United States District Court,
C.D. California.

WEBZERO, LLC,
Plaintiff.
v.
CLICVU, INC,
Defendant.

No. CV-08-0504-MRP (PLAx)

Jan. 23, 2009.

Matthew Lawrence Seror, Michael L. Wachtell, Richard P. Ormond, Shannon E. Keast, Buchalter Nemer PC, Los Angeles, CA, for Plaintiff.

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CLAIM CONSTRUCTION FOR DISPUTED TERMS IDENTIFIED IN PARTIES' JOINT GENERAL ISSUES AND MARKMAN ISSUES REPORT

MARIANA R. PFAELZER**, District Judge.**

INTRODUCTION AND PROCEDURAL HISTORY

In this action, Plaintiff WebZero, LLC ("WebZero") alleges that Defendant ClicVU, Inc. ("ClicVU") infringes WebZero's U.S. Patent No. 6,973,481 ("'481 Patent"). ClicVU counterclaims for declaratory relief that WebZero's patent is invalid.

The parties on July 30, 2008 submitted a Joint Rule 16(b) Report requesting a claim construction hearing after expert discovery.

On Sept. 5, 2008, the parties submitted a Joint General Issues and *Markman* Issues Report (the "Joint *Markman* Rep."). The Report identifies four disputed claim terms:

-> "web page"

-> "dedicated for use"

-> "unique"

-> "automatically associated with"

The parties were invited to brief their proposed constructions. The parties filed simultaneous briefs on Jan. 16, 2009.

The Court considers these disputed terms capable of construction with minimal argument by the parties. It also finds no good cause to delay construction until the close of expert discovery. The Court determined responsive briefing and a hearing would not assist claim construction.

I.

BACKGROUND

The '481 Patent, "System and Method for Creating and Managing Forwarding Email Address," contains 41 claims. Claims 1, 11, 18, and 30 are the independent claims. The invention "is directed to a system and method of creating an email forwarding address during an Internet session." Joint Rep. at 2.

The terms construed in this Order appear in all the independent claims except that "dedicated for use" does not appear in claim 18.

Every claim in the '481 Patent requires creating a "unique email forwarding address" that is "automatically associated" with a web page.

The invention aims to help users control spam (junk email) and change email accounts more easily. '481 Patent col. 1:45-2:7. When a user first visits a web page requesting the user's email address, the invention creates and stores a "unique email forwarding address for the user" that is "automatically associated with said web page." *See, e.g.*, '481 Patent cl.1. On subsequent visits, some claims allow the forwarding address to be retrieved from storage, thereby omitting the creating and storing step. *See, e.g.*, '481 Patent cl. 10. The forwarding address forwards messages to the user's actual email account. The invention helps control spam because the user can disable the forwarding addresses if they begin to receive spam through that forwarding address. The invention also makes changing email addresses easier because the user can simply change the target address-that is, the address to which the forwarding addresses forward email-without having to register a new address with each web page.

II.

LEGAL STANDARD

"The claims of a patent define the invention to which the patentee is entitled" exclusive rights. Phillips v. AWH Corp., 415 F.3d 1303, 1312-13 (Fed.Cir.2005) (en banc) (citations omitted). Construction of the terms of art within the claims is exclusively the province of the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 372, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). During construction, "[t]he words of a [patent] claim are generally given their ordinary and customary meaning," which is "the meaning that the term would have to a person of ordinary skill in the art in question ... as of the [patent's] effective filing date." Phillips, 415 F.3d at 1313. "Importantly, 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." *Id*. The patent's specification is "the single best guide to [its] meaning." *Id*. at 1315.

A court must not, however, import an improper limitation from the specification into a claim by, for example, confining a claim to the embodiments listed in the specification when such a result is not warranted. *Id*. at 1323; E.I. DuPont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed.Cir.1988). Thus, "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention [in the specification] will be, in the end, the correct construction." *Phillips* at 1316 (quoting Renishaw PLC v. Marposs Societa' Per Azioni, 158 F.3d 1243, 1250 (Fed.Cir.1998)).

In construing claim terms, a court should also consider the patent's prosecution history, which consists of "the complete record of the proceedings before the PTO [including] the prior art cited during the examination of the patent." *Id*. at 1317. As with the specification, the prosecution history may demonstrate how the examiner and the applicant understood the invention, as "well as whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id*.

Finally, a court is permitted to rely on "all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises." *Id*. But this type of evidence is generally "less significant than the intrinsic record in determining the legally operative meaning of claim language." *Id*. (citations omitted).

III.

DISCUSSION

The Court's task is to provide "the meaning that [the terms] would have to a person of ordinary skill in the art in question" in the context of the entire patent. Phillips, 415 F.3d at 1313.

Claims 1 and 18 are representative. They are reproduced below for ease of reference. The disputed terms are underlined; additional relevant points of distinction are italicized:

1. During an Internet session where a user is viewing a web page that includes a prompt for an email address, a method of creating and forwarding an email forwarding address to said user comprising the steps of:

creating and storing a *unique* email forwarding address for the user that is *automatically associated with* said web page, said email forwarding address being *dedicated for use* by an entity associated with said web page to enable said entity to send email messages to said user, email messages directed to said email forwarding address being re-directed to a target email address associated with said user; and

sending said email forwarding address to said user to enable said user to use said email forwarding address to satisfy the email address prompt.

18. During an Internet session where a user is viewing a web page *via a first browser window* that includes a prompt for an email address, a method of creating and forwarding an email forwarding address to said user comprising the steps of:

creating and storing a *unique* email forwarding address for the user that is *automatically associated with* said web page, email messages directed to said email forwarding address being re-directed to a target email address associated with said user; and

sending said email forwarding address to said user and displaying said email forwarding address *in a second browser window* different from that displaying said web page to enable said user to use said email forwarding address to satisfy the email address prompt, *said email forwarding address being draggable from said second browser window into the first browser window*.

A. "Web page"

The parties generally agree that "web page" refers to a single page, which may be part of a larger body known as a "website." WebZero Cl. Const. at 6-7; ClicVU Cl. Const. at 7-9.

The parties' dispute appears to be whether the distinction always matters in practice-i.e., whether a "web page" and a "website" might be the same thing under some circumstances. *See* WebZero Cl. Const. at 7.

First, this appears to be a dispute not suitable for claim construction.

Second, all independent claims except for claim 18 have an additional limitation that the forwarding address be "dedicated for use by an entity associated with said web page." '481 Patent cls. 1, 30. *See also* id. cl. 11 (referring to "entities associated with said web pages"). Whatever "entity" means-it has not been briefed by both sides and is not a subject of this Order FN1-it could, on some conceivable constructions, include an entity that runs an entire website.

"Web page" means "a single web page, which may be part of a larger body known as a 'website.' "

B. "Dedicated for use"

The phrase "dedicated for use" appears only in the claims. '481 Patent cls. 1, 11, 30.

WebZero proposes that "dedicated for use" means "for use by a single...." WebZero Cl. Const. Br. at 10. ClicVU prefers "solely and exclusively for use." ClicVU Cl. Const. Br. at 12.

The two constructions are substantially the same, though ClicVU's "solely and exclusively for use" is both clearer and grammatically equivalent to the claim term. The actual dispute appears to be over what does the using. *See supra* n. 1. Hence, WebZero's formulation as "for use by a single...."

In fact, WebZero's brief explains that its proposed construction incorporates the limitation "exclusively." WebZero Cl. Const. Br. at 11 (explaining that "dedicated for use" implies that "one email forwarding address is associated exclusively....").

"Dedicated for use" therefore means "solely and exclusively for use."

C. "Unique"

The term "unique" appears only in the claims and the Background of the Invention. '481 Patent 2:19, 2:24, 3:39, 3:41.

The parties agree on the ordinary meaning of "unique"-as identifying something that is "the only one of its kind," WebZero Cl. Const. Br. at 8, or "the only one." ClicVU Cl. Const Br. at 10.

Each time "unique" appears in the independent claims, it appears in this context: "creating ... a unique email forwarding address ... for the user that is automatically associated with said web page." FN2

There are three reasonable interpretive possibilities. First, (1) the email forwarding address could be "unique" only to the user-that is, "unique ... for the user," is equivalent to "unique to this particular user." Or "unique" could (2) modify both the user of the email address and the web page-that is, the created address is unique to this particular user and unique to this particular web page (or associated entity). And finally, "unique" could mean (3) that the address is associated with a particular web page, leaving "for the user" to mean "on behalf of the user" or "for the user's benefit."

The first identified possibility comports with the most natural parsing. This reading has the uniqueness apply only to the connection between the address and the user. This is WebZero's position. *See* WebZero Cl. Const. Br. at 8. Indeed, it would be quite cumbersome for "unique" to stretch across the phrase beginning with "for," the dependent clause beginning with "that," and the further clause that starts at "with." Moreover, "web page" is already governed by "with" and modified by "said." It taxes the mind to apply "unique" to "web page," which is already heavily qualified. If this were the applicants' intent, "automatically and uniquely associated" or "automatically associated with said web page exclusively" would have been much clearer. This does not necessarily foreclose the other interpretive possibilities, but it does make them much less likely. Finistar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1336 (Fed.Cir.2008) (explaining that, subject to the ordinary artisan standard, "words, in context, receive their meaning according to their placement in grammatical structure").

ClicVU argues for the third construction. ClicVU proposes a necessary 1:1 relationship between each email address and each web page. Joint *Markman* Rep. at 6; ClicVU Cl. Const. Br. at 10-11. ClicVU's construction is consistent with the specification, which states that other "email services are available [which allow a user] to assign a unique forwarding email address to each email contact ... that the person wishes to receive email from." '481 Patent at col. 2:8-21. However, "unique" appears in another context in the claims.

If ClicVU is correct, a "unique" address is unique to the web page (or associated entity). However, in all independent claims except for Claim 18, "dedicated for use" already establishes the uniqueness of the connection between an email forwarding address and a web page (or associated entity). *See,* e.g., '481 Patent cl. 1 ("said email forwarding address being dedicated for use by an entity associated with said web page...."). On ClicVU's interpretation, "dedicated for use" in these claims is either redundant with "unique" or is a phrase that clarifies "unique." Claim 18 requires an address be "unique ... for the user," but it lacks the further language that the address is "dedicated for use." This omission lends support to an interpretation that gives "unique" and "dedicated for use" distinct meanings rather than treating "dedicated for use" as a redundant or clarifying phrase. See Stumbo v. Easterman Outdoors, Inc., 508 F.3d 1358, 1362 (Fed.Cir.2007) (preferring constructions that give meaning to all words and avoid redundancy).

For the same reasons, the second identified possibility-that "unique" aplies both to the user and the web page-results in partial redundancy with "dedicated for use" and renders the absence of "dedicated for use" in Claim 18 a scrivener's error.

Therefore, the best intepretation of "unique," in the context of "unique email forwarding address for the user," is that the address uniquely identifies the user, not that it is necessarily exclusive to a web page (or associated entity).FN3

"Unique email forwarding address for the user" means "email forwarding address for only this particular user." Thus, the same address may be used for several different web pages and need not be "dedicated for use" by a particular web page (or associated entity), except where that limitation is expressly added. *Compare* cls. 1, 11, and 30 *with* cl. 18.

D. "Automatically associated with"

The parties dispute the meaning of "automatically" in the phrase "automatically associated with."

ClicVU proposes that "automatically associated with" means the association happens "without any user input or interaction." ClicVU Cl. Const. Br. at 11. WebZero would add qualifications that the user "need not manually associate" and that the association happens "automatically at the direction of the user." WebZero Cl. Const. Br. at 9.

WebZero's additions are unwarranted. "Need not" is not a qualification that appears on the face of the phrase or from the phrase's context. Rather, the association step happens automatically. That is a strict requirement imparted by the adverb. If the applicants intended to cover associations that could be made manually, the independent claims would lack "automatically." Simply stating "associated with" would capture both "automatically associated with" as well as "manually associated with." And, if the applicants wished to be clear and cautious, dependent claims could then expressly claim the method where the association happens automatically.

As for WebZero's second suggestion, the meaning of "automatically" is confounded if it must be qualified by "at the direction of the user."

ClicVU's construction is correct: "automatically" means "without any user input or interaction." FN4 Therefore, "automatically associated with," means "without any additional user input or interaction, associated with."

IV.

CONCLUSION

"Web page" means "a single web page, which may be part of a larger body known as a 'website.' "

"Dedicated for use" means "solely and exclusively for use."

"Unique email forwarding address for the user" means "email forwarding address for only this particular user."

"Automatically associated with" means "without any additional user input or interaction, associated with."

The Court adopts the foregoing constructions for the '481 Patent.

IT IS SO ORDERED.

FN1. WebZero's brief expands the disputed phrase "dedicated for use" to "dedicated for use by an entity."

WebZero Cl. Const. Br. at 10-12. However, the Joint *Markman* report identified only the phrase "dedicated for use," the status conference at which briefing on the disputed terms was stipulated identified only "dedicated for use," and ClicVU briefed only "dedicated for use." Joint *Markman* Rep. at 6; 12/16/2008 Transcript; ClicVU Cl. Const. Br.

FN2. Claim 11 uses the plural: "addresses," "users," and "web pages."

FN3. As ClicVU points out, the relevant language was added in the only amendment made to the application. Joint *Markman* Rep. at 6. The applicants characterized the claim (Claim 49) that issued as Claim 18 as encompassing the originally filed version of Claim 9 without original Claim 9's limitation of original Claim 2. 06/01/2005 Applicant Arguments at 13. Claim 9 had already been allowed over the prior art. Claim 9 added the requirement of "draggability" between first and second browser windows to claims rejected on prior art. *See id*. at 11, 13; 12/02/2004 Non-Final Rejection at 4-5. In amending other claims, the applicants added both "unique" and "dedicated for use" and argued that these two terms *together,* plus the email forwarding limitation, imparted patentability over the prior art the Examiner cited. 06/01/2005 Applicant Arguments at 12; 12/02/2004 Non-Final Rejection at 4. The claims were allowed as amended without comment from the Examiner.

However, the claim that issued as Claim 18 added the word "unique"-without "dedicated for use"-to the limitations of original Claim 9. The applicants said nothing about the significance of adding the word "unique" alone; or about how (or whether) "unique" without "dedicated for use" adds further limitation to the method of original Claim 9.

Thus, the reasonable interpretations are (1) to assume that the applicants intended the new phrase "unique ... for the user" to add a limitation distinct from "unique ... for the user ... dedicated for use," even though "unique ... for the user" was not discussed in the prosecution history and did not add to patentability over the Examiner's art rejection; (2) to consider the addition of "unique" in Claim 18 an error and read it out of Claim 18; or (3) to read "dedicated for use" into Claim 18, thereby equating "unique ... for the user" with "unique ... for the user ... dedicated for use." Option 1 best accords with one of the plain meanings of "unique," a reading of all the claims in context, and the canons of construction. See Stumbo, 508 F.3d at 1362 (preferring constructions that give meaning to all words and avoid redundancy); Atofina v. Great Lakes Chemical Corp., 441 F.3d 991, 998 (Fed.Cir.2006) ("[I]t frequently happens that patentees surrender more through amendment than may have been absolutely necessary to avoid particular prior art. In such cases, we have held the patentees to the scope of what they ultimately claim, and we have not allowed them to assert that claims should be interpreted as if they had surrendered only what they had to.") (internal quotations and citation omitted).

FN4. To be clear, however, "automatically" only modifies the association step. The '481 Patent contemplates some amount of user interaction with the invention. The word "any" does not negate that the claims are "comprising" claims which admit of user interaction at points other than the association step. Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed.Cir.2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and allows for additional steps.") (internal quotations and citation omitted).

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