

United States District Court,
N.D. California.

TUMBLEWEED COMMUNICATIONS CORP,
Plaintiff.

v.

PAYPAL, INC. and eBay, Inc,
Defendants.

No. C 02-2212 CW

Nov. 6, 2003.

Bernard J. Cassidy, Tumbleweed Communications Corp., Redwood City, CA, Gregory P. Stone, Ted G. Dane, Esq., Munger Tolles & Olson LLP, Los Angeles, CA, Deborah N. Pearlstein, Peter A. Detre, Rohit K. Singla, Munger Tolles & Olson LLP, San Francisco, CA, for Plaintiff.

Chris R. Ottenweller, Rory Bens, Thomas J. Gray, Orrick, Herrington & Sutcliffe, Menlo Park, CA, Heidi Lyn Keefe, Mark R. Weinstein, White & Case LLP, Nathan L. Walker, Wilmerhale, Palo Alto, CA, for Defendants.

CLAIM CONSTRUCTION ORDER

CLAUDIA WILKEN, District Judge.

Plaintiff Tumbleweed Communications Corporation and Defendants PayPal, Inc. and eBay, Inc. dispute the meaning of several terms and phrases used in U.S. Patent No. 5,790,790 ('790 patent), U.S. Patent No. 6,192,407 ('407 patent), and U.S. Patent No. 6,487,599 ('599 patent). Tumbleweed and Defendants each ask the Court to adopt its proposed construction of the disputed terms and phrases. The matter was heard on July 18, 2003. Having considered the parties' papers, the evidence cited therein and oral argument, the Court construes the disputed terms and phrases as set forth herein.

BACKGROUND

Plaintiff Tumbleweed is the assignee of '790, '407, and '599 patents. According to the summaries of the invention, the patents-in-suit describe "an electronic document delivery system and methods of its use." '790 Patent, col. 2, ln. 20-21; '407 Patent, col. 2, ln. 23-24; '599 Patent, col. 2, ln. 26-27. More specifically, in the '790 patent, a "document, preferably in a portable format, is forwarded to a remote server (e.g. using HTTP to 'push' the document to the server). The server sends a generic notification of the document to an intended recipient, and the recipient can download the document from the server using local protocols." '790 Patent, col. 2, ln. 21-26. In the '407 patent, a continuation-in-part of the application that became the '790 patent, and in the '599 patent, a continuation of the application that became the '407 patent, a "document delivery architecture dynamically generates a private Uniform Resource Locator (URL) to distribute

information. Each private URL ('PURL') uniquely identifies an intended recipient of a document, the document or set of documents to be delivered, and (optionally) other parameters specific to the delivery process. The intended recipient of the document uses the PURL to retrieve the document. The server, upon retrieval of the document, customizes the behavior of the retrieval based on attributes of the PURL." '407 Patent, col. 2, ln. 24-32; '407 Patent, col. 2, ln. 27-36.

Tumbleweed has filed suit against Defendants PayPal, Inc. and eBay, Inc., alleging that Defendants' products infringe the patents-in-suit. Now before the Court are the parties' respective positions on claim construction.

LEGAL STANDARD

The interpretation of patent claims is a question of law to be decided by the Court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 371-73 (1996). In construing a claim, the Court must look first to the specific words of the claim. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). "[T]he claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim." *Renishaw PLC v. Marposs Societa per Azioni*, 158 F.3d 1243, 1248 (Fed.Cir.1998).

Words in the claim are generally given their ordinary meaning. *Id.*; *see also Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193, 1202 (Fed.Cir.2002) ("The terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art."). "The ordinary meaning of a claim term may be determined by reviewing a variety of sources, including the claims themselves, other intrinsic evidence including the written description and the prosecution history, and dictionaries and treatises." *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed.Cir.2002) (internal citations omitted).

While words in the claim are generally given their ordinary meaning, the specification or prosecution history may indicate otherwise. *Vitronics Corp.*, 90 F.3d at 1582. "[A] patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition is clearly stated in the patent specification or file history." *Id.*

However, claims are not limited to the preferred embodiment described in the specification. *See SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121 (Fed.Cir.1985) (*en banc*, plurality opinion).

DISCUSSION

I. Document

The parties dispute the meaning of the term "document" as used throughout the claims of the patents-in-suit. Tumbleweed proposes that the term "document" be construed to mean "any record, printed or otherwise, that can be read by a human or a machine," a definition taken from the McGraw-Hill Dictionary of Scientific Terms. Defendants propose that the term "document" be construed to mean "any self-contained piece of work created with an application program and, if saved to disk, given a unique filename by which it can be retrieved," a definition taken from the Microsoft Press Computer Dictionary.

Tumbleweed argues that the ordinary definition it proposes is consistent with the patent, which uses the term "document" broadly to encompass the notion of any "electronic information" or "electronic message."

However, there are at least two problems with Tumbleweed's proffered construction. First, it is not helpful. The meaning of "record" in the proposed definition is no more clear than the meaning of "document" and so would itself need to be defined. Second, and more importantly, Tumbleweed's proposed construction defines the term "document" more broadly than it is used in the patents-in-suit.

In contrast, Defendants' proposed construction more accurately reflects the way in which the term "document" is used in the patent. For example, the specification refers to documents as containing content and color information. '790 patent, col. 9, ln. 30-31. Further, the specification includes the following list of document types: paper, Postscript, Quark, WordPerfect, and Excel. Also, the "Background of the Invention" equates the term "document" with the phrase "electronic file." '790 patent, col. 2, ln. 9-11 ("The disclosed prior art systems and methodologies thus provide some methods for the delivery of documents, but fail to provide an economical, fast delivery system that operates in a push-fashion, while conserving the integrity of the original electronic file."). It also contrasts the term "document" with the term "electronic messages." '790 patent, col. 1, ln. 38-58. This usage supports Defendants' proposed construction. Therefore, the Court construes the term "document" to mean "any self-contained piece of work created with an application program and, if saved to disk, given a unique filename by which it can be retrieved." FN1

FN1. Defendants also propose that the definition of "document" be further refined to state that "the information entered into text fields in a form is not a document." In doing so, Defendants seek to respond to Tumbleweed's preliminary infringement contentions, in which Tumbleweed asserts that the text entered into the subject and message fields of a form used to generate an e-mail each constitutes a separate document as that term is used in the patents-in-suit. The Court declines to adopt this additional language, because doing so would take the Court beyond its appropriate role at this stage in the proceedings, namely defining the meaning of the terms used in the patents-in-suit.

II. Information and Data

The parties dispute the meaning of the words "information" and "data" as used in the claims of the '599 patent. Tumbleweed argues that the terms "information" and "data" are common, well-understood terms that are used according to their ordinary meaning and so do not need to be construed. In contrast, Defendants propose to construe "information" as "items of information understandable by people that, taken together, comprise the sender's document" and "data" as "items of information that, taken together, comprise the sender's document." Defendants thus define both terms with respect to their relationship to the previously defined term, "document." However, nothing in the patents-in-suit suggests that data or information is so limited; in fact, the patents frequently use these terms in their ordinary meaning. Therefore, the Court declines to adopt Defendants' proposed construction. The Court agrees with Tumbleweed that the terms are used according to their ordinary meaning and so declines to construe them.

III. Server

The parties dispute the meaning of the term "server" as used in each of the patents-in-suit. Tumbleweed proposes to construe "server" to mean "a computer, or an integrated set of computers, that provides information or services to other computers on a network." Defendants contend, however, that server should be construed to mean "a single computer that provides information or services to other computers on a network." Thus, the parties dispute whether "a server" is limited to one and only one server, or whether it can encompass several servers acting in concert. Tumbleweed's proposed construction, which encompasses multiple computers acting in concert, is consistent with the canons of claim construction and the

specifications of the patents-in-suit. The Federal Circuit has "repeatedly emphasized [that] an indefinite article 'a' or 'an' in patent parlance carries the meaning of 'one or more' in open-ended claims containing the transitional phrase 'comprising.'" *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed.Cir.2000) (citing cases). Thus, "[u]nless the claim is specific as to the number of elements, the article 'a' receives a singular interpretation only in rare circumstances when the patentee evinces a clear intent to so limit the article." *Id.* Here, the disputed claims use the indefinite article "a" in open-ended claims containing the transitional phrase "comprising." Therefore, according to controlling Federal Circuit precedent, the term "a server" should be construed to mean "one or more servers" unless the patentee has evidenced a clear intent to limit the article "a" to a singular interpretation. The patentee has not evidenced such an intent. To the contrary, the patents-in-suit indicate an unequivocal intent to encompass systems that use more than one server. For example, the specification states that a "preferred embodiment allows individual processes running on a single server to be distributed across a collection of servers." Therefore, the Court construes "server" to mean "a computer, or an integrated set of computers, that provides information or services to other computers on a network."

IV. Notification

The parties dispute the meaning of the term "notification" as used in the claims of the '790 patent. Tumbleweed proposes to define "notification" as "a message that transmits information to a human or machine." Defendants propose to define notification as "a notice of an occurrence." Tumbleweed concedes that this portion of Defendants' proposed construction is unobjectionable.FN2 Because of this, and because the Court finds Defendants' proposed construction more comprehensible, the Court adopts Defendants' proposed construction. However, the Court adds the limitation that the notification must be electronic. Therefore, the Court construes "notification" as "an electronic notice of an occurrence."

FN2. Defendants also propose that the term "notification" be construed to include the limitation that "[i]n the context of the patents, the notice does not include the document." The Court declines to adopt this additional language, because doing so would take the Court beyond its appropriate role at this stage in the proceedings.

V. Acknowledgment

The parties dispute the meaning of the term "acknowledgment" as used in the claims of the '790 patent. Tumbleweed argues that "acknowledgment" should be construed to mean "one or more records that contain information allowing the identification of both the recipient and the electronic document." Defendants propose to define "acknowledgment" as "a recognition that an act has occurred." Defendants propose to define "acknowledgment" according to its ordinary meaning, while Tumbleweed proposes to specify the content of the "acknowledgment," purportedly based on the contents of the specification. However, Tumbleweed cannot point to any part of the specification that so defines acknowledgment.FN3 Thus, this is not an instance in which the patentee has acted as its own lexicographer and adopted a specialized definition. Therefore, the Court rejects Tumbleweed's proposed construction of acknowledgment. The Court finds Defendants' proposed construction to be more appropriate, but linguistically imprecise, because recognition implies something that occurs within a person's mind, which is clearly not what is meant here. Therefore, the Court construes "acknowledgment" as "information evidencing a recognition that an act has occurred."

FN3. In fact, Tumbleweed claims that the specification does not contain the word "acknowledgment."

However, this assertion is inaccurate. The '790 patent's specification does use the term acknowledgment, as follows: "The session manager answers Sam's upload with an acknowledgment, and provides information regarding the transaction." '790 Patent, col. 7, ln. 46-48. This use of the term "acknowledgment" does not support Tumbleweed's proposed construction, because there is nothing in the specification that would suggest that that acknowledgment would necessarily include information allowing the identification of both the recipient and the electronic document.

VI. Direct Reference

The parties dispute the meaning of the term "direct reference" as used in the claims of the '790 patent. Tumbleweed argues that the term "direct reference" should be construed to mean "a reference that identifies: (i) the server where the electronic document is stored; (ii) the electronic document; and (iii) the recipient." Defendants argue that the term "direct reference" should be construed to mean "a reference that takes the receiving computer directly to the electronic document without needing to go through any intermediate steps, pages, or in-boxes." Under Tumbleweed's proposed construction, a direct reference is any reference that takes the user to the actual document that is to be viewed, rather than to an in-box or page that contains a list of documents from which the document to be viewed is to be selected. Defendants' proposed construction incorporates this definition, but adds the additional limitation that the reference must take the user immediately to the document that is to be viewed, without any requiring the viewing of any other screens, such as a password verification screen.FN4 Thus, Tumbleweed argues that "direct" means "particular" in the context of patent, while Defendants argue that "direct" means "without deviation."

FN4. In support of their proposed construction, Defendants rely upon Judge James Ware's supplemental claim construction order in *Tumbleweed Software Corp. v. docSpace Co.*, No. 99-20177 JW (N.D.Cal.), in which Judge Ware construed "direct reference" to mean that "the claims of the '790 patent do not cover products with intermediate steps, pages or in-boxes that are needed to reach the document, but could cover products with intermediate steps, pages or in-boxes that are not needed to reach the document." Defendants argue that this construction is binding on the parties. However, following the entry of this order, the parties to that litigation settled their dispute, and, pursuant to the terms of their settlement agreement, the *docSpace* litigation was dismissed without prejudice. Therefore, Judge Ware's Order lacks preclusive effect. *Bradenfelds v. Heckler*, 716 F.2d 553, 557 (9th Cir.1983); *see also* 9 Charles Wright & Arthur Miller, *Federal Practice & Procedure* s. 2367 ("A voluntary dismissal without prejudice leaves the situation as if the action had never been filed."). Further, Judge Ware's supplemental claim construction was adopted to address whether an allegedly infringing product, which takes the user to an in-box from which a document could be selected, actually infringed, and not whether an allegedly infringing product that takes the user directly to the document at issue once the user verifies his or her identity by entering a password. Therefore, this construction is not particularly relevant to resolving the specific issue presented here.

The parties agree that Tumbleweed added the term "direct reference" to the patent to overcome the Examiner's objection based on the prior art, so, to support their proposed constructions, all parties focus on the prosecution history, specifically Tumbleweed's December 22, 1997 Amendment in Response to Final Action. A review of this document demonstrates that Tumbleweed clearly used the term "direct reference" to refer to a reference that uniquely identifies the document that the receiver seeks to download as opposed to a reference that merely points the receiver to an in-box containing many documents. *See, e.g.*, December 22, 1997 Amendment in Response to Final Action at 8 ("[T]he notification sent to the receiving computer

includes a direct reference to the forwarded electronic document at the server, and ... that receiving computer uses the direct reference to the server to locate and download the forwarded electronic document."); *id.* at 11-12 ("Bobo uses a common 'In-Box' as repository of information where the recipient of a document can go to retrieve the documents, faxes, or messages.... In contrast, the present invention does not establish a proprietary in-box, and simply relies on an existing in-box for the recipient.... The notification message sent to the user contains a direct reference to the sent document ... so that the receiver can go directly to the document without needing to go through a higher-level mailbox."); *id.* at 13 ("In contrast to Bobo, the present invention uses references specific to each document and server, as a part of the notification that is sent to the recipient. The recipient is not required first to use an unchanging URL reference to visit a mailbox, and second, to then look for and find anchors or references to other documents that are stored within the mailbox."). Therefore, the Court rejects Defendants' proposed construction, because it would require that the user be taken immediately to the document that is to be viewed, without viewing any other screens.

However, the Court also declines to adopt Tumbleweed's proposed construction in its entirety. Tumbleweed has not pointed to passages of the specification or prosecution history that would support its claim that the direct reference itself identifies the recipient of the document.FN5 Therefore, the Court construes "direct reference" to mean "a reference that specifically identifies the server where the electronic document is stored and the electronic document itself."

FN5. Tumbleweed points to one passage of the prosecution history that it asserts supports its claim that the recipient must be included in the information contained in the direct reference. That passage states: "Neither Okumura nor Bobo anticipated sending documents by reference, wherein the recipient is notified of a delivery with a message containing a direct reference to an electronic document and server, unique to both the document and recipient." However, this passage merely states that the direct reference is unique to each recipient; it does not state that the direct reference itself identifies each recipient.

VII. Data for Generating a Document and Generating the Document from the Data

The parties dispute the meaning of the phrase "data for generating a document," used in claims 1, 4, and 11 of the '599 patent, as well as the meaning of the similar phrase "generating the document from the data," used in claim 1 of the '599 patent. Tumbleweed proposes that the phrase "data for generating a document" be construed to mean "data that is used to create a document," and that the phrase "generating the document from the data" be construed to mean "using the data to create the document." Defendants contend that these terms are fatally ambiguous and indefinite and thus not subject to definition. Defendants have therefore not offered definitions for these phrases, and instead reserve the right to contest of the validity of the affected claims.

The Court declines to adopt Tumbleweed's proposed constructions. The Court finds that substitution of the word "create" for the word "generating" does not additional clarity to the claim language. Further, the word "create" has a different connotation than the word "generating," with the former suggesting an act of creativity and the latter suggesting an automatic process. For these reasons, the Court does not construe these claims.

CONCLUSION

The Court construes the disputed terms and phrases as stated.

IT IS SO ORDERED.

N.D.Cal.,2003.

Tumbleweed Communications Corp. v. Paypal, Inc.

Produced by Sans Paper, LLC.