United States District Court,
N.D. California.

PIXION, INC,
Plaintiff.
v.
PLACEWARE, INC,
Defendant.

No. C 03-02909 SI

Aug. 2, 2004.

Counsel for plaintiff Pixion, Inc. is Spencer Hosie of Hosie Frost McArthur & Large, LLP in San Francisco, California.

Counsel for defendant PlaceWare, Inc., a subsidiary of Microsoft Corporation, is Michael J. Bettinger of Preston Gates & Ellis LLP in San Francisco, California.

CLAIM CONSTRUCTION ORDER, RE: '694 PATENT

ILLSTON**, J.**

On July 6, 2004, the Court held a hearing regarding the construction of certain disputed claims in U.S. Patent No. U.S. Patent No. 5,591,694 ("the '694 patent"). Having considered the arguments of counsel and the papers submitted, the Court hereby construes the terms as follows.

INTRODUCTION

Plaintiff Pixion, Inc. ("Pixion") has brought suit against defendant Place Ware, Inc. ("PlaceWare") claiming misappropriation of Pixion's trade secrets, infringement of Pixion's patent rights, and infringement of Pixion's trademark. Defendant counterclaims, *inter alia,* that Pixion is infringing the PlaceWare-owned U.S. Patent No. 5,951,694 ("the '694 patent"), entitled "Method of Redirecting a Client Service Session to a Second Application Server Without Interrupting the Session by Forwarding Service-Specific Information to the Second Server." Currently before the Court are the parties' proposed claim constructions for the '694 patent.

BACKGROUND

The '694 patent relates to large scale computer networks providing information-related services and communication services to end users. '694 Patent col. 1:15-17. A redirection technique allows a "user service session to be transferred from one application server to another (replicated) application server without termination of the service session." '694 Patent Abstract. The patent is meant to address certain limitations of the existing architectures for on-line services networks, including (i) existing networks that do

not provide an adequate means for allocating processing resources to user service requests, reducing efficiency; (ii) existing networks that do not provide a means for updating service applications without temporarily taking services off-line; and (iii) existing networks that are not capable of allowing a user to access multiple services at a time. Col. 1:29-37.

In the preferred embodiments, the '694 patent teaches "a client-server architecture for an on-line services network ... in which on-line services are distributed and replicated on groups of application servers." Col. 1:45-48. Particularly relevant here, the patent teaches architecture that "further permits service applications to be updated without temporarily taking the services off-line." Col. 1:65-67.

LEGAL STANDARD

Construction of patent claims is to be made by the trial court as a matter of law. *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 977 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370 (1996). In determining the proper construction of a claim, the Court begins with the intrinsic evidence of record, consisting of the claim language, the patent specification, and, if in evidence, the prosecution history. Id. at 978 (citing Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561 (Fed.Cir.1991)). "The appropriate starting point ... is always with the language of the asserted claim itself." Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1185 (Fed.Cir.1998). Accordingly, although claims speak to those skilled in the art, in construing a claim, claim terms are given their ordinary and accustomed meaning unless examination of the specification, prosecution history, and other claims indicates that the inventor intended otherwise. *See* Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1053 (Fed.Cir.1994). Although words in a claim are generally given their ordinary and customary meanings, a patentee is free to act as his own lexicographer provided that the patentee's special definition is clearly stated in the patent specification or prosecution history. *See* Hormone Research Found., Inc. v. Genentech, Inc., 904 F.2d 1558, 1563 (Fed.Cir.1990).

The claims must be read in view of the specification. Markman, 52 F.3d at 978. Yet while "claims are to be interpreted *in light of* the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims." Sjolund v. Musland, 847 F.2d 1573, 1581 (Fed.Cir.1988) Therefore, the specification can supply understanding of unclear terms, but should never trump the clear meaning of the claim terms. *See* E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed.Cir.1988). Even "[r]eferences to a preferred embodiment, such as those often present in a specification, are not claim limitations." Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855, 865 (Fed.Cir.1988).

Finally, the Court may consider the prosecution history of the patent, if in evidence. The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution. *See* Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed.Cir.1995). In most situations, analysis of this intrinsic evidence alone will resolve claim construction disputes. *See* Vitronics Corp. v. Conceptronics, Inc., 90 F.3d 1576, 1583 (Fed Cir.1996). Courts should not rely on extrinsic evidence in claim construction to contradict the meaning of claims discernable from examination of the claims, the written description, and the prosecution history. *See* Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1308 (Fed.Cir.1999) (citing Vitronics, 90 F.3d at 1583). However, it is entirely appropriate "for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field." *Id*.

DISCUSSION

1. The claims at issue

The terms used in independent claims 1 and 9 of the '694 patent are currently in dispute. FN1 Claim 1 describes a method of redirecting a client service session from a first application server to a second application server without terminating the client service session. Claim 1 reads as follows (Col.25:49-63):

FN1. Initially, terms used in dependent claims 6, 7, 11 and 12 were also in dispute. Pixion and PlaceWare have agreed to narrow the claims at issue. *See* Def.'s Reply Br. at 1, n. 1. Therefore, the Court does not consider the disputed terms of the dependent claims, including "an object," "describes," "state" and "indicia."

In a client-server network in which multiple application servers independently run the same service application to provide like services to end users, a method of redirecting a client service session from a first application server to a second application server without terminating the client service session, said first and second application servers running the same service application, said method comprising the steps of:
prompting said first application server for service-specific information about a state of the client service session;

forwarding said service-specific information about said state to said second application server; and

transferring the client service session from said first application server to said second application server without interrupting the client service session.

Claim 9 is virtually identical in language to Claim 1 and describes a computer-readable medium performing the same steps as those disclosed in Claim 1. Claim 9 reads as follows (Col.26:23-32):

In a client-server network including multiple application servers independently running the same service application to provide like services to end users by redirecting a client service session from a first application server to a second application server without terminating the client service session, said first and second application servers running the same service application, a computer-readable medium having computer-executable instructions for performing the steps of:

prompting said first application server for service-specific information about a state of the client service session;

forwarding said service-specific information about said state to said second application server; and

transferring the client service session from said first application server to said second application server without interrupting the client service session.

2. Construction of the disputed terms in independent claims 1 and 9

A. The preamble

Pixion argues that the preamble gives meaning to the claims and, therefore, must be construed. Specifically, Pixion contends that the term "service application" requires interpretation. PlaceWare disagrees, arguing that the body of each claim "describes the three basic steps of *prompting, forwarding,* and *transferring* required for a structurally complete invention." Def.'s Opening Br. at 6:9-10. Further, PlaceWare contends that the preamble term "service application" is similar to "first application server," a term used in the body of each claim. Citing Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed.Cir.2002), PlaceWare argues that because the claim body defines a structurally complete invention the preamble is not limiting.

Regarding the relevance of the preamble for claim construction, the Federal Circuit has held the following: "Whether to treat a preamble as a limitation is a determination 'resolved only on review of the entire [ ] ... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Catalina Marketing, 289 F.3d at 808 (citing Corning Glass Works v. Sumitomo Electric U.S.A., Inc., 868 F.2d 1251, 1257 (Fed.Cir.1989)). *Catalina Marketing* goes on to state that "[i]n general, a preamble limits the invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Id.* (citing Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed.Cir.1999)). There is no definitive test to determine when a preamble limits claim scope, but there are some guideposts. The following are among the things that can be considered: (i) indication of intent to use the preamble to define the claimed invention; (ii) dependence on a particular disputed preamble phrase for antecedent basis; and/or (iii) importance of the preamble for understanding the limitations or terms in the claim body. *See* Catalina Marketing, 289 F.3d at 808.

In the '694 patent, the preamble has greater weight than PlaceWare acknowledges. The Court finds that the preamble is, in fact, "necessary to give life, meaning, and vitality" to the claim. In fact, the preamble is the very thing that differentiates the two claims at issue. Without the preambles of these two claims there would be no need for claim 9 as the "three basic steps of *prompting, forwarding,* and *transferring* required for a structurally complete invention," Def.'s Opening Br. at 6:8-11, have already been disclosed in claim 1. Claim 1 identifies a method of redirecting a client service session from a first application server to a second application server without terminating the client service session. Claim 9 identifies a computer-readable medium having computer-executable instructions for performing the method described in Claim 1. The preamble gives each claim its identity. Without the preamble, Claim 9 would be pure repetition.

Finding that the preamble gives "life, meaning, and vitality" to the claim, the Court considers the term in dispute: "service application."

Pixion proposes the following construction for "service application": "On-line services offered to end-users in the form of client server application program, including a server portion that runs on one or more of the servers, and a client portion that runs on a microcomputer of an end user." Pixion borrows this construction of "service application" from the detailed description of the preferred embodiments. *See* Col. 6:57-64. Limitations from a preferred embodiment described in the specification generally should not be read into the claim language. *See* Comark, 156 F.3d at 1187. The detailed description of a preferred embodiment of the invention "in no way sheds light on either the meaning of the term to the inventor, or the common meaning of the term to one of skill in the art." *Id.* Pixion's construction is too narrow because, based on the preferred embodiment, it limits the claim to on-line services. The patent explicitly contemplates applicability to other types of distributed systems. *See* Col. 4:47-52 ("Although the architecture is described in the context of an on-line services network, it will be recognized that various aspects and features of the architecture are applicable to other types of distributed systems.").

PlaceWare provides an alternative construction of "service application": "a program running on a server that provides a service to a client." Def.'s Reply Br. at 5:23-24 The Court finds that PlaceWare's construction is true to the meaning of the term in the claim language as well as the specification. *See* Col. 6:58-59 ("client-server applications programs (or 'server applications')"); Col. 7:24-26 ("The term 'service' refers generally to the abstract function or functions performed by a particular service application (or group of related service applications)"). Accordingly, the Court construes "service application" as follows:

"a program running on a server that provides a service to a client"

B. "prompting said first application server"

PlaceWare's proposed construction is "to cue a server that is independently running a service application." In contrast, Pixion defines "prompting" and "application server" separately. For "prompting" Pixion initially offers the following: "The process whereby data (such as image, sound or other output) from a program or programs running on the presenter's machine is relayed to the server, and the server relays data to attendee client computers participating in the same session or conference." Pixion's Br. at 6:3-5. Later in its brief, Pixion offers the following construction of "prompting": "submitting a serialization request to the server ." *Id*. at 6:21. In support of the latter definition, Pixion argues that the "serialization request called out in the specification defines the necessary prompting." *Id*. at 6:27-28, *see also* Col. 17:62-66. Again, Pixion relies on the preferred embodiment and inappropriately limits the claim to a serialization request. PlaceWare explains that serialization is "the process in object-oriented programming whereby the state of an object is represented by a byte stream." Reply Br. at 6:18-20, PlaceWare's Opening Br. at 7, n. 6. Claims 1 and 9 are not limited to object-oriented programming, nor are they limited to the preferred embodiment. Instead, the plain meaning of prompt is "to press into action: incite" or "to give a cue to." *See Webster's II New College Dictionary* (1995). The Court adopts the plain meaning of the term and construes "prompting" as "giving a cue to."

For "application server," Pixion offers: "A computer or network of computers running the application-server program." However, Pixion's proposed definition for "first application server," as used in the phrase "prompting said first application server," is simply "server." The Court finds Pixion's first construction tautologous and the second imprecise. The patent itself provides an ordinary and customary meaning of the term; i.e., "a server independently running a service application." *See* Col. 26:24-25, 25:49-50.

Accordingly, the Court construes "prompting said first application server" as follows:

"giving a cue to a server running the service application"

C. "service-specific information about a state of the client service session"

PlaceWare's proposed construction for the above claim phrase is "the current conditions of an active communication between the server running a particular service application and a client computer." Again Pixion splits the claim phrase, construing it in three parts: (i) "service-specific information," (ii) "state of the client service session," and (iii) "client service session." For "service-specific information," Pixion proffers: "information that describes the internal state of the service session." For "state of the client service session," Pixion proposes: "information about the services that is normally meaningful only to the specific service." Finally, Pixion construes "client service session" as "the use of a particular service by a single client-user (from the opening of the service to the closing of the service)." The Court finds Pixion's three-part

construction confusing and, most importantly, inconsistent. The construction of the individual claim terms does not provide a coherent construction of the claim phrase "service-specific information about a state of a client service session."

Here, again, Pixion relies too heavily on the preferred embodiment, *see* Pixion's Br. at 8 and col. 17:62-66, without illuminating the disputed claim terms. In other words, Pixion's proposed constructions are recitations of the terms themselves, which PlaceWare accurately points out. *See* Reply Br. at 7-9. While Pixion's constructions are generally accurate they are unhelpful. In contrast, the Court finds PlaceWare's proposed construction accurate as well as comprehensive. The Court notes Pixion's concerns about the improper broadening of the claim language with PlaceWare's inclusion of "active communication." Pixion argues that "[t]he 'communication' must be limited to 'server-specific information' as contemplated in the specification and claim language." Pixion's Br. at 8:24-26. However, the Court finds that PlaceWare's proposed definition does clarify that the "active communication" is one that occurs between the server running a particular service application and a client computer. This sufficiently sets the boundaries of the claim phrase.

Accordingly, the Court construes "service-specific information about a state of a client service session" as follows:

"the current conditions of an active communication between the server running a particular service application and a client computer"

D. "forwarding," "transferring," "without interrupting"

Initially disputed, Pixion now accepts defendant's construction of these terms. Therefore, the Court construes the terms as follows: "forwarding" as "sending"; "transferring" as "shifting"; and "without interrupting" as "without terminating."

3. Pixion's objections to the Tony Clark declaration

Pixion objects to paragraph 4 of the declaration of expert witness Tony Clark. Plaintiff argues that Mr. Clark is offering a legal opinion as to the scope of the '694 patent. The Court SUSTAINS plaintiff's objection.

CONCLUSION

For the foregoing reasons and for good cause shown, the Court adopts the constructions set out above. [Docket104 and 105].

IT IS SO ORDERED.

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