and all similar claims. Accordingly, the preamble was necessary to distinguish prior art during the prosecution of the patent, and should now be read to limit the claim. FN3 Conversely, Plaintiff argues that the body of Claim 30 was "substantially different" from the allowed claims and "there is no basis for the inferences that the preamble of claim 30 was replaced because of the absence of the "clock function means in the preamble." (Pl.'s Reply at 2.)

The court finds that the prosecution history of Claim 30 *alone* is too equivocal to justify reading the preamble of the disputed claims to limit the scope of the claim. The court is dubious about Plaintiff's recent assertion that proposed Claim 30 was substantially different from Claim 4. As demonstrated in Plaintiff's proffer to the Patent Office during prosecution of the patent that "[n]ew claim 30 is similar in scope to claim [4] except that it eliminates the recitation of a clock function," Plaintiff represented that the claims were similar except for the absence of part (d) in proposed Claim 30. (Defs.' Mot., Ex. B at NGS 846-47.) Nonetheless, upon review of Claim 30's language, the court finds that the body of Claim 30 is different from the body of the claims in dispute in this case, and the Examiner's rejection of Claim 30 does not detail the specific reasoning behind its rejection, other than the existence of prior art. Accordingly, the prosecution

history of Claim 30 is not enough, on its own, to warrant treating the preamble as a limitation.

Consideration of Plaintiff's other representations during the patent's prosecution, however, does convince the court that Plaintiff relied on the preamble to define Claim 4 and to set it apart from generally available technology. Specifically, in describing its application for Claim 4, Plaintiff clarified that it was seeking a claim to the system detailed in the entire claim (including the preamble), not just the apparatus described in the body of Claim 42, which eventually became Claim 4.

Claim 42 is directed primarily at the apparatus which is located in the office of the benefit provider/physician. Since the basic device is commercially available from a manufacturer who is unrelated to applicants, applicants make no claim to the apparatus apart from the utilization thereof in the system as claimed.

(Def.'s Surreply, Ex. 3 at NGS 1300.) Thus, Plaintiff was not simply claiming the invention as set forth in the body of Claim 4—an apparatus with the means for accomplishing multiple tasks—it was seeking a patent on the apparatus for use in conjunction with a central data base to create a system for input and retrieval of benefit information. The Examiner, therefore, was asked to not consider the apparatus on its own because it was commercially available from another entity and thus not patentable. The Examiner had to consider the apparatus along with the way in which Plaintiff intended it to be used with in the system (i.e., the central data base), which is set forth in the preamble. Accordingly, Plaintiff relied on the preamble in its explanation of its Claim to the Examiner and cannot now claim that the apparatus alone (i.e., the body of Claim 4), or only a portion of the preamble, is all that Plaintiffs sought to claim. The court concludes that the entirety of the preamble language limits Claim 4. *See Eaton Corp.*, 323 F.3d at 1340 ("Claim 14 is an example of the claim drafter choos[ing] to use both the preamble and the body to define the subject matter of the claimed invention, ... as opposed to a preamble reciting an intended use for an invention that is defined in its entirety by the body of the claim.... We therefore conclude that the preamble of claim 14 limits the claimed invention. We do not agree with Eaton that the drive line structure in the preamble can be ignored because it merely provides a 'reference point' during one of the claimed method steps.").

## 2. Antecedent Nature of Preamble

"[D]ependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention." *Catalina Mktg. Inter., Inc.*, 289 F.3d at 808. "Likewise, when the preamble is essential to understand limitations or terms in the claim body, the preamble limits claim scope." *Id.* Plaintiff admits that the following terms have antecedent basis in the preamble: "clock function," "clock function means," and central data base." FN4 Plaintiff argues that reference to the preamble is not necessary to give meaning to the terms. *See Allen Eng'g v. Battel Indus.*, 299 F.3d 1336, 1346 (Fed.Cir.2002). The court disagrees. The preamble for Claim 4 provides the purpose of the "clock function," stating that it "modifies the plan eligibility status data for individual employment group members at appropriate times related to a change in employment group membership." A definition of the "clock function," or its purpose, is not set forth anywhere in the body of the claim. Rather, the body refers back to the preamble by using the phrase "said clock function." (Patent ' 452 Col. 11:1-2.) One can determine what the clock function accomplishes only by reading the preamble. *See In re Paulsen*, 30 F.3d 1475, 1479 (Fed.Cir.1994) ("[T]erms appearing in a preamble may be deemed limitations of claim when they give meaning to the claim and properly define the invention."); *see also Belt Communications Research, Inc.*, 55 F.3d at 621 (finding that the reference to "said packets" in the claim's body referred back to the preamble, thus confirming that the preamble was a positive limitation of the

claim).

Similarly, the body of the claim refers to the "central data base" in each of its provisions, but in order to determine what the central data base consists of, one must first look to the preamble. The preamble states that the central database "consists of at least (a) employment group member identification data, (b) employment group member benefit eligibility status data, (c) defined benefit payment amounts and (d) a clock function...." (Patent '452 Col. 10:54-57.) This definition is not set forth in the claim's body, and thus the preamble is not merely superfluous. *See* Eaton Corp., 323 F.3d at 1339.

## **B. Claim Construction**

Having concluded that the preamble can be limiting, the court now turns to its construction of the disputed terms. In the discussion set forth below, the court will first address the traditional claim terms and then analyze the claims written using "means-plus-function" language.

### **1. Traditional Claim Terms**

#### **a. "Central Data Base"**

First the parties contest the construction of the term "central data base." (Patent '452 Col. 10:53.) Defendants argue that the term means a data base in a single location and that the data base must consist of elements (a) through (d) listed in the preamble. Plaintiff, on the other hand, argues that the term is not limited to a single location and that the data base must only consist of elements (a) through (c). The court first finds that the "central data base" referred to in the preamble and throughout the body of the claim must consist of elements (a) through (d). The language of the patent is clear that the data base must "consist[ ] of at least" (a), (b), (c), "and" (d). The plain language of the preamble supports a construction that includes elements (a) through (d) in the data base. Plaintiff provides no support or reasoning for its position that element (d) need not be present in the data base. *See* Bell Communications Research, Inc., 55 F.3d at 619 ("[R]esort must be had in the first instance to the words of the claim, words [which are ascribed] their ordinary meaning unless it appears the inventor used them otherwise.").

Defendants also argue that "central data base" should be limited to a data base in a single location. The court disagrees that the plain meaning of "central data base" requires a construction that it be located in only one place. The court does find that, based on the singular form of noun "data base," only one data base is contemplated in the claim's language, but it does not necessarily follow that the data base be in only one location. A single data base could potentially be maintained in multiple locations but still be centralized, and nothing in the claim language requires the data base be maintained in only one location. The court notes Defendants' argument that a person skilled in the art of computer systems would understand the term "central data base" to be a data base at only one location, as opposed to the general meaning of "central" or "centralized," which, according to the level of abstraction from which one considers the term, could encompass more than one location. The court, however, does not agree that a "central data base" necessarily must be maintained in only one location. *See* Martin Modell, *A Professional's Guide to Systems Analysis* (2d ed., McGraw-Hill 1996) (original manuscript reproduced at (<http://www.dai-sho.com/pgsa2/index.html>) ("Both centralized and decentralized data bases can be geographically dispersed or physically contiguous."). Accordingly, the court construes "central data base" as "a single data base consisting of at least (a) employment group member identification data, (b) employment group member benefit eligibility status data, (c) defined benefit payment amounts, and (d) a clock function which modifies the plan eligibility status data for individual employment group members at appropriate times related to a change in employment group

membership status."

### **b. "Health Care Benefit Plan Administrator"**

Next, the parties disagree upon the construction of "health care benefit plan administrator." (Patent '452 Col. 10:53-54.) Although the parties' proposed constructions are relatively close with respect to this term, the parties disagree as to whether the administrator must be the entity that adjudicates and pays the health care claims. The language of the claim requires the entity to engage in only plan administration, and says nothing about benefit claim adjudication or payment. Defendants, however, hope to persuade the court that the definition of administration includes the payment and adjudication of claims. Defendants cite *Managed Health Care Simplified: A Glossary of Terms* (1999), which defines plan administration as "[t]he management unit responsible for running and controlling a managed care plan. Plan administration includes such functions as accounting, billing, underwriting, servicing of accounts, marketing, and legal." Defendants also cite to the patent's specification, which allegedly indicates that billing and accounting are integral parts of the system.

The court is not persuaded that a "health care benefit plan administrator," as used in the patent, necessarily be the entity that also pays and adjudicates benefit claims. It may oftentimes be the case that the administrator pays the claim, but it need not necessarily be part of administering a benefit plan. Plaintiff drafted its patent to capture a broad range of plan administrators, not only those that adjudicate and pay claims as part of their administration of the plan. Thus, whether a plan administrator does nearly everything related to a benefit plan (e.g., underwriting, servicing of accounts, marketing, adjudication, payments, etc.) or does a minimal amount of administering, the patent would cover the entity. The scope of the broad claim language is not limited by resort to dictionary or examples in the specification. *See* Ferguson Beauguard/Logic Controls, Div. of Dover Res., Inc. v. Mega Systems, LLC, 350 F.3d 1327, 1348 (Fed.Cir.2003) ("Without proper context in selecting a dictionary definition, a court can err by importing a limitation into patent claims from a dictionary as well as from a patent specification."); *see also* Glaxo Wellcome, Inc. v. AndrX Pharm., Inc., 344 F.3d 1226, 1233 (Fed.Cir.2003) ("It is established that 'as a general rule claims of a patent are not limited to the preferred embodiment ... or to the examples listed within the patent specification.' ") (citations omitted). Accordingly, the court construes this term as simply "an entity that administers a healthcare benefit plan."

### **c. "Defined Benefit Payment Amounts"**

Similarly, Defendants attempt to use the language of the specification to limit the term "defined benefit payment amounts." (Patent '452 Col. 10:56-57.) The language in the claim itself is clear and the court sees no reason to import the limitation from the specification that the payment amounts be associated or connected with specific treatments. Accordingly, the court will adopt Plaintiff's construction.

### **d. "Two-way data communication apparatus ... "**

The parties provide little argument on this term. Nonetheless, the court finds that the plain language of this term and a complete reading of the patent supports the following construction: "a communication device capable of sending and receiving data."

### **e. Claim 5: "Two-Way Data Communication Link"**

The parties also dispute Claim 5, which states, "Apparatus as defined in claim 4 further including a two-way

data communication link between said devices and the central data base." FN5 (Patent ' 452 Col. 11:18-20.) Plaintiff argues that Claim 5 merely refers to and modifies the data communication apparatus set forth in Claim 4. In contrast, Defendants argue that Claim 5 refers to a two-way data communication link that is separate and distinct from the two-way data communication apparatus set forth in Claim 4. The court agrees with Defendants that the plain language of the claim and principles of claim differentiation supports a construction that Claim 5 is separate and distinct from the apparatus defined in Claim 4.

Claim 4 describes a system that includes a central data base as well as a two-way communication apparatus, to be placed at the benefit provider's location, which includes the means for inputting and sending data to the data base and the means for receiving and displaying data from the data base. Claim 5 adds a "two-way communication link" that is not present in Claim 4. The plain language of the claim demonstrates that the "link" is separate from the "apparatus," not merely a modifier to the "apparatus." Again, Claim 5 states "Apparatus as defined in claim 4 further including a two-way data communication link between said devices and the central data base." (Patent '452 Col. 11:18-20.) The term "said devices" in Claim 5 refers, in part, to the apparatus in Claim 4. Claim 5 states that a two-way data communication link exists between "said devices" (i.e., not as part of "said devices"). Thus, the link is not merely a part of the apparatus or redundant with the apparatus as set forth in Claim 4, it is separate and distinct.FN6

If the court were to adopt Plaintiff's proposed construction, the court would have to ignore the doctrine of claim differentiation.

There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant.

Tandon Corp. v. United States Int'l Trade Comm'n, 831 F.2d 1017, 1023 (Fed.Cir.1987); *see also* Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed.Cir.1998) ("While we recognize that the doctrine of claim differentiation is not a hard and fast rule of construction, it does create a presumption that each claim in a patent has a different scope."). In this case, Plaintiff's construction of Claim 5 would be superfluous if it merely restated what the apparatus in Claim 4 encompassed. Defendants are correct that "Claim 5's two-way data communication link is an element in addition to the subject matter set forth in Claim 4." (Defs.' Br. at 16.)

## 2. "Means-Plus-Function" Language

### a. "a clock function which modifies the plan eligibility status data for individual employment group members at appropriate times related to a change in employment group membership"

In the briefing and joint claim construction chart, it appeared that the parties agreed that this term is written using means-plus-function language. At the April 7 hearing, however, Plaintiff indicated that it believed that the term should not be treated as means-plus-function language. Plaintiff argues that the term "clock function which" in Claim 4, and the language "clock function means which" in Claim 9 does not trigger the presumption that the terms are stated in means-plus-function language because only language such as "means for" or "step for" create such a presumption. The court disagrees, and finds that Plaintiff's proposed distinction in the language is a distinction without a difference. There is no principled difference between the term "means for" and "means which," and despite Plaintiff's general argument that the terms are different, it has presented no rationale for finding that the terms have a different meaning when used in a



patent. *Phillips v. AWH Corp.*, No. 03-1269, 2004 WL 743682, (Fed.Cir. Apr.8, 2004) ("We have held that use of the word 'means' creates a presumption that s. 112, para. 6 applies."). Further, at the hearing, Plaintiff admitted that the clock function was not a tangible device or item, and thus had to be stated as a function. To determine what has been patented, the court, and the general public for that matter, would have to consult the specification to determine the appropriate structure (i.e., corresponding structure) for completing the task. Accordingly, the court concludes that this language is expressed in means-plus-function terms.

Thus, the court must first determine the stated function of the claim, and then examine the specification for clearly linked corresponding structure. *See Harley Davidson*, 250 F.3d at 1376; *see also* 35 U.S.C. s. 112(6) ("An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.").

The function to be performed is the automatic updating of the plan eligibility status for individual employment group members, in response to a change in employment group membership status, based upon date or time. The parties essentially agree to this function, and the plain language of the terms supports the court's finding.

Having determined the stated function, the court must now locate the corresponding structure that is clearly linked to that function. Upon review of the specification, the court finds that the corresponding structure is located at lines 58-62 of Column 7 and lines 25-27 of Column 8, Lines 58-62 of Column 7 state: "If no response is received in the stated time, the [administrative] computer, having an internal time clock, as known in the art, notifies the data base for [the insurance plan], and programming steps are taken to change the status of the [insured] from indeterminate to terminated." (Patent '452 at Col. 7:58-62.) Lines 25-27 of Column 8 provide: "[T]he classification was made by the computer immediately upon expiration of the option [to purchase insurance]." These are the only reference to the clock function and automatic updating in the specification, and the computer's internal time clock is the only structure mentioned in the specification that can automatically update based upon date and time .FN7 *See Harley Davidson*, 250 F.3d at 1379 ("The specification must be read as a whole to determine the structure capable of performing the claimed function"). Thus, the claim is limited to this corresponding structure and its equivalents.FN8

**b. "means for inputting beneficiary identification data and sending such identification data to the central data base for verification as to the association between the proposed beneficiary and the employment group benefit plan and, according to said clock function, the status of beneficiary eligibility"**

This language is also written in means-plus-function language because it does not recite the "structure, material, or acts" to accomplish the stated function. Rather, it sets forth the task that must be accomplished with no detail, in the claim, as to how the task is completed. *See York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed.Cir.1996) ("[T]he use of the word 'means' triggers a presumption that the inventor used this term advisedly to invoke the statutory mandates for means-plus-function clauses."). The stated function is the inputting and sending of beneficiary identification data to the central data base for the verification of the beneficiary and the employment group benefit plan and, according to the clock function, the beneficiary's status eligibility.

The corresponding structure that is clearly linked to this function is set forth in various parts of the

specification. Plaintiff agrees with Defendants that the corresponding structure is set forth in Figures 1-2A and in the description contained in line 64 of Column 3 through line 10 of Column 4. The Figures and description in the specification identify a keypad and card swipe mechanism that allows for entry of identification data (device 18 in Figure 1). Data can be entered into the apparatus by way of keypad or card swipe and the apparatus presumably includes a data port that is capable of sending data to the central data base (likely through a telephone line as set forth in Column 9:31-40, but also potentially through other links such as those used in wireless communication). Accordingly, the corresponding structure is the keypad and card swipe mechanism and the mechanism by which the apparatus sends data.

**c. "means for receiving and displaying proposed beneficiary eligibility confirmation from the central data base as a result of the inputting of beneficiary identification data"**

Again, the court finds that this element is written as a means-plus-function clause. The plain language of the claim term states the following function: receiving and displaying proposed beneficiary eligibility confirmation from the central data base in response to the inputting of beneficiary identification data. The court must next determine the corresponding structure in the specification.

The corresponding structure utilized to receive and display the eligibility confirmation is again set forth in Figure 1 (device 18) and is also described briefly at lines 21-25 in Column 5. The specification states that the eligibility status can be received and displayed on the physician's data communication apparatus or terminal. (Patent '452 Col. 5:21-25 ("[T]he eligibility record is transmitted to the physician's terminal. This means that an indication that the patient is in fact on the plan's roster, together with affirmation that the reason for the visit is covered, is transmitted.")).) Thus, this claim term is limited to the benefit provider's data communication apparatus's display screen and associated printer, and the apparatus's mechanism for receiving data, and its equivalents.

**d. "means for inputting proposed benefit identification data and sending such benefit identification data to the central data base"**

The stated function in this means-plus-function clause is the inputting of proposed benefit identification data and the sending of such information to the central data base. The corresponding structure again is the data communication apparatus, including the apparatus's keypad, card swipe mechanism, and the mechanism for sending data. The specification, including the figures, refer only to the apparatus located at the physician's office when describing the input, display, receipt, or sending of data. No other structures are identified in the specification that would be capable of inputting and sending the benefit identification data. Accordingly, the claim term is limited to the apparatus's keypad, card swipe, and mechanism for sending data, and all equivalents.

**e. "means for receiving and displaying the payment amount data from the central data base which corresponds to the previously inputted proposed benefit identification data"**

This claim term is also written in means-plus-function format and requires the court to identify the function and corresponding structure when construing the claim. First, the function is receiving and displaying payment amount data, corresponding to the proposed identification data previously entered, from the central data base. Again, the corresponding structure that accomplishes this task is the data communication terminal; specifically, the apparatus's display screen, printer, and mechanism for receiving data. ( *See* Patent '452 Col, 5:62-66 ("[D]ata regarding the net payment which the [insurance plan] will reimburse the physician is transmitted to the physician's terminal. A printer prints the relevant data on a receipt....").) The

court can locate no other corresponding structure in the specification, and Plaintiff agrees that the function is not clearly linked to any structure other than the data communication apparatus (device 18 in Figure 1).

**f. "means for Inputting and sending to the central data base a payment request based on the proposed benefit payment amount"**

The stated function for the means-plus-function language expressed in Column 11, lines 15-17 is the inputting and sending of payment requests to the central data base based upon the proposed benefit payment amount. Again, the data communication apparatus's keypad (for inputting a payment request) and the mechanism for sending data referred to above, is the corresponding structure found in the specification. ( *See* Patent '452, Figure 1.) The parties do not identify a different or additional structure and the court cannot locate one after a thorough review of the specification,

**g. Claim 7**

Finally, in the parties' June 25, 2003 final claim construction chart it appears that Defendants anticipated that Claim 7 would be in dispute. Although each party offered a proposed construction of Claim 7, neither party briefed the claim or provided analysis to support their proposed construction. Claim 7 states the following:

Apparatus as defined in claim 6 further including notice generating means interconnected with said central data base for receiving data representing changes in status of a beneficiary relative to the employment group and for generating notices of benefit plan eligibility and options associated with said eligibility for transmission to beneficiaries/employment group members; and clock means for initiating activation of said notice generating means a regulated time span following an employment group membership status change.

(Patent '452 Col. 11:26-26.) The court finds that this claim first sets forth the apparatus described in Claim 6 (which is not in dispute in this case), then adds a functional requirement to the claim. Defendants' aptly describe the function in the parties' joint final claim construction chart:

The functional language of this element requires the automatic generating of a notice in response to a change in employment group member status, to beneficiaries or employment group members regarding their benefit plan eligibility and eligibility options, specifically COBRA rights, resulting from said changes in the beneficiary's or employment group member's employment status. The clock means initiates activation of the means for generating the notice based on a regulated time span following an employment group membership status change.

(06/25/03 Final Claim Construction at 11-12.) As discussed with respect to the clock function in Claim 4, the specification indicates that the clock function is located within the administrative computer (i.e., the corresponding structure is the internal time clock in the administrative computer), ( *See* Patent '452 Col. 6:66-68 (stating that the generation of the notification is made by the administrative computer).) Further, the administrative computer activates a printer (device 170 in Figure 1) to print the notices to be provided to the beneficiaries. ( *See id.* Col. 7:1-63 (describing how the internal time clock in the administrative computer updates the status and how the administrative computer "activates a printer 170 which prints a notice which is transmitted to [the beneficiaries]").) The court finds that these devices, the internal time clock in the administrative computer and the separate printer (device 170 in Figure 1) are the corresponding structure for the function described in Claim 7.

**IV. CONCLUSION: CONSTRUCTION CHART**

Claim Language	Court's Construction
"central data base"	a single data base consisting of at least (a) employment group member identification data, (b) employment group member benefit eligibility status data, (c) defined benefit payment amounts, and (d) a clock function which modifies the plan eligibility status data for individual employment group members at appropriate times related to a change in employment group membership status.
"health care benefit plan administrator"	an entity that administers a healthcare benefit plan
"defined benefit payment amounts"	payment amounts according to a predetermined plan
"two-way data communication apparatus ..."	a communication device which is capable of sending and receiving data
Claim 5: "two-way data communication link"	the two-way data communication link is separate and distinct from the two-way data communication apparatus set forth in Claim 4
"a clock function which modifies the plan eligibility status data for individual employment group members at appropriate times related to a change in employment group membership"	<p>This limitation is in the means-plus-function format as permitted by 35 U.S.C. s. 112.</p> <p>The function is the automatic updating of the plan eligibility status for individual employment group members, in response to a change in employment group membership status, based upon date or time.</p>
	Corresponding structure includes an internal time clock in the administrative computer as set forth in lines 58-62 of Column 7 and line 25-27 of Column 8.
"means for inputting beneficiary identification data and sending such identification data to the central data base for verification as to the association between the proposed beneficiary and the employment group benefit plan and, according to said clock function, the status of beneficiary eligibility"	<p>This limitation is in the means-plus-function format as permitted by 35 U.S.C. s. 112.</p> <p>The function is the inputting and sending of beneficiary identification data to the central data base for the verification of the beneficiary and the employment group benefit plan and, according to the clock function, the beneficiary's status eligibility.</p>
	Corresponding structure includes the keypad and card swipe mechanism and the mechanism by which the two-way data communication apparatus (at the physician's location) sends data. (Patent '452 Col.3:64-Col. 4:10.)
"means for receiving and displaying"	This limitation is in the means-plus-function format as

proposed beneficiary eligibility confirmation from the central data base as a result of the inputting of beneficiary identification data"

permitted by 35 U.S.C. s. 112.

The function is receiving and displaying of proposed beneficiary eligibility confirmation from the central data base in response to the inputting of beneficiary identification data.

	Corresponding structure is the benefit provider's two-way data communication apparatus's display screen and associated printer, and the apparatus's mechanism for receiving data. ( <i>Id.</i> Col. 5:21-25 .)
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"means for inputting proposed benefit identification data and sending such benefit identification data to the central data base"

This limitation is in the means-plus-function format as permitted by 35 U.S.C. s. 112.

The function is the inputting of proposed benefit identification data and the sending of such information to the central data base.

	Corresponding structure includes the two-way data communication apparatus's keypad, card swipe, and mechanism for sending data.
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"means for receiving and displaying the payment amount data from the central data base which corresponds to the previously inputted proposed benefit identification data"

This limitation is in the means-plus-function format as permitted by 35 U.S.C. s. 112.

The function is receiving and displaying payment amount data, corresponding to the proposed identification data previously entered, from the central data base.

	Corresponding structure includes the two-way data communication apparatus's display screen, printer, and mechanism for receiving data.
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"means for inputting and sending to the central data base a payment request based on the proposed benefit payment amount"

This limitation is in the means-plus-function format as permitted by 35 U.S.C. s. 112.

The function is inputting and sending of payment requests to the central data base based upon the proposed benefit payment amount.

	Corresponding structure includes the two-way data communication apparatus's keypad and its mechanism for sending data.
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Claim 7: Apparatus as defined in claim 6 further including notice generating means interconnected with said central data base for receiving data representing changes in status of a beneficiary relative to the employment group and for generating

This limitation is in the means-plus-function format as permitted by 35 U.S.C. s. 112.

notices of benefit plan eligibility and options associated with said eligibility for transmission to beneficiaries/employment group members; and clock means for initiating activation of said notice generating means a regulated time span following an employment group membership status change.

The function is the automatic generating of a notice in response to a change in employment group member status, to beneficiaries or employment group members regarding their benefit plan eligibility and eligibility options, specifically COBRA rights, resulting from said changes in the beneficiary's or employment group member's employment status. The clock means initiates activation of the means for generating the notice based on a regulated time span following an employment group membership status change.

Corresponding structure includes the internal time clock in the administrative computer and the separate printer (device 170 in Figure 1)

IT IS SO ORDERED.

IT IS FURTHER ORDERED that, inasmuch as the court finds it unnecessary to consult the expert report, Plaintiff's "Motion in Limine to Strike the Declaration of Mr. Jonah M. Goldsmith" [Dkt. # 26] is DENIED AS MOOT.

FN1. According to Plaintiff, the clock function is "particularly directed to compliance with COBRA," the Consolidated Omnibus Budget Reconciliation Act of 1985, which "requires employers in certain circumstances to continue coverage[, or offer coverage,] for a former employee for a period of time after terminating employment." (Pl.'s Br. at 1.)

FN2. The preamble is as follows:

For use in combination with a central data base which is maintained by a health care benefit administrator and which consists of at least (a) employment group member identification data, (b) employment group member benefit eligibility status data, (c) defined benefit payment amounts and (d) a clock function which modifies the plan eligibility status data for individual employment group members at appropriate times related to a change in employment group membership status.

(Patent '452 at Col. 10:52-61.)

FN3. Defendants also argue that the prosecution of U.S. Patent 4,916,611 ("Patent '611"), Patent '452's parent application, demonstrates that the preamble was necessary to obtain a patent for Claim 4. Claims 1-16 of Patent '611 were rejected in light of prior art, specifically the Pritchard Patent, None of the rejected '611 claims included the "clock function" language found in Claim 4 of Patent '452. Defendants argue that Plaintiff canceled similar provisions in its divisional application that became Patent '452 and introduced new claims that included the "clock function" language, including Claim 4.

FN4. At the hearing, Plaintiff conceded that the clock function set forth in the preamble should likely be read as a positive limitation of Claim 4.

FN5. Claim 5 depends from Claim 4 only. Thus, the construction of this claim is of no consequence to Claim 9.

FN6. This construction is supported by Figure 1 of Patent '452, which lists the apparatus and link separately. The two-way data communication apparatus is labeled # 18, which is separate and distinct from the two-way data communication link, which is labeled # 21. Further, the specification implies that the two terms are separate. ( *See, e.g.*, Patent '452 Col 2:69-3:2 ("The physician, using data terminal 18, communicates with the administration computer 3 on data link 21, and states....").) While the preferred embodiment and specification do not generally limit the plain language of a claim, in this case they do clarify that the apparatus and link need not be one in the same (i.e., the link does not just further define the scope of the apparatus), as Plaintiff argues.

FN7. Plaintiff does not identify a corresponding structure, but does not contest that the above-cited lines from the specification describe the " 'best' mode of the invention." (Pl.'s Br. at 14.) At the hearing, Plaintiff agreed with the corresponding structure set forth in Defendants' proposed claim construction for all means-plus-function terms (although Plaintiff continued to dispute that the clock function required a means-plus-function analysis).

FN8. At the claim construction phase, the court need not, and could not, define all equivalent structures from the universe of potential equivalents. *See Asyst Techs., Inc. v. Empak, Inc.*, 268 F.3d 1364, 1373 (Fed.Cir.2001) (finding that the question of whether an accused structure is an equivalent to the disclosed structure is a question of fact); *Smithkline Beecham Corp. v. Excel Pharm., Inc.*, 356 F.3d 1357, 1361 (Fed.Cir.2004) (infringement by equivalents is a question of fact).

E.D.Mich.,2004.

Northern Patent Management, Inc. v. Healtheon/webmd Corp.

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