

United States District Court,  
E.D. Texas, Texarkana Division.

**CONSTELLATION IP, LLC,**  
Plaintiff.

v.

**AVIS BUDGET GROUP, INC., et. al,**  
Defendants.

Civil Action No. 5:07-CV-38 (LED)

**Feb. 19, 2008.**

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**CLAIM CONSTRUCTION ORDER CONSTRUING U.S. PATENT NO. 6,453,302**

**CAROLINE M. CRAVEN, United States Magistrate Judge.**

This Opinion construes terms in U.S. Patent No. 6,453,302 ("the '302 patent"). Plaintiff Constellation IP, LLC ("Plaintiff") brings this cause of action against Defendants FedEx Corporation and FedEx Corporate Services, Inc. (collectively "Defendants"), alleging Defendants infringe the '302 patent. Defendants generally deny these allegations and assert various affirmative defenses, including that the '302 patent is unenforceable due to inequitable conduct. Defendants also assert declaratory judgment counterclaims for non-infringement, invalidity, and unenforceability. On December 10, 2007, the Court conducted a claim construction hearing in this matter.

**I.**

**Background**

The '302 patent is directed to computerized methods and systems for generating customized sales presentations/proposals for customers of a selling entity. The customized sales presentations are generated to facilitate a sale of goods or services offered for sale by the selling entity. Prior to the '302 patent, sales proposals generally fell into two distinct categories. ('302 patent, col. 1:22-33). The first category included generic proposals, such as "brochures," that provided information about the seller generic to any type of customer. *Id.* These generic sales proposals tended to convey a strong sense of the seller's "look" or identity, but were not customized to any particular customer or type of customer. *Id.* The second category of sales proposals were often customized to target a specific customer or group of customers but the "look" or identity of the seller tended to become diminished as the degree of customer customization increased. *Id.*

The invention described and claimed in the '302 patent addresses the tension between customizing sales presentations for particular customers and ensuring that the seller's "look" or identity is not lost within the customization. ('302 patent, col. 1:22-33). The disclosed embodiments describe a computerized method and system for generating presentations that are customized for particular customers, while at the same time conveying a desired "look" or identity of the selling entity. The '302 patent describes that the "look" or identity of the selling entity may be directly or indirectly conveyed by the customized presentation. ('302 patent, col. 8:12-28). That is, the customized presentation may include elements which convey an impression characteristic that the customer identifies with the selling entity, such as graphics which incorporate pictures or illustrations identifiable with the selling entity. *Id.* This impression characteristic, integrated with other information in the customized presentation, may be designed to maintain or reinforce a "corporate image" of the selling entity. ('302 patent, col. 6:47-52). In other examples, the presentation is customized for a particular type of customer. ('302 patent, col. 4:50-54). For example, the '302 patent describes that the presentation may be customized differently for a computer customer as opposed to an automotive customer. *Id.*

The customer type may be determined from customer information that is received by the computer implemented system, and the customer type may be used to determine certain aspects of the customized presentation. For example, images and other content of the presentation may be selected based on the customer type. ('302 patent, col. 12:48-63). A customized presentation may be generated by integrating information identifiable with a selling entity with customer information to produce a customized presentation for the targeted customer(s) that maintains or reinforces the identity of the selling entity. Examples of such presentations are shown in Figures 18 and 19 of the '302 patent.

The system for generating the customized presentation may be implemented on a standalone computer or in a distributed computing environment. The '302 patent discloses various computer implementations for the presentation generation system, including a distributed computing environment in which information is exchanged via the Internet. (col.5:58-67). The '302 patent was issued on September 17, 2002, by the United States Patent and Trademark Office ("PTO"). Constellation has asserted claims 1-3, 6, 8-16, 19.

The parties filed claim construction briefs and respective responses thereto, and on December 11, 2007, the Court held a claim construction hearing. After considering the parties' submissions, arguments of counsel, and all other relevant pleadings and papers, the Court finds that the claims of the patents-in-suit should be construed as set forth herein.

## II.

### **The Legal Principles of Claim Construction**

A determination of patent infringement involves two steps. First, the patent claims are construed, and, second, the claims are compared to the allegedly infringing device. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1455 (Fed.Cir.1998) ( *en banc* ).

The claims of a patent define the invention to which the patentee is entitled the right to exclude." *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005) ( *en banc* ). In claim construction, courts examine the patent's intrinsic evidence to define the patented invention's scope. *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861 (Fed.Cir.2004); *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1267 (Fed.Cir.2001).

The legal principles of claim construction were recently examined by the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005) ( *en banc* ). Reversing a judgment of non-infringement, an *en banc* panel specifically identified the question before it as: "the extent to which [the court] should resort to and rely on a patent's specification in seeking to ascertain the proper scope of its claims." *Id.* at 1312. Addressing this question, the Federal Circuit specifically focused on the confusion that had amassed from its scattered decisions on the weight afforded dictionaries and related extrinsic evidence as compared to the intrinsic record. Ultimately, the court found that the specification, "informed, as needed, by the prosecution history," is the "best source for understanding a technical term." *Id.* at 1315 ( *quoting* *Multiform Dessicants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed.Cir.1998). However, the court was mindful of its decision and quick to point out that *Phillips* is not the swan song of extrinsic evidence, stating:

[W]e recognized that there is no magic formula or catechism for conducting claim construction. Nor is the court barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.

*Phillips*, 415 F.3d at 1324. Consequently, this Court's reading of *Phillips* is that the Federal Circuit has returned to the state of the law prior to its decision in *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed.Cir.2002), allotting far greater deference to the intrinsic record than to extrinsic evidence. "[E]xtrinsic evidence cannot be used to vary the meaning of the claims as understood based on a reading of the intrinsic record." *Phillips*, 415 F.3d at 1319.

Additionally, the Federal Circuit in *Phillips* expressly reaffirmed the principles of claim construction as set forth in *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), *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576 (Fed.Cir.1996), and *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111 (Fed.Cir.2004). Thus, the law of claim construction remains intact. Claim construction is a legal question for the courts. *Markman*, 52 F.3d at 979. The claims of a patent define that which "the patentee is entitled the right to exclude." *Innova*, 381 F.3d at 1115. And the claims are "generally given their ordinary and customary meaning" as the term would mean "to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Vitronics*, 90 F.3d at 1582. However, the Federal Circuit stressed the importance of recognizing that the person of ordinary skill in the art "is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips*, 415 F.3d at 1313.

Advancing the emphasis on the intrinsic evidence, the *Phillips* decision explains how each source, the claims, the specification as a whole, and the prosecution history, should be used by courts in determining

how a skilled artisan would understand the disputed claim term. *See, generally, id.* at 1314-17. The court noted that the claims themselves can provide substantial guidance, particularly through claim differentiation. Using an example taken from the claim language at issue in *Phillips*, the Federal Circuit observed that "the claim in this case refers to 'steel baffles,' which strongly implies that the term 'baffles' does not inherently mean objects made of steel." *Id.* at 1314. Thus, the "context in which a term is used in the asserted claim can often illuminate the meaning of the same term in other claims." *Id.* Likewise, other claims of the asserted patent can be enlightening, for example, "the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Id.* at 1315 (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed.Cir.2004)).

Still, the claims "must be read in view of the specification, of which they are part." *Markman*, 52 F.3d at 978. In *Phillips*, the Federal Circuit reiterated the importance of the specification, noting that "the specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" 415 F.3d at 1315 (quoting *Vitronics*, 90 F.3d at 1582). To emphasize this position, the court cites extensive case law, as well as "the statutory directive that the inventor provide a 'full' and 'exact' description of the claimed invention." *Id.* at 1316 (citing *Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed.Cir.2003)); *see also* 35 U.S.C. s. 112, para. 1. Consistent with these principles, the court reaffirmed that an inventor's own lexicography and any express disavowal of claim scope is dispositive. *Id.* at 1316. Concluding this point, the court noted the consistency with this approach and the issuance of a patent from the Patent and Trademark Office and found that "[i]t is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Id.* at 1317.

Additionally, the *Phillips* decision provides a terse explanation of the prosecution history's utility in construing claim terms. The court simply reaffirmed that "the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.* (citing *Vitronics*, 90 F.3d at 1582-83). It is a significant source for evidencing how the patent office and the inventor understood the invention. *Id.*

Finally, the Federal Circuit curtailed the role of extrinsic evidence in construing claims. In pointing out the less reliable nature of extrinsic evidence, the court reasoned that such evidence 1) is by definition not part of the patent, 2) does not necessarily reflect the views or understanding of a person of ordinary skill in the relevant art, 3) is often produced specifically for litigation, 4) is far reaching to the extent that it may encompass several views, and 5) may distort the true meaning intended by the inventor. *See id.* at 1318. Consequently, the Federal Circuit expressly disclaimed the approach taken in *Texas Digital*. While noting the *Texas Digital* court's concern with regard to importing limitations from the written description-"one of the cardinal sins of patent law," the Federal Circuit found that "the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history." *Id.* at 1320. Thus, the court renewed its emphasis on the specification's role in claim construction.

Many other principles of claim construction, though not addressed in *Phillips*, remain significant in guiding this Court's charge in claim construction. The Court is mindful that there is a "heavy presumption" in favor of construing claim language as it would be plainly understood by one of ordinary skill in the art. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed.Cir.1999); *cf. Altiris, Inc., v. Symantec Corp.*, 318 F.3d 1364, 1372 (Fed.Cir.2003) ("[S]imply because a phrase as a whole lacks a common

meaning does not compel a court to abandon its quest for a common meaning and disregard the established meaning of the individual words.") The same terms in related patents are presumed to carry the same meaning. *See Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed.Cir.2003) ("We presume, unless otherwise compelled, that the same claim term in the same patent or related patents carries the same construed meaning.") "Consistent use" of a claim term throughout the specification and prosecution history provides "context" that may be highly probative of meaning and may counsel against "[b]roadening of the ordinary meaning of a term in the absence of support in the intrinsic record indicating that such a broad meaning was intended ...." *Nystrom v. TREX Co.*, 424 F.3d 1136, 1143-46 (Fed.Cir.2005).

Claim construction is not meant to change the scope of the claims but only to clarify their meaning. *Embrex, Inc. v. Serv. Eng'g Corp.*, 216 F.3d 1343, 1347 (Fed.Cir.2000) ("In claim construction the words of the claims are construed independent of the accused product, in light of the specification, the prosecution history, and the prior art .... 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.") (citations and internal quotations omitted). Regarding claim scope, the transitional term "comprising," when used in claims, is inclusive or open-ended and "does not exclude additional, unrecited elements or method steps." *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1235 (Fed.Cir.2005) (citations omitted). Claim constructions that would read out the preferred embodiment are rarely, if ever, correct. *Vitronics*, 90 F.3d at 1583-84.

The Court notes that a patent examiner's "Reasons for Allowance," where merely summarizing a claimed invention and not specifically noting that patentability is based on a particular feature, do not limit the scope of the claim. *See Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1375 (Fed.Cir.2003). Similarly, an examiner's unilateral statements in a "Notice of Allowance" do not result in the alteration of claim scope. *See id.*; *see also Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1346-47 (Fed.Cir.2005). "[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable." *Omega Eng'g*, 334 F.3d at 1326. The Federal Circuit has "declined to apply the doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous." *Id.* at 1324.

The doctrine of claim differentiation is often important in claim construction. *Phillips*, 415 F.3d at 1315 (citing *Liebel-Flarsheim*, 358 F.3d at 910). "Claim differentiation" refers to the presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim. *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380 (Fed.Cir.2006). This is in part because "reading an additional limitation from a dependent claim into an independent claim would not only make that additional limitation superfluous, it might render the dependent claim invalid." *Id.*; *see also SRI Int'l. v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1122 (Fed.Cir.1985) ("It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement.") This doctrine is based in part on the presumption that each claim has a different scope. 35 U.S.C. s. 282; *Curtiss-Wright*, 438 F.3d at 1380. The difference in meaning and scope between claims is presumed to be significant to the extent that the absence of such difference in meaning and scope would make a claim superfluous. *Free Motion Fitness, Inc. v. Cybex Int'l*, 423 F.3d 1343, 1351 (Fed.Cir.2005). Although a validity analysis is not a regular component of claim construction, if possible claims should be construed to preserve their validity. *Phillips*, 415 F.3d at 1327; *see also Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed.Cir.1999).

To respect a patent's presumption of validity, *see* 35 U.S.C. s. 282, a court should hold a claim indefinite

only after reasonable efforts at construction prove futile. Exxon Research Research & Eng'g v. United States, 265 F.3d 1371, 1375 (Fed.Cir.2001). A claim is not indefinite merely because it poses a difficult issue of claim construction. Bancorp Services LLC v. Hartford Life Insurance Co., 359 F.3d 1367, 1371 (Fed.Cir.2004). "Only claims not amenable to construction or insolubly ambiguous are indefinite" and thus invalid. Datamize L.L.C. v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed.Cir.2005) (internal quotes omitted). If the claim's meaning is discernable, "even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree," the claim is "sufficiently clear to avoid invalidity on indefiniteness grounds." Exxon Research, 265 F.3d at 1375. A party must show invalidity for indefiniteness by clear and convincing evidence, and close questions of indefiniteness "are properly resolved in favor of the patentee." Datamize, 417 F.3d at 1348; Exxon Research, 265 F.3d at 1380.

Guided by these principles of claim construction, this Court directs its attention to the patent-in-suit and the disputed claims terms.

### III. CONSTRUCTION OF THE '302 PATENT

#### A. Background

The patent describes multiple embodiments for implementing the claimed inventions, and Figures 1 and 5 illustrate two of those embodiments in block diagram form. Constellation asserts the patent makes clear that the illustrative embodiments were not intended to be limiting ( *see id.* at 9:52-56), and the intrinsic evidence provides no basis to deviate from the "general rule that terms in the claim are to be given their ordinary and accustomed meaning." Gart v. Logitech, Inc., 254 F.3d 1334, 1341 (Fed.Cir.2001).

#### B. The Claim Terms

Claim 1 of the '302 patent is reproduced below with the disputed claim terms underlined:

1. A computer implemented method of *generating a customized proposal for a customer of a selling entity* to facilitate a sale of a *commodity* offered for sale by the selling entity to the customer, the computer system including a memory arrangement and at least one processing unit, the method comprising the steps of:

storing, in the memory arrangement, a plurality of *selling entity images*, each of said selling entity image having a corresponding visual *impression characteristic* which the customer of the selling entity identifies with the selling entity;

developing a customer solution for the customer based on customer information received in the computer system, the customer information representing an interest of the customer in the *commodity*;

retrieving a selling entity image from the plurality of *selling entity images*;

generating a *proposal image* by *integrating a customer solution specific image with the selected selling entity image to reflect a portion of the customer solution in a manner which maintains the corresponding visual impression characteristic of the selected selling entity image*; and

*outputting* the proposal image for presentation of the customer solution to the customer *in a manner which reinforces the identity of the selling entity*.

('302 patent at Claim 1 (emphasis added)).

Claims 2, 3, 6, 8-16, and 19 of the '302 patent are reproduced below with the disputed claim terms underlined:

2. The method as recited in claim 1, further including the step of identifying a *presentation output template* based on the customer solution, the *presentation output template* defining a manner in which customer solution information is integrated with the selling entity element.

3. The method as recited in claim 2, wherein the selected selling entity element comprises an image.

6. The method of claim 1, wherein the *impression characteristic indirectly conveys* the corporate image of the selling entity to the customer.

8. The method of claim 1, wherein the customer solution comprises text.

9. The method of claim 1, wherein the customer solution comprises a picture.

10. The method of claim 1, further including the step of identifying and retrieving a *presentation output template*, wherein the *presentation output template* defines the selling entity element.

11. A computer system for generating a customized presentation for a customer of a selling entity to facilitate a sale of a product offered for sale by the selling entity to the customer, the computer system comprising:

a memory arrangement storing a plurality of *selling entity elements*, each of said selling entity elements having a corresponding *impression characteristic* which the customer of the selling entity identifies with the selling entity;

a plurality of subsystems, including at least one processing unit coupled to access the memory arrangement, the plurality of subsystems including:

a customer solution subsystem provided to develop a customer solution for the customer based on customer information received in the customer solution subsystem representing an interest of the customer in the product, and

a *presentation item* generating subsystem provided to retrieve a selling entity element from the plurality of *selling entity elements* and to generate a *presentation item* by integrating, in a manner which maintains the corresponding impression characteristic of the selected selling entity element, customer solution information with the selected selling entity element to reflect a portion of the customer solution; and

an output device provided to output a customized presentation for presentation of the customer solution *in a manner which reinforces the identity of the selling entity*.

12. A computer implemented method of generating a customized *presentation item* to facilitate a sale of a product offered for sale by the selling entity to a plurality of different types of customers, the computer system including a memory arrangement and at least one processing unit, the method comprising the steps

of:

storing one or more *selling entity elements* in the memory arrangement, the selling entity element being identifiable with the selling entity by customers of the selling entity;

storing a plurality of *customer type* elements in the memory arrangement, the customer type elements corresponding to different types of customer for the product offered for sale by the selling entity; receiving customer profile information of a particular customer; receiving information indicative of the particular customer's interests in the product;

generating a customer solution for the particular customer based on the customer's interest in the product;

determining from the customer profile information a *customer type* of the particular customer;

retrieving, from the plurality of *customer type* elements, a *customer type* element corresponding to the *customer type* of the particular customer;

retrieving a selling entity element from the plurality of *selling entity elements*; and

*integrating the selected customer type element and the selected selling entity element into an integrated presentation output* customized for the particular customer based on the customer solution.

13. A method as recited in claim 12, wherein the *customer type* corresponds to a different target market for the product and the plurality of *customer type* elements represent the different target markets.

14. The method as recited in claim 12, further including the step of identifying a *presentation output template* based on the customer solution, the *presentation output template* defining the manner of integration of the *customer type* element and the selected selling entity element.

15. The method as recited in claim 14, wherein the step of retrieving the selling entity element includes the step of retrieving a selling entity element indicated by the *presentation output template*.

16. The method as recited in claim 14, wherein the step of retrieving the customer type element includes the steps of: identifying a group of *customer type* elements indicated by the *presentation output template*, and retrieving a *customer type* element from the group of *customer type* elements which corresponds to the *customer type* of the particular customer.

19. A computer system for generating a customized *presentation item* to facilitate a sale of a product offered for sale by the selling entity to a customer, the system comprising:

a memory arrangement, the memory arrangement storing one or more selling entity elements selected to be identifiable by customers of the selling entity as being associated with the selling entity and a plurality of *customer type* elements, each *customer type* elements corresponding to a different target market for the product offered for sale by the selling entity; and

a plurality of subsystems, including at least one processing unit, coupled to the memory arrangement to facilitate generation of a *presentation item* customized for a particular customer, the plurality of subsystems

including:

a customer information subsystem provided to receive and store within the memory arrangement customer information, the customer information including customer type information indicative of a target market associated with the particular customer and customer interest information indicative of interests of the particular customer in the product offered for sale by the selling entity, and

a presentation generation subsystem provided to automatically retrieve, from the memory arrangement, a *customer type* element corresponding to the target market indicated by the customer information as being associated with the particular customer and a selected selling entity element, and to *integrate the retrieved customer type element and the retrieved selling entity element into a presentation output* customized for the particular customer based on the customer interest information.

('302 patent at claims 2, 3, 6, 8-16, and 19) (emphasis added).

## **1. Undisputed Claim Terms**

The parties have agreed on the construction of the following claim terms. The parties agree "product" should be construed as "product or service." The parties agree the terms "retrieving," "selected," and "output device" do not need construction; they should be given their ordinary meanings. The parties agree the terms "integrating ... to reflect ... in a manner which maintains the corresponding visual impression characteristic" (Claim 1) and "integrating, in a manner which maintains the corresponding impression characteristic" (Claim 11) should be construed as "bringing together (parts or elements) in a way that maintains the corresponding visual impression characteristic." The parties further agree the terms "integrating ... into an integrated presentation" (Claim 12) and "integrate ... into a presentation output" (Claim 19) should be construed as "to put or bring together (parts or elements) so as to form a presentation." The Court agrees with the parties' proposed constructions.

## **2. Disputed Claim Terms**

Constellation requests the Court construe two additional terms appearing in the '302 patent: "customized proposal" and "commodity." FedEx proposes constructions for fourteen disputed terms or groups of terms discussed below. FedEx contends that five claim terms at issue—"impression characteristic," "selling entity element," "in a manner which reinforces ...," "indirectly conveys," and "corporate image"—are indefinite under 35 U.S.C. s. 112(2). In the event that FedEx's indefiniteness challenges fail, FedEx proposes alternative claim constructions for these five claim terms.

FedEx has also moved for summary judgment of indefiniteness as to those terms. *Halliburton Energy Servs., Inc. v. M-I, LLC*, 456 F.Supp.2d 811, 822-23 (E.D.Tex.2006). Before turning to claim construction, the Court will address the indefiniteness arguments raised in the motion for summary judgment and the claim construction briefing. If any of the terms at issue are found indefinite, there would be no need to construe any claim that contains such term or terms.

## **C. Indefiniteness**

A patent is presumed valid. 35 U.S.C. s. 282. Overcoming this presumption requires a presentation of clear and convincing evidence of invalidity. *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1378 (Fed.Cir.2005) (citations omitted). That standard of proof also applies in the summary judgment context. *Id.*

(citations omitted). Thus, "[a] party asserting that a claim is indefinite bears the burden to show this by clear and convincing evidence." *Blackboard, Inc. v. Desire2Learn, Inc.*, 2007 U.S. Dist. LEXIS 56680, \*20-21 (E.D.Tex.) ( *citing* *Datamize v. Plumtree Software Inc.*, 417 F.3d 1342, 1347-48 (Fed.Cir.2005)).

In order to comply with the requirements of 35 U.S.C. s. 112(2), a patent claim must describe the invention with sufficient clarity for a patentee's competitor to determine whether or not it infringes. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28-29, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). Consistent with this principle, patent claims cannot have a scope that depends "solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention.... Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention." *Datamize*, 417 F.3d at 1350 (citation omitted).

The trial court must decide whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. " *Seattle Box Co., Inc. v. Industrial Crate & Packing, Inc.*, 731 F.2d 818, 826 (Fed.Cir.1984). The use of "words of degree" does not "automatically render a claim invalid." *Id.* (upholding validity of claim using term "substantially equal to"). Moreover, definiteness is not defeated merely because persons skilled in the art might disagree about the scope of the claims at issue. *InterTrust Technologies Corp. v. Microsoft Corp.*, 275 F.Supp.2d 1031, 1045 (N.D.Cal.2003). This Court has held that patent claims are indefinite where "[t]here is no objective standard to allow one of ordinary skill to design around the invention." *Cisco Sys., Inc. v. Telcordia Techs., Inc.*, No. 9:06-cv-160, 2007 WL 2316272, at (E.D.Tex. Aug.10, 2007) (finding subjective claim term indefinite in *Markman* opinion).

Definiteness does not compel absolute clarity, and the definiteness of a claim term depends on whether that term can be given any reasonable meaning. *Datamize*, 417 F.3d at 1347. As stated earlier herein, a claim is not indefinite merely because it poses a difficult issue of claim construction. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1376 (Fed.Cir.2001). A claim is sufficiently clear to avoid invalidity on indefiniteness grounds "if the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree." *Id.*

Here, FedEx asserts that the terms "impression characteristic," "corporate image," "indirectly conveys" and "in a manner which reinforces the identity" require an analysis of "the subjective judgment of the customer," and therefore are indefinite. FedEx relies on, among other cases, *Datamize v. Plumtree Software Inc.*, 417 F.3d 1342 (Fed.Cir.2005). The term at issue in *Datamize* was an "aesthetically pleasing" look and feel. The Federal Circuit was easily able to determine the ordinary meaning of aesthetically pleasing as "having beauty that gives pleasure or enjoyment." *Id.* at 1348. But, the court was unable to determine any objective standard by which to measure this definition. For example, the court looked to the specification and the prosecution history and determined that neither limited the subjectivity of "aesthetically pleasing" look and feel. *Id.* at 1350. The question was not whether the term at issue had some definition-the question was whether the term provided objective guidance on its scope.

The Federal Circuit noted that the specification contained examples of aesthetic features of screen displays, but the specification did not explain what particular selection of features would be "aesthetically pleasing" and concluded that the patent "provides no guidance to a person making aesthetic choices such that their choices will result in an 'aesthetically pleasing' look and feel of an interface screen." *Id.* at 1352. As such, the Federal Circuit found that the scope of "aesthetically pleasing" look and feel necessarily depended on an undefined standard, and the claims were indefinite under 35 U.S.C. s. 112. *Id.* at 1352-1353 ("Reference to undefined standards, regardless of whose views might influence the formation of those standards, fails to

provide any direction to one skilled in the art attempting to determine the scope of the claimed invention ... the definition of 'aesthetically pleasing' cannot depend on the undefined views of unnamed persons, even if they are experts, specialists, or academics .").

Turning to the five claim terms at issue in this case, claims 1 and 11 require an "*impression characteristic* which the customer of the selling entity identifies with the selling entity," and claim 6 requires an "*impression characteristic*" that "*indirectly conveys the corporate image of the selling entity to the customer.*" Claim 1 further requires presenting "the customer solution to the customer in a manner which *reinforces the identity of the selling entity.*" ('302 patent at 14:38-40; 14:53-54).

FedEx asserts these claim terms are subjective and explicitly tied to the perspective of each customer. For example, FedEx argues that what might "reinforce identity" to some customers might not "reinforce identity" to other customers, leaving no objective standard for the public to determine the scope of the invention. *Datamize*, 417 F.3d at 1350. However, the Court is of the opinion the phrase "in a manner which reinforces the identity" in the '302 patent does not refer to how a customer may subjectively view a company. Nothing in the specification supports FedEx's argument that the phrase is indefinite as being "subjective." This phrase is not indefinite.

FedEx further asserts, among other things, that "impression characteristic" is indefinite under 35 U.S.C. s. 112(2) because it is a subjective term. FedEx offers a similar argument with respect to the term "selling entity element." The specification gives specific examples of "impression characteristics" - "the layout, color, fonts and font size, of a particular publication of the selling entity." ('302 patent, 8:65-67). The "impression characteristic," when used in connection with "selling entity element," is the characteristic of the selling entity which conveys the identity of the seller to the seller's customers (such as, for example, a color scheme or particular font). ('302 patent, 1:51-54, 3:43-46, 6:15-17, 8:17-28). As the claim language and the specification make clear, selling entity elements/images have corresponding "impression characteristics." Just as the "selling entity element" and "selling entity image" are identifiable by persons having ordinary skill in the art, persons of ordinary skill can determine whether the corresponding "impression characteristic" is conveyed to the customer. ('302 patent, 6:49-7:4, 8:65-67). Using the examples of USA Today and the Wall Street Journal, each of these "looks" conveys a "visual impression characteristic" that a customer objectively identifies with the company projecting that "look." ('302 patent, 6:53-7:4).

Finally, the specification makes clear that a "corporate image" is a "look" that is presented by a selling entity-something that can be and is determined objectively. Contrary to FedEx's position, the phrase "corporate image" in the '302 patent does not refer to how a customer may subjectively "feel" about a company, e.g., a "good" company or a "bad" company. Nothing in the specification supports FedEx's argument that the phrase is indefinite as being "subjective."

In sum, the Court is not convinced that these claim terms hinge upon the subjective judgment of the customer as urged by FedEx. FedEx has not met its burden of showing, by clear and convincing evidence, that a person of ordinary skill in the art could not determine whether an accused device or method infringes the asserted claims of the '302 patent. There is not clear and convincing evidence that a person of ordinary skill would not be able to do so.

## **D. Claim construction**

### **1. "customized proposal" (Claim 1)**

## a. The Parties' Proposed Constructions

Constellation's Proposed Construction	FedEx's Proposed Construction
"Customized proposal" should be construed as "a proposal targeted to a customer or customers."	"Customized proposal" should be construed as a "printed proposal image (for a specific customer)."

## b. Discussion

According to FedEx, the specification of the '302 patent clearly distinguishes between "proposals" and "presentations" by consistently noting that "proposals" are *printed* materials. And, according to FedEx, the patentee consistently uses the two terms "presentation" and "proposal" to convey two different meanings. Unlike Constellation's proposed construction, FedEx's proposed constructions for "proposal image," "presentation item," "customized proposal," and "outputting" incorporate a distinction between "presentation" and "proposal," (i.e., proposals are printed). FedEx asserts the specification, among other things, emphasize this distinction (Def. Ex. 8 at 2, 7):

The proposal tool 500 is generally accessed to provide a proposal which is formatted for providing a *hard-copy printout* whereas the presentation tool is generally accessed to provide a real-time presentation on a user interface screen. Def. Ex. 12 (08/692,045 application p. 41) (emphasis added);

The presentation item may be any type of audio and/or visual output, including an image, such as text or graphics, a video clip, or an audio clip, and may be output in a variety of manners, such as a *proposal in hard copy* or a multimedia presentation." Col. 3:26-30 (emphasis added);

The information developed during the sales process by the salesperson must be presented to such people in a *printed proposal form*. For this purpose, the proposal module 412 is provided. The proposal module 412 automatically converts the customer solution developed using the other components and modules into a high-quality, personalized *printed proposal* including colors and graphics. Def. Ex. 13 (U.S. Patent No. 6,067,525, col. 17:1-7) (emphasis added);

The proposal presentation matching function adds a plurality of *printed proposal* formats and association data to the system memory. Each *printed proposal format* stored in the system memory is available for use by the system to generate a specific type of printed proposal. The association data is information that specifies an *association between the plurality of printed proposal formats and the plurality of presentation formats*. Typically, a user selects a specific presentation format which is associated with a specific printed proposal format which the system automatically generates as a result of the association. In an environment in which a user desires to generate a specific printed proposal as opposed to a specific type of presentation ...; Def. Ex. 14 (08/744,169 application p. 10) (emphasis added); and

System integration of the customer module, presentation module and proposal module provides the system with the ability to present a solution to a customer and then quickly and automatically produce a *printed proposal* that matches the presentation.

Id. at 11 (emphasis added). FedEx's specification support is from other patents and applications that the '302 patent applicants incorporated by reference into the '302 patent.

On the other hand, Constellation asserts FedEx's arguments regarding 1) proposal image; 2) customized proposal; and 3) outputting are based on a misreading of the specification of the '302 patent. According to Constellation, the text indicates that the proposal exists before it is printed. For example, according to the specification: "The presentation item ... may be output in a variety of manners, such as a proposal in hard copy...." ('302 patent 3 :26-30). If proposal means "printed proposal," as suggested by FedEx, Constellation asserts the phrase "proposal in hard copy" is redundant.

Consistent with the specification, FedEx construes claim 1's three "proposal" limitations-"generating a customized proposal," "generating a proposal image," and "outputting the proposal image"-to incorporate the concept of printed material. FedEx's construction of these terms not only recognizes the meaning of "proposal" as used in the specification, but also ensures that the three "proposal" terms in claim 1 remain internally consistent with one another and with the context of claim 1 as a whole (i.e., as directed toward printed proposals). *Vitronics*, 90 F.3d at 1582. In contrast, FedEx construes the "presentation item" term of claims 12 and 19 not as printed material but as "audio and/or visual output." Again, this distinction is derived from the specification. Under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005) ( *en banc* ), the specification's distinction between proposals (printed material) versus presentations (not limited to printed material) should not be ignored.

### c. Court's Construction

Accordingly, the Court construes the term "customized proposal" to mean: **"a printed proposal image (for a specific customer)."**

## 2. "presentation item" (Claims 12, 19)

### a. The Parties' Proposed Constructions

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"Presentation item" should be construed as "audio and/or visual output."

Alternatively, "presentation item" should be construed as "an item in (or 'of') a presentation."

### b. Discussion

The Court is of the opinion the term "presentation item" does not need to be construed. The term "presentation item" shall be given its plain meaning.

## 3. "a proposal image" (Claim 1)

### a. The Parties' Proposed Constructions

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"A proposal image" should be construed to mean "a composite [or printed] image of text and/or graphics integrating seller-specific and customer solution-specific information."

## b. Discussion

The Court agrees with Constellation that the term "a proposal image" has its plain meaning, and does not require any further construction.

### 4. "customer type; types of customers" (Claims 12, 13, 16), "customer type element(s)" (Claims 12, 3, 14, 16, 19), "customer type information" (Claim 19)

#### a. The Parties' Proposed Constructions

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"Customer type; types of customers" should be construed as "industry or technology area of the customer."  "Customer type element(s)" should be construed as "images, text, articles, graphics, photographic illustrations, video and/or audio identifying the industry or technology area of the customer."  "Customer type information" should be construed as "information identifying the industry or technology area of the customer."

## b. Discussion

The claim terms "customer type; types of customers" are found in claims 12, 13, 16 of the '302 patent. The claim term "customer type element(s)" is found in claims 12, 3, 14, 16, 19 of the '302 patent. The claim term "customer type information" is found in claim 19 of the '302 patent."

FedEx argues its proposed construction incorporates the specification's repeated use of industry or technology area examples for "customer types." *See Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1303 (Fed.Cir.2004) (construing the term "group" in accordance with the specification, where the patentee "repeatedly, consistently, and exclusively use[d] 'group' to denote fewer than all subscribers"). According to FedEx, each time the specification identifies "customer types" within the '302 patent's exemplary embodiments, the "customer types" are always expressed as industry types or technology:

a different element might be used for a computer type customer than for an automotive products type customer. Col. 4:53-55;

Types of customers may include, for example, customers in the travel industry, computer industry, and automotive industry. In the example of intellectual property services, the customer type may represent the technology area, such as computer, chemical, mechanical, etc., with which the customer (client) is involved. A customer type image of a plane, hotel, or beach may be associated with a customer in the travel industry, while a customer type image representing a picture of an assembly line or car may be associated with a customer in the automotive industry. Col. 7:47-57;

customer types, such as biotechnology companies or computer companies, etc. Col. 12:37-38;

customer type has been identified as an [sic] computer industry company ....; Col. 13:15-16.

Although FedEx contends its proposed construction could include customer types of any "industry or any technology area," not just those expressly listed in the '302 patent, the Court is not convinced FedEx's construction does not limit the claim element to the examples identified in the specification. As urged by Constellation, customers are routinely categorized into "types" based on any number of criteria. Common customer "types" used by businesses include, but are not limited to, frequent shopper, frequent flyer, profession, consumer, government, retail, big client, small client, high-roller, single, married, parent, homeowner, shopping club member, local resident, and others. The Court agrees with Constellation that "customer type" has its plain meaning and does not require any further construction. Additionally, there is no support for "customer type information" being limited to information identifying a customer type as suggested by FedEx.

### **c. Court's Construction**

For the reasons discussed above, the Court is of the opinion the terms "customer type; types of customers," "customer type element(s)," and "customer type information" shall be given their plain meaning and do not require any further construction.

## **5. "a customer solution specific image" (Claim 1)**

### **a. Parties' Proposed Construction**

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"A customer solution specific image" should be construed as "text or graphics identifying part of the customer solution."

Alternatively, "a customer solution specific image" should be construed as "an image related to the customer solution."

### **b. Discussion**

The Court agrees with FedEx that a "customer solution specific image" is not an everyday term but rather is a term unique to the '302 patent. The term has a special meaning and functional responsibility (i.e., identifying part of the customer solution) as set out in the specification of the '302 patent:

The customer solution information may be a customer solution specific image which contains a portion of the customer solution, for example, a textual overview of the customer solution or the proposed document. Col. 10:33-37; and

[I]ntegrating customer solution information with the retrieved selling entity element to reflect a portion of the customer solution .... Col. 1:61-63.

The specification explains that this image is specific to the customer solution because the image contains a

"portion of the customer solution." *See, e.g.* Col. 10:33-37, Col. 1:61-63. However, the Court finds no support for the portion of FedEx's definition defining "specific image" as "text or graphics...." The language recited by FedEx does not suggest that the "customer solution specific image" is limited to text or graphics.

### c. Court's Construction

Based on the foregoing, the Court construes "a customer solution specific image" to mean: **"an image identifying part of the customer solution."**

## 6. "impression characteristic (Claims 1, 6, 11)

### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	While FedEx believes this term is indefinite, alternatively "impression characteristic" should be construed as "characteristic that indirectly conveys a notion, remembrance, or belief."

Alternatively, "impression characteristic" should be construed as "characteristic that conveys an impression."

### b. Discussion

The term "impression characteristic" is found in claims 1, 6, and 11 of the ' 302 patent. FedEx asserts its alternative construction is more appropriate than no construction at all or Constellation's alternative construction. According to FedEx, the only mention of "impression characteristic" in column 8 confirms FedEx's position that "impression characteristics" indirectly convey information. And, according to FedEx, given the specification's explanation that impression characteristics *indirectly* convey information, an appropriate construction should include the concept of indirect conveyance.

The Court is not convinced, as urged by FedEx, that the specification of the ' 302 patent always describes "impression characteristics" as indirectly conveying. For example:

The computer system stores, in the memory arrangement, selling entity elements having a corresponding impression characteristic which the customer of the selling entity identifies with the selling entity.

The '302 patent 1 :50-54.

[T]he selling entity elements may be, for example, images, templates and /or audio information having impression characteristics which customers identify with the selling entity.

*Id.* at 3:43-46.

[S]ome of the selling entity elements used to generate a customized presentation may include impression characteristics which are designed to reinforce a 'corporate image' of the selling entity.

*Id.* at 6:47-51.

[T]he template may itself comprise a selling entity element having an impression characteristic, the impression characteristic being, for example, the layout, color fonts and font size, of a particular publication of the selling entity.

*Id.* at 8:63-67. None of these quoted passages from the specification of the '302 patent limit "impression characteristic" to an indirect conveyance, as FedEx suggests.

Additionally, claim 6 requires that "the impression characteristic indirectly conveys the corporate image...." FedEx argues that an "impression characteristic" can only indirectly convey something ( *i.e.*, no direct conveyance). FedEx's construction, however, renders the language of claim 6 superfluous. That is, if "impression characteristics" can only indirectly convey, then the term "indirectly" in claim 6 is superfluous. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed.Cir.2005) (explaining that the term "steel baffles" strongly implies that the term "baffles" does not inherently mean objects made of steel); *Power Mosfet Technologies, L.L. C. v. Siemens AG*, 378 F.3d 1396, 1410 (Fed.Cir.2004) (interpretations that render some portion of the claim language superfluous are disfavored).

For these reasons, the Court declines to limit "impression characteristic" to an indirect conveyance. The Court otherwise adopts FedEx's alternative construction.

### c. Court's Construction

Accordingly, the Court construes the claim term "impression characteristic" to mean: "**characteristic that conveys a notion, remembrance, or belief.**"

## 7. "indirectly conveys" (Claim 6)

### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	While FedEx believes this term is indefinite, alternatively "indirectly conveys" should be construed as "conveys without using direct conveyance means (e.g. trademark, logos, the seller's name, pictures of particular products or service, names, addresses, and the like)."

### b. Discussion

FedEx asserts its proposed alternative construction is taken directly from the specification and is consistent with the specification's use of the term "indirectly convey." The specification explains that basic selling entity elements may include images, audio data, and other information which **directly convey** the entity of the seller, such as the **logo(s), trademark(s), pictures of particular products, names, addresses, etc** . Other selling entity elements are representations having an impression characteristic which **indirectly conveys** the identity or "image" of the seller to a customer, **without using direct conveyance means such as trademarks, logos, the seller's name, and the like**. Col. 8:13-21 (emphasis added).

FedEx's proposed claim construction is essentially that "indirectly conveys" means "not a direct

conveyance." The use of the prefix "in" to denote "not" is a widely known English language principle that does not need to be explained to jurors. Jurors will be quite familiar with the word "indirect." The other portion of FedEx's definition is an unjustified attempt to read examples from the specification into the claims in the form of an open ended list of what "indirectly conveys" does *not* mean. This approach to claim construction is not warranted by case law and is more confusing than helpful. The Court agrees with Constellation that the jury is capable of distinguishing between direct and indirect modes of conveying information.

### c. Court's Construction

The claim term "indirectly conveys" shall be given its plain meaning and does not require any further construction.

### 8. "in a manner which reinforces the identity of the selling entity" (Claims 1, 11)

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	While FedEx believes this term is indefinite, alternatively "in a manner which reinforces the identity of the seller" should be construed as "in a way that strengthens the identity of the selling entity."

### b. Discussion

Alternatively, FedEx proposes that "in a manner which reinforces the identity of the seller" should be construed as "in a way that strengthens the identity of the selling entity." FedEx uses a dictionary definition, asserting it is consistent with the specification. Specifically, FedEx contends the use of "reinforce" in the specification is consistent with the common meaning of "reinforce" as "to strengthen." OXFORD ENGLISH DICTIONARY 537 (2d ed.1989). FedEx asserts the specification emphasizes the *strength* of the selling entity's identity:

These [prior art] brochures provide information about the seller generic to any type of customer, and in doing so *convey a strong sense of the seller's 'look' or identity*. On the other hand, the seller's [sic] may create customized proposals to target a specific customer or group of customers. As the degree of customization increases however, *the 'look' or identity of the seller tends to be lost*.

Col. 1:23-30 (emphasis added).

FedEx's proposed construction attempts to equate the phrase "reinforces the identity" with the phrase "strengthens the identity." The specification cited by FedEx does not support FedEx's proposed construction, and the very next sentence specifically states that there is a desire to "maintain the 'image' or 'look' of the selling entity." ('302 patent 1 :31-34). Nothing in the specification states that the identity of the seller should be "strengthened." FedEx's proposed construction is contrary to the specification.

### c. Court's Construction

The claim term "in a manner which reinforces the identity of the selling entity" shall be given its plain meaning and does not require any further construction.

## 9. "presentation output template" (Claims 2, 10, 14, 15, 16)

### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"Presentation output template" should be construed as "template that defines the format of the presentation, or programs, rules, or instructions performing the functions of a template."

Alternatively, "presentation output template" should be construed as "1) a template that defines the format of the presentation, or 2) programs, rules, or instruction that define the format of a presentation."

### b. Discussion

FedEx asserts its proposed construction for "template" is consistent with the patent specification. According to FedEx, just as the patentee did in the case of "product," (i.e., "products *or services*" ), the patentee defined "template" in the specification in a manner that expressly expands the commonly understood meaning of "template:"

The term includes templates as commonly known *as well as* programs, rules, or instructions which perform the functions of the templates described herein.

Col. 8:48-51 (emphasis added).

In resolving this dispute, the Court first considers the language of the claims. Though claims are construed in light of the specification, they are not necessarily limited by the specification. *See* Markman, 52 F.3d at 980. "Generally, particular limitations or embodiments appearing in the specification will not be read into the claims." *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 867, 228 USPQ 90, 93 (Fed.Cir.1985). Here, Defendants offer no rationale for departing from this rule, and their attempt to import limitations is rejected.

FedEx's proposed construction actually differs from what is stated in the patent specification. FedEx's proposed construction has two parts: 1) a template that defines the format of the presentation, and 2) programs, rules or instruction performing the functions of a template. Actually, the specification limits the second part of the construction to "the functions of the template *described herein*." Thus, although FedEx argues that its proposed construction comes straight from the specification, FedEx's proposal departs from the specification. In particular, the two parts of the construction should have parallel constructions. The Court agrees with Constellation that the phrase "presentation output template" should be construed to mean: "1) a template that defines the format of the presentation, or 2) programs, rules, or instructions that define the format of a presentation."

### c. Court's Construction

Accordingly, the Court hereby construes the term "presentation output template" to mean: **"1) a template that defines the format of the presentation, or 2) programs, rules, or instruction that define the**

## format of a presentation."

### 10. "selling entity image(s)" (Claim 1)

#### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"Selling entity image(s)" should be construed as "text or graphic identifiable with the selling entity."

Alternatively, "selling entity image(s)" should be construed as "a selling entity element that comprises an image."

#### b. Discussion

According to FedEx, the term "selling entity image" was added to claim 1 in an amendment made during prosecution of the application that led to the ' 302 patent. Specifically, during prosecution, the examiner issued an office action allowing the claims but asking the applicants to delete the word "system" from the preamble of claim 1 because the claim was a method claim, not an apparatus claim. FedEx states the applicants responded with an amended claim 1, explaining in the "Remarks" section:

In paragraph 1 of the Office Action, Claim 1 and 12 were objected to because of the inclusion of the term "system" within the preamble of these claims which recite a computer implemented method. The Applicant has amended claims 1 and 12 to eliminate the use of this term. As such, the Applicant respectfully requests that this objection be withdrawn.

(FedEx Ex. 5). FedEx asserts the applicants did not tell the Patent Office that they also made almost twenty additional, unauthorized changes to claim 1. *Id.* These changes were not identified to the examiner in [bracketed] and underlined text as required by the Rules (37 C.F.R. s. 1.121(a)(2); M.P.E.P. s. 714.22) nor were they discussed in the "Remarks" section of the applicants' response. According to FedEx, after the claims were allowed, and under the auspices of making one simple, clerical change requested by the examiner, the applicants snuck a wholesale rewrite of claim 1 past the Patent Office. Among the changes to claim 1 was the deletion of the term "selling entity element" in favor of the term "selling entity image." ( *See* FedEx Ex. 7) (identifying all of the changes made in violation of 37 C.F.R. s. 1.121(a)(2)).

Here, the patentee chose to rewrite claim 1, substituting a new term, "selling entity image," for the originally filed term, "selling entity element." But, the patentee left the originally filed "selling entity element" term in the other claims. FedEx asserts this implicates the principle that "[c]ourts presume a difference in meaning and scope when a patentee uses different phrases in separate claims." *ReedHycalog UK, Ltd. v. Baker Hughes Oilfield Operations Inc.*, No. 6:06 CV 222, 2007 WL 3001423, at (E.D.Tex. Oct. 12, 2007), *citing* *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-15 (Fed.Cir.2005) (en banc). Consistent with this principle, FedEx offers different constructions for the respective terms.

The Court agrees with the portion of FedEx's proposed construction for "selling entity image" that the image is "identifiable with the selling entity." This portion of FedEx's proposal is directly supported by the

specification:

Certain *selling entity images* having impression characteristics may include articles having text of a certain font size or type *identifiable with the selling entity*, or graphics which incorporate pictures or illustrations *identifiable with the selling entity*.

Col. 8:23-28 (emphasis added).

However, the Court does not find support in the specification to construe the word "image" to mean "text or graphic." "Image" should not be arbitrarily limited to examples set out in the specification. Moreover, the word "image" needs no construction because it will be sufficiently clear to the jury.

### c. Court's Construction

Accordingly, the Court hereby construes the term "selling entity image(s)" to mean: **"image(s) identifiable with the selling entity."**

## 11. "selling entity element(s)" (Claims 2, 3, 11, 12, 14, 15, 19)

### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	While FedEx believes this term is indefinite, alternatively "selling entity element(s)" should be construed as "images, audio, data, and other information which directly convey the identity of the seller and images, audio, data, templates, video clips, and other information that indirectly convey the identity or 'image' without using direct conveyance means."

Alternatively, "selling entity element(s)" should be construed as "an element that conveys the identity of a selling entity."

### b. Discussion

In addition to arguing the phrase "selling entity element(s)" is indefinite under 35 U.S.C. s. 112(2), FedEx asserts the claim term appears without any antecedent basis in claims 2 ( "*the* selling entity element") and 3 ( "*the* selected selling entity element"). Specifically, FedEx contends this antecedent basis problem in claims 2 and 3 is another consequence of the patentee's amendment-in violation of 37 C.F.R. s. 1.121(a)(2)-during prosecution. FedEx states that claim 1 as originally filed would have provided the appropriate antecedent basis for "selling entity element" in claims 2 and 3, but when the patent applicants surreptitiously modified claim 1-including the undisclosed switch from "element" to "image"-the applicants created a fatal antecedent basis problem. *See In re Oetiker*, 951 F.2d 1267 (Fed.Cir.1991) (unpublished); 37 C.F.R. s. 1.75(d)(1); M.P.E.P. s. 2173.05(e) ("A claim is indefinite when it contains words or phrases whose meaning is unclear. The lack of clarity could arise where a claim refers to 'said lever' or 'the lever,' where the claim

contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference.").

Regarding FedEx's antecedent basis argument, FedEx presents no argument or evidence for why the phrase is thought to be indefinite in the other claims in which it appears—claims 11, 12, 14, 15 and 19. Not only does the claim phrase have the same meaning in all the claims, but the phrase's meaning is clear from the phrase itself. Moreover, claims 2 and 3, including the subject phrase, are easily understood. The Court is not convinced by clear and convincing evidence that this claim is indefinite or invalid.

Turning to the construction of "selling entity element," FedEx asserts the specification specifies that there are two categories of "selling entity elements"—those that directly convey the identity of the selling entity and those that indirectly convey the identity (or "image") of the selling entity:

The selling entity element may be one which *directly or indirectly conveys* the identity of the selling entity. Col. 12:45-46; and

Basic selling entity elements ... directly convey the identity of the seller, .... Other selling entity elements ... indirectly convey[ ] ... the identity or 'image' of the seller to a customer, without using direct conveyance means .... Col. 8:13-21.

The specification provides graphical examples of the distinction. Finally, the specification enumerates non-limiting examples: 1) Selling entity elements that *directly convey*: images, audio data, and other information. Col. 8:13-15; and 2) Selling entity elements that *indirectly convey*: images, audio clips, templates, video clips, and other information. Col. 8:22-24.

FedEx asserts its construction explains what "selling entity elements" do (i.e., convey identity either directly or indirectly), and how they do it (i.e., through images, audio data, templates, video clips, etc.) without limiting the claim to the examples disclosed in the specification (i.e., by incorporating "... and other information"). The Court agrees with Constellation that FedEx attempts a wholesale importation into the claims of examples of "selling entity elements" provided in the specification. Using FedEx's logic, the entire specification could be read into the claims so long as all open-ended limitations were included. FedEx's proposed construction is contrary to a fundamental rule of claim construction that "although the specification may aid the court in interpreting the meaning of disputed claim language, particular embodiments and examples appearing in the specification will not generally be read into the claims." *Comark Comms., Inc.*, 156 F.3d at 1187.

Although FedEx's alternative construction attempts to read the specification into the claims, the Court agrees with FedEx that the phrase should be construed. The Court is further of the opinion that the construction should recognize, as urged by FedEx in its alternative construction, that the specification identified two categories of selling entity elements, those that directly convey and those that indirectly convey the identity of the selling entity. Thus, the Court adopts Constellation's alternative proposal for the phrase "selling entity element" with the addition of the concepts of direct and indirect conveyance.

### **c. Court's Construction**

The Court construes "selling entity element(s) to mean: **"element(s) that conveys directly or indirectly the identity of a selling entity."**

## 12. "outputting" (Claim 1)

### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	"Outputting" should be construed as "printing the proposal image."

### b. Discussion

The Court is of the opinion the term "outputting" does not need to be construed. The term "outputting" shall be given its ordinary meaning.

## 13. "commodity" (Claim 1)

### a. Parties' Proposed Construction

Constellation's Proposed Construction	FedEx's Proposed Construction
"Commodity" should be construed as "something of use or value."	"Commodity" should be construed as "tangible item or article of trade, such as goods, merchandise, wares, produce, as distinguished from services."

### b. Discussion

FedEx asserts the term "commodity" was surreptitiously added to claim 1 in the December 30, 1999, amendment. According to FedEx, the applicants replaced each instance of "product" in claim 1 with "commodity" but left "product" in all of the other claims-again implicating the common-sense principle that different words in different claims mean different things. *See, e.g., Forest Labs., Inc. v. Abbott Labs., 239 F.3d 1305, 1310 (Fed.Cir.2001).*

Although "product" is expressly defined in the specification, "commodity" is not. The parties agree that "product" extends to "products *or services*" because the specification explains that the term product, as used herein, is intended to cover anything offered by a selling entity, including tangible items *and services*. Col. 4:3-5. According to FedEx, while the patentee expressly chose to give "product" a uniquely broader definition in the specification, he did not choose to do so for "commodity." FedEx asserts there is no basis in the specification to expand the ordinary meaning of "commodity" to cover "services."

The only instance of "commodity" in the specification consists of a figure that is misdescribed:

The seller data **200a** includes product information **202 [sic]**, selling entity elements **204 [sic]**, topical selling entity elements **206 [sic]**, template information **208 [sic]**, as well as other information **210 [sic]**.

Col. 7:16-20. FedEx asserts Constellation's only "support" for the proposition that the "specification uses the terms 'product' and 'commodity' interchangeably" is grounded on this inaccurate figure (and accompanying text). (Constellation's Brief at p. 7).

"Commodity" should not be broadened beyond its ordinary meaning based only on the inaccurate Figure 200a (and accompanying text). Nystrom, 424 F.3d at 1145-46 ("Broadening of the ordinary meaning of a term in the absence of support in the intrinsic record indicating that such a broad meaning was intended violates the principles articulated in *Philips*." ) Nor should the inaccurate figure be used to vitiate the principle that different words used in different claims are presumed to have a different scope. Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed.Cir.1998). If the applicants intended for "commodity" to be the same as "product," they could have ensured this by defining "commodity" in the same way that they chose to define "product."

Without any express guidance in the specification or the prosecution history as to the meaning of "commodity," FedEx's proposed construction relies upon the ordinary meaning of "commodity"-which does not encompass "services." For instance, "legal services," as described in the specification, do not fall within the ordinary meaning of "commodity." Rather, as the OXFORD ENGLISH DICTIONARY confirms, "commodity" encompasses tangible items or articles of trade, such as goods, merchandise, wares, and produce. Even the WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY relied upon by Constellation sets forth the definition of commodity as "an economic good ... *as distinguished from services*."

The Court has reviewed the dictionary definitions supplied by the parties. Both the OXFORD ENGLISH DICTIONARY and the WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY provide, as one definition of commodity, "an article of commerce." The Court is of the opinion this definition sufficiently defines the term "commodity" and makes clear the term excludes services.

**c. Court's Construction**

The Court construes "commodity" to mean: **"an article of commerce."**

**14. "corporate image" (claims 1, 14)**

**a. Parties' Proposed Construction**

Constellation's Proposed Construction	FedEx's Proposed Construction
This claim language has its plain meaning, and does not require any further construction.	While FedEx believes this term is indefinite, alternatively "corporate image" should be construed as "a concept or impression, created in the minds of the public, of a particular institution."

**b. Discussion**

The pertinent portion of the specification reads as follows:

As will be seen in the sample written proposal in FIG. 18 the proposal is customized to the potential customer and customer solution, while indirectly conveying a desired '*corporate image*' which captures and maintains a unique 'look' associated with USA Today (TM) throughout the proposal. For example, the cover page of the proposal is identifiable as a front page of a USAToday (TM) newspaper product, through the use of appropriate image layout, organization, font, and color, among other things. In addition, the various graphs and graphics within the body of the proposal presentation are customized to the customer and/or the customer solution while retaining the 'look' of graphs and graphics found in a USAToday (TM) newspaper

and which advertisement space customers of USA Today (TM) would identify with USA Today (TM). This information is indirectly conveyed in the sense that it does not rely on USA Today trademarks, logos, etc., but draws its recognition from its correspondence to an 'image' associated with USA Today (TM).

'302 patent 6 :47-7 :4.

This portion of the specification defines "corporate image." Therefore, the term "corporate image" does not need to be construed. The term shall be given its ordinary meaning.

#### IV. CONCLUSION

Accordingly, the Court hereby construes the claim terms consistent herewith. A chart summarizing these constructions is attached as Exhibit A.

#### EXHIBIT A

<b>CLAIM TERM</b>	<b>COURT CONSTRUCTION</b>
"customized proposal"	"a printed proposal image (for a specific customer)."
"presentation item"	No construction necessary.
"a proposal image"	No construction necessary.
"customer type; types of customers"	No construction necessary.
"customer type element(s)"	No construction necessary.
"customer type information"	No construction necessary.
"a customer solution specific image"	"an image identifying part of the customer solution."
"integrating ... to reflect ... in a manner which maintains the corresponding visual impression characteristic"	"bringing together (parts or elements) in a way that maintains the corresponding visual impression characteristic."
"integrating, in a manner which maintains the corresponding impression characteristic"	"bringing together (parts or elements) in a way that maintains the corresponding visual impression characteristic."
"integrating ... into an integrated presentation output"	"to put or bring together (parts or elements) so as to form a presentation."
"integrate ... into a presentation output"	"to put or bring together (parts or elements) so as to form a presentation."
"impression characteristic"	"characteristic that conveys a notion, remembrance, or belief."
"indirectly conveys"	No construction necessary.
"in a manner which reinforces the identity of the selling entity"	No construction necessary.
"presentation output template"	"1) a template that defines the format of the presentation, or 2) programs, rules, or instruction that define the format of a presentation."
"selling entity image(s)"	"image(s) identifiable with the selling entity."
"selling entity element(s)"	"element(s) that conveys directly or indirectly the identity of a selling entity."

<b>"outputting"</b>	No construction necessary.
<b>"commodity"</b>	"an article of commerce"
<b>"corporate image"</b>	No construction necessary.
<b>"product"</b>	"product or service"
<b>"retrieve[ing]"</b>	No construction necessary.
<b>"selected"</b>	No construction necessary.
<b>"output device"</b>	No construction necessary.

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