United States District Court,
S.D. New York.

KEEN, INC,
Plaintiff.
v.
INFOROCKET.COM, INC,
Defendant.

No. 01 CV 8226(LAP)

July 26, 2002.

In patent infringement suit, alleged infringer moved for summary judgment. The District Court, Preska, J., held that: (1) within patent providing for a method of, or apparatus for, facilitating the delivery of advice to consumers using a server unit which can store and display the names and characteristics of experts and then rapidly assist in connecting the expert and consumer for real-time communication, claim terms "automatically establishing" a telephone connection "in response to" the selection of an icon by the consumer means that clicking on or selecting a displayed icon corresponding to an expert results in an immediate telephone connection between the expert and the consumer, without a series of intervening manual steps, and (2) the patent was not infringed.

Motion granted.

MEMORANDUM AND ORDER

LORETTA A. PRESKA**, District Judge.**

Plaintiff Keen, Inc. ("Keen") brings this action against defendant InfoRocket.com, Inc. ("InfoRocket") alleging patent infringement, trade dress infringement and unfair competition. On January 29, 2002, the parties entered into a stipulation dismissing Keen's second and third claims, leaving only the patent infringement claim. InfoRocket now moves for summary judgment on the basis of noninfringement and invalidity based on obviousness and nonenablement. For the foregoing reasons, InfoRocket's motion for summary judgment on the basis of noninfringement is granted.

BACKGROUND

Keen, formerly known as Keen.com, Incorporated, began providing an Internet and telephony-based marketplace for buying and selling advice and information in 1999. (Compl.para.para. 2, 6). Through Keen, consumers seeking live, immediate advice on a wide variety of topics are able to connect by telephone to any one of thousands of independent advisors for a fee that is determined by the advisor's rate and the length of the conversation. (*Id*. para. 6). Keen's revenue stems from its charged commission, a percentage of the

total cost of the call. (*Id.*).

On April 24, 2001, the United States Patent and Trademark Office issued U.S. Patent No. 6,223,165 B1 (the "'165 Patent"), entitled "Method and Apparatus to Connect Consumer to Expert," to Randall B. Lauffer. (Compl., Tab 1). Lauffer assigned all right, title and interest in the '165 Patent to Keen. (Id., Tab 2). The abstract of the '165 Patent states that the invention "provides for a method of (or apparatus for) facilitating the delivery of advice to consumers using a server unit which can store and display the names and characteristics of experts and then rapidly assist in connecting the expert and consumer for real-time communication." (Id., Tab 1).

At the time Keen introduced its live, immediate advice service, InfoRocket offered an Internet-based service that did not provide live, immediate advice by telephone. (Id. para. 8). In early June 2001, InfoRocket added to its existing service a live telephonic advice service. (Answer para. 11). On June 1, 2001, Keen's attorney wrote to Beth Haggerty, President and Chief Executive Officer of InfoRocket, advising her that Keen had received a patent on its live, immediate advice service and that it had invested significant time and assets into cultivating customer loyalty and designing the appearance of its website. (Compl.para. 10).

On June 8, 2001, InfoRocket filed a complaint with this Court captioned *InfoRocket.com, Inc. v. Keen, Inc.,* No. 01 Civ. 5130(LAP) (the "5130 Complaint"), seeking a declaratory judgment that the '165 patent is invalid, unenforceable and not infringed. (5130 Complaint para. 16). This complaint further alleges that Keen infringes U.S. Patent No. 5,818,836, entitled "Method and Apparatus for Anonymous Voice Communication Using an Online Data Service," and that the patent was issued to Stephen C. DuVal and licensed exclusively to InfoRocket (the "DuVal Patent"). (Id. para. 7). FN1

FN1. Keen answered the 5130 Complaint and filed a counterclaim, which InfoRocket answered. Outside of these pleadings, however, very little has occurred-at least from the Court's perspective-with respect to this complaint.

On August 31, 2001, Keen filed a complaint with this Court captioned *Keen, Inc. v. InfoRocket.com, Inc.,* No. 01 Civ. 8226(LAP) (the "8226 Complaint"), seeking preliminary and permanent injunctive relief and money damages against InfoRocket for: (1) infringement of the '165 Patent; (2) trade dress infringement under the Lanham Act relating to the appearance and design of Keen's website; and (3) unfair competition under common law and/or statutory law. The 8226 Complaint was referred to me as possibly related to the 5130 Complaint; on September 28, 2001, I accepted the 8226 Complaint as related.

On October 23, 2001, Keen moved for a preliminary injunction on the 8226 Complaint pursuant to Rule 65 of the Federal Rules of Civil Procedure to enjoin InfoRocket from infringement of the '165 Patent and of Keen's distinctive trade dress for its website. In its responding brief, InfoRocket argued, *inter alia,* that: (1) InfoRocket's service does not infringe the ' 165 Patent; (2) the '165 Patent is invalid as obvious in light of the combination of the DuVal Patent and U.S. Patent No. 5,862,223, issued to Jay S. Walker (the "Walker Patent"); (3) the '165 Patent is not enabled; and (4) Keen is not entitled to trade dress protection for its website.

On January 8, 2002, a hearing was held on Keen's preliminary injunction motion; both parties presented evidence in the form of testimony and documents. That same day, I orally denied the motion. First, I found that InfoRocket had raised a substantial question as to whether the combination of the Walker and DuVal

Patents render the claims of the '165 Patent obvious. Second, I found that InfoRocket had raised a substantial question as to whether InfoRocket infringed the '165 Patent. Specifically, I noted that the plain words of claim 1 of the '165 Patent teach that once a consumer selected a displayed icon, a telephone connection between the consumer and an expert is "automatically establish[ed]." As witnesses for both parties agreed, however, a consumer must take several steps on InfoRocket's website between clicking on the telephone icon and being connected to an expert, thus tending to demonstrate noninfringement. This view was confirmed by, *inter alia,* the prosecution history of the '165 Patent, which demonstrates that the word "automatically" was added to Keen's application amendment to avoid the "time consuming and tedious ... maze that requires the consumer call into the IVRU and navigate [his or her] way into having the expert contacted." Third, I found that InfoRocket had raised a substantial question as to whether the '165 Patent was enabled. Fourth, I found that InfoRocket had raised a substantial question as to whether Keen was entitled to trade dress protection for its website. Finally, I found that Keen had failed to demonstrate irreparable harm and that the issuance of an injunction would irreparably harm InfoRocket.

On January 29, 2002, the parties entered into a stipulation dismissing Keen's second and third claims, leaving only the patent infringement claim.

On February 13, 2002, InfoRocket filed the instant motion for summary judgment, asserting, as it did in its opposition to Keen's motion for a preliminary injunction, that InfoRocket does not infringe the claims of the ' 165 Patent, the combination of the Walker and DuVal Patents renders the claimed invention obvious and the '165 Patent is not enabled.

DISCUSSION

I. Summary Judgment Standard

Under Rule 56, summary judgment shall be rendered if the pleadings, depositions, answers, interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. *See* Fed. R. Civ. Proc. 56(c); Anderson v. Liberty Lobby, 477 U.S. 242, 250, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). An issue of fact is genuine when "a reasonable jury could return a verdict for the nonmoving party," and facts are material to the outcome of the litigation if application of the relevant substantive law requires their determination. Anderson, 477 U.S. at 248.

The moving party has the initial burden of "informing the district court of the basis for its motion" and identifying the matter that "it believes demonstrate[s] the absence of a genuine issue of material fact." Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986).

The substantive law determines the facts which are material to the outcome of a particular litigation. Anderson, 477 U.S. at 250; Heyman v. Commerce & Indus. Ins. Co., 524 F.2d 1317, 1320 (2d Cir.1975). In determining whether summary judgment is appropriate, a court must resolve all ambiguities, and draw all reasonable inferences against the moving party. Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587-88, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986) (citing United States v. Diebold, Inc., 369 U.S. 654, 655, 82 S.Ct. 993, 8 L.Ed.2d 176 (1962)).

If the moving party meets its burden, the burden then shifts to the non-moving party to come forward with "specific facts showing that there is a genuine issue for trial." Fed. R. Civ. Proc. 56(e). The non-moving party must "do more than simply show there is some metaphysical doubt as to the material facts."

Matsushita, 475 U .S. at 586. Only when it is apparent, however, that no rational finder of fact "could find in favor of the non-moving party because the evidence to support its case is so slight" should summary judgment be granted. Gallo v. Prudential Residential Servs. Ltd. Partnership, 22 F.3d 1219, 1223 (2d Cir.1994).

II. Infringement

An infringement analysis involves two steps. "First, the claim scope is determined without regard to the accused device. ... Second, the properly construed claim is compared with the accused device to determine whether all of the claim limitations are present either literally or by equivalent." Optical Disc Corp. v. Del Mar Avionics, 208 F.3d 1324, 1333-34 (Fed.Cir.2000) (citing Young Dental Mfg. Co. v. Q3 Special Prods., Inc., 112 F.3d 1137, 1141 (Fed.Cir.1997)). The first step is a question of law, while the second step is a question of fact. Id. at 1334. FN2

FN2. The Federal Circuit has cautioned that "[a] district court should approach a motion for summary judgment on the fact issue of infringement with great care." Cole v. Kimberly-Clark Corp., 102 F.3d 524, 528 (Fed.Cir.1996).

A. Claim Construction

1. Generally

When interpreting patent claims, the Court must first consider the intrinsic evidence of record. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996) (citing Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996)). There are three sources of intrinsic evidence: the claims, the specification and the prosecution history of the patent. *Id*. (citing Markman, 52 F.3d at 979). "Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language." *Id*.

First, the Court must look to the claims themselves to define the scope of the patented invention. *Id*. "Without an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning." York Prods., Inc. v. Cent. Tractor Farm & Family Ctr., 99 F.3d 1568, 1572 (Fed.Cir.1996). However, "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, 90 F.3d at 1582 (citation omitted).

Second, the Court must review the specification "to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Id*. "Claims must be read in view of the specification, of which they are a part." *Id*. (citing Markman, 52 F.3d at 979). The specification "is always highly relevant to the claim construction analysis" and "is the single best guide to the meaning of a disputed term." *Id*.

Third, the Court may consider the prosecution history of the patent, which "contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims." *Id*. (citing Markman, 52 F.3d at 980). Thus, the prosecution history is "often of critical significance in determining the meaning of the claims." *Id*. (citing Markman, 52 F.3d at 980).

If the Court is able to determine the meaning of the patent claims based upon intrinsic evidence alone, it may not rely on extrinsic evidence. *Id*. at 1583. "Extrinsic evidence is that evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles." *Id*. at 1584. FN3 Even if invoked, however, extrinsic evidence "may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language." *Id*. This is because "competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention." *Id*.

FN3. The Federal Circuit further noted:
Although technical treatises and dictionaries fall within the category of extrinsic evidence, as they do not form a part of an integrated patent document, they are worthy of special note. Judges are free to consult such resources at any time in order to better understand the underlying technology and 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.

Id. at 1584 n. 6.
2. Construction of the '165 Patent **claims**

Keen has alleged that InfoRocket infringes claims 1-10, 12-19 and 44 of the '165 Patent. (Keen's Mem. Prelim. Inj. at 11). Claim 1 of the '165 Patent claims:

A method of connecting two parties in real time, the method comprising:

displaying a list of experts to a consumer via an Internet connection with said consumer prior to the consumer submitting a question;

the list indicating individually whether each expert is currently available to telephonically communicate with said consumer at a time when said consumer is viewing the list, said list includes a compensation rate for each expert;

in response to the consumer selecting a displayed icon corresponding to an expert from the list, automatically establishing a telephone connection between the expert and the consumer prior to the consumer submitting a question to the expert; and

said automatically establishing the connection includes a central controller placing a telephone call to said consumer via a connection separate from said Internet connection, and said central controller placing a telephone call to said expert.

('165 Patent, col. 9, ln. 65 to col. 10, ln. 18). Claim 1 is the only independent claim contained within the '165 Patent that is alleged to be infringed.

[1] In their claim construction arguments, the parties focus primarily on certain phrases contained in claim 1 of the '165 Patent, *viz.,* "automatically establishing" a telephone connection "in response to" the selection of an icon by the consumer. With respect to the claims themselves, InfoRocket argues that the meaning of these phrases is "unequivocal":

"In response to" means exactly what it [says]. Namely, that the telephonic connection is made in response to selecting an icon. The telephonic connection is not made in response to selecting a button. Nor is it made in response to dialing a number. The language "in response to" means that once the consumer merely selects the icon, he does not perform any further manual steps to facilitate the connection.

(InfoRocket's Mem. Summ. J. at 5). In response, Keen asserts that the claims do not require an "instantaneous relationship between selecting the icon and completing the connection, like a switch closing an electrical circuit to turn on a light." (Keen's Opp'n Mem. Summ. J. at 4). Rather, according to Keen, the claims "contain language demonstrating that the process of 'automatically establishing a telephone connection' includes 'manual' steps." (Id. at 5).

With respect to the specification, InfoRocket points to the sole example provided in the '165 Patent, which describes a consumer clicking an icon and being connected to an expert:

David clicks an icon in Joe's box *and a second or two later,* a streaming real-time video of Joe appears on David's PC, and if David's PC is so enabled, Joe sees David in his PC.

(InfoRocket's Mem. Summ. J. at 6 (citing '165 Patent, col. 9, lns. 46-48) (emphasis added)). InfoRocket also highlights the portion of the specification that describes the consumer's "last step" as clicking on the symbol corresponding to the expert-indicating that the consumer need not do anything further in order to be connected to the expert. (Id. (citing '165 Patent, col. 2, lns. 27-31)). Keen responds by asserting that the steps between the consumer's selecting an icon and being connected to an expert are "interactive safety steps" consistent with the '165 Patent's intent to "protect the interests of the consumer." (Keen's Opp'n Mem. Summ. J. at 6).

With respect to the prosecution history, InfoRocket states that Keen's significant narrowing of the scope of the claims during the application process supports its interpretation of the disputed claim language. (InfoRocket's Mem. Summ. J. at 6). Claim 1 of the originally filed application claimed:

1. A method of facilitating the delivery of advice to consumers, comprising:

providing a server unit with the ability to store the names or identification of two or more experts, said experts coded by one or more expert characteristics, said server having the ability to detect which experts are online;

said server having the ability to display at least one of said expert characteristics with information-rich graphics or symbols;

said server having the ability to respond to a consumer's selection of expert by either sending the consumer a means to contact expert or by connecting the consumer and expert for real-time communication;

wherein the time-to-connect between consumer and expert is 30 minutes or less.

(Declaration in Support of John A. Bauer, sworn to on February 15, 2002, Ex. 2, at 38 ("Bauer Decl.")). This claim was rejected by the Patent and Trademark Office ("PTO"). (P.I. Hearing Tr. at 71-73). So, too, was the following significantly more narrow claim rejected, in light of the Walker Patent, as obvious:

101. A method of connecting two parties in real time, the method comprising:

displaying a list of experts to a consumer, the list including an indication of each expert's current availability; and,

in response to the consumer selecting an expert from the list, establishing a real time communication connection between the expert and the consumer.

(Bauer Decl., Ex. 2, at 170, 189). Only after this claim was rejected did Keen amend its application to the language as it exists in Claim 1 in the ' 165 Patent. (Id. at 229). In distinguishing this amended claim from the Walker Patent, Keen asserted:

In addition, Walker does not disclose a central controller automatically placing two independent separate calls to the expert and consumer, in response to the consumer selecting an icon displayed via the Internet. Rather, Walker teaches away from the claimed limitation by only teaching a time consuming and tedious Interactive Voice Response Unit maze, that requires the consumer call into the IVRU and navigate their way into having the expert contacted. (Walker col. 29).

(Id. at 289 (emphasis omitted)). Keen responds to InfoRocket's argument by suggesting that the prosecution history of the '165 Patent does not address the "in response to" or "automatically establishing" language, but rather focused on the differences between the way that the '165 Patent and the Walker Patent taught to select an expert (*icon v. bidding process*) and the patents' different usage of telephones (central controller and *Internet connection v. Interactive Voice Response Unit*). (Keen's Opp'n Mem. Summ. J. at 9).

I find that InfoRocket's interpretation of the phrases "automatically establishing" and "in response to" in Claim 1 of the '165 Patent is correct and I construe the claims accordingly. The Oxford English Dictionary's first definition of "automatically" includes "by spontaneous, or apparently spontaneous, action," (1 Oxford English Dictionary 805 (2d ed.1991 (the "Dictionary")), and the second definition includes "without active thought or volition, unconsciously, involuntarily, mechanically," (id.). The Dictionary's definition 1a of "response" includes "an answer, a reply," and definition 1c includes "[t]he way in which an apparatus responds to a stimulus...." (8 Oxford English Dictionary 741 (2d ed.1991)). FN4 Using these plain meanings, the stimulus in the ' 165 Patent is the clicking on the icon. The apparatus or, here, the website, responds to that stimulus by establishing the telephone connection. Use of the word "immediately" as a modifier confirms that the response, that is, the telephone connection, is set up spontaneously or mechanically, without additional volitional acts.

FN4. Keen provides no independent definition in the '165 Patent of the term "automatically." Therefore, that term is defined by its ordinary meaning, which may include the use of a dictionary. *See* CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed.Cir.2002) ("Sensibly enough, our precedents show that dictionary definitions may establish a claim term's ordinary meaning."); York Prods., 99 F.3d at 1572-73 (using two dictionaries to construe the term "substantially").

Thus, the plain meaning of the words in claim 1 is that clicking on or selecting a displayed icon corresponding to an expert results in an immediate telephone connection between the expert and the consumer, without a series of intervening manual steps. This construction is confirmed by both the

specification (reflecting the consumer's clicking the icon as the "last act" and a connection "a second or two later") and the prosecution history (where Keen's twice-amended application documents attempted to circumvent the prior art by, *inter alia,* adding the word "automatically" to modify "establishing a telephone connection," (Bauer Decl., Ex. 2, at 229, 289)).

Ultrak, Inc. v. Kustom Signals, Inc., No. Civ. 3:96-CV-1569-H, 1997 WL 528046 (N.D.Tex. Aug.18, 1997), further confirms this construction. There, plaintiff Ultrak, Inc. ("Ultrak") alleged infringement of claim 1 of its patent entitled "Police Protection Method and Apparatus" against defendant Kustom Signals, Inc. ("Kustom"). *Id.* at *1. Both Ultrak's and Kustom's systems "enable recording of a police officer's interrogations and interactions by using a wireless microphone transmitter to transmit the officer's conversations to a recording device located in the officer's patrol car." *Id.* In the patented Ultrak device, when the microphone transmitter is not being used it is stored in a recharging holder in the police car. *Id.* An officer exiting his vehicle removes that transmitter from its holder-which "automatically initiates transmission and recording"-and places it in his pocket. *Id.* Further, the transmitter has an "override" provision that enables the officer to remove it from the holder and move without transmitting. *Id.* In the accused Kustom system, however, "the microphone transmitter is worn continuously on the officer's belt," and the officer must manually turn on the transmitter before it can be used. *Id.*

Ultrak argued that Kustom's device infringed claim 1 of the patent, which claims "a method for providing the record of interrogation and activity by police officers, ... including: a. replacement of an automatically activated transmitter in the officer's clothing." *Id.* Kustom, in turn, moved for summary judgment for noninfringement "on the basis that the accused device does not involve the 'replacement' of an 'automatically activated transmitter' on an officer's person." *Id.*

With respect to claim construction, the parties presented different interpretations of the phrase "automatically activated." *Id.* at *3. Kustom asserted that it refers to "the feature of the patented system that the transmitter begins sending a signal to the recorder immediately upon removal from its holder, without the officer having to switch the unit on." *Id.* Therefore, Kustom's system would not infringe the patent because an officer must manually turn on Kustom's transmitter to start recording. *Id.* Ultrak, on the other hand, argued that the phrase only means that the officer must push a button to record particular words and that the use of the phrase "automatic" is meant "to distinguish the patented device's 'hands-free' transmitter from walkie-talkie-type 'push-to-talk' transmitters that had been the subject of other patents for police devices." *Id.*

After considering both the patent and its prosecution history, the court agreed with Kustom's claim interpretation:

[T]wo central features of the "automatic" operation of the transmitter were 1) that the system began to transmit and record immediately, without the officer having to take any special action, and 2) that it did not enable the officer (intentionally or otherwise) to turn the transmitter off and on easily to selectively record. Moreover, considering ordinary meaning of the term, "automatically activated" is naturally construed to mean that a device begins operating without being specially turned on.

Id.

Keen cites *Bingo Brain, Inc. v. California Concepts, Inc.,* 2002 U.S. Dist. LEXIS 1209 (N.D.Ill. Jan. 24, 2002), to support its interpretation of the term "automatically." (Letter from Mark D. Rowland to the Court,

dated April 26, 2002, at 2). That case does not support Keen's position. In *Bingo Brain,* the parties were competitors in the market for hand-held devices that allowed players to use multiple bingo cards simultaneously. Dependent Claim 18 in the patent at issue provided:

18. The method of claim 13 wherein the number configurations for the next game having identification numbers which are displaced in a predetermined relationship from the identification numbers of the previous game are *automatically* transferred from storage to the calculating unit without entering the identification numbers of the selected number configurations. ('151 Patent, Col. 6, lines 40-46).

(*Id*. at (emphasis added)). Both parties agreed that this phrase meant, at a minimum, that "the device automatically enters the next set of bingo cards at the end of a game." (*Id*. at *21). But while defendants argued that "the use of the word 'automatically' in Claim 18 precludes any human intervention to initiate the transfer of the number configurations," plaintiff suggested that "this automatic function can *also* be initiated by the player by pressing a button to signal that the game is over." (*Id*. (emphasis added)).

The court agreed with plaintiff's interpretation of the claim:

The Patent details a device that is able to determine which sheet of bingo cards follows the sheet just played, and pull that successor sheet from its memory so the player can play this sheet next. *No intervention is required for the device to determine which sheet of cards is next. Nor is intervention required for the device to retrieve that sheet from the memory. In other words, the device has a "self-regulating mechanism" that enables it to complete those functions. Only the timing of these processes is initiated by human intervention.* Thus, the question becomes whether the fact that this procedure is initiated by an external factor precludes it from being automatic. The court finds that it does not. The device, on its own, ascertains which sheet of bingo cards comes next and makes that sheet available for play-the player merely prompts the machine to perform this automatic function. An "automatic" garage door opener, similarly, does not sense that an automobile is ready to enter or depart a garage, but performs automatically once it is prompted to do so. Much the same, the device does not sense that a player in the bingo hall has shouted "bingo" and call up the next sheet to be played, but prepares for the next game once the player instructs the device that a new game is starting.

(*Id*. at *21-*22 (emphasis added)). Therefore, the court concluded, "the word 'automatically,' as used in the '151 Patent, does not preclude human intervention to trigger a process that is, in all other respects, automatic." (*Id*. at *24).

In the instant case, however, both parties agree, as they must, that the ' 165 Patent requires, at a minimum, that a telephone connection between a consumer and an expert *is* initiated by an external factor- *i.e.,* the clicking of an icon. In other words, neither party suggests that when the consumer sits down at his computer, the computer "senses" that the consumer desires to initiate a telephone connection with the expert and "automatically" facilitates that connection. Rather, the only issue is how much more additional human intervention is needed, beyond the initial clicking of an icon, before InfoRocket is outside the scope of Claim 1's "automatically establishing" language. Therefore, *Bingo Brain* does not change the result.

B. Infringement

Once the claims of a patent are properly construed, the Court must compare the alleged infringing device with the claims of the patent. Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1351

(Fed.Cir.2001). The accused device infringes the patent if it "embodies every limitation of the claims," either literally or under the doctrine of equivalents. IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1429 (Fed.Cir.2000).

1. Literal Infringement

[2] Keen presents no genuine issue of material fact as to whether InfoRocket's website literally infringes the '165 Patent. It is undisputed that there are numerous steps a consumer navigating InfoRocket's website must take between initially clicking on an icon and being connected to an expert on the telephone. Indeed, Keen's own expert in the areas of Internet and telephone technology, James Salter, confirmed at the preliminary injunction hearing the existence of those steps:

Q: I think you're not really answering my question. My question is: When you click [InfoRocket's] icon, is the next step a telephone call placed to the expert? The very next step.

A: No.

Q: In fact, isn't the next step that the user sees a not live connection with the expert, but he sees another screen, is that correct? He would see this type of screen.

A: Yes. The same screen that I indicated in my demonstration.

Q: Right. And this screen does not contain an icon corresponding to current availability, does it?

A: No, it does not.

Q: It's a button, correct; that's the "Talk Now" button?

A: That's correct.

Q: Okay. So let's go back. We have the expert. We click on this icon, and instead of talking to the expert, we get a next screen, correct?

A: Correct.

Q: And then, we now click on the "Talk Now" button, and are we connected yet to the expert?

A: No. The selecting the "Talk Now" button is a confirmation that the consumer wants to continue with the telephone conversation.

Q: Right. So you agree that when you click the "Talk Now" button, you're still not connected to the expert, correct?

A: Not at the time that that-not immediately, no.

(P.I. Hearing Tr. at 62-63). Even after these steps, the process is still not complete: the consumer receives a phone call and must press the number "1," which causes the central controller to contact the advisor by

placing a phone call to that advisor. (Bauer Decl., Ex. 5, Deposition of Richard Belgard, at 55, 57). The advisor must then answer the telephone and press the number "1". (P.I. Hearing Tr. at 45). Only then is a connection between the consumer and the advisor finally established. (Id.). In other words, the connection between consumer and expert on InfoRocket's website is not "automatically establish[ed]" per the properly construed language in Claim 1, meaning that there is no literal infringement.

2. Doctrine of Equivalents

If the Court finds no literal infringement, an accused product may still be found to infringe under the doctrine of equivalents. The doctrine of equivalents ensures that "a patent protects its holder against efforts of copyists to evade liability for infringement by making only insubstantial changes to a patented invention." Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushika Co., 535 U.S. 722, ----, 122 S.Ct. 1831, 1835, 152 L.Ed.2d 944 (2002).

"To infringe a claim under the doctrine of equivalents, an accused device must include an equivalent for each literally absent claim limitation." Torto Co. v. White Consolidated Indus., Inc., 266 F.3d 1367, 1370 (Fed.Cir.2001). "An element in the accused product is equivalent to a claim limitation if the differences between the two are 'insubstantial' to one of ordinary skill in the art." Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 812-13 (Fed.Cir.2002) (quoting Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 40, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997)). "Insubstantiality may be determined by whether the accused device 'performs substantially the same function in substantially the same way to obtain the same result' as the claim limitation." *Id*. at 813 (quoting Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950)).

As the Supreme Court recently confirmed in *Festo,* the doctrine of equivalents may be limited by prosecution history estoppel:

Prosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process. Estoppel is a "rule of patent construction" that ensures that claims are interpreted by reference to those "that have been cancelled or rejected." The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes. When, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent. On the contrary, "[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases[,] ... and [t]he difference which [the patentee] this disclaimed must be regarded as material."

535 U.S. at ----, 122 S.Ct. at 1838.

Just as InfoRocket's website does not literally infringe the claims of the ' 165 Patent, the website also does not infringe those claims under the doctrine of equivalents. The differences between the numerous steps required to connect a consumer and an expert on InfoRocket's website, on one hand, and the '165 Patent's requirement that a telephone connection be "automatically establish[ed]" in response to a consumer's selecting an icon that corresponds to an expert, on the other hand, can hardly be described as "insubstantial." Further, to the extent that prosecution history estoppel is applicable, it does not alter this conclusion-indeed, if anything, it provides further support. Keen at least twice amended its application for the '165 Patent,

distinguishing itself from the Walker Patent by asserting that, *inter alia,* "Walker does not disclose a central controller automatically placing two independent separate calls to the expert and consumer, in response to the consumer selecting an icon displayed via the Internet." (Bauer Decl., Ex. 2, at 289 (emphasis omitted); *see* Festo, 535 U.S. at ----, 122 S.Ct. at 1840 ("A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with s. 112.")).

III. Obviousness and Nonenablement

Because InfoRocket's motion for summary judgment on the basis of noninfringement has been granted, InfoRocket's motions for invalidity based on obviousness and nonenablement are denied as moot.

CONCLUSION

InfoRocket's motion for summary judgment on the basis of noninfringement is granted. The Clerk of the Court shall mark this action closed and all pending motions denied as moot.

SO ORDERED:

S.D.N.Y.,2002.
Keen, Inc. v. InfoRocket.com, Inc.

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