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

VISTO,
Plaintiff.
v.
MICROSOFT,
Defendant.

Civil Action No. 2:05-CV-546

Aug. 28, 2007.

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CLAIM CONSTRUCTION ORDER

DAVID FOLSOM**, District Judge.**

In the present action, Visto asserts that Microsoft infringes various claims under three of its patents. Microsoft has counterclaimed and alleges that Visto infringes three of its patents. The parties have filed claim construction briefs presenting their proposed constructions and the Court has held a *Markman* hearing. After considering the relevant briefing and the applicable law, the Court issues this order construing the various claims at issue.

(I) TECHNOLOGY

In this case, Visto asserts claims from three patents against Microsoft and Microsoft asserts three patents against Visto. Visto's patents are: United States Patent No. 6,085,192 (hereafter the "'192 Patent"); United States Patent No. 7,039,679 (hereafter the "'679 Patent"); and United States Patent No. 6,708,221 (hereafter the "'221 Patent"). The '192 Patent is entitled "System and Method for Securely Synchronizing Multiple

Copies of a Workspace Element in a Network." Both the '679 and '221 Patents are entitled "System and Method for Globally and Securely Accessing Unified Information in a Computer Network." In a prior case involving Visto, United States District Judge Ward construed several claims in the '192 and '221 patents. *See Visto Corp. v. Seven Networks, Inc.,* 2:03-cv-333, (E.D. Tex. April 20th, 2005). That case will be referred to herein as the *Seven Networks* case and the claims construction order will be referred to as the "Ward Order."

All three of the Visto patents primarily concern the synchronization of data on separate workspaces. The '192 Patent concerns a system for securely synchronizing data on a portable device that is outside of the firewall of a separate device. *See* '192 Patent at Abstract. Specifically, the system claimed in the '192 Patent utilizes a global server, which exists outside of the network firewall but is connected to multiple clients, to facilitate synchronization while keeping the network environment inside the firewall secure. *See* '192 Patent, col.1 ll.52-59. The system also includes a synchronization module located at the client sites to examine data and determine whether any of the data (referred to as "workspace elements") has been modified. *See* id. col.1 ll.60-64. A synchronization agent operates on the global server outside of the firewall to indicate whether a copy of the workspace element has been modified. *See* id . col.1 ll.64-67. This system allows clients using the system to automatically synchronize workspace data between multiple sites regardless of whether the sites are protected by site firewalls. *See* id. The synchronization process described in the '192 Patent is initiated by the synchronization-start module. *See* id. col.2 ll.2-5. Additionally, synchronization may be initiated at predetermined times and can carry out synchronization even if changes have been made to both the workspace element and the independently modifiable. copy. *See* id. col.2 ll.11-17.

The '679 and '221 Patents similarly claim a system and method for securely and remotely accessing and synchronizing information inside a computer network. The patents explain that one set of workspace data is stored on a client site. In turn, the client is connected to the global server through a computer network. *See* '679 Patent, col.2 ll.57-60. The summary of the invention explains, "[t]he client is configured to synchronize selected portions of the first set of workspace data (comprising workspace elements) with the global server, which stores independently modifiable copies of the selected portions." '679 Patent, col.2 ll.58-62. The global server stores a second set of workspace data and is configured to allow a user to access that data from a remote terminal. *See* id. col.2 ll.63-67. Furthermore, the global server includes a synchronization agent which is capable of automatically establishing a secure connection between the client and the global server. The secure connection allows the system to synchronize portions of the first set of workspace data with the second set of workspace data on the global server. *See* id. col.3 ll.18-23. The synchronization agent informs the client's base system whether any workspace elements in the second set have been modified. *See* id. col.3 ll.26-29. The patent explains that "[m]odified version may then be exchanged so that an updated set of workspace elements may be stored at both locations, and so that the remote user can access an updated database. If a conflict exists between two versions, the base system then performs a responsive action such as examining content and generating a preferred version, which may be stored at both locations." *See* id. col.3 ll.29-35. The patent also makes clear that the system may include a "synchronization-start module at the client site ... that initiates interconnection and synchronization when predetermined criteria have been satisfied." *See* id. col.3 ll.35-39. In sum, the '679 and '221 Patents allow a client user to securely and remotely access and synchronize workspace data by utilizing the global server. *See* ' 221 Patent, col.3 ll.57-59.

The three patents asserted by Microsoft are: United States Patent No. 6,125,369 (hereafter the "'369 Patent"); United States Patent No. 6,560,655 (hereafter the "'655 Patent"); and United States Patent No. 5,946,691 (hereafter the "'691 Patent"). The '369 Patent is entitled "Continuous Object Synchronization Between Object

Stores on Different Computers." In order to facilitate continuous object synchronization, the '369 Patent utilizes a synchronization manager. The synchronization manager is a computer program that executes on a primary computer. The summary of the invention explains that the synchronization manager "maintains a reference store and communicates with an auxiliary computer." *See* '369 Patent, col.2 ll.6-8. Various computer applications run on each computer and an object store is also maintained on each computer. *See* id. col.2 ll.8-10. The system of the '369 Patent generates a notification to the synchronization manager whenever a change is made, thereby facilitating continuous synchronization. *See* '369 Patent, col.2 ll.57-63. Microsoft explains that the '369 Patent's system of continuous synchronization is superior to prior art systems which only update data at specific times or upon a user request. *See* Doc. No. 75 at 5-6.

The '655 Patent is entitled "Synchronization Manager for Standardized Synchronization of Separate Programs." The invention "provides a centralized, standardized mechanism for managing the synchronization of data between local and remote computers according to user preferences." Computer applications register synchronization handlers with a synchronization manager and, upon a synchronize event, the synchronization manager calls the handlers to perform the synchronization of items in the respective application. *See* '655 Patent, col.2 ll.2-8. Importantly, the '655 Patent makes clear that "[t]he synchronization manager provides consistent user interfaces for obtaining user preferences related to synchronization and for presenting information to the user, thus resulting in a consistent user experience." *See* id. col.2 ll.10-14. Microsoft argues that this system is superior over prior art which required a user to specialized and different synchronize software for each respective application. *See* Doc. No. 75 at 13.

Finally, the '691 Patent is entitled "Method of Presenting, Storing, and Updating a Filing Identifier for a Data Record." Unlike the other patents, which deal with synchronizing data, the '691 Patent concerns the actual filing of data records. The patent explains that the data records have multiple fields for receiving information related to the subject that the data relates to. *See* '691 Patent, col. 1 ll.52-54. A common example of this would be a address book on a computer program. Upon creating a data record for John Doe the user has the opportunity to enter information into multiple fields such as name, address, phone number, and email address. Microsoft argues that the ' 691 Patent is unique in that it also allows a user to designate one of those fields as a filing identifier. *See* id. col.1 ll.55-59. "The filing identifier identifies the location used by the computer system for filing the data record in a sorted list." *See* id. col.1 ll.58-60. This allows flexibility as to which field the data record is filed under. Additionally, one aspect of the '691 Patent is that the system is capable of "automatically updating the information in the predefined filing format fields if the information received in at least one of the data fields is modified." *See* id. col.2 ll.8-11. The invention is also capable of automatically generating multiple predefined filing formats for use as a filing identifier based on the information inputted in the data field. *See* id. col.2 ll.61-64. These preselected formats include options such as (1) last name, first name; (2) first name last name; (3) company name; etc. *See* id. col.2 ll.34-37.

(II) LEGAL PRINCIPLES OF CLAIM CONSTRUCTION

A determination of patent infringement involves two steps. First, the patent claims are construed, and, second, the claims are compared to the allegedly infringing device. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1455 (Fed.Cir.1998) (en banc).

The legal principles of claim construction were recently reexamined by the Federal Circuit in Phillips v. AWH Corp., 415 F.3d 1303 (Fed.Cir.2005) (en banc). Reversing a summary judgment of non-infringement, an en banc panel specifically identified the question before it as "the extent to which [the court] should

resort to and rely on a patent's specification in seeking to ascertain the proper scope of its claims." Id. at 1312. Addressing this question, the Federal Circuit specifically focused on the confusion that had amassed from its recent decisions on the weight afforded dictionaries and related extrinsic evidence as compared to intrinsic evidence. Ultimately, the court found that the specification, "informed, as needed, by the prosecution history," is the "best source for understanding a technical term." Id. at 1315 (quoting Multiform Dessicants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1478 (Fed.Cir.1998)). However, the court was mindful of its decision and quick to point out that *Phillips* is not the swan song of extrinsic evidence, stating:

[W]e recognized that there is no magic formula or catechism for conducting claim construction. Nor is the court barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.

Phillips, 415 F.3d at 1324 (citations omitted). Consequently, this Court's reading of *Phillips* is that the Federal Circuit has returned to the state of the law prior to its decision in Texas Digital Sys. v. Telegenix, Inc., 308 F.3d 1193 (Fed.Cir.2002), allotting far greater deference to the intrinsic record than to extrinsic evidence.

Additionally, the Federal Circuit in *Phillips* expressly reaffirmed the principles of claim construction as set forth in Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed.Cir.1996), and Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111 (Fed.Cir.2004). Thus, the law of claim construction remains intact. Claim construction is a legal question for the courts. Markman, 52 F.3d at 979. The claims of a patent define that which "the patentee is entitled the right to exclude." Innova, 381 F.3d at 1115. And the claims are "generally given their ordinary and customary meaning" as understood by "a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." Vitronics, 90 F.3d at 1582. However, the Federal Circuit stressed the importance of recognizing that the person of ordinary skill in the art "is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Phillips, 415 F.3d at 1313.

Advancing the emphasis on the intrinsic evidence, the *Phillips* decision explains how each source, the claims, the specification as a whole, and the prosecution history, should be used by courts in determining how a skilled artisan would understand the disputed claim term. *See, generally, id*. at 1314-17. The court noted that the claims themselves can provide substantial guidance, particularly through claim differentiation. Using an example taken from the claim language at issue in *Phillips,* the Federal Circuit observed that "the claim in this case refers to 'steel baffles,' which strongly implies that the term 'baffles' does not inherently mean objects made of steel." *Id*. at 1314. Thus, the "context in which a term is used in the asserted claim can often illuminate the meaning of the same term in other claims." *Id; see also* BrookhillWilk 1, LLC. v. Intuitive Surgical, Inc., 334 F.3d 1294, 1299 (Fed.Cir.2003) ("While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms.") Likewise, other claims of the asserted patent can be enlightening, for example, "the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Id*. at 1315 (citing Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 910 (Fed.Cir.2004)).

Still, the claims "must be read in view of the specification, of which they are part." Markman, 52 F.3d at

978. In *Phillips,* the Federal Circuit reiterated the importance of the specification, noting that "the specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.' " Phillips, 415 F.3d at 1315 (quoting Vitronics, 90 F.3d at 1582). To emphasize this position, the court cited extensive case law, as well as "the statutory directive that the inventor provide a 'full' and 'exact' description of the claimed invention." *Id.* at 1316 (citing Merck & Co. v. Teva Pharms. USA, Inc., 347 F.3d 1367, 1371 (Fed.Cir.2003)); *see also* 35 U.S.C. s. 112, para. 1. Consistent with these principles, the court reaffirmed that an inventor's own lexicography and any express disavowal of claim scope is dispositive. *Id.* at 1316. Concluding this point, the court noted the consistency between this approach and the issuance of a patent from the Patent and Trademark Office and found that "[i]t is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Id.* at 1317.

Additionally, the *Phillips* decision provides a terse explanation of the prosecution history's utility in construing claim terms. The court simply reaffirmed that "the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.* (citing Vitronics, 90 F.3d at 1582-83). It is a significant source for evidencing how the patent office and the inventor understood the invention. *Id.*

Finally, the Federal Circuit curtailed the role of extrinsic evidence in construing claims. In pointing out the less reliable nature of extrinsic evidence, the court reasoned that such evidence (1) is by definition not part of the patent, (2) does not necessarily reflect the views or understanding of a person of ordinary skill in the relevant art, (3) is often produced specifically for litigation, (4) is far reaching to the extent that it may encompass several views, and (5) may distort the true meaning intended by the inventor. *See id.* at 1318. Consequently, the Federal Circuit expressly disclaimed the approach taken in *Texas Digital*. While noting the *Texas Digital* court's concern with regard to importing limitations from the written description, "one of the cardinal sins of patent law," the Federal Circuit found that "the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history." *Id.* at 1320.

Thus, the court renewed its emphasis on the specification's role in claim construction. "[E]xtrinsic evidence cannot be used to vary the meaning of the claims as understood based on a reading of the intrinsic record." Phillips, 415 F.3d at 1319.

Many other principles of claim construction, though not addressed in *Phillips,* remain significant in guiding this Court's charge in claim construction. The Court is mindful that there is a "heavy presumption" in favor of construing claim language as it would be plainly understood by one of ordinary skill in the art. Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999); *cf. Altiris, Inc., v. Symantec Corp.,* 318 F.3d 1364, 1372 (Fed.Cir.2003) ("[S]imply because a phrase as a whole lacks a common meaning does not compel a court to abandon its quest for a common meaning and disregard the established meaning of the individual words.") The same terms in the same patent or related patents are presumed to carry the same meaning. Omega Eng'g, Inc. v. Raytek Corp., 334 F.3d 1314, 1334 (Fed.Cir.2003) Claim construction is not meant to change the scope of the claims but only to clarify their meaning. Embrex, Inc. v. Service Eng'g Corp., 216 F.3d 1343, 1347 (Fed.Cir.2000) "The construction of claims is simply a way of elaborating the normally terse claim language[ ] in order to understand and explain, but not to change, the scope of the claims." *Id.* (citation omitted). Regarding claim scope, the transitional term "comprising," when used in claims, is inclusive or open-ended and "does not exclude additional, unrecited elements or method

steps." CollegeNet, Inc. v. ApplyYourself, Inc., 418 F.3d 1225, 1235 (Fed.Cir.2005) (citations omitted). "[P]articular embodiments appearing in the written description will not be used to limit claim language that has broader effect." Innova/Purewater, 381 F.3d at 1117. Claim constructions that would read out the preferred embodiment are rarely, if ever, correct. Vitronics, 90 F.3d at 1583-84.

The Court notes that a patent examiner's "Reasons for Allowance," where merely summarizing a claimed invention and not specifically noting that patentability is based on a particular feature, do not limit the scope of the claim. *See* Apex Inc. v. Raritan Computer, Inc., 325 F.3d 1364, 1375 (Fed.Cir.2003). Similarly, an examiner's unilateral statements in a "Notice of Allowance" do not result in the alteration of claim scope. *See id.; see also* Salazar v. Procter & Gamble Co., 414 F.3d 1342, 1346-47 (Fed.Cir.2005).

The doctrine of claim differentiation is often important in claim construction. Phillips, 415 F.3d at 1315 (citing Liebel-Flarsheim Co., 358 F.3d at 910). "Claim differentiation" refers to the presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim. Curtiss-Wright Flow Control Corp. v. Velan, Inc., 438 F.3d 1374, 1380 (Fed.Cir.2006). This is in part because "reading an additional limitation from a dependent claim into an independent claim would not only make that additional limitation superfluous, it might render the dependent claim invalid." *Id.;* SRI Int'l. v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1122 ("It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement.") The doctrine, based in part on the presumption of validity, holds that each claim is presumed to have a different scope. 35 U.S.C. s. 282; Curtiss-Wright, 438 F.3d at 1380. The difference in meaning and scope between claims is presumed to be significant to the extent that the absence of such difference in meaning and scope would make a claim superfluous. Free Motion Fitness, Inc. v. Cybex Int'l, 423 F.3d 1343, 1351 (Fed.Cir.2005). Although a validity analysis is not a regular component of claim construction, if possible, claims should be construed to preserve their validity. Phillips, 415 F.3d at 1327; *see also* Rhine v. Casio, Inc., 183 F.3d 1342, 1345 (Fed.Cir.1999).

With these principles in mind, the Court turns to the patents-in-suit.

II. THE VISTO PATENTS

(A) Overview of the Patents

As set forth above, Visto alleges that Microsoft infringes the @192 Patent, the '221 Patent, and the '679 Patent. The patent application for the ' 192 Patent was filed on April 11, 1997. The patent issued on July 4, 2000, listing Daniel J. Mendez, Mark D. Riggins, Prasad Wagle, and Christine C. Ying as the inventors. *See* Doc. No. 72, ex. A at 10. On June 18, 2004 a reexamination request was filed with the PTO. Following the reexamination of the '192 Patent the PTO issued a Reexamination Certificate for the '192 Patent on November 22, 2005. *See* id., ex. A at 2.

The application for the '221 Patent was filed on September 20, 2000. The ' 221 Patent application was a continuation of the application that led to the '192 Patent. *See* Doc. No. 72, ex. C at 2. The '221 Patent issued on March 16, 2004, listing, inter alia, the same inventors as the '192 Patent. Likewise, the application for the '679 Patent was a continuation of the patent applications for both the '192 and the '221 patents. *See* id., ex. D at 2. The '679 Patent issued on May 2, 2006. *See* id.

At the present time the parties dispute eight terms arising in eight claims. Specifically at issue are claims 1, 2, 11, and 22 of the '192 Patent; claim 8 of the '221 Patent; and claims 1, 3, and 11 of the '679 Patent. Those

claims are set forth in Exhibit A attached to this Order.

(B) Claim Construction

The parties request that the Court construe eight terms and phrases appearing in the Visto patents. The terms arise out of seven claims in the three patents. Because the patents' incorporate by reference each others applications, and because several terms appear in claims throughout the patents, this Order will not include separate subsections for each of the three patents. The Court construes the contested language as follows:

(a) "initiating steps ___ and ___" and "initiating the general synchronization module and the synchronization agent"

The term "initiating" appears in claims 1, 11, and 22 of the '192 patent. Claims 1 and 22 use the phrase "initiating steps ___ and ___" and claim 11 states "initiating the general synchronization module and the synchronization agent." Visto argues that no construction of either phrase is necessary beyond the term "initiating." *See* Doc. No. 72 at 13. Visto asserts that the proper construction of the term "initiating" is "to cause or facilitate the beginning of." Id. at 13. On the other hand, Microsoft explains that the Court should construe the phrases as a whole. Thus, Microsoft proposes that the phrases including "initiating" mean "issuing a synchronization request." *See* Doc. No. 78 at 7.

Microsoft supports its construction by arguing that the claim language clearly shows that the initiating is done by outbound communication from within the firewall and that the specification explains, "since synchronization is initiated from within the firewall, the typical firewall, which prevents in-bound communications, does not act as an impediment to workspace data synchronization." '192 Patent, col.2 ll.45-48. Microsoft also notes the prosecution history supports its interpretation. *See* Doc. No. 78, Ex. E at 5 It argues that Visto distinguished other patents by arguing to the PTO that the "initiating" synchronization limitations may require issuing a synchronization request. *See* Doc. No. 78 at 8.

The Court is unpersuaded. While the prosecution history is relevant to this Court's claim construction, the Court should not narrow a claim "absent the applicant's clear disavowal of claim coverage." *See Amgen,* 314 F.3d at 1327. Here there was no such "clear disavowal." As Visto points out, the prosecution history referred to by Microsoft never discusses a "request," and instead focuses on *where* the synchronization is initiated from-i.e. from inside the firewall. Claim 1 of the '192 patent makes clear that initiation of the steps is "from within the firewall." Thus, no further limitation need be read into the term. *See* Doc. No. 78, ex. E at 5. In addition, the specification of the '192 patent further clarifies that "initiating" is not confined to a "request" because it discusses synchronization as a result of several different events occurring. *See* '192 Patent, col.5 ll.35-59 ("the synchronization-start module [ ] may initiate data synchronization upon user request, at a particular time of day, after a predetermined time period passes, after a predetermined number of changes, after a user action such as user log-off or upon like criteria."). In short, if the applicant had wanted to limit "initiating" to "issuing a synchronization request" then he could have simply added such a limitation to the claim language. Here, the claims simply use "initiating." When the patentee has not clearly acted as his own lexicographer and the claim language does not lack sufficient clarity to ascertain the scope of the claim, this Court should give terms in the claim their ordinary meaning. *See* Gart v. Logitech, Inc., 254 F.3d 1334, 1341 (Fed.Cir.2001). As such, the Court defines the term "initiating" to mean "to cause or facilitate the beginning of." No further construction of the phrases "initiating steps ___ and ___" and "initiating the general synchronization module and synchronization agent" is necessary.

(b) "independently modifiable emails"

Visto argues that this phrase is properly construed as "emails that are capable of being modified independent of each other. The emails do not have to be in the same format." *See* Doc. No. 72 at 15. On the other hand, Microsoft proposes that the phrase should be construed as "multiple copies of an email that are capable of being modified independent of each other. The copies do not have to be in the same format." Microsoft argues that the claim language indicates that the emails are simply copies of the same email throughout the process of synchronization. Microsoft explains that "independently modifiable emails" are simply one type of "independently modifiable copies." *See* Doc. No. 78 at 9. Therefore, Microsoft couches the issue as whether "independently modifiable emails" means copies that can be independently modified, or whether it refers to the synchronization of separate and unrelated emails. *See* Hr'g Tr. at 39-40. The Court finds that the issue is not so black and white.

Here, claim 1 only refers to "independently modifiable e-mails." However, the specification of the '679 Patent makes clear that selected *portions* of workspace data are synchronized by the invention. *See, e.g.*, '679 Patent, col.2 ll.59-62 (making clear that the client is intended to "synchronize selected portions of the first set of workspace data with the global server, which stores independently modifiable copies of the selected portions."); col.3 ll.18-23 ("The base system and synchronization agent automatically establish a secure connection there between and synchronize the selected portions of the first set of workspace data stores on the client and the second set of workspace data stored on the global server"); *see also* col.4 ll.13-15. Visto argues, therefore, that the specification teaches that the emails do not have to be entire copies of each other. As Visto explains, Microsoft's construction improperly limits the claim to entire copies of an email. *See* Doc. No. 72 at 15. While the Court does find that such a construction would be inconsistent with the intrinsic evidence, it also notes that the "portions" of workspace data discussed in the specification does not refer to portions of individual emails. Instead, the specification language refers to the limited portions of all workspace data that require synchronization. *See* '679 Patent, col.2 ll.62; col.6 ll.33-36. With this understanding, the Court considers the breadth of "independently modifiable emails."

Microsoft seeks to narrowly limit the term to complete copies of an email. However, the Court finds that a construction that omits Microsoft's proposed limitation is in line with Judge Ward's previous order. Judge Ward construed a similar term, "independently modifiable copy," in Visto's '708 patent. Judge Ward concluded that the term meant "a copy of a workspace element capable of being modified independent of the workspace element. The copy of the workspace element does not have to be in the same format as the workspace element." Here, the Court finds that the appropriate construction of "independently modifiable email" should recognize that the word copy is replaced with "email" and there is no reason to conclude that the replacement of copy with email requires synchronization of only complete emails. On the other extreme, however, the Court finds that Microsoft is correct to the extent that the patent does not refer to the synchronization of completely separate emails. Visto's broad proposal could possibly lead to such a conclusion. Therefore, the Court adopts Visto's definition with the following modification. "Independently modifiable emails" means "emails that are capable of being modified independent of each other. The emails cannot be unrelated and do not have to be in the same format."

(c) "independently modifiable [copy/email]

The next related term is "independently modifiable [copy/email]." This term is found in claims 1, 11, and 22 of the '192 patent and in claims 1, 3, and 11 of the '679 patent. The underlying phrase "independently modifiable copy" was construed by Judge Ward to mean "a copy of workspace element capable of being modified independent of the workspace element. The copy of the workspace element does not have to be in the same format as the workspace element." This Court has just construed "independently modifiable email"

as meaning "emails that are capable of being modified independent of each other. The emails cannot be unrelated and do not have to be in the same format."

Given these constructions, Visto argues that no additional construction is necessary. Further, Visto notes that "independently modifiable" is apparent to one of ordinary skill in the art. In sum, Visto argues that Judge Ward has already construed "independently modifiable" when he construed "independently modifiable copy." Under that construction, "independently modifiable" would simply mean "capable of being modified independent of the workspace element." Alternatively, Microsoft urges the Court to adopt the construction "[a copy/email] that the user can modify without modifying another [copy/email]." Microsoft argues that this construction necessarily includes the limitation that "independently modifiable [copy/email]" does not include transient copies that the user cannot directly change. Microsoft argues that the specification makes clear that such transient copies, which are generated during the synchronization process, are not the copies that must be synchronized following modification. The Court finds that the real issue here stems from the arch-nemesis of every first year law student-the passive voice. Due to the language chosen to construe "independently modifiable copy" and "independently modifiable emails," the question remains: capable of being modified independently by what or whom?

As noted, Microsoft relies on the specification to support its proposed limitation that independently modifiable emails or copies must be modified by the user. Visto, however, again argues that Microsoft is improperly attempting to add a copy requirement to the claim. *See* Hr'g Tr. at 17. The Court notes that the specification of the '192 patent seems to imply that independently modifiable copies are maintained and modified by users. *See, e.g.,* '192 patent, col. 1 ll.31-33; col.1 ll.46-48; col.2 ll.34-37. However, the Court cannot conclude that these implications in the specification are a clear disavowal of modifications made by something other than the user. *See* Phillips, 415 F.3d at 1316 (noting that an inventor has dictated a claim's scope when the specification reveals an intentional disavowal of a certain definition). Therefore, no further construction of this term is necessary and, unfortunately, the indefiniteness created by the use of the passive voice remains.

(e) "server"

Relying on a technical dictionary, Visto argues that the term "server" means "a computer that provides services to another computer." *See* Doc. No. 72 at 11-12. Visto explains that the technical definition it proposes is most consistent with the specification of the '192 and '221 patents as well as other intrinsic evidence. Microsoft relies on the MICROSOFT PRESS COMPUTER DICTIONARY and proposes that a "server" is "a computer or program that responds to commands from a client." Microsoft also defines "client" as "a computer that accesses shared network resources provided by the server."

In support of its position, Microsoft explains that the term "server" is a term of art in the computer networking field that is more limited than the ordinary understanding that something which serves is a server. *See* Doc. No. 78 at 16; Hr'g Tr. 46. However, Microsoft's proposed construction includes a limitation that the server respond to commands. The Court finds that the specification does not reveal any requirement that the server respond only to a command and not merely a request. In fact, the specification repeatedly refers to requests to the server. *See, e .g.,* '221 Patent, col.3 ll.6-8; '679 Patent, col.7 ll.7-9. One skilled in the art would generally understand that a client makes requests to a server and the specification clearly supports this understanding. *See* Phillips, 415 F.3d at 1313 ("[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.").

On a separate note, the Court finds that there is no support in the specification for Microsoft's proposed definition of a client. The specification demonstrates that a client is tied to the task of sending service requests to a server. *See, e.g.,* '221 Patent, col.3 ll.6-9; '679 Patent, col.3 ll.10-17. As a result, the Court adopts Microsoft's proposed construction with the following modifications. The term "server" is construed as "a computer or program that responds to commands or requests from a client. A client is a computer or program that sends commands or requests to the server."

(f) "Internet"

The term "Internet" appears in claim 22 of the '192 patent and in claim 1 of the '679 patent. Microsoft argues that the Court should construe "Internet" as "the worldwide, publicly accessible network that connects other networks, such as corporate, university, and government networks." Visto argues that no construction of this term is necessary. However, Visto also explains that if construction is necessary it would not object to Microsoft's proposal if it were modified to read, "a network that connects other networks, such as corporate, university, and government networks."

Microsoft explains that the issue is whether "Internet" is the public, worldwide internet, or whether it can be some other private, trusted network behind a firewall. *See* Doc. No. 78 at 18. Microsoft argues that the patents limit "Internet" to the worldwide, publicly accessible internet because they refer to the "Internet" with a capital "I" and because they concern synchronizing data with a mobile device that may be all over the country. Therefore, Microsoft argues that it only makes sense that the patents are referring to the worldwide web and not merely to a private network. *See, e.g.,* Hr'g Tr. 50.

Microsoft also argues that Judge Ward's construction of "firewall" implicitly supports its position because Judge Ward discussed the broad ability of the firewall to "protect[ ] an organization's network against external threats, such as hackers, coming from another network, such as the Internet." On the other hand, Visto argues that Judge Ward's construction supports *its* position because it mentions external threats coming from "*another network*." *See* Doc. No. 72 at 19. Visto explains that Judge Ward's construction confirms that internet does not inherently refer to a worldwide or publicly accessible network. *See* id.

The Court finds that the term "Internet" does warrant construction. However, the Court rejects Microsoft's proposed limitation that "Internet" is a worldwide, publicly accessible network. As Visto points out, the patents do not exclusively use the capitalized version of "internet." *See, e.g.,* '679 Patent, col.1 ll.59. In addition, Microsoft's own dictionary definition makes no mention of a network that is publicly accessible. In fact, the dictionary states:

internet ... 1. Any network that connects other networks; 2. **Internet.** a large network of this type that covers the U.S. and extends to Canada, Europe, and Asia, providing connectivity between governments, universities, and corporate networks and hosts.

ACADEMIC PRESS DICTIONARY OF SCIENCE & TECHNOLOGY (1992).

Finally, the specifications of the patents do not support Microsoft's proposal. While the patents anticipate synchronization to occur in remote areas via computer networks such as the Internet, there is no requirement that it be a global or publicly accessible network. As a result, "Internet" means "a network that connects other networks, such as corporate, university, and government networks."

(g) "storing the preferred version at the first store and the second store"

Visto argues that no construction of this phrase is necessary as the meaning is apparent to one of ordinary skill in the art. On the other hand, Microsoft argues that it is properly construed as "transmitting the preferred version to the first and second store." Microsoft explains that the word storing can refer to either actively or passively storing. *See* Hr'g Tr. 52. Microsoft argues that storing in the sense used here refers to actively storing-i.e. transmitting. Microsoft draws its proposed construction from Judge Ward's construction of the means-plus-function term, "means for storing the preferred version," and argues that Judge Ward construed "storing" as "transmitting."

The Court finds that Judge Ward's order does not limit "storing" to "transmitting." Judge Ward explained that "[i]n the context of claims 10 and 11 of the '192 patent ... it appears that the patentee used the term 'storing' in the sense associated with the transmission of the preferred versions to the two memory stores." *See* Ward Order at 30. Given the fact that Judge Ward stated that "storing" is simply *associated* with the act of transmitting the preferred versions, the Court cannot conclude that he intended to limit the term "storing" to "transmitting." Thus, notwithstanding the fact that Judge Ward was identifying the function of a means-plus-function limitation, his statement simply emphasized the fact that "storing" is used in the active sense in the claims of the '192 patent. *See* Ward Order at 30-31.

Furthermore, this recognition is furthered by the fact that Judge Ward limited the corresponding structure to the software that performed the act of storing. *See* id. at 30. One of ordinary skill in the art would understand the distinction between *storing* a preferred version and *transmitting* the same. For example, a preferred version may be stored without transmitting the entire version, but rather by transmitting only a modified portion of the data. The ' 192 patent's specification makes clear that its methods are intended to store the preferred versions at the first and second stores in the active sense of the word "store." *See, e.g.,* '192 Patent, col.5 ll.60-65. Therefore, the Court concludes that "storing the preferred version at the first store and at the second store" means "actively storing the preferred version at the first and second store."

(h) "normally open ... firewall port"

The phrase "normally open LAN firewall port" appears in claim 1 of the '679 patent. Visto urges the Court to construe "normally open ... firewall port" as "a port that is typically configured to be open for packet traffic in a firewall. Ports 80 and 443 are examples of normally open ports." On the other hand, Microsoft argues that a more appropriate construction is "a port that is typically configured to allow all messages addressed to the port to pass through."

The Court finds that Microsoft's proposal is unsound for several reasons. First, Microsoft's proposal differs from Visto's interpretation in that it refers to messages instead of packets of data. The Court finds that the specification clearly supports Visto's construction, *see* '679 Patent, col. 11 ll.31-33, and Microsoft ostensibly concedes this point. *See* Doc. No. 78 at 18 n. 4. As a technical matter, Microsoft's construction is also inaccurate in the sense that it states messages are addressed to the port. As Visto properly points out, it is understood that data is actually sent using a specific protocol which has a port number associated therewith. *See also* Doc. No. 83, ex. B.

Additionally, the parties disagree about the meaning of "normally open." Microsoft argues that the port is not open unless it allows all data packets sent to the port to pass through. However, the Court cannot conclude that the specification contains such a limitation. While Microsoft is correct in pointing out that the

purpose of the patent is to utilize ports that are normally open, it does not necessarily follow that all packets must be able to pass through all the time. In fact, one skilled in the art would understand that ports could be open for certain types of packets-this understanding is consistent with Visto's construction. Further, the Court is unable to find any language in the specification that support's Microsoft's proposal and feels that such a construction would render the claim language "normally open" superfluous.

Finally, the parties disagree as to whether the claim construction should note that ports 80 and 443 are examples of normally open ports. Microsoft argues that Visto is improperly asking the Court to make factual findings as to whether these ports refer to normally open firewall ports. However, the claims of the '679 patent specifically refer to a normally open port as an HTTP or HTTP (SSL) port. '679 Patent, claim 2, 3. In addition, the specification provides support the claim language. For example, column 10 of the '679 patent notes that HTTP is a commonly enabled protocol and that the system can use the SSL port to establish a secure communication channel. One skilled in the art would generally recognize that the HTTP port is port 80 and that the SSL port is port 443. Therefore, the Court construes "normally open LAN firewall port" to mean "a port that is typically configured to be open for packet traffic in a firewall. Ports 80 and 443 are examples of normally open ports."

III. THE MICROSOFT PATENTS

(A) The '369 Patent

The '369 patent issued on September 26, 2000, to Charles Wu and George T. Hu, of the Microsoft Corporation. The application for the '369 Patent was filed on October 27, 1997. As noted above, the patent is entitled "Continuous Object Synchronization Between Object Stores on Different Computers." *See* Doc. No. 75, ex.1 at 1.

(1) Claim Construction

The parties request that the Court construe five terms and phrases appearing in the '369 Patent. The terms arise out of claims 4, 9, and 10. These claims are set forth in Exhibit B attached to this Order. The Court construes the contested language as follows:

(a) "portable information device"

The first disputed term is "portable information device." Microsoft argues that the '369 Patent specification expressly defines the term. *See* Doc. No. 75 at 6. In fact, the specification states, "[f]or purposes of this description, the term 'portable information device' means a small computing device having a processing unit that is capable of running one or more application programs, a display, an input mechanism, that is typically something other than full-size keyboard." '369 Patent, col.5 ll.21-27. On the other hand, Visto agrees with Microsoft that the definition for this term is in the '369 specification. *See* Doc. No. 77 at 8. However, Visto proposes that the Court include an additional portion of the specification which states "[t]he input mechanism *might be* a keypad, a touch-sensitive screen, a track ball, a touch-sensitive pad, a miniaturized QWERTY keyboard, or the like. In other implementations, the portable information device *may be* implemented as a personal digital assistant (PDA), a personal organizer, a palmtop computer, a computerized notepad, or the like." '369 Patent, col.5 ll.29-33 (emphasis added). The parties agree that when the patentee acts as his own lexicographer his definition controls. Here, Visto's proposal, while in the specification is not part of the definition provided. Rather, the proposed addition shows examples of possible devices that could fit the definition. Therefore, the proper construction of a "portable information

device" is a "a small computing device having a processing unit that is capable of running one or more application programs, a display, an input mechanism, that is typically something other than full-size keyboard."

(b) "synchronization manager"

The term "synchronization manager" appears in claims 4, 9, and 10 of the '369 Patent. Microsoft's proposed definition for this term is "software that manages the process of bidirectionally maintaining consistency between two instances of a database." *See* Doc. No. 75 at 7. The basis of Microsoft's proposal is the prosecution history which analogizes the term "synchronization" to prior art. That history states:

Thus Buchanan uses "synchronization" to refer to a process of bidirectionally maintaining consistency between two instances of a database. This is the same sense in which the application uses the term.

Doc. No. 75, ex.6 at 2.

Visto argues that the definition of synchronization manager is "a computer program that compares copies of objects on separate stores whenever a device is connected by means of direct physical cable or IR (infrared) communications, and issues commands to bi-directionally synchronize [maintain consistency between] the objects." *See* Doc. No. 77 at 9. Visto argues that the prosecution history used by Microsoft is neither "legally nor factually tenable." Doc. No. 77 at 6. Visto suggests that in this case the specification is a better guide to defining the term because "the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation." *See* Doc. No. 77 at 12 (quoting Phillips, 415 F.3d at 1317).

The Court finds that the prosecution history here carries substantial weight in determining the meaning of the term "synchronization manager." The Federal Circuit has noted that the prosecution history "is often of critical significance in determining the meaning of the claims." *See* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996) (citing Markman, 52 F.3d at 980). During prosecution of the '369 Patent, all claims were rejected as being obvious over, inter alia, the Buchanan patent. *See* Doc. No. 75, ex. 6 at 1. In distinguishing its claims over those and other patents, Microsoft expressly noted that the term "synchronization" as used in its application referred "to a process of bi-directionally maintaining consistency between two instances of a database." *See* Doc. No. 75, ex.6 at 2. The Court finds that Microsoft clearly operated as its own lexicographer as to this term. *See, e.g.,* Home Diagnostics, Inc. v. Lifespan, Inc., 381 F.3d 1352, 1356 (Fed.Cir.2004) ("As in the case of the specification, a patent may define a term in prosecuting the patent."); CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed.Cir.2002) ("... the claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and *clearly* set forth a definition of the disputed term in either the specification or *prosecution history*.") (emphasis added).

Visto's reliance on the patent abstract is also misplaced. For example, Visto supports its proposed definition by citing the portion of the abstract stating "[t]he synchronization manager *compares* object instances from the first and second object stores in response to initially connecting the portable computer for data communications with the primary, and synchronizes any objects whose instances differ from each other." *See* Doc. No. 77 at 9 (quoting '369 Patent at Abstract) (emphasis added). Although the Court agrees that the synchronization manager *compares* object instances and synchronizes any objects whose instances differ from each other, the portion of the abstract cited by Visto simply discloses a function of the synchronization

manager and does not provide a definition of the synchronization manager.

Additionally, Visto's claim that the definition should include a requirement that the synchronization manager and the Handheld/Personal Computer (hereafter "H/PC") synchronization manager be connected by means of direct physical cable connection or IR (infrared) communications is without merit because the '369 specification portions relied on by Visto refers to preferred embodiments of a communications medium. *See* '369 Patent, col.4 ll.2-6; *see also* '369 Patent, col.6 ll.23-25, 34-35. Thus, the Court finds that the proposed requirement should not be included in the term "synchronization manager" simply because the '369 Patent specification uses "physical cable and IR (infrared) communications" as preferred embodiments of a communications medium.

Finally, Visto argues that the prosecution history establishes that synchronization requires continuous linkage. *See* Doc. No. 77 at 11. However, the term before the Court is "synchronization manager"-not a means-for limitation. Accordingly, the prosecution history cited by Visto, which is an office action letter summarizing prior art, does not provide a clear definition for the term "synchronization manager." *Cf.* Vitronics, 90 F.3d at 1582. As discussed above, however, the Court determines that the definition provided by the patentee during prosecution is clear and unmistakable. Therefore, the term "synchronization manager" means "software that manages the process of bidirectionally maintaining consistency between two instances of a database."

(c) "continuously synchronized"

The disputed term "continuously synchronized" appears in claims 4 of the ' 369 Patent. Specifically, the term appears in the preamble of claims 4 and 5. *See* '369 Patent, col. 135 ll.35, 53. Microsoft proposes that no construction is necessary because the patentee merely uses the term in the preamble. *See* Doc. No. 75 at 10. Visto, however, argues that even though the term is in the preamble, it is a limiting term in need of construction. *See* Doc. No. 77 at 12-13.

Although the preamble may be "necessary to give life, meaning, and vitality" to the claim, Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed.Cir.1999), the Court finds that the prosecution history of the disputed term is probative when there is "*clear reliance* on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed.Cir.2002) (emphasis added). Here, during prosecution Microsoft did not distinguish its invention from prior art by claiming that their invention is continuously connected. *See* Doc. No. 75, ex.6 at 4. Rather, Microsoft distinguished the invention over prior art by noticing that the prior art did not mention a portable information device. *Id. at 6.* The Court finds that Microsoft did not clearly rely on the preamble term "continuously synchronized" to distinguish between its patent and prior art. Therefore, the term "continuously synchronized" merely states a purpose or intended use of the invention and, thus, no construction is necessary.

(d) "object"

The term "object" appears in claims 4, 9, and 10 of the '369 Patent. Both parties agree that an "object" includes a data item. *See, e.g.,* Doc. No. 75 at 11; Doc. No. 77 at 15. However, Visto argues that the term "object" is a "data item that contains both data and procedures for manipulating that data." *See* Doc. No. 77 at 15. Microsoft argues that no construction is necessary, but would not object to simply construing an object as "a data item." *See* Doc. No. 75 at 11.

The Court notes that words in the '369 patent are given ordinary and customary meaning unless Microsoft acted as its own lexicographer. *See Vitronics,* 90 f.3d 1582. However, the ordinary meaning of the terms is defined as "the meaning that the term would have to a person of ordinary skill in the art ... at the time of the invention." *See* Phillips, 415 F.3d at 1313. Here, Microsoft does not define the term in the '369 patent specification, but one skilled in the art would recognize that the term "object" has a special in meaning in an object-oriented programming environment. The '369 patent specification explains that the invention utilizes Component Object Model (COM) technology, which is common in Microsoft products. *See* '369 Patent, col.4 ll.56-60. One skilled in the art would understand that COM is based on object-oriented programming, though multiple programming languages could be used. In fact, Microsoft's own website defines COM technology as an object-oriented system. *See* Microsoft Developer Network Library, Component Object Model, http://msdn2.microsoft.com/en-us/library/ms680573.aspx (last visited July 17, 2007) ("COM is a platform-independent, distributed, object-oriented system, for creating binary software components that can interact."). This definition exemplifies the fact that one skilled in the art would also understand COM to allow for reuse of objects through well-defined interfaces. In fact, MerriamWebster's 2006 Collegiate Dictionary defines an object as a "data structure in object-oriented programming that can contain functions as well as data, variables, and other data structures." FN1 *See* MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (11th ed.2006). One skilled in the art would understand that the functions discussed are procedures for manipulating data. Therefore, the term "object" is properly construed as "a data item that may contain data and/or procedures for manipulating that data."

FN1. The Court recognizes that the 2006 edition of the dictionary contains this definition while the contemporaneous version of the same dictionary does not. The Court does not consider the dictionary definition as dispositive, but merely as further evidence of how widely accepted the definition assigned by those skilled in the art at the time of the invention has presently become.

(e) "object store manager"

Claims 4, 9, and 10 of the '369 Patent also contain the term "object store manager." The Court has already defined "object" as "a data item that may contain data and/or procedures for manipulating that data" and the parties agree that "object store" is defined as a "storage location for objects." As a result, Microsoft argues that no construction of "object store manager" is necessary. *See* Doc. No. 75 at 12. However, Microsoft argues that if the term is construed it should mean "software that manages an object store." *See* id. On the other hand, Visto's proposed construction is "a computer program that mediates all communications with a specific object store. The object store manager is separate from the synchronization manager and performs the function of notification. First and second object store managers execute on different computers." *See* Doc. No. 77 at 16-17.

The obvious first issue is whether the "object store manager" is separate and distinct from the synchronization manager. In support of this limitation Visto argues that during prosecution Microsoft distinguished prior art as not teaching a system with an object store manager which exists as a distinct and separate component from the synchronization manager. *See* Doc. No. 77 at 17. The Court agrees. If a patent applicant makes statements during prosecution that distinguish prior art, such statements "may serve to narrow the scope of a claim." *See* Spectrum Int'l v. Sterilite Corp., 164 F.3d 1372, 1378 (Fed.Cir.1998). During prosecution the applicant clearly distinguished prior art by stating the prior patent "disclose[d] only a single management component, referred to as a 'synchronization manager,' and d[id] not disclose any

second component that would perform the recited role of the 'object store manager.' " *See* Doc. No. 77, ex. B at 10.

Visto's next proposed limitation is that the "object store manager" performs the function of notification. Microsoft points to a portion of the specification that contemplates the possibility of object store managers that do not have the ability to generate notifications. *See* Doc. No. 75 at 12 (citing '369 Patent, col .7 ll.16-20). However, the Court finds that the claim language and the prosecution history clearly demonstrate that the object store manager is capable of initiating notification to the synchronization manager. For example, claims 4, 5, and 9 each claim a system or method comprising, inter alia, an object store manager that "initiates a notification to the synchronization manager." *See, e.g.,* '369 Patent, col.135 ll.45-46. Further, the patentee clearly traversed a prior art rejection of what is now claim 9 by explaining the prior patent did not "detect any data changes by receiving notifications initiated by an object store manager." *See* Doc. No. 77, ex. B at 10. Thus, the applicant clearly understood the object store manager as being capable of sending notifications to the synchronization manager.

Relatedly, the parties dispute whether the "object store manager" mediates all communications with a specific object store. Visto cites the detailed description of the invention which refers to unsolicited notifications which are sent to the synchronization manager. *See* Doc. No. 77 at 18 (citing '369 Patent, col.7 ll.1-20). However, that portion of the specification also discusses the possibility that the synchronization manager polls for changes in the object stores. *See* '369 Patent, col.7 ll.16-21. The prosecution history cited by Visto does not foreclose the invention's ability to send polling requests. It merely notes that the prior art was incapable of detecting data changes by receipt of notifications. *See* Doc. No. 77, ex. B at 10. Though the object store manager initiates notifications and is involved in communication, the Court does not find that it necessarily mediates all communications.

Finally, the issue remains as to whether first and second object store managers execute on different computers. Microsoft argues that first and second object store managers are not even required. *See* Doc. No. 75 at 13. Visto argues that the specification requires that the first and second object store managers execute on different computers. *See* Doc. No. 77 at 18 (citing '369 Patent, col.13 ll.7-18). Concerning these arguments, the Court finds that nothing in the claim language supports a limitation that first and second object managers execute on different computers. *See, e.g.,* '369 Patent, col.136 ll.13-23. For example, claim 9 merely discusses executing an object store manager and does not define its location. Likewise, the portion of the specification cited by Visto does not provide any express disavowal as to the meaning of object store manager. In sum, the Court construes "object store manager" to mean "a computer program that mediates communications with a specific object store. The object store manager is separate from the synchronization manager and is capable of initiating a notification to the synchronization manager."

(C) '655 Patent

The next patent at issue is Microsoft's '655 Patent. The '655 Patent issued to Roger F. Grambihler, et al., on May 6, 2003. *See* Doc. No. 75, ex.2 at 1. The underlying patent application was filed on June 22, 1999. *See* id. The parties dispute three terms in one claim of the '655 Patent.

(1) Claim Construction

(a) "central synchronization service"

The first disputed term is "central synchronization service." Microsoft proposes that "central synchronization

service" means "a central program module that manages synchronization." *See* Doc. No. 75 at 14. On the other hand, Visto's proposed construction of this term is:

[A] computer program comprising a synchronization manager that manages the synchronization of data from multiple applications by loading, queuing and calling (upon the occurrence of a synchronization event) methods to run handlers registered by the applications with the synchronization manager. The synchronization manager provides a consistent interface for obtaining user preferences and presenting information to the user regardless of the application and/or data that is being synchronized. The synchronization manager does not require the user to separately run synchronization programs or deal with separate user interfaces for each program to adjust synchronization settings, or to view the synchronization progress. The synchronization manager is distinguished from synchronization using agents.

See Doc. No. 77 at 20.

The first sentence of Visto's construction creates two limitations: (1) that the program manages data from multiple applications; and (2) that the program calls methods to run handlers. As to the former limitation, Microsoft avers that there is no support that the synchronization manager *must* manage the synchronization of data from multiple applications. *See* Doc. No. 75 at 15. In fact, Visto concedes in its response that the synchronization manager is simply capable of managing data from multiple applications. *See* Doc. No. 77 at 20. The Court notes that the claim language itself lists the possibility of the synchronization manager only loading one handler to synchronize the data of one program. *See* '655 Patent, Claim 27 ("... receiving a synchronization event at a central synchronization service; ... loading *at least one* synchronization handler, each synchronization handler corresponding to a separate application or component that has data capable of being synchronized ...") (emphasis added). As a result, Visto's first proposed limitation is without support. *See* Phillips, 415 F.3d at 1314 ("To begin with, the context in which a term is used in the asserted claim can be highly instructive.").

Visto argues the second limitation is necessary because Microsoft distinguished prior art references during prosecution by stating the prior art was not about "a centralized manager loading or calling anything resembling a registered handler as recited in the claims, wherein each handler corresponds to one of a plurality of separate programs/applications or components." *See* Doc. No. 77, ex. F. Visto also argues that the specification supports its interpretation because it notes that "the synchronization manager calls each handler [in order to synchronize]." *See id*. (citing '655 Patent, col.7 ll.43-47). As an initial matter, the Court fords that the claim language FN2 teaches that in response to a synchronization event, at least one of the synchronization handlers is loaded and "each loaded synchronization handler [is] called by the centralized management component to synchronize the data of its corresponding program." *See* ' 655 Patent, col.44 ll.12-15. The specification confirms that, "[t]o synchronize, the synchronization manager 60 calls each handler." *See* id., col.7 ll.43-44. The specification notes that one aspect of the invention, which avoids any need by the user to separately run multiple applications to synchronize data, is that the synchronization manager calls each handler to perform synchronization. *See* ' 655 Patent, col.7 ll.28-32. In addition, one skilled in the art would understand that methods are, generally speaking, simply statements in a computer program to perform an action. Therefore, calling upon the handler would necessarily include calling methods to run handlers. Notwithstanding, the Court finds that no clarification is added to any construction by including such detail. The risk of jury confusion would certainly arise if every step in the computer program were included in every construed term.

FN2. Though the term "centralized management component" is not a term in dispute, Visto had construed

the term to be synonymous with the term "central synchronization service." The Court agrees and determines that the language of claim 1 is relevant to construe the term "central synchronization service" of claim 27.

Visto's next proposed limitation is as follows: "The synchronization manager provides a consistent interface for obtaining user preferences and presenting information to the user regardless of the application and/or data that is being synchronized ." Microsoft points out that this limitation violates the doctrine of claim differentiation. *See* Doc. No. 75 at 15. Specifically, Microsoft argues that claim 1 does not necessarily have to provide a user interface because dependent claim 3 states that "the centralized management component includes at least one dialog for interfacing with the user." *See* id. (referring to ' 655 Patent, co.44 ll.21-23). In short, Microsoft asserts that the "dialog for interfacing with the user" in claim 3 is congruent with Visto's proposed limitation, "consistent interface for obtaining user preferences."

The Court is unpersuaded. As Visto notes, requiring the centralized management component to provide a consistent user interface is not the same as "dialog for interfacing with the user" as used in dependent claim 3 of the patent. *See* Doc. No. 77 at 21. The dialogs described in claim 3 "may not necessarily be present unless specifically invoked by the user or triggered by a synchronization event." *See* id. (citing '655 Patent, col.8 ll.17-19). To be sure, claim 1 and claim 27 each refer to a system which loads synchronization handlers which correspond to separate applications in order to facilitate synchronization. *See* '655 Patent, col.44 ll.6-16 ("A system for managing the synchronization of data, comprising, a centralized management component, a plurality of synchronization handlers registered with the centralized management component, each synchronization handler corresponding to a separate program having data maintained at different locations, the management component receiving a synchronization event, and in response thereto loading at least one of the synchronization handlers, each loaded synchronization handler called by the centralized management component to synchronize the data of its corresponding program."); col.45 ll.22-36 ("computer-executable instructions for performing steps comprising ... loading at least one synchronization handler, each synchronization handler corresponding to a separate application or component that has data capable of being synchronized; and directing from the central service each loaded synchronization handler to synchronize data based on the user preference information in response to the synchronization event."). When read in light of the specification these claims consist of a system for synchronizing while creating a consistent user experience. *See* Phillips, 415 F.3d at 1315 ("[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive.' ") (quoting Vitronics, 90 F.3d at 1582). For example, the summary of the invention specifically states that "[t]he synchronization manager provides consistent user interfaces for obtaining user preferences related to synchronization and for presenting information to the user, thus resulting in a consistent user experience.." *See* '655 Patent, col. 2 ll.11-15; *see also* col.43 ll.52-56 ("As can be seen from the foregoing detailed description, there is provided a centralized synchronization manager that provides a user with a consistent user experience while eliminating the need for the user to separately launch applications to synchronize data."). As a result, the Court finds that the synchronization manager inherently provides a consistent user interface.

Visto next proposes that the synchronization manager "does not require the user to separately run synchronization programs or deal with separate user interfaces for each program to adjust synchronization settings, or to view the synchronization progress." *See* Doc. No. 77 at 20. Visto relies on prosecution history in which Microsoft claimed the invention "does not require the user to separately run each program to synchronize the various data." *See* id., ex. F at 9. The Court, however, finds that the prosecution history does not support Visto's proposal. In its entirety, the referenced prosecution history clarifies that the reason a

user does not need to separately run each program is because "the synchronization manager *provides a consistent user interface (or set of user interfaces) for obtaining user preferences related to synchronization*." *See* id. (emphasis added). The Court therefore finds that the prosecution history supports a finding that the synchronization manager provides a consistent user interface, but does not support the need for any further clarification that "the synchronization manager does not require the user to separately run synchronization programs." *See* Phillips, 415 F.3d at 1317 ("Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent.").

The final sentence of Visto's proposed construction states, "[t]he synchronization manager is distinguished from synchronization using agents." Visto ostensibly adds this statement in an attempt to clarify the distinction between the '655 Patent, which "provides a centralized, standardized mechanism for managing the synchronization of data between local and remote computers according to user preferences," and prior art patents which utilized program specific synchronization agents. However, the Court finds that this evidence does not impose the limitation Visto suggests. Again, the prosecution history simply affirms what the '655 Patent makes clear-that it is an invention directed toward a method for managing synchronization that provides a consistent user interface that is not program specific. For example, the paragraph of prosecution history following the language Visto cites clarifies that the '655 Patent differs from the Tognazzini patent in the sense that synchronization handlers are loaded, called, and registered with the synchronization system. *See* Doc. No. 77, ex. F at 10. This statement merely demonstrates the purpose of the handlers.

In light of the foregoing, the Court finds that "central synchronization service" means "a computer program comprising a synchronization manager that manages the synchronization of data from one or more applications and provides a consistent user interface. The centralized synchronization service responds to a synchronization event by loading one or more handlers and calls upon the handlers to synchronize the data of its respective program."

(b) "synchronization handler"

The next disputed term is "synchronization handler," appearing in claim 27 of the '655 Patent. Microsoft proposes that the term simply refers to "software that handles synchronization." *See* Doc. No. 75 at 14. Visto argues that the term "synchronization handler" is a term of art and should not be construed so simply. *See* Doc. No. 77 at 22. Instead, Visto's proposal is "a computer program associated with a specific application that performs synchronization for that application independent of the synchronization manager, and controls the way in which synchronization is handled, e.g., the protocol used, how the data is stored, etc. A synchronization handler is distinct from an application component. A handler must have the ability to be called to synchronize data without running the application program to which it corresponds." *See* Doc. No. 77 at 22.

The Court begins with the claim language itself. *See* Phillips, 415 F.3d at 1313. For example, claim 1 claims

A system for managing the synchronization of data, comprising, a centralized management component, a plurality of *synchronization handlers registered with the centralized management component, each synchronization handler corresponding to a separate program having data maintained at different locations,* the management component receiving a synchronization event, and in response thereto *loading at least one of the synchronization handlers,* each loaded synchronization handler called by the centralized management component to synchronize the data of its corresponding program.

'655 Patent, col.44 ll.6-16 (emphasis added).

Claim 27 claims:

A computer-readable medium having computer-executable instructions for performing steps comprising: receiving a synchronization event at a central synchronization service; obtaining user preference information related to the synchronization event; *loading at least one synchronization handler, each synchronization handler corresponding to a separate application or component that has data capable of being synchronized;* and directing from the central service each *loaded synchronization handler to synchronize data based on the user preference information in response to the synchronization event*.

'655 Patent, col.45, ll.22-36 (emphasis added).

The emphasized language demonstrates that each handler is loaded by the synchronization manager. The specification even confirms that the synchronization manager calls the respective handlers to perform synchronization. *See, e.g.*, '655 Patent, col.7 ll.43-50. This alone would lead one skilled in the art to assume that the handlers are independent and separate from the synchronization manager. In any event, the specification closes any doubt:

The way in which synchronization is handled ... is performed by the handlers, and *is independent of the synchronization manager* 60. In other words, the synchronization manager 60 provides the dialogs 64 *and appropriately invokes the handlers to perform synchronization,* but leaves the synchronization up to the handlers.

See id. at ll.32-39 (emphasis added).

Furthermore, the prosecution history demonstrates this invention is distinguishable from synchronization systems that operate without a centralized synchronization manager which calls synchronization handlers as necessary. *See* Doc. No. 77, ex. F at 11. In light of the prosecution history and the specification as a whole, the Court concludes that the specification language quoted above is not merely one possible embodiment, but is a central aspect of the invention and limits the synchronization handler. As a result, Visto's first limitation, that the handlers are independent from the synchronization manager, is appropriate.

Visto next argues that this term is properly limited as being able to synchronize data without running its corresponding application program. Microsoft argues that this limitation violates the doctrine of claim differentiation because claim 38 states "each synchronization handler is loaded and called by the centralized management component independent of whether the application or component to which the synchronization handler corresponds is running." *See* Doc. No. 75 at 18 (quoting '655 Patent, claim 38). Visto responds that claim differentiation only creates a presumption that claims cover separate inventions and that the '655 patent makes clear that the synchronization handlers "have the ability to be called to synchronize data without running the application program to which it corresponds." *See* Doc. No. 77 at 23 (citing Backyard Nature Prods. v. Woodlink, Ltd., 81 Fed. Appx. 729 (Fed.Cir.2003). Notwithstanding, the Court finds that the specification supports the contention that a handler is *capable* of being called and synchronizing data without running the application to which it corresponds. For example, claim 38 expressly states that the handler can be "loaded and called by the centralized management component independent of whether the application ... to which the synchronization handler corresponds is running." *See* '655 Patent, Claim 38.

Furthermore, the specification explains that "the user does not need to separately run each application to synchronize the data." *See* id., col.7 ll.31-32.

This understanding dovetails with another limitation proposed by Visto-whether a synchronization handler is distinct from an application component. Visto argues that since an application component need not run during synchronization then the synchronization handler is inherently distinct from the application. *See* Doc. No. 77 at 23. In actuality, Visto may very well be correct. It seems likely that any embodiment of the present invention would likely have handlers that are separate. However, nothing in the claims or the specification necessarily requires this limitation. Although it is clear that the handlers and the synchronization managers are separate, an application program could potentially include or be indistinct from a synchronization handler. Therefore, the Court finds that "synchronization handler" is properly construed as "a computer program associated with a specific application that performs synchronization for that application independent of the synchronization manager and controls the way in which synchronization is handled, e.g., the protocol used, how the data is stored, etc. A synchronization handler is capable of being called to synchronize data without running the application program to which it corresponds."

(c) "separate application or component"

The last disputed term from the '655 Patent is "separate application or component." Microsoft argues that no construction is necessary, but would not object to "an application or component that is distinct from the other applications or components." *See* Doc. No. 75 at 22. Visto proposes "an application or component that is distinct from the synchronization manager, the synchronization service, and any other application or component." *See* Doc. No. 77 at 27.

Claim 27 of the '655 Patent concerns synchronization of data and, in part, reads:

A computer-readable medium having computer-executable instructions for performing steps comprising: receiving a synchronization event at a central synchronization service; obtaining user preference information related to the synchronization event; *loading at least one synchronization handler, each synchronization handler corresponding to a separate application or component that has data capable of being synchronized* ....

'655 Patent, claim 27 (emphasis added).

Visto properly points out that the prosecution history sheds light on the present term. The emphasized portion of the claim originally read: "loading at least one application component." After that claim was rejected Microsoft amended the claim to read "loading at least one synchronization handler, each synchronization handler corresponding to a separate application or component." *See* Doc. No. 77, ex. F at 19. The Court finds that the prosecution history demonstrates that the PTO and the applicant understood the phrase "separate application or component" to mean "an application or component that is distinct from the other applications or components." *See* Phillips, 415 F.3d at 1317. Instead of loading at least one application component the amended invention would load at least one synchronization handler that corresponds to a separate application or component. *See* Doc. No. 77, ex. F at 19. Therefore, the Court construes "separate application or component" as meaning "an application or component that is distinct from the synchronization manager, the synchronization service, and any other application or component."

(D) The '691 Patent

The last patent at issue is the '691 Patent. The patent application was filed on May 15, 1996 and the '691 Patent issued to Se-Wai Lee, et al., on August 31, 1999. The '691 Patent is entitled "Method of Presenting, Storing, and Updating a Filing Identifier for a Data Record." Claim 1 is the only claim at issue. The parties ask the Court to construe five terms.

(1) Claim Construction

(a) "designated field"

The first disputed term is "designated field." Microsoft argues that the term does not require construction, but would not object to "specified field in the data record." *See* Doc. No. 75 at 33. Visto proposes, "a distinct field in the data record, referred to as the "file as" field, for receiving and displaying a filing identifier." *See* Doc. No. 77 at 36.

Visto argues that the intrinsic evidence refers to the "designated field as the field for receiving the filing identifier. *See* Doc. No. 77 at 36 (citing, *inter alia,* col.8 ll.18-22). Microsoft counters by noting that the claim originally stated the designated field *for receiving* a filing identifier ...." *See* Doc. No. 75 at 30 (citing First Amendment to the '691 Patent). The Court finds that Visto's position is more consistent with the specification and the prosecution history as a whole. For example, in response to later office action the applicant distinguished prior art by explaining the designated field's role of receiving. Specifically, the applicant explained that the prior art was about "accessing records stored in different file system formats." *See* Doc. No. 77, ex. G at 10-11. The applicant then noted that the claims of the '691 Patent contrastingly "recite a special field, for example the claimed 'designated field' for receiving the filing identifier." *See* Doc. No. 77, ex. G at 11. In addition, the specification makes clear that the designated field is for "receiving a filing identifier." *See* '691 Patent, col.1 ll.57-58. This evidences how the applicant understood the '691 patent. *See* Phillips, 415 F.3d at 1316-17.

Notwithstanding, the Court cannot accept Visto's proposed limitation that the designated field is limited to the "file as" field. A full reading of the patent specification reveals that the "file as" field is merely one embodiment of the designated field. *See* '691 Patent, col.8 ll.18-23 (noting that the "designated field" is "referred to herein as a 'file as' field 70"). More specifically, even though " 'file as' field" appears throughout the specification, it is simply a label given to the designated field for ease of explanation. *See* id., col.1 ll.41-43 ("[T]he preferred embodiment of the present invention automatically provides a designated field for filing, generally referred to as the 'file as' field."). Visto's reliance on Bell Atlantic Network Servs., Inc. v. Covad Comm. Group, Inc., 262 F.3d 1258 (Fed.Cir.2001), is misplaced because labeling the field as the "file as" field does not constitute using the term in a certain manner throughout the specification. *Contra* id. at 1271 (focusing on the manner that the term "mode" was used throughout the specification).

Visto also argues that the designated field is "for displaying a filing identifier." *See* Doc. No. 77 at 36. Visto refers the Court to portions of the specification that relate to displaying filing formats. *See* Doc. No. 77 at 36. However, the portions of the specification that Visto cites do not limit the displaying function to the designated field. *See* '679 Patent, col.8 ll.36-39 ("*The drop down menu button 72 is used to display* predefined filing formats, as discussed in more detail below, that are automatically formatted for use in the 'file as' field 70.") (emphasis added). As a result, the Court finds that "designated field" is properly construed as "a distinct field in the data record for receiving a filing identifier. For example, a designated field may be the 'filed as' field."

(b) "automatically generating a filing identifier"

The next disputed term is "automatically generating a filing identifier." The parties agree that "filing identifier" is construed as "information that identifies the location used by the computer system for filing the data record in a sorted list." Thus, Microsoft argues that the disputed term does not require construction, but would not object to "creating a filing identifier without requiring the user to manually type in the filing identifier ." *See* Doc. No. 75 at 33. On the other hand, Visto proposes, "populating the designated field with information entered in one of the other fields without user intervention." *See* Doc. No. 77 at 37.

The first issue raised by the parties' competing constructions is whether the filing identifier is generated from the other data fields. The claim language implies that the filing identifier stems from the other data fields because it states that the information is automatically selected from one of the information fields of the data record. *See* '691 Patent, claim 1. The specification clarifies any confusion by teaching a system that the filing identifier is automatically updated upon modification of information in the data fields.FN3 *See* id., col.1 ll.60-65; col.11, 21-25.

FN3. The Court notes that the patent teaches the ability to enter a filing identifier even when the label is not entered a separate data field. *See, e.g.,* '691 Patent, col.11 ll.9-14; col. 10 ll.7-16. However, these examples involve manually typing a filing identifier and do not constitute "automatically generating a filing identifier."

Additionally, the parties disagree whether the word generating simply means "creating a filing identifier" or more specifically refers to "populating the designated field." In support of the latter construction Visto points the Court to portions of the specification discussing the "process of populating the predefined filing format fields...." *See* Doc. No. 77 at 37 (citing, e.g., col.9 ll.37-38). The Court finds, however, that populating the fields is not necessarily the same as generating a filing identifier. As Microsoft point out, nothing in the specification implies that generating a filing identifier is the equivalent of populating the designated field.

The final issue is how to construe the term "automatically." Microsoft argues that Visto's proposal, "without user intervention," is contrary to the teachings of the patent. *See* Doc. No. 75 at 34. However, the portions of the specification cited by Microsoft refer to the ability of the user to choose which filing identifier will be inserted into the designated field. *See* id. (citing '691 Patent, claim 5 ("the step of providing an option to select one of said predefined filing formats"); col.3 ll.61-63 ("The user may select one of the predefined formats to enter in the 'file as' field"). The Court finds that to the extent the actual generation of the filing identifier is involved the specification demonstrates a system that generates a filing identifier without user. *See* '691 Patent at Abstract (outlining the "step of automatically generating, *by the computer system,* a plurality of predefined filing formats") (emphasis added). As a result, "automatically generating a filing identifier" means "creating a filing identifier with information entered in one of the other fields without user intervention."

(c) "information automatically selected from one of the plurality of information fields"

Microsoft again argues that no construction is necessary but would not object to "information chosen by the computer from one of the plurality of information fields." *See* Doc. No. 75 at 35. Visto proposes the "information for generating the filing identifier is selected from one of the information fields without user intervention." *See* Doc. No. 77 at 38. The dispute between the parties centrally revolves around the meaning of "automatically." Microsoft argues that its construction is more clear because Visto's construction "is at

best ambiguous about what 'user intervention' is avoided." *See* Doc. No. 75 at 35. Microsoft further argues that Visto's proposal could therefore exclude the preferred embodiment where the user selects on of the predefined fields as the "file as" field. *See* id. (citing '691 Patent, col.3 ll.61-63).

The Court is unpersuaded by Microsoft's arguments. As noted above, the key distinction is between the task of automatically generating a filing identifier and actions that may take place afterward. The patent is clear that after a user enters or updates information into one of the plurality of information fields, the filing identifier is automatically created based upon the information without any further user intervention. *See* '691 Patent, claim 1 ("in response to entry of information by a user into one of the plurality of information fields ... automatically generating a filing identifier"); col.8 ll.62-64 ("When a user enters a new contact or updates a name or company name, the predefined filing formats for the "file as" field 70 are automatically generated."). Contrastingly, the portion of the specification cited by Microsoft refers to a *user* later selecting a predefined format to enter into the "file as" field. *See* '691 Patent, col.3 ll.61-63. This action takes place only after the invention automatically generates the filing identifier. Therefore, "information automatically selected from one of the plurality of information fields" means "information for generating the filing identifier that is selected from one of the information fields without user intervention."

(d) "user command for data output"

The next disputed term is "user command for data output." Microsoft argues that no construction is necessary but would not object to "user action requesting data output." *See* Doc. No. 75 at 35. Visto argues that the phrase should be construed as "user action requesting a set of data records." *See* Doc. No. 77 at 39. Thus, the dispute between the parties relates to the meaning of "data output." Visto argues that the term "data output" refers to a "set of data records." *See* id. For example, Visto cites portions of the specification that refer to a need for a method of identifying data records. *See* id. (citing '691 col.1 ll.40-43). The finds that these portions of the specification do not limit the claim to only sets of records. Even though the specification may refer to "data record" in the plural sense and refers to lists of data records, the claim itself uses "data record" in singular form and provides no basis for the limitation Visto proposes. As a result, "user command for data output" means "user action requesting data output."

(e) "outputting said data record from the computer system memory in accordance with the filing identifier"

Microsoft argues that the Court should construe the final disputed term as "outputting the data record based on the filing identifier." *See* Doc. No. 75 at 36. Visto's proposal is "outputting the data record in an order based on the filing identifier." *See* Doc. No. 77 at 39-40.

The central issue boils down to whether "in accordance with" means "based on" or "in an order based on." Microsoft reiterates that the claim contemplates outputting a single data record. *See* Doc. No. 75 at 37. Therefore, Microsoft argues that there is no requirement that the output be in any particular order. *See* id. On the other hand, Visto argues that the specification states that the "filing identifier identifies the location used by the computer system for filing the data record in a sorted list." *See* Doc. No. 77 at 40 (citing '691 Patent, col.1 ll.58-60). The Court finds that Visto is misplaced to the extent that outputting a data record must be in a sorted list. Tellingly, and as noted above, there is no requirement that data output even include multiple data records. Therefore, "outputting said data record from the computer system memory in accordance with the filing identifier" is properly construed as "outputting the data record based on the filing identifier."

IV. CONCLUSION

Accordingly, the Court hereby **ORDERS** the disputed claim terms construed consistent herewith.

EXHIBIT A

Set forth below are the claims in the Visto patents. Disputed terms are set forth in boldface type. Where necessary independent claims are included to provide context to an asserted dependent claim.

The claims in the '192 Patent that are relevant to this claim construction order are:

1. A computer-based method comprising the steps of:

(a) establishing a communications channel through a firewall using an HTTP port or an SSL port;

(b) generating first examination results from first version information which indicates whether a first workspace element stored at a first store within the firewall has been modified;

(c) generating second examination results from second version information which indicates whether an independently-modifiable copy of the first workspace element has been modified, the copy being stored at a second store on a smart phone outside the firewall;

(b) **initiating steps (b) and (c)** from within the firewall through the communications channel when predetermined criteria have been satisfied;

(e) generating a preferred version from the first workspace element and from the copy based on the first and second examination results, wherein if only one of the first workspace element and the copy has been modified, the step of generating includes selecting the one as the preferred version; and

(f) **storing the preferred version at the first store and at the second store.**

10. A system comprising:

a communications channel through a firewall comprising one of an HTTP port and an SSL port;

a general synchronization module for operating within the fast firewall and for examining first version information to determine whether a first workspace element at a first store has been modified;

a synchronization agent for operating outside the first firewall and for forwarding to the general synchronization module second version information which indicates whether an **independently modifiable** copy of the first workspace element at a second store on a smart phone has been modified;

a synchronization-start module for operating within the first firewall and for **initiating the general synchronization module and the synchronization agent** when predetermined criteria have been satisfied;

means for generating a preferred version from the first workspace element and from the copy by comparing the first version information and the second version information, wherein if only one of the first workspace element and the copy has been modified, then the means for generating selects the one as the preferred

version; and

means for **storing the preferred version at the first store and at the second store.**

11. The system of claim 10 further comprising a communications module for communicating through the first firewall, wherein the first firewall is positioned between a trusted network and the Internet.

22. A computer-readable storage medium storing program code for causing a computer-based system to perform the steps of,

(a) generating first examination results from first version information which indicates whether a first workspace element stored at a first store within a firewall positioned between a trusted network and the **Internet** has been modified;

(b) generating second examination results from second version information which indicates whether an independently-modifiable copy of the first workspace element has been modified, the copy being stored at a second store on a smart phone outside the firewall;

(c) **initiating steps (a) and (b)** from within the firewall through an **Internet** communications channel when predetermined criteria have been satisfied;

(d) generating a preferred version from the first workspace element and from the copy based on the first and second examination results, wherein if only one of the first workspace element and the copy has been modified, then selecting the one as the preferred version; and

(e) storing the preferred version at the first store and at the second store.

The claims in the '679 Patent that are relevant to this claim construction order are:

1. An e-mail system for providing synchronized communication of **independently modifiable e-mails** over an **Internet** between a local area network (LAN) **server** secured by a LAN firewall with at least one **normally open LAN firewall port,** and each of a plurality of smart-phone devices, said system comprising: a global **server** secured by a global **server** firewall having a global **server** firewall port therein; a first **Internet** communication channel coupling said LAN **server** to said global **server** through said open LAN firewall port and said global **server** firewall port; a plurality of second **Internet** communication channels, each coupling said global **server** to a respective one of said smart-phone devices; at least one translator for translating e-mail data of different formats such that e-mails transmitted to said global **server** and said smart-phone devices are of a format or formats which are acceptable thereto; at least one storage device for storing version information indicating differences between **independently modifiable e-mails;** a general synchronization module responsive to a synchronization start command to synchronize different **independently modifiable e-mails;** and a synchronization-start module coupled to said general synchronization module, said synchronization-start module being responsive to an existence of predetermined criteria to produce and send a synchronization start command to said general synchronization module.

3. A system, according to claim 1, wherein the normally open port is an HTTPS (SSL).

11. A system, according to claim 1, wherein said translator is located at one or more of said plurality of said smart-phone devices.

The claim in the '221 Patent that is relevant to this claim construction order is:

8. A system for synchronizing workspace data, comprising: means for storing first workspace data on a first device; means for storing second workspace data on a second device; means for determining differences between the first workspace data and the second workspace data; means for storing the differences at a global **server;** and means for sending the differences from the global **server** to the second device.

EXHIBIT B

Set forth below are the claims in the Microsoft patents. Disputed terms are set forth in boldface type. Where necessary independent claims are included to provide context to an asserted dependent claim.

The claims in the '369 Patent that are relevant to this claim construction order are:

4. A **continuously synchronized** storage system, comprising:

first and second information devices that are connectable for data communications, at least one of the information devices comprising a **portable information device;**

first and second **object** stores maintained on the first and second information devices, wherein the first and second **object** stores contain synchronized instances of **objects;**

a **synchronization manager;**

a first **object store manager** that maintains the first **object** store and that initiates a notification to the **synchronization manager** when an instance of a particular **object** in the first **object** store changes;

wherein the **synchronization manager** is responsive to the notification to synchronize the instances of said particular **object** in the first and second **object** stores.

9. A method of synchronizing **objects** between first and second **object** stores, comprising the following steps:

executing an **object store manager** to maintain the first **object** store on a **portable information device;**

initiating a notification from the **object store manager** whenever an instance of a particular **object** in the first **object** store changes; and

executing a **synchronization manager** that responds to the notification by synchronizing instances of the particular **object** in the first and second **object** stores.

10. Computer-readable storage media having instructions for performing the steps recited in claim 9.

The claim in the '655 Patent that is relevant to this claim construction order is:

27. A computer-readable medium having computer-executable instructions for performing steps comprising: receiving a synchronization event at a **central synchronization service;** obtaining user preference information related to the synchronization event; loading at least one **synchronization handler,** each **synchronization handler** corresponding to a **separate application or component** that has data capable of being synchronized; and directing from the central service each loaded **synchronization handler** to synchronize data based on the user preference information in response to the synchronization event.

The claim in the '691 Patent that is relevant to this claim construction order is:

1. A computer-implemented method for filing information in a computer system, the information associated with a one of a plurality of data records, said data records having a plurality of fields for receiving information related to the subject of said data record, comprising the steps of:

providing a plurality of information fields associated with said data record;

providing a **designated field** in said data record for a filing identifier for said data record;

in response to entry of information by a user into one of the plurality of information fields of said data record, **automatically generating a filing identifier** in the **designated field,** the filing identifier comprising **information automatically selected from one of the plurality of information fields** of the data record;

storing the information of said data record including the **designated field** in a memory of the computer system;

in response to a **user command for data output** of said data record, **outputting said data record from the computer system memory in accordance with the filing identifier** in the **designated field.**

E.D.Tex.,2007.
Visto v. Microsoft

Produced by Sans Paper, LLC.