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

TROVER GROUP, INC,
v.
DIEBOLD INCORPORATED.

Civil Action No. 2:06-CV-445

Oct. 21, 2008.

Steven Nelson Williams, Steven Howard Slater, Slater & Matsil, Dallas, TX, Anthony Kyle Bruster, Louis Brady Paddock, Richard Benjamin King, Nix Patterson & Roach LLP, Texarkana, TX, David Neil Smith, Nix Patterson & Roach LLP, Daingerfield, TX, for Trover Group, Inc., et al.

Bruce S. Sostek, Gerald Wayne Roberts, Jane Politz Brandt, Thompson & Knight, Dallas, TX, Elizabeth L. Derieux, Sidney Calvin Capshaw, III, Capshaw Derieux, LLP, Longview, TX, for Diebold Incorporated.

ORDER ON CLAIM CONSTRUCTION

CHARLES EVERINGHAM IV, United States Magistrate Judge.

Before the *Markman* hearing, the parties resolved most of their claim construction disputes. They presented four to the court for resolution, two of which concerned the proper construction of the plaintiffs' design patents. After the hearing, the Federal Circuit decided Egyptian Goddess, Inc. v. Swisa, Inc., 543 F.3d 665, 2008 WL 4290856 (Fed.Cir. Sept. 22, 2008). In that case, the court held it was a matter of the court's discretion whether to provide a detailed verbal description of the design depicted in the drawings appended to a design patent. Egyptian Goddess, 2008 WL 4290856, at * 14.

In this case, the designs at issue are relatively straightforward, and, depending on how the case develops, the court may find it necessary to instruct the jury on certain aspects of the drawings which bear on claim scope. *Id*. As a result, the court is persuaded that no construction is necessary at this time for the design patents. Moreover, because the claim construction disputes relating to the utility patents are relatively few, the court dispenses with a full memorandum opinion on the issues and proceeds directly to the construction of the disputed terms, applying the principles set forth in Phillips v. AWH Corp., 415 F.3d 1303 (Fed.Cir.2005)(en banc).

1. Unique identifier

The '345 patent uses the term "unique identifier." In the context of claim 1, the relevant limitation provides:

a digital storage connected to said controller for storing in said digital storage a plurality of said digital data files each of which is associated with a respective one of said stored digital image files wherein each

associated pair of one of said data records and one of said image files *has a respective unique identifier* that is stored in both the data record and the image file of an associated pair.

U.S. Patent No. 5,751,345, claim 1 (emphasis added).

Trover contends that this term means "a distinctive name for an image file that provides a hard link with the associated data record ." Diebold contends that the term means "one-of-a-kind name for an image file that provides a hard link with the associated data record on a one-to-one basis." The dispute between the parties is over the word "unique."

The claim language suggests that the defendant's construction of "unique" is more appropriate than the one proposed by the plaintiff. "Unique" is not a technical term, and, generally speaking, "unique" means "one of a kind." *See* The American Heritage College Dictionary, at 1476 (3d ed.1997, 1993). The specification does not show any intent to depart from the ordinary meaning of this term. In addition, the cited portion of the prosecution history confirms this usage, although the court is not convinced that the defendant's construction is entirely proper. The court construes "unique identifier" as "a one of a kind name for an image file that provides a hard link with the associated data record."

2. Only when/only if

The claims of the '346 patent use the terms "only when" and "only if." To place the constructions in context, the relevant language of claim 1 provides:

storing at least said second image in a digital storage *only when said extent of change* is greater than said reference value, wherein said second images can be read from said digital storage ...

U.S. Patent No. 7,51,346, claim 1 (emphasis added).

The plaintiff argues the relevant language signifies a condition precedent. According to the plaintiff, the term means that "a particular image is stored when the comparison test is met and it is not stored when the comparison test is not met." The defendant argues that the term means "only storing when the condition is met and never storing when the condition is not met." The dispute boils down to certain statements made during prosecution of the '346 patent.

The plaintiffs point to a statement in the prosecution history which suggests that the applicants defined "only when" and "only if" to mean "that a particular second image is stored when the comparison test is met, and it is not stored when the comparison test is not met." Plaintiffs' Claim Construction Brief, Exh. E. Similarly, the examiner stated in an Interview Summary that amending the claims with "only" before "when" "would clearly define 'only when' as signifying a condition precedent function." Plaintiffs' Claim Construction Brief, Exh. F.

The defendant argues that the court should consider another portion of the prosecution history, which states:

Because the present invention stores only the images which occur when there has been a change, a surveillance system incorporating the present invention can monitor and record activity in a secured area over a long period of time while using a minimum amount of data storage space.

The court has carefully reviewed the patent and the prosecution history and is persuaded that the plaintiffs' view of the definition provided during prosecution is correct. The court construes the "only when" and "only if" terms as defined by the applicants in prosecution and has adapted that definition to provide constructions in the context of the various asserted claims. Accordingly, the language in claim 1 means "the second image is stored when the extent of change is greater than the reference value, and it is not stored when the extent of change is not greater than the reference value." The language of claim 4 means "the second digitized image is stored when the determined number of pixels exceeds the reference number, and it is not stored when the determined number of pixels does not exceed the reference number." The language of claim 5 means "the new digitized image is stored when the determined number of pixels exceeds the reference number, and it is not stored when the determined number of pixels does not exceed the reference number ." The language of claim 6 means "the new digitized image is stored when the detached number of pixels exceeds the reference number and not stored when the detached number of pixels does not exceed the reference number." The language of claim 7 means "the second image is stored when the extent of change is greater than the reference value, and it is not stored when the extent of change is not greater than the reference value."

The court adopts the above constructions. The parties are ordered that they may not refer, directly or indirectly, to each other's claim construction positions in the presence of the jury. Likewise, the parties are ordered to refrain from mentioning any portion of this opinion, other than the actual definitions adopted by the court, in the presence of the jury. Any reference to claim construction proceedings is limited to informing the jury of the constructions adopted by the court.

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