

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

FALL LINE PATENTS, LLC,

Plaintiff,

V.

ZOE'S KITCHEN, INC., ET AL,

Defendants.

[illegible]

Civil Action No. 6:18-CV-00407-RWS
(LEAD CASE)

CLAIM CONSTRUCTION ORDER

Before the Court is Fall Line’s Opening Claim Construction Brief. Docket No. 99.¹ This brief was filed in June of 2019. After briefing was completed and the Court heard argument on the issue in August of 2019. *See* Docket Nos. 102, 103, 117. Two days after the claim construction hearing, the Court granted a stay in this case pending *Inter Partes* Review. Docket No. 110. On October 20, 2022, the Court lifted the stay in this case. Docket No. 164. Shortly afterwards, the Court ordered supplemental briefing on claim construction. Docket No. 201. The parties jointly submitted a supplemental brief on December 22, 2022, which identified the agreed constructions and the terms that require review. Docket No. 205. And prior to the joint supplemental brief, the parties had submitted additional briefing for the Court’s consideration. *See, e.g.*, Docket Nos. 134, 139, 169. Now, in view of the complete record before it, the Court provides the constructions set forth below.

¹ Since claim construction first began in 2019, a number of Defendants have settled with Fall Line. The only remaining Defendants at this time are the McDonald's defendants, McDonalds Corporation and McDonalds USA, LLC.

I. BACKGROUND

There is one remaining claim in this case—Claim 7 of U.S. Patent No. 9,454,748 (the '748 Patent). The '748 Patent, titled “System and Method for Data Management,” was filed on October 22, 2010 and issued on September 27, 2016. The '748 Patent generally “relates to a system of computing devices for the collection and management of information” and “[m]ore particularly . . . relates to a system for collecting and managing information including a plurality of computer devices loosely networked to a server and an operating system for a computer which provides a number of features favorable for use in the inventive system.” '748 Patent at 1:16–24. The Abstract of the '748 Patent states:

A method for the management of data collected from a remote computing device including the steps of: creating a questionnaire; transmitting the questionnaire to a remote computer; executing the questionnaire in the remote computer to prompt a user for responses to questions of the questionnaire; transmitting the responses to a sever via a network; making the responses available on the Web. Preferably, computers used in connection with the inventive method are loosely networked in that network connections between computers are not always available and, when a connection is not available, data is stored at a node of the network and transmitted at the earliest time when a connection is available. In one preferred embodiment, the inventive method is used to collect survey data and to make the responses to the survey available to a client in virtually real time over the Internet.

Claim 7 of the '748 Patent, the claim in dispute in this case, recites the following elements (disputed terms emphasized):

7. A method for collecting survey data from a user and making responses available via the Internet, comprising:
 - (a) designing a **questionnaire** including at least one question said **questionnaire** customized for a particular location having branching logic on a first computer platform wherein at least one of said at least one questions **requests location identifying information**;
 - (b) automatically transferring said designed **questionnaire** to at least one loosely networked computer having a GPS integral thereto;
 - (c) **when said loosely networked computer is at said particular location, executing said transferred questionnaire on said loosely networked computer, thereby collecting responses from the user**;

- (d) while said transferred **questionnaire** is executing, using said GPS to automatically provide said location identifying information as a response to said executing **questionnaire**;
- (e) **automatically transferring** via the loose network any responses so collected in real time to a central computer; and,
- (f) making available via the Internet any responses transferred to said central computer in step (e).

II. LEGAL PRINCIPLES

A. Claim Construction

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Innova/Pure Water Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). To determine the meaning of the claims, courts start by considering the intrinsic evidence. *Phillips*, 415 F.3d at 1313; *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861 (Fed. Cir. 2004); *Bell Atl. Network Servs., Inc. v. Covad Commc’ns Grp., Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001). The intrinsic evidence includes the claims themselves, the specification, and the prosecution history. *Phillips*, 415 F.3d at 1314; *C.R. Bard, Inc.*, 388 F.3d at 861. The general rule—subject to certain specific exceptions—is that each claim term is construed according to its ordinary and accustomed meaning as understood by one of ordinary skill in the art at the time of the invention in the context of the patent. *Phillips*, 415 F.3d at 1312–13; *Alloc, Inc. v. Int’l Trade Comm’n*, 342 F.3d 1361, 1368 (Fed. Cir. 2003); *Azure Networks, LLC v. CSR PLC*, 771 F.3d 1336, 1347 (Fed. Cir. 2014) (quotation marks omitted) (“There is a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time.”) *cert. granted, judgment vacated*, 135 S. Ct. 1846 (2015).

“The claim construction inquiry . . . 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). “[I]n all aspects of claim construction, ‘the name of the game is the claim.’” *Apple Inc. v. Motorola*,

Inc., 757 F.3d 1286, 1298 (Fed. Cir. 2014) (quoting *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998)) *overruled on other grounds by Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015). First, a term’s context in the asserted claim can be instructive. *Phillips*, 415 F.3d at 1314. Other asserted or unasserted claims can also aid in determining the claim’s meaning, because claim terms are typically used consistently throughout the patent. *Id.* Differences among the claim terms can also assist in understanding a term’s meaning. *Id.* For example, when a dependent claim adds a limitation to an independent claim, it is presumed that the independent claim does not include the limitation. *Id.* at 1314–15.

“[C]laims ‘must be read in view of the specification, of which they are a part.’” *Id.* (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc)). “[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002). This is true because a patentee may define his own terms, give a claim term a different meaning than the term would otherwise possess, or disclaim or disavow the claim scope. *Phillips*, 415 F.3d at 1316. In these situations, the inventor’s lexicography governs. *Id.*

The specification may also resolve ambiguous claim terms “where the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the words alone.” *Teleflex, Inc.*, 299 F.3d at 1325. But, “[a]lthough the specification may aid the court in interpreting the meaning of disputed claim language, particular embodiments and examples appearing in the specification will not generally be read into the claims.” *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir.

1998) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988)); see also *Phillips*, 415 F.3d at 1323. “[I]t is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004).

The prosecution history is another tool to supply the proper context for claim construction because, like the specification, the prosecution history provides evidence of how the U.S. Patent and Trademark Office (“PTO”) and the inventor understood the patent. *Phillips*, 415 F.3d at 1317. However, “because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Id.* at 1318; see also *Athletic Alts., Inc. v. Prince Mfg.*, 73 F.3d 1573, 1580 (Fed. Cir. 1996) (ambiguous prosecution history may be “unhelpful as an interpretive resource”).

Although extrinsic evidence can also be useful, it is “less significant than the intrinsic record in determining the legally operative meaning of claim language.” *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc.*, 388 F.3d at 862). Technical dictionaries and treatises may help a court understand the underlying technology and the manner in which one skilled in the art might use claim terms, but technical dictionaries and treatises may provide definitions that are too broad or may not be indicative of how the term is used in the patent. *Id.* at 1318. Similarly, expert testimony may aid a court in understanding the underlying technology and determining the particular meaning of a term in the pertinent field, but an expert’s conclusory, unsupported assertions as to a term’s definition are not helpful to a court. *Id.* Extrinsic evidence is “less reliable

than the patent and its prosecution history in determining how to read claim terms.” *Id.* The Supreme Court has explained the role of extrinsic evidence in claim construction:

In some cases, however, the district court will need to look beyond the patent’s intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period. *See, e.g., Seymour v. Osborne*, 11 Wall. 516, 546 (1871) (a patent may be “so interspersed with technical terms and terms of art that the testimony of scientific witnesses is indispensable to a correct understanding of its meaning”). In cases where those subsidiary facts are in dispute, courts will need to make subsidiary factual findings about that extrinsic evidence. These are the “evidentiary underpinnings” of claim construction that we discussed in *Markman*, and this subsidiary factfinding must be reviewed for clear error on appeal.

Teva Pharm. USA, Inc. v. Sandoz, Inc., 574 U.S. 318, 331–32 (2015).

B. Departing from the Ordinary Meaning of a Claim Term

There are “only two exceptions to [the] general rule” that claim terms are construed according to their plain and ordinary meaning: “1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution.”² *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014) (quoting *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)); *see also GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014) (“[T]he specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal.”). The standards for finding lexicography or disavowal are “exacting.” *GE Lighting Sols.*, 750 F.3d at 1309.

To act as his own lexicographer, the patentee must “clearly set forth a definition of the disputed claim term,” and “clearly express an intent to define the term.” *Id.* (quoting *Thorner*, 669

² Some cases have characterized other principles of claim construction as “exceptions” to the general rule, such as the statutory requirement that a means-plus-function term is construed to cover the corresponding structure disclosed in the specification. *See, e.g., CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1367 (Fed. Cir. 2002).

F.3d at 1365); *see also Renishaw*, 158 F.3d at 1249. The patentee’s lexicography must appear “with reasonable clarity, deliberateness, and precision.” *Renishaw*, 158 F.3d at 1249. To disavow or disclaim the full scope of a claim term, the patentee’s statements in the specification or prosecution history must amount to a “clear and unmistakable” surrender. *Cordis Corp. v. Bos. Sci. Corp.*, 561 F.3d 1319, 1329 (Fed. Cir. 2009); *see also Thorner*, 669 F.3d at 1366 (“The patentee may demonstrate intent to deviate from the ordinary and accustomed meaning of a claim term by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”). “Where an applicant’s statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable.” *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013).

III. THE PARTIES’ STIPULATED TERMS

The parties agreed to the construction of the following terms in their Joint Supplemental Claim Constructions Brief (Docket No. 205):

Claim Term/Phrase	Agreed Construction
“customized for a particular location”	Plain meaning
“loosely networked” / “loose network”	“tolerant of intermittent network connections and tolerant of the type of network connection available”
“GPS integral thereto” / “said GPS”	“GPS receiver integral thereto” / “said GPS receiver”
“executable”	“of, pertaining to, or being a program file that can be run” and includes JAVA and markup languages (XML, HTML, JSON, etc.)”

(Docket No. 205 at 3–4). In view of the parties’ agreement on the proper construction of the identified terms, the Court hereby **ADOPTS** the parties’ agreed constructions.

IV. CONSTRUCTION OF DISPUTED TERMS

The parties’ dispute the meaning and scope of five claim terms in the ’748 Patent. The Court addresses these terms individually below.

A. “questionnaire”

Disputed Term	Plaintiff’s Proposal	Defendants’ Proposal
“questionnaire”	“a program or form that includes a question or statement, which calls for a response”	No construction necessary. Alternatively: “a program or form that includes a question or statement, which calls for a response”

The parties dispute whether the term “questionnaire” requires construction. Docket No. 205 at 4–5. Defendants argue that the term does not require construction in the context of the ’748 Patent; however, in the alternative, Defendants have stated that they “have no objection to Plaintiff’s proposed construction.” *Id.* at 4–5 n.5 (citing Docket No. 102). Plaintiff argues that, because Defendants have conceded that they do not object to the Plaintiff’s proposed construction, that the Court should adopt the Plaintiff’s proposed construction. *Id.* at 4. Further, in its opening brief, the Plaintiff argued that the court in *MacroSolve* construed the term “questionnaire” to mean “a program or form that includes a question or statement, which calls for a response.” Docket No. 99-2 at 14 (*MacroSolve, Inc. v. Antenna Software, Inc. et al*, Case No. 6:11-cv-287-MHS-KNM, Docket No. 493 (E.D. Tex. Jan. 21, 2014)) (construing terms in U.S. Patent No. 7,822,816, the parent of the ’748 Patent).

Because Defendants do not disagree with the construction adopted by the court in *MacroSolve*, the Court construes the term “questionnaire” to mean “a program or form that includes a question or statement, which calls for a response.” Thus, for the reasons set forth above, the Court construes the term **“questionnaire”** to mean **“a program or form that includes a question or statement, which calls for a response.”**

B. “when said loosely networked computer is at said particular location, executing said transferred questionnaire on said loosely networked computer, thereby collecting responses from the user”

Disputed Term	Plaintiff's Proposal	Defendants' Proposal
“when said loosely networked computer is at said particular location, executing said transferred questionnaire on said loosely networked computer, thereby collecting responses from the user”	No construction necessary.	“when the said loosely networked computer is at said particular location, prompting a user via the loosely networked computer to input responses to the transferred questionnaire

The parties dispute whether the disputed phrase requires construction. Docket No. 205 at 5–9. Defendants state that they “can now agree that no further construction” is needed for the term “when said loosely networked computer is at said particular location.” *Id.* at 7. Defendants, however, contend that the remote computing must prompt the user to input responses. *Id.* at 8–9. The Court finds that the phrase does not require construction because it is unambiguous and is easily understandable by a jury.

Defendants originally proposed a construction that required the questionnaire to be executed upon the device “arriving at the location.” Docket No. 102 at 16–20. The specification, however, describes using “handheld computers” (*i.e.*, remote computing devices) in places such as “a stockroom for a manufacturing facility” or a “production floor.” ’748 Patent at 8:18–24. Plaintiff argued that “[s]tockrooms and production floors are not the type of place where the questionnaire would be executed only at the moment the computer is brought into the room or onto the floor.” Docket No. 99 at 16. The Court agrees.

To be sure, the specification describes using the claimed methods to transfer patient data from medical providers to insurance companies. ’748 Patent at 11:43–12:53. The medical provider’s computers are equipped with the questionnaires, and the specification states that “medical information can be entered into the form(s) in the system *following* treatment by the [provider].” *Id.* at 12:17–19 (emphasis added). This indicates that the questionnaire does not need

to be executed the moment the computer enters the medical facility, rather it may be executed after the treatment is performed. Accordingly, to the extent that Defendants argue that a questionnaire must be executed upon arrival, the Court rejects that argument. The Court agrees with Defendants that the execution occurs “when said loosely networked computer is at said particular location,” not before when the computer is at some other location.

Regarding the issue of prompting the user, the specification states that “in a preferred embodiment *the user* will initiate the questionnaire.” *Id.* at 9:29–30. The specification adds that “the user might be instructed to initiate the questionnaire as soon as he or she pulls into the drive-in lane of a take-out eatery.” *Id.* at 9:32–34. Accordingly, the intrinsic evidence indicates that the questionnaire is not required to be executed when the remote computing device first arrives at the location, or that the remote computing must prompt the user to input responses.

Regarding Defendants’ attempt to redraft “executing” as “prompting a user,” Defendants cite to portions of the specification that include embodiments for “prompting a user.” Docket No. 102 at 20–21; Docket No. 205 at 9 (citing ’748 Patent at Abstract, 5:66–6:2, 8:25–28, 9:55–57, 10:55–56). The Court finds that these are only examples and do not limit the claims as Defendants contend. *Electro Med. Sys. S.A. v. Cooper Life Sci.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994) (“[A]lthough the specifications may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments”). These examples do not support Defendants’ argument that “the step of ‘executing’” must be “performed by prompting the user to obtain a response.” Docket No. 102 at 21. As discussed above, the specification provides other examples, and also states that “in a preferred embodiment *the user* will initiate the questionnaire.” ’748 Patent at 9:29–30 (emphasis added). Accordingly, the Court rejects Defendants’ construction.

For the reasons set forth above, the phrase **“when said loosely networked computer is at said particular location, executing said transferred questionnaire on said loosely networked computer, thereby collecting responses from the user”** is given its **plain and ordinary meaning**.

C. “requests location identifying information”

Disputed Term	Plaintiff’s Proposal	Defendants’ Proposal
“requests location identifying information”	No construction necessary.	“requests information identifying the user’s location”

The parties dispute whether the phrase requires construction. Docket No. 205 at 10–12. Defendants argue that their construction makes clear that the “location” in this claim term is that of the user, not the location to which a user may be traveling. *Id.* at 11–12. The Court finds that the phrase does not require construction, because it is unambiguous and is easily understandable by a jury. Claim 7 recites that the loosely networked computer has an integral GPS, and that this GPS is used to “automatically provide said location identifying information as a response to said executing questionnaire.” Thus, the “requested location identifying information” is for the loosely networked computer, which includes the GPS, and not the user. This is the plain language of the claim. Accordingly, the Court finds that Defendants have incorrectly inserted the additional limitation that the location must be “the user’s” location.

Defendants argue that the “location” cannot be both the user’s location and the “brick and mortar location,” and that their construction resolves ambiguity in the claim. Docket No.102 at 22. Defendants’ argument is unpersuasive and ignores the phrase in the context of the claim. The claim language requires a location, not necessarily the location of a brick-and-mortar business, and not necessarily the location of a user. Instead, the claim requires the location information of the loosely networked computer, which secondarily includes the location of the user if they are at the same

location. Indeed, Plaintiff correctly argues that Defendants conceded this point during the claim construction hearing. Docket No. 205 at 10–11 n.15 (citing Docket No. 117 at 62:20–63:14, 65:5–11). Thus, the Court rejects Defendants’ construction because it improperly adds a user’s location limitation.

For the reasons set forth above, the phrase “**requests location identifying information**” is given its **plain and ordinary meaning**.

D. Order of Steps

Disputed Term	Plaintiff’s Proposal	Defendants’ Proposal
Order of Steps	Steps must be performed in order only as dictated by the logic of the claim language: (a) must begin before, but can overlap with (b); (b) must begin before, but can overlap with (c); (d) must overlap with (c); (c) and (d) must begin before, but can overlap with (e); (e) must begin before, but can overlap with (f).	Steps must be performed in the order claimed

The parties dispute what order the steps of Claims 7 must be performed. Docket No. 205 at 12–18. The general rule is that method claim steps are not construed to require a specific order. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2000). This is true unless logic, grammar, or the intrinsic evidence require a narrower construction. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369–70 (Fed. Cir. 2003). Plaintiff argues that not all of the steps must be performed in order, and that the steps can overlap. Docket No. 205 at 13 n.20 (citing Docket No. 99 at 21). Defendants originally contended that the step must be performed in the order claimed and cannot overlap. Docket No. 102 at 24. Defendants now argue that the only steps that can overlap are 7(c) and 7(d), as 7(d) requires using the GPS to automatically provide “said

location identifying information” “while said transferred questionnaire is executing,” and that execution commences in step 7(c). Docket No. 205 at 18. Defendants contend that allowing for the significant overlapping makes no logical sense and is not supported by the specification. *Id.*

The Court generally agrees with Plaintiff, that once a preceding step begins, the steps can overlap. Defendants’ construction requires the recited questionnaire to be “complete” before preceding to the subsequent steps. This was the same argument defendants made in the *MacroSolve* case, which was rejected by the court. Document No. 99-2 at 27 (“There is nothing in the claim language that would require the tokens and responses to be sent as a packet as Defendants contend. Such a requirement would be similar to the ‘complete’ requirement that Defendants proposed for ‘questionnaire.’ As previously discussed, this limitation will not be read into the claim.”). With this background, the Court turns to the specific arguments made by the parties in this case.

a. Executing the Questionnaire Before the Responsive GPS Information

Defendants originally argued that the questionnaire must be executed at the remote device before responsive GPS information is entered into the questionnaire. Docket No. 102 at 25. In particular, in Claim 7, step (c) (“executing said transferred questionnaire”) must commence before step (d) (“while said transferred questionnaire is executing, using said GPS to automatically provide said location information as a response to said executing questionnaire”). *Id.* The Court agrees that the questionnaire must be executed at the remote device before responsive GPS information is entered into the questionnaire.

Step (c) of Claim 7 recites “executing said transferred questionnaire on said loosely networked computer” when “said loosely networked computer is at said particular location.” The claim further recites that “while said transferred questionnaire is executing, using said GPS to

automatically provide said location identifying information as a response to said executing questionnaire.” Thus, the plain language of the claim recites that the GPS does not provide the location until the questionnaire is initially executed.

This is consistent with arguments made by the patent owner in its Response to Defendants’ IPR petition. Specifically, the Patent Owner stated the following:

In order to acquire location information, the questionnaire (claim 7) and/or the tokens in the questionnaire (claims 1 and 20) *must be* executed to obtain the current location of the handheld device and the GPS location information *must then be* automatically inserted and/or obtained in response to the executing questionnaire.

Docket No. 99-10 at 15–16) (emphasis added). Similarly, Plaintiff confirmed this ordering in its opening brief. Docket No. 99 at 24 (“Yes, the GPS coordinates are not entered into the questionnaire until the ‘executing’ step begins . . .”). Accordingly, the Court finds that the questionnaire must be executed at the remote device before responsive GPS information is entered into the questionnaire. Specifically, step (c) must begin before, but can overlap with step (d).

b. Further Overlapping of Steps

Defendants argue that the steps cannot overlap as a matter of grammar and logic. Docket No. 205 at 16–18. The Court disagrees. This is the same argument the court rejected in *MacroSolve*. Docket No. 99-2 at 27. Defendants’ construction would require the recited questionnaire to be “complete” before preceding to subsequent steps. Docket No. 102 at 26 (“[T]he specification does not disclose ‘overlapping’ the creation and transmission of a questionnaire by transmitting portions of an incomplete questionnaire before the questionnaire has been completed.”).

There is nothing in the claim language that would require the questionnaire and responses to be “complete,” as Defendants contend. In fact, the specification explicitly discloses incremental transfers of the questionnaire. ’748 Patent at 4:28–31 (“It is a further object of the present invention

to provide an operating system for a handheld computer wherein programming changes will only necessitate incremental transfers of program instructions.”), 9:14–17 (“According to another preferred arrangement, there is provided a system, substantially as defined above, wherein the questionnaire which is transmitted to the handheld can be incrementally updated on each networked handheld 28, rather than resending the entire questionnaire.”).

In a footnote, Defendants previously contended that this corresponds to dependent claim 6, which recites additional steps. Docket No. 102 at 26 n.4. Dependent claim 6 does include additional steps, but it also indicates that the questionnaire need not be “complete” before proceeding to the next recited step in the method. Instead, the claim language only requires that the process of creating the questionnaire must begin before subsequent steps are taken. Accordingly, the Court rejects Defendants’ argument that it would be logically impossible to begin the questionnaire before the step of creating it is completed. Contrary to Defendants’ argument, it is logically possible to design parts of the questionnaire, transmit the questionnaire, and then add more questions. Similarly, it would be logically possible to transfer a portion of the responses to a server or central computer, store the responses, and then transfers other portions of the responses to the server or central computer.

For the reasons set forth above, **the steps of Claim 7 must be performed in the following order: (a) must begin before, but can overlap with (b); (b) must begin before, but can overlap with (c); (c) must begin before, but can overlap with (d) and (e); (e) must begin before, but can overlap with (f).**

E. “automatically transferring”

Disputed Term	Plaintiff’s Proposal	Defendants’ Proposal
“automatically transferring”	“transferring that is not initiated upon direction of the user”	“transferring that is not initiated by the user and does not happen at the direction of the user”

The parties dispute whether Plaintiff limited the scope of the term “automatically transferring” during the IPR. Docket No. 205 at 18–21. The term “automatically transferring” appears in Claim 7, which includes step (a) that recites “designing a questionnaire . . . on a first computer platform” Step 7(b) recites “automatically transferring said designed questionnaire to at least one loosely networked computer having a GPS integral thereto,” and step 7(e) recites “automatically transferring via the loose network any responses so collected in real time to a central computer.”

Defendants argue that during the IPR, Plaintiff distinguished two prior art references, Barbosa (U.S. Patent No. 6,961,586) and Hancock (U.S. Patent No. 6,202,023), on the basis that they do not disclose “automatically transferring” as recited in steps 7(b) and 7(e). According to Defendants, Plaintiff disclaimed any interpretation of “automatically transferring” that includes an action that is initiated by a user or occurs at the direction of a user. Docket No. 205 at 19. Plaintiff responds that the specification expressly refers to “automatic” transfers in contrast to transfers that are initiated “upon direction of the user.” *Id.* at 18 (citing ’748 Patent at 9:62–67).

In distinguishing Barbosa, Plaintiff argued that Barbosa’s synchronization does not meet the “automatically transferring” step because “Barbosa teaches synchronization *upon user request*, not automatically” Docket No. 139-6 at 19–20 (IPR sur-reply) (emphasis in original). Plaintiff contended that what Barbosa taught was inconsistent with the ’748 Patent, which distinguished an “automatic” transfer from one that occurred “upon direction of the user.” *Id.* Quoting the specification, Plaintiff argued the following:

Consider the word “automatic” as it is used in the ‘748 Patent. See EX1001, 9:62-67 (emphasis added): “This transfer may optionally occur automatically, or upon direction of the user as specified by the client during the creation of the form.”

Id. at 20 (emphasis in original). Plaintiff argued that the “user initiated” synchronizations were not “automatic” as required by the ‘748 Patent, because Barbosa taught that synchronization “may” or “may not” occur depending on whether a user chooses to initiate it. *Id.* at 22.

Plaintiff similarly distinguished Hancock because it also required the user to direct the system to make the transfer:

Hancock fails to teach the automatic transfer of the questionnaire to the recipient device. Figure 18 of Hancock explains why this is so. That figure begins with the client connecting to the server (step 1802). If the Go2 software is not already on the client, i.e., if “Existing Data Packet?” is “NO” (step 1804), then the server offers to send the Go2 application to the client (step 1806). “If it is determined in step 1804, that a data packet is not available, control passes to step 1806. In step 1806 the user is offered an opportunity to download the Go2 Application software 15000.” EX 1003, 30:40-46. Then *only if* the client accepts the offer, the Go2 software is transmitted to the client and installed. This is not “automatically transferring said designed questionnaire” as [is] required by step 7(b).

Id. at 26-27 (emphasis in original).

Upon a careful review of the submitted evidence, the Court finds that Defendants’ arguments fail to meet the high standard to justify a disclaimer. *Avid Tech., Inc. v. Harmonic, Inc.*, 812 F.3d 1040, 1045 (Fed. Cir. 2016) (“When the prosecution history is used solely to support a conclusion of patentee disclaimer, the standard for justifying the conclusion is a high one.”). Contrary to Defendants’ contention, Plaintiff was not making a sweeping disclaimer of any transfer that was somehow caused by a person. Instead, Plaintiff distinguished the prior art because the transfers were initiated upon direction of the user, and thus, were not “automatic.” Defendants failed to show that the alleged disavowal was both clear and unmistakable. *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325-26 (Fed. Cir. 2003) (“[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution

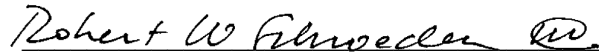
be both clear and unmistakable.”). Accordingly, the Court adopts Plaintiff’s construction, and rejects Defendants’ construction.

For the reasons set forth above, the Court construes the term “**automatically transferring**” to mean “**transferring that is not initiated upon direction of the user.**”

V. CONCLUSION

The Court adopts the constructions above for the disputed terms of the Asserted Patent. Furthermore, the parties should ensure that all testimony that relates to the terms addressed in this Order is constrained by the Court’s reasoning. However, in the presence of the jury, the parties should not expressly or implicitly refer to each other’s claim construction positions and should not expressly refer to any portion of this Order that is not an actual construction adopted by the Court. The references to the claim construction process should be limited to informing the jury of the constructions adopted by the Court.

SIGNED this 23rd day of January, 2023.


ROBERT W. SCHROEDER III
UNITED STATES DISTRICT JUDGE