

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

PETER PEDERSEN

Plaintiff,

V.

MAILGUN TECHNOLOGIES, INC.

Defendant.

Case No 6:21-cv-01153-ADA

PATENT CASE

JURY TRIAL DEMANDED

**PLAINTIFFS' RESPONSE TO DEFENDANT MAILGUN TECHNOLOGIES, INC.'S
OPENING CLAIM CONSTRUCTION BRIEF**

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I. PLAINTIFF’S RESPONSE TO DEFENDANT’S INTRODUCTION AND BACKGROUND

This case involves a patent that focuses on an electronic message management system and methods using that system. The system is described in claims 1-7 and 12-18 and the method claims are described in claims 8-11 of U.S. Patent No. 6,965,920 (“the ’920 Patent”).

The asserted claims of the patent-in-suit recite in a plain and straightforward manner, an electronic computer system and method that communicates with a global digital communications network. A “recipient” profile system is claimed for receiving “recipient profile data,” and the data includes delivery parameters that are specified by the recipient “including where, when, and how” specific types of messages are to be delivered to the recipient from the system. Ex. 1, ’920 Patent at 11:17-32. The system includes “a messenger profile” that receives messenger profile data from messengers (i.e., system or persons sending a message), and “a message input application” for receiving and storing “message files” from a messenger via the global network. Ex.1, ’920 Patent at 11:33-39. The system then includes “an individual message generator” that uses the data files “to generate an individual message to be sent to the recipient specified by the messenger.” Ex. 1, ’920 Patent at 11:40-46. A “message management database” includes recipient and messenger profile databases for storing the respective profile data and a message database for storing message data files. Ex. 1, ’920 Patent, Col. 11:40-50.

II. PLAINTIFF’S RESPONSE TO DEFENDANT’S ARGUMENT

A. “message file” (claim 1): Defendant Seeks to Improperly Construe a Phrase Not Found in the Claim and Improperly Limit that Phrase to One of at Least Two Embodiments of the Specification

Defendant seeks to improperly limit a phrase that is not found in claim 1, the phrase “message file.” The proper phrase, recited above, is “message files,” the plural of “message

file.” The phrase “message file” does not appear in any of the claims. The Court should disregard plaintiff’s argument to construe “message file” on this issue alone.

Defendant then seeks to improperly limit the phrase “message file” to a single embodiment out of the specification. Defendant summarized the “message file” to mean “a file that contains a composed message and its recipients.” Defendant Brief, p. 2 (Dkt. 22). Defendant proceeds to quote out of one embodiment of the specification of the ’920 Patent, where “a message file” may be “uploaded.” Ex. 1, ’920 Patent at 10:26. However, the sentence directly above this line states that “a message input form . . . allows the messenger to elect 304 to enter a message **manually or by uploading** a message file.” Ex. 1, ’920 Patent at 10:23-25. The embodiments of the specification clearly show there are at least two ways to elect to enter a message, either manually or by uploading. Plaintiff infers from defendant’s phrase “message file” that defendant seeks to limit the claimed phrase “message files” to only the uploading embodiment. This is improper limiting of the claim according to well-established Federal Circuit precedent.

The Federal Circuit has repeatedly and unequivocally stated it is improper to limit the claims to an exemplary embodiment—even if it is, in fact, the only embodiment. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005); *Kara Tech. Inc. v. Stamps.com Inc.*, 582 F.3d 1341, 1347-48 (Fed. Cir. 2009); *Cont’l Circuits LLC v. Intel Corp.*, No. 2018-1076, 2019 WL 489069, at *6 (Fed. Cir. Feb. 8, 2019); *Liebel–Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004).

Defendant has no basis for its argument. Defendant asserts that this narrow reading is how “a person of ordinary skill in the art would have understood a ‘message file’ is uploaded as a complete message with recipients and content.” Defendant Brief, p. 6 (Dkt. 22). This assertion

is not based on a declaration from an expert, one skilled in the art, or from the '920 Patent itself. Cited above, the specification clearly calls for at least another embodiment where a message file may be entered or loaded “manually.” Ex. 1, '920 Patent at 10:23-25. In fact, the specification here explicitly states that uploading the message file is an alternative embodiment: “[i]f uploading 315 a message file is **elected**. . .” (emphasis added) Ex. 1, '920 Patent at 10:26.

In addition, limiting the plural “message files” to the unclaimed “message file” reads limitations into the claims that are not there. Message files, according to the specification may be one or more files used to create a message to a recipient, such as a recipient file:

If manually entering 305 the message information is elected, the input form 53 prompts the messenger to enter specifications of message type and content type. The message input editor 350 then looks for match 306 between the messenger, message type, content type and the recipient message profiles in the recipient message profile database 122, and a list of matching recipient IDs is presented to the messenger. The message input editor 350 receives 307 any amendments (additions, deletions, modification) to the recipient ID list, and finally confirm the Recipient ID's list. Ex. 1, '920 Patent at 10:38-54.

None of the patent claims here should have imports of limitations from the specification into the claims. The Federal Circuit consistently has cautioned that “courts must take care not to import limitations into the claims from the specification,” *Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1288 (Fed. Cir. 2009), and “expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.” *Phillips v. AWH Corp.*, 415 F.3d at 1323; *see also Kara* at 1347-48 (Fed. Cir. 2009) (single detailed embodiment is “not enough, however, to limit the patentee’s clear, broader claims.”).

Defendant's construction of "message file" from claim 1 should be rejected, and the plain and ordinary meaning (no construction necessary) of the phrase "message files" should be held by the Court.

B. "a method of inputting data into the message management system of claim 1" (claim 8/ "The method of claim 8" (claims 9-11): Defendant's Arguments are Contrary to U.S. Patent and Trademark Office Claim Dependency Rules and Court Procedures for Invalidity

Defendant's proposed "construction" of the claim 8 preamble, quoted above, as "indefinite" is not a construction at all. It is a proposed indefiniteness argument under 35 U.S.C. § 112(b), which defendant advances in an effort to avoid proposing a claim construction. Nonetheless, under the Manual of Patent Examining Procedure, "35 U.S.C. § 112(b) or pre-AIA 35 U.S.C. § 112, second paragraph requires that a patent application specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention." MPEP 2173. In this case, the claims are clearly not indefinite. Method claims 8-11 were granted by the USPTO as "particularly pointing out and distinctly claiming the subject matter" that Mr. Pederson regarded as his invention.

Defendant's lack of a proposed construction aside, defendant's reasoning of why the claims are indefinite also fail in view of USPTO rules. Claim 8 is an independent method claim, and its dependents 9-11 are method claims. The preamble to claim 8 states an intended use, of the method being practiced upon the system of claim 1. Claim 8 does not depend from claim 1, it merely recites an intended system upon which the method steps can be practiced. This is perfectly acceptable claims drafting of a preamble that was accepted by the Examiner at the USPTO. The USPTO rules state that

The claim preamble must be read in the context of the entire claim. The determination of whether the preamble recitations are structural limitations **or**

mere statements of purpose or use can be resolved only on review of the entirety of the record to gain an understanding of the what the inventors actually invented and intended to encompass by the claim as drafted without importing extraneous limitations from the specification. MPEP 2111.02 Effect of Preamble [R-10.2019], II. Preamble Statements Reciting Purpose or **Intended Use** (emphasis added) (*citing Corning Glass Works, v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). (emphasis added.)

Claim 8’s preamble does not state, for example, “The system of claim 1, wherein. . .” or “The system of claim 1, further comprising. . .” as do claim 1’s dependents 2-7 and 12-18.

Claim 8 merely recites an intended use of the method steps to be performed on the system of claim 1. This is acceptable claim drafting to recite back to a system claim in the preamble as an intended use. Otherwise, the inventor would have to recite the entire claim 1 in the preamble, which the USPTO generally would not even allow.

According to the USPTO, in order to be a dependent claim in proper form, the claim must further limit the subject matter of the claim upon which it depends:

When examining a dependent claim, the examiner should determine whether the claim complies with 35 U.S.C. 112(d), which requires that dependent claims contain a reference to a previous claim in the same application, specify a further limitation of the subject matter claimed, and include all the limitations of the previous claim. MPEP 608.01(n)(III) Test for Proper Dependency.

Independent method claim 8 does not further limit the system claim of claim 1. Claim 8 cannot make any such limitations to a system claim since claim 8 is a method claim, not a system claim. The USPTO examiner who allowed the ’920 Patent is well aware of basic claims drafting under 35 U.S.C. § 112(d) and allowed the claims since the claims follow proper independent/dependent claims drafting procedures.

The Court should reject defendant’s proposal of construction of claims 8-11 as indefinite, and allow the plain and ordinary meaning of the claims to be used at trial.

C. “accepting . . . [and entering . . .]” (claim 8): Defendant’s Construction of “Indefinite” Fails for the Same Reasons Cited Above in Subsection B

Here, defendant's indefiniteness argument fails for the same reasons cited above, namely that it is not a construction at all. Defendant, in Footnote 4 of its brief, also relies here on viewing claim 8 through the lens of it being dependent upon claim 1, which explained above, is incorrect. Defendant's Brief, p. 7, n. 4 (Dkt. 22).

Contrary to defendant's theory, claim 11 does not make claim 8 indefinite. Claim 11 is a properly drafted dependent to claim 8, since claim 11 "contain[s] a reference to a previous claim in the same application, specif[ies] a further limitation of the subject matter claimed, and include[s] all the limitations of the previous claim. MPEP 608.01(n)(III) Test for Proper Dependency. The relevant step from claim 8 states:

accepting input data from the client computer and entering the input data into an electronic message management database of the message management system. Ex. 1, '920 Patent at 12:35-37.

Claim 11 states:

The method of claim 8, wherein the accepting step includes entering the input data into an electronic message management database comprising a recipient profile database, a messenger profile database, and a message database. Ex. 1, '920 Patent at 12:45-49.

As read by one skilled in the art, claim 11 follows the USPTO procedure of referring to its dependency of claim 8 and to the method steps, which are divided into paragraphs, of claim 8 to which it is narrowing (the "accepting" step).

Claim 11 narrows the "entering" step that follows in the same paragraph as the "accepting" step, which is an acceptable practice of claims drafting at the USPTO. Namely, claim 11 recites further intended system components to enter the input data into including a recipient profile database, messenger profile database, and a message database. Unrealized by

defendant, these are proper claims drafting procedures that were accepted by the USPTO examiner as a valid claims. Defendant has not proved indefiniteness, and is in the wrong stage of this case to attempt to do so.

Defendant's construction of "indefinite" of the final step of claim 8 should be rejected, and the claim should be read in the plain an ordinary meaning of one skilled in the art, meaning no construction is required.

D. "wherein the messenger profile application receives and stores messenger profile data, including recipient identifications and recipient profiles, which messages to deliver to the recipients and profiles stored" (claim 12): Defendant's Proposed "Indefinite" Claim Construction Fails for the Same Reasons as Subsections "B" and "C"

Defendant proposes an "indefinite" claim construction for the dependent system claim 12 because "this language is unintelligible to a person of skill in the art." Defendant's Brief, p. 8 (Dkt. 22). This argument fails for the same reasons stated above, *inter alia*, that the claim is not indefinite under 35 U.S.C. § 112(b). Asserting the claim is unintelligible is clearly not a claim construction. In fact, one skilled in the art *did* read the claim and *did* find it intelligible – the USPTO examiner, when he allowed claim 12 and granted the '920 Patent. As above in Subsections B and C, defendant provides no evidence except attorney argument (*e.g.*, the claim is "such nonsense", Defendant's Brief, p. 8) of why the examiner, who is one skilled in the art of reading and understanding a patent, could not understand the claim or its scope and why another reader who is skilled in the art could not understand as well.

Plaintiff's proposed construction of plain and ordinary meaning of the claim is proper. When broken into its parts, the claim uses clear language:

- The electronic message management system of claim 1, (depends from independent claim 1)

- wherein the messenger profile application receives and stores messenger profile data,
- including recipient identifications and recipient profiles,
- which messages to deliver to the recipients and profiles stored. Ex, 1, '920 Patent at 12:49-53.

The “which messages to deliver to the recipients and profiles stored” simply refers back to the “messages” and “individual message” of claim 1 that are delivered to recipients, and “recipient profile” data that is used and stored in the system. Defendants are reading claim 12 in a vacuum, where they must read it along with the entirety of claim 1, since as the USPTO requires, a dependent claims must “include all the limitations of the previous claim.” MPEP 608.01(n)(III) Test for Proper Dependency.

One skilled in the art did read and approve claim 12 for grant as a patent claim. The claim is intelligible and is not indefinite. Defendant’s “construction” of indefinite should be rejected and plaintiff’s construction of plain and ordinary meaning should be followed by the Court.

III. CONCLUSION

For the reasons set forth above, Pedersen respectfully requests that the Court rejects Mailgun’s proposed construction of “message file” and find claims 8-12 not indefinite.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 12, 2022, I served the foregoing document via email on all counsel for Defendant.

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