United States District Court,
D. Utah, Central Division.

John B. ADRAIN,
Plaintiff.
v.
HYPERTECH, INC,
Defendant.

No. 298CV037C

May 9, 2000.

ORDER

CAMPBELL**, J.**

Plaintiff John B. Adrain is the holder of U.S. Patent No. 5,446,665 ("the '665 Patent") and U.S. Patent No. 5,523,948 ("the "8 Patent"). The "8 Patent is a continuation-in-part of the '665 Patent. The patents relate to onboard computers or engine control modules ("ECMs") that control vehicle engine functions. Adrain claims that Defendant's products infringe claims 6 and 11 of the '665 Patent and claims 1, 5, and 19 of the "8 Patent. This matter is now before the court for construction of the asserted claims of the patents, as required by Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996).

Discussion

I. ***The*** '665 Patent

A. ***Claim 6-Interpretation of the Disputed Terms***

Claim 6 reads (with the disputed terms underlined):

6. An improved automotive computer for controlling engine performance comprising:

a first computer for providing control signals to said engine, said control signals comprising engine operating parameters;

a plurality of memories coupled to said first computer for providing at least one *originally provided programmed mode* for operating said engine and at least one *additional programmed mode;* and

wherein said first computer and plurality of memories are combined to provide a fixed system of control to said engine, said fixed system having a bus coupling said first computer and plurality of memories; and

a control coupled to said bus to select said at least one *additional programmed mode* from said plurality of memories, said *additional programmed mode* not being *originally included* in said fixed system as *originally manufactured,*

whereby engine operation is made responsive to said control.

_____ Resolution of the disputed terms in Claim 6 depends upon the proper interpretation to be given the words "originally," "additional" and the phrase "whereby engine operation is made responsive to said control."

The starting point for determining the meaning of these terms is the language of the claim itself. However, as the Federal Circuit explained:

Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996).

1. ***Originally***

While both parties apparently agree that the word should be given its ordinary and customary meaning, they do not agree on what that meaning is. Adrain maintains that originally simply means "prior to ." Hypertech's proposed interpretation is "included with the car when it was manufactured."

Hypertech's proposed interpretation is, in essence, the correct one. The ordinary meaning of "originally" is "from the first: ... in the beginning: in the first place: initially, primarily." *Webster's 3d New Int'l Dictionary* (1971). FN1 There is nothing in the claim language itself, the specification or the file history that clearly indicates that a different meaning should be assigned the word. And there is nothing in the specification or the file history to support adding the limitation "when the car was manufactured."

FN1. The court is well aware that it must first, in interpreting the claims of the patent, look to the intrinsic evidence, that is, the patent itself, including claims, specification and if in evidence, prosecution history. However, as the court noted in *Vitronics,* "Judges ... may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." 90 F.3d at 1584 n. 6. *See also* Kegel Co. v. AMF Bowling, Inc., 127 F.3d 1420, 1427 (Fed.Cir.1997) (quoting *Webster's 3d New Int'l Dictionary* for ordinary meaning of word "assembly").

Therefore, "originally provided programmed mode" means the programmed mode that was first or initially included with the car before use of the invention. "Originally included" means first or initially included with the car before use of the invention. "Originally manufactured" means first or initially manufactured by the original equipment manufacturer.

2. ***Additional Programmed Mode***

The ordinary meaning of the word "additional" is "existing or coming by way of addition: added, further." *Id*. The meaning of "addition" is "the result of adding: anything added: increase, augmentation." *Id*. Adrain proposes that the term means "in some way different." Hypertech's interpretation, "in addition to," is the ordinary meaning.

The specification supports a conclusion that the term should be given its ordinary meaning. The specification teaches that the invention provides more programs than are originally, or initially provided with the computer, and are present along with the original program. (*See* '665 Patent col. 3 ll. 45-47, col. 5 ll. 15-19.)

The proper interpretation of "additional programmed mode" is a programmed mode that is in addition to, and supplemental to the originally provided programmed mode.

3. *Whereby engine operation is made responsive to said control*

Adrain contends that this term "simply means that the 'control' can affect the operation of the engine, in this case by selecting an 'additional programmed mode' other than the 'originally provided program mode." ' (Pl.'s Claim Constr. Statement at 6.) Hypertech asserts that the proper interpretation of this term is "the vehicle must be responsive to the act of selecting a program while the vehicle is moving or while it is stopped, but otherwise in normal operation." (Hypertech's Substantive Obj. to Adrain's Prop. Claim Constr. at 13.) The question, then, is whether the term must be limited, as Hypertech argues, to reflect that the selection of the program must occur while the vehicle is "in normal operation."

According to Hypertech, both the specification and the prosecution history mandate this construction. And while the specification does lend general support for this construction, *see* '665 Patent col. 6 ll. 54-57 ("If the operator is on an uncrowded open highway, he may wish to change the operating conditions of the engine to one which provides optimum fuel economy at constant high speed."), it is the prosecution history that provides the most guidance.

During prosecution of the parent patents of the '665 and "8 patents, the examiner rejected certain claims as being anticipated by U.S. Patent No. 4,502,324, the Marino Patent. In seeking to distinguish his invention from the Marino Patent, Adrain asserted, "Marino does not describe a system in which the internal operating control of the engine can be changed while driving or under driving conditions." (Amend. & Req. Extension of Time at 12, attached as Ex. F to Hoover Decl. in Supp. of Hypertech's 3d Mot. Summ. J.) Later in the prosecution, Adrain again emphasized that his invention could be distinguished from the Marino Patent because "Marino is not an improvement in a vehicle, but a stationary piece of shop equipment.... In other words, the prior art electronic system in the car is a fixed design which is not reconfigurable as the car is driving down the road." (Amend. after Final at 7, attached as Ex. H to Hoover Decl. in Supp. of Hypertech's 3d Mot. Summ. J.) In contrast to the prior art, Adrain explains that with his invention "[t]he operation of the vehicle is changed by the interactive control while the vehicle is in transit, that is, while driving down the road." (Id . at 7-8) Adrain also argued to the examiner that his invention was not obvious in light of U.S. Patent No. 5,084,821, the Oshuga Patent: "This [Oshuga] is distinguished from the *in transit selection of program* according to applicants' claimed invention.... What applicant has claimed in distinction is to permit in-transit choice of preprogrammed alternative modes of operation, stored in chips, to replace the engine control provided by the originally provided program." (Amend. & Req. Extension of Time at 6, attached as Ex. L to Hoover Decl. in Supp. of Hypertech's 3d Mot. Summ. J. (emphasis in original)).

On March 9, 1995, the examiner issued a Notice of Allowability. In the Reasons for Allowance, the examiner stated:

The present application claims an universal module that is coupled to a bus for arbitrarily reconfiguring programmed control of an electronic control unit regardless of the design of a system in which the ECU is employed; ... and a control coupled only to the preprogrammed memory for selectively communicating the preprogrammed memory to the ECU, operation of which vehicle is being changed by the control *while the vehicle is in normal operation* and thereafter becomes controlled according to the additional program in the preprogrammed memory in lieu of the originally provided program. The limitations as set forth are not taught nor suggested in the prior art of record. In light of the foregoing, the claims of the present application are found to [be] patentable over the prior art.

(Notice of Allowability at 2-3 (emphasis added), attached as Ex. B to Hoover Decl. Support of Hypertech's Reply to Hypertech's 5th Mot. Summ. J.)

Hypertech's contention that the term must be read in light of the prosecution history, and the representations made by Adrain to gain patentability is correct. The patent in Grain Processing Corp. v. American Maize-Prods. Co., 840 F.2d 902 (Fed.Cir.1988) claimed a waxy starch hydrolysate. In construing the term "exceptional clarity and complete lack of opacity" used in one of the patent claims, the court concluded that the proper meaning was dictated by the prosecution history and meant both initial and long term clarity. The court noted that the patentees were able to secure the patent only after convincing the PTO that their invention, in contrast to the prior art, had the capacity to remain haze-free for long periods of time. Here, Adrain faced a similar situation: When his applications were rejected as anticipated by the Marino Patent, and obvious under the Oshuga Patent, Adrain, to overcome the objections, made clear that with his invention, unlike the prior art, additional programs could be selected while the vehicle was in use.

The court concludes that Hypertech's proposed construction "the vehicle must be responsive to the act of selecting a program while the vehicle is moving or while it is stopped, but otherwise in normal operation" reflects the limitation that Adrain represented was correct during the prosecution of the patent and thus, is the correct interpretation of the term.

B. *Claim 11-Interpretation of Disputed Terms* FN2

FN2. There is no dispute that the words "originally" and "additional" should be given the same interpretation as in Claim 6, and that the term "for use in controlling said engine" should be interpreted the same as "whereby engine operation is made responsive to said control."

Claim 11 reads (with the disputed terms underlined):

11. An automotive computer control system for an engine to control engine performance comprising:

...

an *universal control means* coupled to said bus of said fixed system for providing at least one additional program and for allowing selection of at least one additional program not included as said originally provided program stored within said memory, said selection through said control means designating one of

said originally provided program and said at least one additional program for use in controlling said engine.

_____ 1. ***Universal Control Means***

The parties agree that this term is a "means-plus-function" term. "The Patent Act provides explicit guidance for interpretation of claim elements expressed in means-plus-function terms...." Valmont Indus. v. Reinke Mfg. Co., 983 F.2d 1039, 1041 (Fed.Cir.1993). This guidance is found in 35 U.S.C. s. 112, para. 6, which states:

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.

Therefore, the functional claim is limited to the "corresponding structure, material, or acts" contained in the specification. *See* Valmont, 983 F.2d at 1042. The Federal Circuit explained:

Unlike the ordinary situation in which claims may not be limited by functions or elements disclosed in the specification, but not included in the claims themselves, in writing a claim in means-plus-function form, a party is limited to the corresponding structure disclosed in the specification and its equivalents. *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*. The duty to link or associate structure in the specification with the function is the *quid pro quo* for the convenience of employing s. 112, para. 6.

Kahn v. General Motors Corp., 135 F.3d 1472, 1476 (Fed.Cir.), *cert. denied,* 119 S.Ct. 177 (1998) (emphasis added) (citations omitted).

There is no dispute that Claim 11 states that the function of the universal control means is to "provid[e] at least one additional program and to allow [ ] selection of at least one additional program." '665 Patent, Claim 11. The problem lies in ascertaining the corresponding structure disclosed in the specification. Adrain contends that "an embodiment of the 'universal control means' is shown as the 'human interactive control module-item 16 in figures 1 and 2." (Pl.'s Claim Constr. Statement on Disputed Portions of the Claims at 9). Yet nothing in the specification discloses that the "human interactive control module" is, indeed, the "universal control means" element of the claim. In fact, no mention at all is made of "universal control means" in the specification. Because Adrain's specification does not adequately disclose the structure that corresponds with the universal control means, A drain has failed to particularly point out and distinctly claim that particular means. *See* B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1425 (Fed.Cir.1997).

II. ***The*** "8 Patent

_____ A. ***Claims 1, 5, and 19-Interpretation of the Disputed Terms***

The parties agree that the disputed terms in the "8 Patent should be interpreted the same as they were in the '665 Patent. Therefore, no elements are left for construction in Claim 1, only one element is left for construction in Claim 5, and only one element is left for construction in Claim 19.

Claim 5 reads (with the element left for construction underlined):

5. The improvement of claim 1 wherein said control comprises *means for erasing said originally provided memory and writing a new program into said originally provided memory from said at least one preprogrammed memory*.

Claim 19 reads (with the element left for construction underlined):

19. A method of controlling an automotive computer comprising the steps of:

providing control signals to an engine from a first computer, said control signals comprising engine operating parameters;

providing at least one originally provided programmed mode for operating said engine from at least one originally provided memory coupled to said first computer;

communicating a *superseding signal* to a bus coupled to said first computer and said at least one originally provided memory through a diagnostic/emulation port or harness coupled to said bus from an adapter module, said *superseding signal* to alter control of said engine by said first computer;

selectively controlling said engine by means of said first computer through at least one additional programmed mode provided by said adapter module, said additional programmed mode not being originally included in said originally provided memory.

1. ***Claim 5-Means for Erasing and Writing a New Program***

The parties do not dispute that the term "means for erasing ... and writing a new program" are means-plus-function elements. And, like the earlier means-plus-function element ("universal control means"), the means stated is to be construed to cover only the corresponding structure, material, or acts that are clearly linked to the function in the specification. *See* Kahn, 135 F.3d at 1476.

The two functions at issue in Claim 5 appear to be: (1) the erasing of the originally provided memory, and (2) replacing the originally provided memory with at least one preprogrammed memory. The parties have not adequately addressed whether these are, in fact, the functions at issue in Claim 5, and whether the specification clearly links a structure to the functions. Therefore, the parties are directed to submit, on or before June 1, 2000, memoranda addressing this issue, which includes legal analysis and specific citations to the language in the specification which they believe support their positions.

2. ***Claim 19-Superseding Signal***

Adrain interprets the "superseding signal" element, as "a signal that is communicated by the adapter module to the bus connected to the first computer and the originally provided memory. Communication of the superseding signal by the adapter module to the bus causes a change in the control of the engine by the first computer." (Pl.'s Claim Const. at 16.) Adrain points to no evidence, either intrinsic or extrinsic, in support of this construction. Hypertech contends that this element is vague, indefinite, and gives no teaching as to the scope or coverage of the claim.

It appears that construction of this element depends, at least in part, on whether Adrain has made an adequate disclosure under 35 U.S .C. s. 112, para. 1. The court is unable to make that determination based on the present record. Therefore, the parties are directed to submit, on or before June 1, 2000, memoranda

addressing the question of whether sufficient disclosure has been made. The parties are, without repeating information from their earlier memoranda, to refer the court to the claim language of the "8 patent, portions of the specification and the prosecution history which they believe support their positions. The memoranda must include legal analysis, with reference to case law.

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