

MICROSOFT CORPORATION

ORDER RE CLAIM CONSTRUCTION

In their written memoranda, the parties disagree regarding the meaning of the following terms contained in Claim 1 of the '853 patent:

"Upon a single entry of the execute command" and

"Analyzing the document to determine if the first information is contained therein."

During oral argument, the parties agreed that "upon" means "on or immediately or very soon after" and that "first information" refers to text in the document that is entered by a user. The remaining dispute with respect to claim construction focuses on:

1. What is meant by "the execute command"?
2. Whether the claim covers a method requiring the user to select particular text in the document before the document is analyzed and a search for first information is conducted.

This Court has carefully reviewed the '853 patent and its prosecution history bearing in mind the following principles of claim construction.

1. Claim terms generally should be construed to have their ordinary and customary meaning unless a different meaning is given to them by the patentee and indicated with reasonable clarity and precision in the patent or its prosecution history. K-2 Corp. v. Salmon S.A., 191 F.3d 1356, 1362-63 (Fed. Cir. 1999); Nothern Telecom Ltd. v. Samsung Elecs. Co., 215 F.3d 1281, 1295 (Fed. Cir. 2000).
2. Technical terms generally are construed to have the meaning that would be attributed to them by one of ordinary skill in

ambiguities in the meaning of the terms used and to determine whether the patentee has used any claim terms in a manner that would be inconsistent with their ordinary and customary meaning. Watts v. XL Sys., 232 F.3d 877, 883 (Fed. Cir. 2000); Interactive Gift Express v. Compuserve, 256 F.3d 1323, 1331-32 (Fed. Cir. 2001).

4. The prosecution history may be consulted for the purpose of determining whether the patentee clearly disavowed a particular interpretation of a claim. Amgen, Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1327 (Fed. Cir. 2003); Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1313 (Fed. Cir. 2002).

Based on a review in accordance with those principles; and, for the reasons stated below, this Court hereby construes the disputed terms of claim 1 as follows:

1. "the execute command" means the execute command referred to in the preceding element of claim 1 as "an execute command which initiates a record retrieval from an information source."
2. "input device" means a device that allows a user to provide input into a computer system.
3. "the input device" means the input device referred to in the preceding element of Claim 1 as "an input device configured to enter an execute command which initiates a record retrieval program." It includes a menu choice or selection because:
 - a. The patent specification specifically refers to "input device" as including a "menu choice." Column 3, Lines 41-43.
 - b. The abstract refers to the function item that initiates the retrieval process as including "selection in a menu."
4. "Entry of the execute command" may be accomplished by clicking on or selecting a menu choice.
5. "upon a single entry of the execute command" means that:
 - a. analysis of the document to determine if it contains

accenting it, highlighting it, or otherwise selecting it.

Text selection by the user was clearly disavowed by Arendi during prosecution of the patent as demonstrated by the following:

- i. On April 25, 2000, Arendi's initial application was rejected as unpatentable, in part, because the Pandit patent provided for the use of pull-down menus to select operations or programs that may be used in connection with "text accented, highlighted or otherwise indicated." Hedloy Examiner's Detailed Action (April 25, 2000) ¶ 5 (quoting Pandit, U.S. Patent No. 5,859,636, col. 2 line 34).
- ii. On June 12, 2000, Arendi's representative responded by distinguishing Pandit on the ground that "in Pandit, the user must accent text, prior to recognizing the text, whereas in the present invention, the step of entering the execute command does not include highlighting or selecting the text, or first information." Hedloy Examiner's Interview Summary (June 14, 2004). The Examiner noted that "[a]n amendment [would] be submitted which includes this difference." Id.
- iii. On July 27, 2000, Arendi followed up by amending its application to add the words "upon a single entry of" before the words "the execute command." Hedloy Amendment (July 27, 2000).
- iv. On September 18, 2000, the examiner rejected the amended application on the ground that it was anticipated by the Tso patent (U.S. Patent No. 6,085,201). Hedloy Examiner's Detailed Action (September 18, 2000).
- v. On October 17, 2000, Arendi's representative attempted to distinguish Tso on the ground

- vi. On December 18, 2000, Arendi further amended its application to add the words "analyzing the document to determine if the first information is contained therein, and if the first information is contained in the document". Hedloy Amendment (December 18, 2000). Arendi's representative explained the amendment as clarifying that "the invention does not require the user to select a text string to be processed since it functions automatically upon a single click of an input device." Id.
 - vii. On January 2, 2001, the examiner allowed the application stating that "[i]n Tso, the text string to be processed is determined by the current cursor position as specified by the user . . . whereas the present invention 'does not require the user to select the text string to be processed since it functions automatically upon a single click of an input device' to determine if the first information is contained within the document." Hedloy Examiner's Reasons for Allowance (January 2, 2001).
6. "first information" means text in the document that is entered by a user and can be used by the record retrieval program to search sources external to the document for second information associated with the first information.

IT IS SO ORDERED.


Ernest C. Torres
Chief Judge

Date: Sept. 27, 2004