United States District Court,
C.D. California.

CATCH CURVE, INC,
Plaintiff.
v.
PROTUS IP SOLUTIONS, INC,
Defendants.

No. CV 06-02574 DDP (AJWx)

May 11, 2007.

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CLAIM CONSTRUCTION ORDER

[Plaintiff's Opening Claim Construction Brief filed on March 23, 2007; Defendant's Opening Claim Construction Brief filed on March 23, 2007]

DEAN D. PREGERSON**, District Judge.**

This matter is before the Court for claim construction. Catch Curve, Inc., Venali, Inc., FN1 and Protus IP Solutions, Inc. ("Protus"), have submitted briefs FN2 regarding construction of patent claims.FN3 The goal of this order is to construe the patents and determine the appropriate definitions for the disputed terms.

FN1. When Venali originally filed its opening claim construction brief and reply brief with this Court, it joined in the arguments of CallWave, a defendant in a then-pending infringement action bought by Catch Curve. *Catch Curve, Inc. v. CallWave, Inc.,* CV 05-04819 DDP (AJWx) (C.D.Cal.). Since that time, the CallWave action has been dismissed by stipulation of the parties. (*See* March 23, 2007, Stip. & Order.) Because Venali and Protus has both relied on CallWave's briefs, however, the Court has reviewed them.

FN2. At the hearing on this matter, Protus indicated that it had filed a motion for leave to file a surreply in this matter. As neither Catch Curve nor the Court had the opportunity to review or respond to the surreply before the hearing, the Court hereby denies Protus' motion.

FN3. Venali and Protus ("Defendants") have agreed that their Markman hearings should be heard at the same time because they pertain to construction of identical claims and nearly identical terms. Thus, the Court has addressed their claim construction arguments together in ruling. The same order has been issued in both cases.

I. LITIGATION BACKGROUND

A. *Catch Curve's Infringement Suit Against Venali*

On July 1, 2005, Plaintiff Catch Curve brought this suit against Defendant Venali, alleging patent infringement. Catch Curve is the owner by-assignment of the following patents: U.S. Patent No. 4,994,926 (the "'926 Patent"), U.S. Patent No. 5,291,302 (the "'302 Patent"), U.S. Patent No. 5,459,584 (the "'584 Patent"), U.S. Patent No. 6,643,034 (the "'034 Patent"), and U.S. Patent No. 6,785,021 (the "'021 Patent"). These patents are all entitled "Facsimile Telecommunications System and Method." Venali provides a fax-to-email service that Catch Curve argues infringes these patents under 35 U.S.C. s. 271.

On December 5, 2005, Venali filed an answer to the complaint and a counterclaim against Catch Curve. On December 27, 2006, Venali filed an answer, amended counterclaim, and third-party complaint against j2 (Catch Curve's parent company). On January 8, 2007, Venali filed a corrected answer to the complaint, amended counterclaim and third party complaint.

In its answer, Venali contends that it is not infringing, and will not infringe, directly or indirectly, any claim of the patents-in-suit. Venali also asserts a number of affirmative defenses: (1) the patents-in-suit are invalid for failure to comply with the requirements of 35 U.S.C. s. 101, et seq. *;* (2) claims under the patents-in-suit are barred, in whole or in part, by the doctrines of laches, waiver and estoppel; (3) Catch Curve has failed to state a claim upon which relief can be granted pursuant to Fed.R.Civ.P. 12(b)(6); (4) Catch Curve's claims for injunctive relief are barred by the existence of an adequate remedy at law; (5) Catch Curve is precluded by the doctrine of prosecution history estoppel and/or prior art from asserting any construction of the claims in the patents-in-suit that would cover Venali's accused products and/or services; (6) Catch Curve is precluded from enforcing the patents-in-suit due to patent misuse; and (7) Catch Curve's conduct related to the patents-in-suit constitutes unclean hands and renders the patents unenforceable.

B. *Venali's Counterclaim Against Catch Curve and Third Party Complaint Against j2*

In its amended counterclaim and third party complaint, Venali alleges that j2 and Catch Curve have engaged in an illegal scheme to unfairly compete with Venali and other competitors in the consumer/small office/home office ("SOHO") Internet facsimile services industry in violation of the Sherman and Clayton Acts, the Lanham Act and California Unfair Competition Law. Venali alleges that the following conduct by Catch Curve and j2 supports its claims: (1) harassment of competitors generally, and Venali in particular, by bringing baseless patent infringement suits; (2) tortious interference with Venali's business relations based on a campaign of threats of patent infringement lawsuits targeting Venali's customers; (3) willful infringement of competitors' trademarks; (4) dissemination of false information about the validity and applicability of the Audio Fax patent portfolio; and (5) other unfair, anti-competitive, and illegal actions.

Venali also alleges that j2 was instrumental in the creation of Catch Curve, that Catch Curve is a wholly owned subsidiary of j2 and at all relevant times has been the alter ego of j2. Venali asserts that in furtherance of its anti-competitive scheme j2 has sought to conceal its relationship with Catch Curve. On April 30, 2007, this Court issued an Order Granting in Part and Denying in Part Catch Curve's Motion to Dismiss Counts Two through Six and Eight of Venali's counterclaim and third party complaint. In its Order, the Court determined that Venali's Sherman Act and sham litigation claims should stand pending this claim construction hearing. The Court dismissed Venali's tying and s. 17200 counterclaims with leave to amend.

C. *Catch Curve's Infringement Suit Against Protus*

Catch Curve has also brought a similar suit against Protus, alleging infringement of the same five patents. Like Venali, Protus also operates an online fax to e-mail service. Protus has also filed various counterclaims against Catch Curve.

II. THE CLAIM CONSTRUCTION PROCESS

An infringement analysis involves a two-step inquiry: (1) determining the meaning and scope of the patent claims asserted to be infringed; and (2) comparing the properly construed claims to the accused device. Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The current hearing seeks only to complete the first step of this inquiry.

The Supreme Court has held that claim construction is a question of law for courts, not juries. Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Claim construction is conceptually distinct from discovery of which products or processes might be infringing. The fundamental underlying question is the meaning of the patent claims to a person having ordinary skill in the art at the effective filing date of the patents.

The first step is to look at to the words of the claims themselves, to define the scope of the patented invention. K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1364 (1999). The courts have frequently stated the words of a claim are generally given their ordinary and customary meaning. Vitrionics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). The ordinary and customary meaning of a claim term is the meaning that the term would have to the 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. Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed.Cir.2005) (en banc). The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. *Id*. That starting point is based on the well-settled understanding that inventors, are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. *Id*.

Other claims of the patents in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term. *Id*. at 1314. Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims. *Id*. Differences among claims can also be a useful guide in understanding the meaning of particular claim terms. *Id*.

The claims, of course, do not stand alone; 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*. at 1313, 1314 (emphasis added). This is true because although the claims themselves may provide guidance as to the meaning of a particular term, those terms are part of an "integrated written instrument ... consisting principally of a specification that concludes with the claims." *Id*. at 1315 (quotations omitted). Thus, the specification is "the *primary basis* for construing the claims" in light of the "statutory requirement that the specification describe the claimed invention in full, clear, and exact terms." *Id*. (internal quotations omitted) (emphasis added).

In other words, "the best source for understanding a technical term is the specification from which it arose,

informed as needed, by the prosecution history." *Id*. (citations and quotations omitted). Consistent with this principle, the courts have recognized that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. *Id*. at 1316. In such cases, the inventor's lexicography governs. *Id*. In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. *Id*. In that instance as well, the inventor has dictated the correct claim scope, and the inventory's invention, as expressed in the specification, is regarded as dispositive. *Id*.

The prosecution history also plays an important role in claim interpretation "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*. at 1317. The prosecution history consists of "the complete record of the proceedings before the Patent Trademark Office [("PTO")] and includes the prior art cited during the examination of the patent." *Id*. Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent. *Id*. Although the prosecution history is generally less useful than the specification for claim construction purposes, it can still can 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*.

Consideration of the claim language, the specification, and the prosecution history-collectively referred to as the "intrinsic evidence"-should resolve any ambiguity in claim terms in most situations. *See id*. at 1313-14 (citation omitted). Only in instances where the meaning of the claim term remains ambiguous in light of the intrinsic evidence may the Court consider certain "extrinsic evidence" in construing the claims. However, expert testimony may be helpful for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field. *See id*. at 1319 (citation omitted).

Dictionaries and treatises can also be useful extrinsic evidence. *Id*. at 1318. However, precedent counsels against reliance on dictionary definitions at the expense of the specification, because such reliance "focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent." *Id*. at 1321; *see also* Nystrom v. Trex Co., 424 F.3d 1136, 1145 (Fed.Cir.2005).

III. PATENTS-IN-SUIT

The technology at issue is a fax communications system which was designed to improve security and save redial efforts by transmitting facsimile machines when the intended destination fax machine is busy or otherwise unavailable. The technology accomplishes this by providing a "store and forward facility" ("SAFF") which receives fax es transmitted by an originating fax machine, stores them, and forwards (or retransmits) these messages to their intended destinations at a time when the receiving machine is available.

Thus, a SAFF essentially acts as a proxy for a transmitting fax machine. When the receiving fax machine, is available, the fax message and the call status information are delivered by the SAFF to the receiving machine on behalf of the transmitting machine. If the receiving fax machine is not available, (e.g., if the receiving fax machine is busy), a SAFF stores the fax message and call status information and attempts retransmission a number of times. By doing so, the system eliminates "trial and error" delivery attempts by the originating machine.

At the claim construction hearing, the parties confirmed that the effective filing date of the '926 patent is September 1988. They also confirmed that the effective filing date for certain parts of the remaining patents-in-suit is February 12, 1991.

IV. CONSTRUCTION OF THE CLAIM TERMS

This dispute turns on whether the term "fax /facsimile" in the patents-in-suit requires transmissions using facsimile protocol and machines that can direct and interpret it. Fax technology requires the completion of a plurality of "handshaking functions" between communication transceivers prior to transmission to ensure that appropriate phasing and transmitter-receiver relationships are established. This handshaking function, or "digital dialogue," is the "protocol" by which receiving fax machines are able to decipher and process the information sent by the originating fax machine.

Catch Curve's position is that the use of the word "fax" in the patents-in-suit does not require the use of any particular protocol for fax transmissions or fax machines. Venali and Protus contend that the claims asserted in the patents-in-suit require the use of fax protocol.

A. *Facsimile/Facsimile Protocol*

Catch Curve argues that "facsimile protocol" should be construed as a "format and procedure that governs the transmission of facsimile messages from an originating facsimile machine to a call handling facility." Catch Curve contends that because the term "facsimile protocol" is recited only in one claim, it should not be imported as a limitation on all use of the word "facsimile."

Defendants argue that although the term "facsimile protocol" only appears explicitly in claim 69 of the '021 patent, the concept of "facsimile protocol" is necessarily present in all of the claim limitations that discuss fax machines or fax messages. To hold otherwise, Defendant argue, would give Catch Curve the rights to technology outside the scope of its invention. Accordingly, Defendants request that the Court adopt a definition of the word "facsimile" that limits it to the protocol that defined the word at the effective filing date.

To resolve this dispute, the Court first turns to language of the claims themselves. According to the claim language, the fax messages are transmitted by a *facsimile* machine to the SAFF. The SAFF then forwards the fax messages to recipient *facsimile* machines. Because the patentees claimed their invention in terms of this particular kind of transmitting machine and this particular kind of message, it is important to give meaning to these limitations in the claims. For a machine to be a "fax" machine that sends "fax" messages, it must use a certain *protocol*-what the parties often refer to as a "digital dialogue"-to communicate. Otherwise, nothing distinguishes these machines from any other machine used for communication.

Another component of all of the asserted claims that confirms that the fax-related terms require the use of facsimile protocol is the "SAFF." In the claims, the SAFF is the facility that receives the fax message from the transmitting fax machine, stores it, then forwards it to a recipient fax machine. Catch Curve admits that, in so doing, the SAFF acts "as a proxy" for the fax machines. Given that these fax machines-to be called as such-must necessarily engage in the protocol unique to facsimile communications-the SAFF, which simply forwards the message from one fax machine to the next, must similarly engage in facsimile protocol to send and receive the fax.

The preambles to the claims are additional intrinsic evidence that the fax-related terms contemplate the use

of facsimile protocol. Courts determine whether a preamble limits a claim on a case-by-case basis in light of "the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history." Allen Eng'g v. Bartell Indus., 299 F.3d 1336 (Fed.Cir.2002). Although no litmus test defines when a preamble limits claim scope, Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed.Cir.2002), the general rule is that preamble language acts as a limitation on the claim when it is necessary to give life, meaning, and vitality to it. Kropa v. Robie, 38 C.C.P.A. 858, 187 F.2d 150, 152 (CCPA 1951). Moreover, if it helps to determine the scope of the patent claim, then it is construed as part of the claimed invention. NTP v. Research in Motion, 418 F.3d 1282, 1305 (Fed.Cir.2005).

Here, Venali has requested that the Court consider the preambles to the claims as additional evidence that the asserted claims require the use of facsimile protocol. The preambles to claim 55 of the '926 patent and claim 24 of the '302 patent are identical, describing the inventions as "a method for facilitating facsimile communications between a transmitting facsimile machine and at least one intended facsimile machine." The preamble to claims 30 and 48 of the '584 patent and the preamble to claim 1 of the '034 patents describe the inventions as "a method for operating a facsimile store and forward facility to facilitate facsimile communications." This preamble language constitutes a limitation on the asserted claims because it sets forth a fundamental characteristic of the invention-a system for fax machine to fax machine communication. Because the preambles help determine the scope of the claims, the Court construes them as part of the claimed invention. HTP, 418 F.3d at 1305.

Given the foregoing, the Court finds that it is clear from the language of the claims that "facsimile protocol" means the standardized procedure that governs the transmitting and receiving of facsimile messages, excluding other protocols whereby the substance of a facsimile message is converted into a different format and then retransmitted using some other protocol. However, mindful of the instruction in *Phillips* that "the specification is always highly relevant to the claim construction analysis" and is "the single best guide to the meaning of a disputed term," the Court has also reviewed the specifications in this case to reach this conclusion. Phillips, 415 F.3d at 1315.

According to the specifications, "all fax transmissions initiated by a subscriber to the fax management system are first intercepted by an originator SAFF." The SAFF then "engages the originating machine in the same digital dialogue that would have occurred if a direct connection to the destination machine had actually been made ..." thereby "... agreeing to accept the fax format requested by the originating machine." Finally, the SAFF "engages the destination machine in the necessary preliminary digital dialogue." FN4 This language makes clear that, at the transmitting and receiving ends of the communication and at the SAFF, the fax messages are transmitted and received using the "digital dialogue" that is the core feature of facsimile protocol. As the Federal Circuit emphasized in *Phillips,* "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." Phillips, 415 F.3d at 1316.

FN4. ('926 patent, col. 6; '021 patent, col. 5.)

Moreover, the specifications contain no indication that the inventors ever considered that their patents covered anything more than fax-to-fax services. The specifications make clear that the scope of the invention was limited to transmission of messages over a telephone line from an originating fax machine to a destination fax machine, with the benefit of a store and forward facility as part of the switched telephone network. ('926 patent, col. 2.) The specifications emphasize that in order to receive a fax message from the

SAFF, the receiving device must operate using "fax mode or format." ('302 patent, col. 16.) Although the specifications and each of the figures address facsimile machines and computers connected to telephone lines,FN5 the specifications are devoid of any reference communicating faxes using other means than facsimile protocol. This is the case because the invention was based on communications between fax machines conducted over the switched telephone network, *not* a packet switched network.

FN5. *See* discussion of "switched telephone network" infra.

Finally, the Court has reviewed the file history, which also confirms that the technology requires the use of fax protocol. Significantly, the PTO initially rejected-draft claims from the '926 patent because of the existence of technology that received messages in digital teletype protocols and converted those messages into fax protocols so that the receiving fax machine could receive the message. However, the '926 patent was eventually approved specifically because Catch Curve argued that the existing technology could not "accept, process, or communicate a message originating from a fax machine." In short, Catch Curve used the distinction between fax and other protocols to obtain its patents. The Court construes the claims now in such a way as to render the patents invalid.

In an attempt to persuade the Court that the claims are not restricted by the use of facsimile protocol, Catch Curve makes several arguments. First, Catch Curve argues that Defendants' position is inconsistent with their descriptions of their own products and services. Catch Curve points to several of Defendants' advertisements describing Defendants' fax-to-e-mail services as enabling customers to receive "fax es" in their e-mail inboxes. (Pl's. Reply at 7.) Thus, Catch Curve contends, even Defendants recognize that a "fax" can be received through the use of non-facsimile protocol.

The Court disagrees with Catch Curve's characterization of the Defendants' advertisements-which, it notes, are the type of extrinsic evidence that carries little weight in claim construction. A brief review of these advertisements reveals that they do not use the term "fax" in the same way that it would have been used by a person of ordinary skill in the art in question at the effective filing date of these patents. Instead, they use contemporary a lay definition of "fax" that does not comport with its meaning for the purpose of claim construction.

In further support of the idea that the patents-in-suit describe fax "conversion," Catch Curve invokes the doctrine of claim differentiation. Catch Curve contends that because the term "facsimile protocol" only appears in one claim-claim 69 of the '021 patent-then that term must be limited to that claim. Catch Curve argues that its patents require the use of facsimile protocol only with respect to the *transmission* of the fax message from the transmitting fax machine to the call handling facility, i.e., the SAFF, and not with respect to the *forwarding* of the fax message from the SAFF to the recipient fax machine. Thus, Catch Curve argues, its claims are not limited to the use of facsimile protocol unless that term is explicitly stated.

As an initial matter, the Court notes that the doctrine of claim differentiation only applies when the failure to differentiate would render a *claim*-not a limitation-superfluous. Torto Co. v. White Consolidated Indus., Inc., 199 F.3d 1295, 1302 (Fed.Cir.1999) (doctrine applies "[t]o the extent that the absence of such difference in meaning and scope would make a claim superfluous). Because Catch Curve is not arguing that claim 69 of the ' 021 patent would be superfluous if "facsimile" requires the use of a facsimile protocol, the doctrine of claim differentiation appears inapplicable.

Moreover, there is nothing in the claims to suggest that the transmitting fax machine of claim 69 of the '021 patent is different from the transmitting fax machine of the other asserted claims. Catch Curve's position that they are different-one uses fax protocol, the other does not-violates the principle that when all patents "derive from the same parent application and share many common terms," the courts must "interpret the claims consistently across all asserted patents." NTP, 418 F.3d at 1293.

In addition, when the claims contemplate conversion from one protocol to another, the claims say so. For example, the '302 patent, claim 9, claims "converting facsimile message signals received from said store and forward facility into suitable video display signals for display on the normal television set." The '302 patent, claim 13 claims "a video display generator and RF modulator means for converting facsimile messages received from a store and forward facility." Claim 34 of the '302 patent claims "a conversion means for converting facsimile signals received from said store and forward facility into suitable video display signals for display on the normal television set." Given that the patentee was capable of specifying when a claim required conversion, it follows that where no conversion is specified, none is contemplated.

Finally, in support of its position that SAFF "outbound" communication need not use facsimile protocol or be transmitted on a switched telephone network, Catch Curve argues that some of the claims fail to recite the words "switched telephone network" to limit the outbound transmission. However, the failure to recite these words in describing the outbound transmission does not indicate that the inventor contemplated that this transmission might take any or all forms. The use of the word "facsimile" in the same claims clearly indicates that the scope of possible formats for the outbound was limited to facsimile protocol.

For the foregoing reasons, the Court, proposes the following construction of "facsimile":

CONSTRUCTION: image data transmitted using facsimile' protocol on the switched telephone network

The Court proposes the following construction of facsimile protocol:

CONSTRUCTION: the standardized procedure that governs the transmitting and receiving of facsimile messages over the switched telephone network

B. ***Fax-Related Terms***

Having determined that the word "facsimile/fax" in the asserted claims should be limited to facsimile protocol communication over telephone lines, the Court now construes the other fax-related terms identified by the-parties.

1. ***Facsimile Messages***

Catch Curve argues that this term means "image data for facsimiles." Defendants argue that this term means either "a message transmitted and received using facsimile protocol," or "a message transmitted and received over a switched telephone network using facsimile protocol."

Under Catch Curve's litigation position, any further transmission of a document that was once transmitted by a facsimile machine remains a fax transmission. This position cannot be reconciled with the patents that the PTO issued. For a fax message to be a "fax" message within the meaning of the patents, it must be:

CONSTRUCTION: A message transmitted and received by facsimile protocol

2. ***Facsimile Machine***

Catch Curve argues that the "facsimile machine"/"fax device" term should be construed as "equipment for receiving or transmitting facsimile messages." Venali argues that it should be construed as "a device that uses facsimile protocol to transmit and receive fax messages over a telephone call," and Protus argues that it should be construed as "a machine that transmits and receives messages over s switched telephone network using facsimile protocol."

For the reasons described above, Catch Curve's definition is too broad. Accordingly, the Court construes this term as follows:

CONSTRUCTION: A mac hine for transmitting or receiving messages while using facsimile protocol

3. ***Paperless Facsimile Terminal Machine/Paperless Facsimile Device***FN6

FN6. The parties agree that these terms are used synonymously in the patents.

In the asserted claims, "paperless facsimile terminal machine" appears only in the '302 patent, claim 24, and "paperless facsimile device" appears only in the '034 patent, claim 1. As the claim language makes clear, this term describes the modem and specific software that allow a paperless fax terminal device to emulate fax terminals by using fax protocol. The '302 patent, claim 6 recites a "paperless facsimile terminal machine," and the balance of the claim requires a "signal modem" that can be programmed to operate in "facsimile communications mode so that facsimile messages stored in the subscriber's mailbox can be directly displayed on said display means of the paperless facsimile terminal machine." Similarly, the summary of the invention states the "so-called 'paperless' fax terminals" are "small portable computers equipped with modems and software programs which enable them to emulate fax terminals." ('034 patent, claim 4.) The summary also states that "[i]n recent years, paperless fax techniques allow a computer or a micro-processor equipped with specific software and modem to directly transmit and receive facsimile messages." This confirms that the specific software and modem allow the "paperless fax device" to emulate a fax machine by sending or receiving messages over the switched telephone network using facsimile protocol.

Moreover, all embodiments in the '034 and '302 patent specifications require a modem to enable the paperless fax device to emulate a fax terminal. "Although patent claims need not be limited to the preferred embodiment when the invention is more broadly described, 'neither do the claims enlarge what is patented beyond what the inventor has described as the invention.' " *Inpro II Licensing,* 450 F.3d at 1350 (Fed.Cir.2006) (citation omitted). For these reasons, the Court construes this term as follows:

CONSTRUCTION: A machine that emulates; facsimile terminals by using facsimile protocol

C. ***SAFF Terms and Section 112, para. 6***

In certain claims, Catch Curve described its invention using the means-plus-function format. *See* 35 U.S.C. s. 112, para. 6 (allowing claims to means performing a function). Such claims' scope is restricted to the structures or acts described in the patent's specification for performing those functions, and their equivalents. *E.g.,* J & M Corp. v. Harley Davidson, Inc., 269 F.3d 1360, 1367 (Fed.Cir.2001).

If the word "means" appears in a claim associated with a function, s. 112, para. 6, presumptively applies. Micro Chem., Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1257 (Fed.Cir.1999). That presumption can be overcome, but only if party presents evidence that "the claim itself recites sufficient structure, material, or acts to perform the claimed function." *Id*.

Interpreting means-plus-function claims requires first identifying the claimed function and then determining the corresponding structures in the specification. Omega Engineering, Inc. v. Raytek Corp., 334 F.3d 1314, 1321 (Fed.Cir.2003). For claim construction purposes, the Court should identify as corresponding structures only the specific structures actually described in the specifications, as opposed to broader, but undisclosed categories of such structures. Smiths Indus. Med. Systs. v. Vital Signs, Inc., 183 F.3d 1347, 1357 (Fed.Cir.1999).

1. "*Mass Storage Means" Limitation*

The "mass storage means" is a means for storing fax data. ('926 patent, claim 55 & '302 patent, claim 24.) This claim structure tracks the format for invoking the means-plus-function framework, and thus s. 112, para. 6, presumptively applies. Micro Chem. Inc. v. Great Plains Chem. Co., 194 F.3d 1250, 1257 (Fed.Cir.1999).

Here, the Court finds that "mass storage means" is a proper mean-plus-function limitation because, while there are endless ways to store information, the claim language itself provides none of that structure. Notably, other courts have treated the term "storage means" as a means-plus-function limitation. *E.g.*, General Creation LLC v. Leapfrong Enters., 232 F.Supp.2d 661, 674-78 (W.D.Va.2002). The corresponding structure disclosed in the specification is a file on a magnetic disk. ('926 patent.) Thus, the Court finds that is the proper construction.

2. "*Computer Means" Limitation*

In the asserted claims, "computer means" is introduced as a means for performing a certain function, i.e.., a means for controlling the store and forward facility. ('926 patent, claim 55; '302 patent, claim 24.) Catch Curve argues that the phrase "computer means" should not be construed according to the strictures of s. 112, para. 6, because any presumption that it is a means-plus-function limitation is rebutted by the word "computer," which recites a sufficiently definite structure for performing the claimed function.

In support of this proposition, Catch Curve argues that the term "computer" had a particular definition at the time that the '926 patent was filed. However, the Court finds that because a physical item listed has a specific definition, the structure requirement is overcome. In order for the means-plus-function presumption to be rebutted, the claim itself must recite sufficient structure, material or acts to perform claimed function. Apex, Inc., v. Raritan Computer, Inc., 325 F.3d 1364, 1371-72 (Fed.Cir.2003). While every computer may have a defined structure, it does not follow that every computer has structure sufficient to control the operation of a store and forward facility. *See* WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1349 (Fed.Cir.1999) ("in a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.")

Here, Catch Curve has not met the burden of demonstrating that the claims recite sufficient structure to perform the claimed function of operating the store and forward facility. Moreover, Catch Curve's reliance

on the technical dictionary definition of "computer" falls within the *Texas Digital* line of cases that is disfavored post- *Phillips*. *See generally* Phillips, 415 F.3d 1303, 1321-22. Accordingly, the Court finds that "computer means" is a means-plus-function phrase.

3. "*Store and Forward Facility*" *Limitation*FN7

FN7. The SAFF is also referred to as the "call handling facility." The parties have agreed that "SAFF" and "call handling facility" should have identical constructions.

The term "store and forward facility" is not written in standard "means" format and is thus presumptively hot subject to s. 112, para. 6. However, even where the words "means" of "step(s) for" are absent, s. 112, para. 6, will still apply if the claim phrase fails to provide sufficient structure or acts for performing its function. *See, e.g.,* Mas-Hamilton Group v. LaGard, Inc., 156 F.3d 1206, 1213-14 (Fed.Cir.1998). Accordingly, Defendants argue that because the "SAFF" is comprised of two means-plus-function phrases (computer means and mass storage means) and the claims do not recite sufficiently definite structure, the "SAFF" should also be construed as a means-plus-function limitation.

The Court finds that the means-plus-framework applies to the "SAFF" because the claim term is written as a functional term and has no inherent structure. The "SAFF" has numerous functions in the claims, all related to receiving facsimile messages, storing them, and determining when and where to transmit them. ('926 patent, claim 55.) The corresponding structure is the structure to be used for performing these functions, including both the physical hardware and the software required performance.

Catch Curve again relies on the dictionary definitions of the terms "facility" and "store and forward" as proof that the "SAFF" has a definite structure associated with it. However, even these definitions describe the *function* of storing in more detail than the *structure* that does the storing. Given that the "SAFF" is characterized by two means-plus-function terms and the claims do not recite a definite structure, the Court finds that it is also a means-plus-function term. It is therefore limited to the structure disclosed in the specification.

D. *Switched Telephone Network*

Protus requests that the Court construe the term "switched telephone network" as the "circuit switched telephone network." Catch Curve argues that the Court should construe the term as "a system for handling telephone calls."

As discussed above, the Court finds that the asserted claims require the use of facsimile protocol-a digital dialogue over the "switched telephone network." The patents confirm that the term "switched telephone network" refers to the standard worldwide telephone network, and not the packet switched network used for sending e-mails. (Roberts Decl. at 12.) Moreover, the file history indicates that, in trying to overcome a prior art rejection, the patentee argued that "the present application and invention presumes the existence of a switched telephone network." (Protus Ex. G, at CC_P 124677.)

Protus requests that the Court insert the "switched telephone network" term into the definition of all fax-related claims. However, the Court does not believe this is necessary. When a machine operates using "fax protocol," it necessarily is sending fax messages over the switched telephone network. By including the term "fax protocol" in the fax-related terms, the Court has already complied with Protus' request.

Furthermore, the Court agrees with Catch Curve that Protus' definition is redundant. However, the Court does not agree that the "switched telephone network" term can have the broad definition that Catch Curve proposes. Thus, the Court finds that the term "switched telephone network" may be understood according to its ordinary and customary meaning and does not require construction.

E. ***Terms Not Requiring Construction***

Claim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement. It is not an obligatory exercise in redundancy. NTP, 418 F.3d at 1282. In light of the clarification provided by the Court's proposed construction of the "facsimile," the Court does not deem it necessary to construe the remaining disputed terms.

V. CONCLUSION

For the foregoing reasons, the Court orders that the terms of the claims in the patents-in-suit have the meanings as indicated above.

IT IS SO ORDERED.

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