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

LOTTOTRON, INC,
Plaintiff.
v.
SCIENTIFIC GAMES CORP,
Defendant.

No. 03 Civ. 0920(HB)

Sept. 8, 2003.

Assignee of patents brought action against alleged infringer of four patents on lottery wagering system that enabled subscriber to place wagers through use of telephone. Upon parties' motion for construction of terms "routed" and "routing" which appeared throughout many of the patents' claims, the District Court, Baer, J., held that: (1) term "routed" and "routing" meant specifying the path for incoming message according to characteristic of the incoming message, and transmitting incoming message on specified path, instead of merely transmitting messages or identifying characteristics of messages; (2) terms "ACD means" and "communication means" in patents were construed as combination of voice responsive unit with programmed computer processor; (3) term "storage means" in patent claims would not be construed as means-plus-function limitation, as to claim describing means by which subscribers' incoming messages and wagering information were received and stored; and (4) construction of independent claims as to whether illustrative embodiment consisting of equipment from certain designated manufacturers would be treated as benchmark structure against which infringement should be measured entailed factual inquiry that would be better resolved after issue of infringement was before court.

Ordered accordingly.

5,415,416, 5,904,619, 5,910,047, 5,921,865. Construed.

OPINION & ORDER

BAER**, J.**

Plaintiff Lottotron, Inc. ("Lottotron") commenced a lawsuit against defendant Scientific Games Corp. ("Scientific Games"), for patent infringement of four patents assigned to Lottotron. The four patents-in-suit are United States Patent Nos. 5,910,047 ("the '047 patent"); 5,415,416 ("the '416 patent"); 5,904,619 ("the '619 patent"); and 5,921,865 ("the '865 patent") (collectively "the Scagnelli patents"). A *Markman* hearing was held on July 14, 2003 to determine the meaning of disputed terms. The Court construes the terms in the context of the asserted claims as follows.

I. THE SCAGNELLI PATENTS

The Scagnelli patents concern a lottery wagering system or method that enables a subscriber to place lottery wagers through a telecommunication means, such as a telephone, in one or more available lotteries. In one preferred embodiment, separate telephone numbers are provided for "enrolling" subscribers, *e.g.,* signing up wagerers new to the system, and for wagering. Depending on the phone number called by the subscriber, an automatic call director ("ACD") directs the call to the appropriate voice responsive unit ("VRU") that provides voice instructions to either enroll a subscriber or place a wager according to which of a plurality of lottery games the subscriber prefers to play.

II. GENERAL CLAIM CONSTRUCTION STANDARDS

Claim construction is a matter of law for the court. 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). The process begins with the language of the claims, which is to be read and understood as it would be by a person of ordinary skill in the art. Dow Chem. Co. v. Sumitomo Chem. Co., 257 F.3d 1364, 1372 (Fed.Cir.2001); Hockerson-Halberstadt, Inc. v. Avia Group Internat'l, Inc., 222 F.3d 951, 955 (Fed.Cir.2000); *see also* Markman, 52 F.3d at 986 ("[T]he focus [in construing disputed terms in claim language] is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term[s] to mean."). In construing the claims, the Court may examine both intrinsic evidence (*e.g.,* the patent, its claims, the specification and file history) and extrinsic evidence (*e.g.,* expert reports, testimony, and anything else). Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309 (Fed.Cir.1999). In interpreting the disputed terms, it is well settled that a court should look first to the intrinsic evidence. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). Generally, the terms in a claim should be given their ordinary and accustomed meaning as understood by one of ordinary skill in the art at the priority date of the patent application. Dow Chem., 257 F.3d at 1372; K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1362 (Fed.Cir.1999). Extrinsic evidence is considered only where the intrinsic evidence does not provide a sufficient description to resolve ambiguities in the scope of the claim. *See* Vitronics, 90 F.3d at 1583; Johnson Worldwide Assoc., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999). The definition of a claim term may be altered from its ordinary and accustomed meaning if "clearly and deliberately" set forth in the intrinsic evidence, such as the written description and prosecution history. K-2 Corp., 191 F.3d at 1363. For instance, arguments made during the prosecution of a patent application to distinguish the claimed invention over the prior art may limit the scope of construction of the claim term, and should be given the same weight as claim amendments. Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 979 (Fed.Cir.1999); Southwall Techns., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed.Cir.1995).

If a clause contains a means-plus-function limitation, the first step in construing it is to identify the function of that limitation. Micro Chem., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1258 (Fed.Cir.1999). The next step is to identify the corresponding structure in the written description necessary to perform that function. *Id.* If a claim limitation employs means-plus-function language, the limitation may only be construed to cover "the corresponding structure ... described in the specification." 35 U.S.C. s. 112, para. 6. A "structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the *quid pro quo* for the convenience of employing s. 112, para. 6." B. Braun Medical, Inc. v. Abbott Laboratories, 124 F.3d 1419, 1424 (Fed.Cir.1997).

Invocation of s. 112, para. 6 does not relieve the inventors of the requirements under s. 112, para.para. 1 & 2. In re Donaldson Co., 16 F.3d 1189, 1195 (Fed.Cir.1994). "For a claim to meet the particularity

requirement of [35 U.S.C. s. 112,] para. 2, the corresponding structure(s) of a means-plus-function limitation must be disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation." Atmel v. Information Storage Devices, Inc., 198 F.3d 1374, 1382 (Fed.Cir.1999). "The disclosure of the structure (or material or acts) may be *implicit* or *inherent* in the specification if it would have been clear to those skilled in the art what structure (or material or acts) corresponds to the means (or step)-plus-function claim limitation." Manual of Patent Examining Procedure ("MPEP") (8th ed.) s. 2181 (2003) (citing Atmel, 198 F.3d at 1380; *In re Dossel,* 115 F.3d at 946-47)(emphasis added). Satisfaction of the description requirement imposed by para. 1 will satisfy the requirements of para. 6. In re Knowlton, 481 F.2d 1357, 1366 (CCPA 1973). When the written description only implicitly or inherently sets forth the structure corresponding to the means-plus-function, however, the Patent and Trademark Office recommends that the disclosure be amended "to explicitly state, with reference to the terms and phrases of the claim element, what structure ... performs the function recited for a claim element." MPEP s. 2181. Even so, when the structure is only implicit or inherently disclosed in the written description, that description may comply with s. 112, para.para. 1 & 2 if a person skilled in the art would know and understand which structure corresponds to the means limitation. *See* Creo Prods., Inc. v. Presstek, Inc., 305 F.3d 1337, 1347 (Fed.Cir.2002)(affirming holding that claim was not invalid despite the fact the structure corresponding to the recited function in a means-plus-limitation was only implicit in the written description); MPEP s. 2181 (acknowledging that a disclosure that implicitly sets forth the corresponding structure may be "in compliance with 35 U.S .C. 112, first and second paragraphs.").

III. DISCUSSION

The parties here seek claim construction of the term "routed" and "routing," which are terms that appear throughout many of the claims in the Scagnelli patents. In addition, defendants contend that the means-plus-function claim limitations in many of the asserted claims are indefinite or largely limited to the type of machine enumerated by the specifications.

A. Function of Routed and Routing

Lottotron takes claim 1 FN1 of the '047 patent as an example of a claim that uses the terms "routing" and "routed." Clause (a), which contains the term "routing," is a mean-plus-function limitation. From the face of the claim, the ACD means performs two functions: (1) it receives incoming messages from subscribers and (2) *routes* each of said messages according to which one of said plurality of different wagering formats FN2 is requested by a caller. Lottotron contends that the term "route" should be treated as equivalent to "transmit." Scientific Games contends that routing, in addition to transmission, requires "(i) an identification of a characteristic of the calls, communications or messages" and "(ii) a selection of a destination for the calls, communications, or messages depending on the identified characteristic." Scientific Games ("S.G.") Br. at 4.

FN1. Claim 1 reads as follows:

A wagering system for accepting a plurality of different wagering formats over a telephone comprising:
a) automatic call director means for receiving incoming messages from subscribers and *routing* each of said messages according to which one of said plurality of different wagering formats is requested by a caller;
b) message responsive means connected thereto for receiving the incoming messages *routed* from said automatic call director means, for generating a series of messages requesting subscriber wager information to be input, for playing an associated series of audio messages requesting confirmation of the subscriber wager information, and for playing a confirmation message with an associated ticket number assigned to a

wager; and
c) host processor means having storage means connected to said message response means for receiving said subscriber wager information, comparing said subscriber wager information to a master subscriber enrollment file for validation, storing said subscriber wager information in a master subscriber wager file in the storage means, and assigning an associated ticket number to the wager.
FN2. Wagering format refers to the kind of lottery games that are available, such as Keno, Lotto, and 3- or 4-digit lotteries.

[1] Neither the specification nor prosecution history clearly spells out the definition of "routing" and "routed." I will presume, as the parties do here, that the terms carry the ordinary meaning as understood by persons of ordinary skill in the art. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366-67 (Fed.Cir.2002). Despite the agreement that dictionaries may be used to help construe the terms, *see* Lottotron Repl. at 4; S.G. Br. at 10, the parties interpret the significance of the dictionary definitions differently. Scientific Games suggests that the dictionary definitions are wholly consistent with its construction that requires the ACD means to identify a characteristic of the message, select a destination for such message, and transmit the messages. Scientific Games notes that the verb "route" is defined to mean: "[t]o send by a *certain route,*" or "[t]o assign a route to," *Webster's II New Riverside Dictionary* 595 (Revised ed.1996) (emphasis added); "to send or forward by a *particular route,*" *Webster's Encyclopedic Unabridged Dictionary of the English Language* 1676 (1996) (emphasis added); "to send *by a select route,*" or "to divert *in a specified direction,*" Merriam Webster On-Line, *at http:// www.merriam-webster.com* (last visited June 19, 2003) (emphasis added). In addition, defendant observes that Newton's Telecom Dictionary defines "routing" as "[t]he process of *selecting* the correct circuit path for a message." *Newton's Telecom Dictionary* 618 (14th ed.1998) (emphasis added).

Lottotron argues that Scientific Games' definition is wrong because, *inter alia,* it ignores the ordinary definition of the term, which "does not inherently require 'identification' or 'selection,' " Lottotron Repl. at 4, and because it imports limitations from one embodiment in the specification into the claim term. *Id.* at 5. Further, Lottotron notes that it would be entirely consistent to substitute the word "transmit" in place of "route" in the specification.

Neither party disputes that the term "route" or "routing" in the claims entails transmitting messages. The issue that must be resolved here concerns whether one skilled in the art would understand "routing" to also include identifying a characteristic of the message and selecting a destination for the message based on the characteristic. Although "dictionaries ... are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms," Texas Digital Systems, Inc. v.. Telgenix, Inc., 308 F.3d 1193, 1202 (Fed.Cir.2002), the Federal Circuit "cautioned against the use of non-scientific dictionaries 'lest dictionary definitions ... be converted into technical terms of art having legal, not linguistic significance.' " Bell Atlantic Network Services, Inc. v. Covad Communications Groups, Inc., 262 F.3d 1258, 1267 (Fed.Cir.2001) (quoting Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1478 (Fed.Cir.1998)). The communications systems and protocols claimed and described in the Scagnelli patents relate to the telephonic communications art, *see* Classification Search 379 listed on '416 patent, '619 patent, '047 patent, and '865 patent, and hence, telecommunication dictionaries appear to be a natural and reasonable place to begin my inquiry into the ordinary meaning of the terms "route" and "routing." *See* Vitronics, 90 F.3d at 1584 n. 6 ("[T]echnical treatises and dictionaries ... are worthy of special note. Judges are free to consult such resources at any time ... and may also rely on dictionary definitions when construing claim terms."). As noted above, Newton's Telecom Dictionary defines "routing" as "[t]he process of

selecting the correct circuit path for a message." *Newton's Telecom Dictionary* 618 (14th ed.1998). FN3 The Glossary of Telecommunications Terms published by the National Communications System Office of Technology and Standards defines "routing" to mean "[t]he process of determining and prescribing the path or method to be used for establishing telephone connections or forwarding messages." *Federal Standard 1037 C: Glossary of Telecommunication Terms,* Office of Technology and Standards, *at* http://www.its.bldrdoc.gov/fs-1037/ (1996); *see also T1 Glossary 2000: Glossary of Telecommunication Terms,* American National Standard for Telecommunications, *at http://www.atis.org/tg2k/t1g2k.html* (2001) (adopting 1037 C Federal Standard definition of "routing"). The definitions clearly suggest that "routing" must specify the path on which to transmit the message. Assuming my reliance on these specialized dictionaries is misplaced, I would add that the standard English dictionaries also support the view that the process of "routing" a message must entail determining the particular route that the message will follow. The particularity of the route would be lost if the ACD means lacked the ability to specify the path on which to transmit the message. *See, e.g., Webster's Encyclopedic Unabridged Dictionary of the English Language* 1676 (1996) (defining "routing" to mean "to send or forward by a *particular route*" (emphasis added)).

FN3. Neither party disputes that the meaning of "route" and "routing" has not changed since the issuance of the '416 patent, which issued in 1995 and the other three patents-at-issue, which issued in 1999, and thus I may rely on dictionary definitions up through approximately 1999, when the later three patents issued. *See* Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp., 309 F.3d 1365, 1370 (Fed.Cir.2002).

Lottotron contends that the selection of the destination arises not from the ACD means, but rather from the wagerer. Although Lottotron is in some respects correct that the destination of the transmission is specified by the wagerer when there are a "plurality of different wagering formats," '047 patent (claim 1), that choice must be translated to the ACD means, which specifies the appropriate subsystem of the invention to transfer the call. One must discriminate between the selection by the subscriber, and the selection taken by the ACD means to effectuate the request placed by the subscriber. If the ACD means lacked the capacity to specify which, among the plurality of wagering formats subsystems to transfer the call, the lottery wagering system would be inoperative. In other words, the wagerer could make his selection, but if the ACD means did not have the ability to specify the appropriate subsytem to which the call was to be transferred, the invention would be unable to "rout [e] each of said messages according to which one of said plurality of different wagering formats [was] requested by [the] caller." '047 patent (claim 1).

Scientific Games contends that the specification supports its position that the process of routing further includes the step of identifying a characteristic of the call or message. None of the definitions from the standard English or technical dictionaries, however, inherently requires "routing" to include such a step. Scientific Games notes that if a subscriber called, for example, 1-800-ENROLL, the disclosed ACD should transfer the call to the enrollment VRU, whereas if the caller dialed 1-800-WAGER, the ACD should transfer the call to the wagering VRU. From the described process, Scientific Games concludes that the ACD, and hence the ACD means, must identify the number dialed, *e.g.,* 1-800-WAGER or 1-800-ENROLL. Scientific Games assumes that the ACD corresponds to the ACD means. It would be improper, as Scientific Games seeks to do here, to look at the structure described in the specification and attempt to superimpose the function performed by it onto the function recited in the means-plus-function clause. *See* Micro Chem. ., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1258 (Fed.Cir.1999). Furthermore, it would be a cardinal sin of patent law for a court to "read into a claim a limitation from a preferred embodiment, if that limitation is not present in the claim itself." Bayer AG. v. Biovail Corp., 279 F.3d 1340, 1348 (Fed.Cir.2002); *see also* CCS Fitness, 288 F.3d at 1366 ("[A]n accused infringer ... cannot [narrow a claim

term's ordinary meaning] by simply pointing to the preferred embodiment or other structures or steps disclosed in the specification or prosecution history.").

Scientific Games further argues that the addition of the "routing" limitation according to the requested wagering format to overcome prior art adds weight to its argument that "routing" includes more than simply transmitting a message. I see no evidence that the inventors sought to differentiate their inventions from prior art on the ground that prior art that "routed" calls did not identify a characteristic of the incoming message. Indeed, the patent examiner acknowledged the existence of prior art that routed incoming calls based on the subscriber's financial institution information to make electronic fund transfers. *See, e.g.,* Walsh Exh. I, Tab 30 (11/17/98 Office Action Summary for '047 patent) at 5. The examiner found that the amended claims were patentable because the prior art neither disclosed nor suggested "routing incoming calls based upon [the] wagering format requested." Id. (emphasis added); *see also* Gulia Exh. E, Tabs 6, 7 (Amendment and Notice of Allowance in '619 patent) (allowing claims after inventors amended claim to "rout[e] each of said communications [according] to one of a plurality of different wagering formats as requested by a subscriber."); Gulia Exh. F, Tabs 6, 8 (Office Action and Amendment in the '865 patent). In the examiner's view, the basis for routing the calls was the principle distinguishing feature that made the claims allowable over prior art. I find nothing in the intrinsic evidence that precludes the claimed invention from having a separate element that identifies a property of the incoming call, and conveys such information to the corresponding structure that performs the routing function, so that it may route the call in accordance with the wagering format selected by the caller. The ramification of the amendment cannot be stretched so far as to suggest that the inventors sought to distinguish their inventions from prior art on the basis that routing must include identifying a characteristic of the message from the subscriber, as Scientific Games perhaps implies in its argument. I find no limitation in the claim language nor any clear statement in the specification or prosecution history that redefines the definition of "routing" to include the task of identifying a characteristic of the incoming message from subscribers.

In sum, I concur with defendants that "routing" must entail more than simply transmitting calls, contrary to plaintiff's argument. Rather, "routing" further includes specifying the path on which to transmit the subscriber's call. For the foregoing reasons, the term "routing" in the context of the claims is construed to mean:

(1) specifying the path for a subscriber's incoming message according to a characteristic of the incoming message; and

(2) transmitting the incoming message on the specified path.

Messages are "routed" if they arrive at a destination via a "routing" process as defined above.

B. Construction of '047 Patent **Independent Claims**

The '047 patent has 5 independent claims, *i.e.,* claims 1, 6, 10, 11, and 15. Lottotron does not intend to assert claims 10 or 15. As to claims 1, 6, and 11, clause (a) in each respective claim is a means-plus-limitation that recites two functions-(1) receiving incoming messages and (2) routing those messages on the basis of the wagering format requested by the caller. Scientific Games contends that there is no structure described in the specification that corresponds to both receiving incoming messages and routing messages on the basis of the wagering format requested by the wagerer. Patent claims must be presumed to be valid, 35 U.S.C. s. 282, and should be construed accordingly, to preserve their validity if possible. *See, e.g.,* Tate Access Floors, Inc.

v. Interface Architectural Resources, Inc., 279 F.3d 1357, 1367 (Fed.Cir.2002). "A challenge to a claim containing a means-plus-function limitation as lacking structural support requires a finding, by clear and convincing evidence, that the specification lacks disclosure of structure sufficient to be understood by one skilled in the art as being adequate to perform the recited function." Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc., 336 F.3d 1308 (Fed.Cir.2003) (citing Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1377 (Fed.Cir.2001)). Scientific Games focuses, in particular, on the fact that the ACD depicted in Figure 1 of the '047 patent routes calls according to the number dialed by the caller, but not according to the wagering format requested by the caller. Lottotron concedes that the ACD "does not perform the claimed function (routing according to which of a plurality of different formats is requested)," Lottotron Repl. at 10, and thus the ACD in Figure 1 is not an "ACD means."

Lottotron contends that the "[s]tructure which performs the format-dependent routing function [recited in clause (a)] is the equipment which performs the function illustrated at the bottom of Figure 3" of the '047 patent. Lottotron Repl. at 10. Figure 3 depicts a flow chart for the wagering and game selection process. According to Lottotron, "the operation of the [VRU] and host computer are described with reference to flow charts [in the Figures,] which instruct a person of ordinary skill how the devices should be programmed to achieve the desired result." Id. at 13. As shown in Figures 3 and 3C and described at column 5, line 35 through column 6, line 53 of the '047 patent, the VRU prompts the caller for information as to the subscriber's ID and pin, and requests the amount the subscriber would like to wager. By the time the VRU plays the "state selection" script, the host processor should have checked the subscriber's validation, and signaled the VRU to either proceed with the "state lottery" script or "to *transfer* the call to customer service." Id. at 6:39-44 (emphasis added). After the subscriber selects the state in which he or she seeks to play the lottery, the VRU then plays the "game selection" script of the selected state and invites the subscriber to play one of a plurality of lotteries. Id. at 6:28-35. If, for instance, the subscriber pressed "6" on his telephone keypad, the subscriber's call would then "be *transferred* to the 6-digit Lotto process as described in FIGS. 5, 5A, and 5B." Id. at 6:36-38 (emphasis added). "If subscriber cannot place a wager for any reason at this point, the VRU will *transfer* the caller to a customer service agent for assistance in completing the wager." Id. at 6: 46-49. From the description of the wagering and game selection process, '047 patent, 5 :35-6 :53, it would be plain to persons of ordinary skill that the VRU plays an integral role in routing the call according to the wagering format requested by the subscriber. By virtue of the VRU's ability to "transfer" calls, it must inherently be able to accept calls, *i.e.,* take "incoming messages" from subscribers and send them on to another destination.

[2] [3] The critical inquiry into whether the disputed means-plus-function limitation satisfies the definiteness requirement, *i.e.,* 35 U.S.C. s. 112, para. 2, is "whether one skilled in the art would have understood that the specification ... disclosed structure [that is] capable of performing the function recited in the claim language." Creo Prods., 305 F.3d at 1347. As noted above, the written description discloses that the host processor instructs the VRU as to where to transfer the call if problems arise in the validation process. Further, the specification notes that the "VRU also can be *programmed* to determine [whether] a subscriber is having difficulty in using the system." *Id.* at 6:44-46 (emphasis added). Persons of ordinary skill in the art of electronic lottery wagering would understand, on the basis of the disclosure that the VRU may be "programmed," that the structure referenced in clause (a) of claims 1, 6, and 11 must correspond to a VRU with a computer processor, and that this computer processor instructs the VRU as to the path on which the incoming messages should be directed, in accordance with the flowchart depicted in the bottom third of Figure 3 of the '047 patent. The written description provides sufficient disclosure to one skilled in the art to know and understand that the VRU receives incoming messages and transfers the incoming messages, in accordance with instructions from a computer processor. FN4 Atmel, 198 F.3d at 1382. Neither

party disputes that the ACD means in claims 1 and 6 corresponds to the same structure as the "communication means" in claim 11. Accordingly, both are construed, pursuant to 35 U.S.C. s. 112, para. 6, as the combination of a VRU with programmed computer processor to collectively perform the function of receiving calls from subscribers and routing those calls according to the wagering format selected by the subscriber.

FN4. I would add in connection with construing the steps encompassed by "routing" that nothing in the intrinsic record prohibits the claimed invention from having an element, separate from the ACD means, that identifies a characteristic of incoming message, *e.g.,* identify whether the subscriber presses "6" on his keypad to play 6-digit Lotto, and forwards this information to the ACD means, which would then route the call based on this information.

[4] Lottotron contends that "storage means" in claim element 11(c) should not be treated as a means-plus-function limitation. Scientific Games raises no argument against Lottotron's contention. Clause (c) of claim 11 reads as follows: "storage means connected to said message means for receiving and storing said wagering information." The use of "means for" in a clause creates a presumption that the inventor intended to cast the clause as a means-plus-function limitation, pursuant to 36 U.S.C. s. 112, para. 6. Sage Prods., Inc., v. Devon Indus., Inc., 126 F.3d 1420, 1427 (Fed.Cir.1997). The presumption may be rebutted if the means-plus-function limitation "describes the structure supporting the [claimed function]." Cole v. Kimberly-Clark Corp., 102 F.3d 524, 531 (Fed.Cir.1996). In *Cole,* for instance, the Federal Circuit determined that "perforation means ... for tearing" did not come within the ambit of s. 112, para. 6 because the recitation of "perforation" provided sufficient recitation of structure to overcome the presumption that ordinarily applies. *Id*. In that case, the Federal Circuit found that "the word 'means' did nothing to diminish the precise structural character of th[e perforation] element." *Id*. Here, "storage" is defined by the Glossary of Telecommunications Terms to mean "[a] device consisting of electronic, electrostatic, electrical, hardware or other elements into which data may be entered, and from which data may be obtained, as desired." *Federal Standard 1037 C: Glossary of Telecommunication Terms,* Office of Technology and Standards, *at* http:// www.its.bldrdoc.gov/fs-1037/ (1996). In view of the definition of storage, and Scientific Games' lack of specific resistance to Lottotron's argument, I agree that "storage" describes the structure for "receiving and storing" wagering information, and that the addition of "means" does little to diminish the structural character of this element. Accordingly, "storage means" will not be treated as a means-plus-function limitation.

C. Construction of '416 Patent **Independent Claims**

[5] The '416 patent includes 5 independent claims (claims 1, 9, 14, 24, and 31). Plaintiff does not intend to assert claims 14, 24, or 31. Claims 1 and 9 recite a "voice responsive means" for receiving "incoming calls routed from the ACD" means. For reasons similar to those expressed above in III.A, "routed" is construed to have the same meaning as above. For the most part, Lottotron does not dispute that the specific equipment identified by Scientific Games represents an illustrative example of structures corresponding to the functions recited in the means-plus-function limitations. Lottotron takes issue principally with the extent to which the illustrative embodiment, consisting of equipment from certain designated manufacturers, should be treated as the benchmark structure against which infringement should be measured. It is of course a basic tenet of patent law that claims should not be limited to only the illustrative embodiment contained in the specification. Karlin Tech. Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 973 (Fed.Cir.1999). Deciphering the scope of equivalents afforded by s. 112, para. 6 and the doctrine of equivalents entails a factual inquiry,

D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1575 (Fed.Cir.1985), which, in my view, would be better resolved once the issue of infringement is before me, and I know more about the accused devices. Accordingly, I will leave the equivalence questions for later.

D. Construction of "619 Patent **Independent Claims**

[6] The '619 patent has only one independent claim. Claim 1(a) recites: "means for receiving communications from subscribers and routing each of said communications to one of a plurality of different wagering formats as requested by a subscriber." The term "according" appears to have been inadvertently omitted following the word "communications" in clause (a), *i.e.,* "routing ... communications [according] to one of a plurality of different wagering formats." The parties dispute whether the claim should be construed to include the word "according." Lottotron contends that the claim should be construed as though the word had been included, to give effect to the meaning which was intended by the applicant and understood by the patent examiner. Although Scientific Games recognized the word omitted, it argues that I must adhere to the claim as written, even if it may result in a reading that is "nonsensical or impossible to achieve," S.G. Br. at 24, thus rendering the claim invalid.

The Federal Circuit has warned against construing claims in a way that redrafts the claim to cure errors therein, when "[t]hat would unduly interfere with the function of claims in putting competitors on notice of the scope of the claimed invention." Hoganas AB v. Dresser Industries, Inc., 9 F.3d 948, 951 (Fed.Cir.1993); *see also* Quantum Corp. v. Rodime, PLC, 65 F.3d 1577, 1584 (Fed.Cir.1995)(refusing to redraft claims to maintain validity after patentee improperly broadened claims); Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1357 (Fed.Cir.1999) (declining to construe claims in a way that would redefine a claim limitation and frustrate the notice function of claims to a competitor or those skilled in the art); Becton Dickinson & Co. v. C.R. Bard Inc., 922 F.2d 792, 799 n. 6 (Fed.Cir.1990) (reversing district court for rewriting independent claims into dependent claims despite plain language of the claims showing that they are independent). When the error, however, is obvious and of a typographical or clerical nature, the Federal Circuit and numerous other courts, including the United States Supreme Court, have held that courts may disregard the error, and construe the patent claim in accord with the way a reasonable competitor or persons skilled in the art would understand the claim. *See, e.g.,* I.T.S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429, 441-42, 47 S.Ct. 136, 71 L.Ed. 335 (1926) (finding omission of the word "rear" in the claim to be clerical and construing claim as if it had been included because "[t]his is not in any real sense, a re-making of the claim; but is merely giving to it the meaning which was intended by the applicant and understood by the examiner."); Lemelson v. General Mills, Inc., 968 F.2d 1202, 1204 n. 3 (Fed.Cir.1992) (construing a claim to include the word "toy" when the omission was plainly an "inadvertent error"); Reinharts, Inc. v. Caterpillar Tractor Co., 85 F.2d 628, 637 (9th Cir.1936) (acknowledging that mere clerical and typographical errors may be disregarded when construing patent claims); Isco Int'l, Inc., v. Conductus, Inc., 2003 WL 276250, at * (D.Del. Feb.10, 2003)(reviewing numerous cases where courts have disregarded typographical or clerical errors in patent claims); Baily v. Dart Container Corp. of Michigan, 157 F.Supp.2d 110, 124 n. 7 (D.Mass.2001) (disregarding typographical error when the error is clear to one skilled in the art). Notably, without direction from Lottotron, Scientific Games correctly surmised the word that was omitted, S.G. Br. at 24, which leads me to conclude that a reasonable competitor, such as Scientific Games, or persons skilled in the art, would have recognized the correct word to read into the apparent omission. Persons skilled in the art, in view of the wagering process described by Figures 3 and 5B, would understand that the communication means does not route messages "to a wagering format," because that makes no sense at all. Figures 3 and 5B show that the invention routes messages according to the wagering format selected by the subscriber to the "message means connected to said communication means ... for providing a series of

messages requesting subscriber wagering information particular to said one of the plurality of wagering formats." '619 patent (claim 1(b)). In view of the figures and the written description, I agree with Lottotron that competitors, as evidenced by Scientific Games' *Markman* brief, and those skilled in art, would grasp what was intended by the inventors in claim 1(a). Accordingly, I will construe clause (a) of claim 1 to include "according," as proposed by Lottotron.

As for the functions recited in clause (a) of claim 1, I must look to the written description to identify the corresponding structure that performs the recited function. Lottotron contends that the corresponding structure is the same as that identified in the the '047 patent for "communications means." I agree. The '619 patent matured from a continuation application of the '047 patent disclosure, and thus their written descriptions should be virtually identical. Given that the functions recited in clause (a) are identical to those recited in, for example, claim 11(a) of the '047 patent, which also recites "communication means," I will construe "communication means" in the '619 patent to have the same meaning as that in the '047 patent.

E. Construction of '865 Patent **Independent Claims**

The '865 patent includes 5 independent claims (claims 1, 5, 8, 23, 24). Clause (a) of claims 1 and 5 recites a "communication *means* for receiving communications from subscribers, said communication means including computer means and a wireless link." (emphasis added). As noted above, use of "means for" language raises the presumption that the inventors sought to invoke s. 112, para. 6. The presumption may be rebutted if the clause contains sufficient structure to perform the claimed function in its entirety. Altiris, Inc., v. Symantec Corp., 318 F.3d 1363, 1375-76 (Fed.Cir.2003). Although clause (a) recites computer means and wireless link structures, neither party disputes, and I assume this to be true, that those structures, without more, cannot perform entirely the claimed function. Hence, despite the recitation of structure, both parties agree that clause (a) is a means-plus-function limitation.

[7] Further, neither party disputes that the corresponding structure to the "communications means for receiving communications from subscribers" combines an ACD, computer means, and wireless link. *See* July 16, 2003 S.G. Letter; July 18, 2003 Lottotron Letter. Lottotron contends that although the " 'communication means' is subject to a means plus function analysis under Section 112(6)," the " 'computer means and wireless link' are not." July 24, 2003 Lottotron Letter. I disagree. Lottotron concedes that the corresponding structure, identified as the "communication means" in clause (a), includes the combination of "a computer (to enter the wagering date), a wireless link (connecting the computer to the wagering system), and an ACD or equivalent for connecting the subscriber to the 'message means." ' Lottotron fails to articulate any reason why s. 112, para. 6 should apply to only certain elements in this combination but not to others. I find no reason to treat the structural elements recited in the claims any differently than structural elements recited in the specification.

[8] Lottotron further contends that the wireless link connects the computer means to the ACD. Lottotron Repl. Br. at 17 ("[C]ommunication means must be construed to include both the computer input, the ACD, and a wireless link between the two."). The computer and wireless link are described in the '865 patent as follows:

The link between the telephone handset and the ACD may be through the telephone company equipment by landline, wireless communications such as cellular telephone, satellite communications or fiber optic connections. Where the subscriber has computer facilities, voice and touch-tone is not required and the subscriber may access the system directly from the computer.

Contrary to Lottotron's suggestion, nothing within this description indicates that the wireless link connects the computer to the ACD. Indeed, wireless communications is mentioned in the specification only as a substitute for a landline connection between the subscriber's telephone and the ACD. I must reject Lottrotron's attempt to import a limitation into the claims that is plainly unsupported. The corresponding structure "for receiving communications from subscribers" is construed to consist of the combination of an ACD, computer means and wireless link, and equivalents thereof.

[9] Scientific Games further challenges the validity of claim 1 on the ground that the "plurality of wagering formats," recited in clause (b), is indefinite because it was defined prior to using "the" in front of the term. The error made was clerical and one that does not in my view hinder a competitor or one skilled in the art from understanding what the inventors claimed. Accordingly, clause (b) will be construed to read, in part, "a plurality of wagering formats." As to the other claims that involve questions of equivalents, I leave that issue in connection with clause (c) to be resolved another day.

Claim 5 is similar to claim 1, but contains fewer limitations. Each of the limitations in claim 5 are undisputedly means-plus-function limitations that are subject to s. 112, para. 6. Both sides agree that claim 5 should be construed to have the same corresponding structure as that associated with each limitation in claim 1. The only dispute between the parties appears to rest, as with the '416 patent, on the permissible scope of equivalents under s. 112, para. 6 and the doctrine of equivalents, both of which are issues better resolved later when I know more about the accused devices.

[10] Claims 8, 23, and 24 recite a method of wagering,FN5 which includes routing communications according to the wagering format requested by the subscriber. Scientific Games contends that because the specification allegedly fails to provide adequate description for the structure that carries out the "routing according to the wagering format" function in claims 1 and 5, the step that performs that function must likewise be inadequately supported to meet the enablement requirement under s. 112, para. 1. Enablement is a question of law based on a factual inquiry. Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc., 166 F.3d 1190, 1194 (Fed.Cir.1999). Whether the disclosure enables persons of ordinary skill in the art to practice the claimed invention is better resolved upon more a developed record in a motion for summary judgment. Accordingly, I decline to decide here whether claims 8, 23, and 24 are enabled.

FN5. Although Scientific Games initially seemed to suggest in its brief that claims 8, 23 and 24 should be construed as step-plus-function limitations, it conceded at oral arguments that those claims are not in fact step-plus-function limitations.

IV. CONCLUSION

The term "routing" in the asserted claims of the patents-at-issue is construed to mean (1) specifying the path for a subscriber's incoming message according to a characteristic of the incoming message; and (2) transmitting the incoming message on the specified path. Messages are "routed" if they arrive at a destination via a "routing" process as defined above. This Court reserves decision on the scope of equivalents afforded by s. 112, para. 6 or the doctrine of equivalents, both of which are questions of fact, until I know more about the accused devices or methods. Further, this Court reserves decision on the questions of non-enablement until a fuller factual record is developed, from which I may make more reasoned determination. This Court acknowledges that Scientific Games may move, in accordance with this

Court's claim construction, for summary judgment to invalidate the asserted claims.

The "automatic call director means" in claims 1 and 6, and the "communication means" in claim 11 of the '047 patent is construed to correspond to the combination of a VRU with programmed computer processor, and equivalents thereof. The "storage means" clause is construed to fall outside the scope of s. 112, para. 6. Clause (a) in claim 1 of the '619 patent is construed to read as "communication means for receiving communications from subscribers and routing each of said communications [according] to one of a plurality of different wagering formats as requested by a subscriber." "Communication means" in the claim 1(a) of the '619 is to be construed in the same way as "communication means" in the '047 patent. Clause (a) of claims 1 and 5 in the '865 patent is a means-plus-function limitation, and the communication means will be construed to correspond to the combination of an automatic call director, computer means and wireless link, and equivalents thereof. The second function recited in clause (b) of claim 1 in the '865 patent is construed to read as "providing a series of messages requesting subscriber information particular to one of [a] plurality of wagering formats."

SO ORDERED

S.D.N.Y.,2003.
Lottotron, Inc. v. Scientific Games Corp.

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