UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION

PARAGON SOLUTIONS, LLC — CASE NO. 1:06cv677

Plaintiff — Judge Barrett

-vs-

TIMEX CORPORATION

Defendant

OPINION AND ORDER

This matter came on for hearing on October 16, 2007. The Parties previously filed their Joint Claim Construction Statement (Doc. 25) with the Court on August 20, 2007. The Parties are engaged in the competitive field of athletic training support devices. They manufacture and promote fitness products that are conceived to provide anatomic and metabolic feedback to athletes in training. Both companies seek to promote themselves as delivering up-to-the-second information regarding athletic performance. The competitive edge belongs to the supplier who can provide more comfortable and more easily adaptable equipment with faster results for the end user.

Paragon's patent at issue is *Stubbs*, et al U.S. 6,736,759 (the '759 patent[1]). Both Parties agree that the first step in resolving patent disputes is to determine the meaning and scope of the patent claims alleged to be infringed upon; and that this is the function of the Court. "A literal patent infringement analysis involves two steps: the proper

[1] The *Stubbs* Patent (May 18, 2004) is assigned to Paragon Solutions, LLC. and is an exercise monitoring system which includes electronic positioning device, physiological monitor and a display unit configured for displaying data provided by the electronic positioning device and the physiological monitor.

construction of the asserted claims and a determination as to whether the accused method or product infringes the asserted claims properly construed." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). The Parties submitted a Joint Claim Construction Statement Chart of Agreed and Disputed Terms (Doc. 25), which the Court will follow in its analysis.

CLAIM LANGUAGE:

1. An exercising monitoring system comprising: (a) a [1] ***data acquisition unit*** comprising an [2] ***electronic positioning device*** and a [3] ***physiological monitor***, said data acquisition unit configured to be worn by a ***subject*** performing a physical activity;

The Parties agree on the construction of **electronic positioning device, physiological monitor** and **subject**.

DISPUTED TERM:

[1] DATA ACQUISITION UNIT:
(Claim 1,6,8,9,10, 11, 23, 29 and 31)

PARAGON'S PROPOSED CONSTRUCTION:

[1] The terminology "data acquisition unit" means an assemblage of inter-related components that unify the function of acquiring data from an electronic positioning device and a physiological monitor (col. 3, lines 16-18 and lines 20-22; col. 7, lines 55-61; col. 8, lines 608 and lines 37-40; col. 17, lines 18-19; Figs. 4,6,8 and 15.

TIMEX'S PROPOSED CONSTRUCTION:

[1] "data acquisition unit" means one structure that includes the electronic positioning device and the physiological monitor. (Specification, Col. 8, Line 66 to Col. 9, Line 6; Figure 5; and the Prosecution History, including the: (1) Feb. 12, 2003 Office Action, and (2) July 14, 2003 Response).

Paragon relies on the specifications while Timex relies on the prosecution history.

Paragon directs the Court to the various references and specifications that suggest that the data acquisition component/unit may be part of multiple structures that are physically separate from each other; and provides the Court with various references within the specifications to support this position. The patent claims do not stand alone but are part of a fully integrated written instrument consisting principally of the specification that concludes with the claims. Acquiring the claims must be read in view of the specification of which they are a part. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005); *Vitronics Corp. v. Conceptronic, Inc.,* 90 F.3d 1576, 1582 (Fed. Cir. 1996). Claims are generally given their ordinary and customary meaning in accordance with a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.,* 415 F.3d at 1312-1313. Patents are addressed and intended to be read by others of skill in the pertinent art. *Id.* at 1313.

Timex cites the Court to the prosecution history. "It is well settled that in interpreting an asserted claim the Court should look first to the intrinsic evidence of record, *i.e*., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." *Vitronics Corp.,* 90 F.3d at 1582, *citing Markman,* 52 F.3d at 979. The prosecution history is often of critical significance in determining the meaning of claims. *Victronics*, 930 F.3d at 1583.

The PTO examiner initially found the '759 claims to be anticipated or obvious in light of *Root*, *et al*. (U.S. Patent 6,013,007 attached to Doc. 21 as Exhibit 1 [2]) and therefore

[2] The *Root* patent (January 11, 2000) is assigned to Liquid Spark, LLC and is a global positioning system (GPS) based personal athletic performance monitor for providing the athlete with real time athletic performance feedback data such as elapsed exercise time, distance covered, average pace, elevation difference, distance to go and/or advice for reaching preset targets.

rejected Paragon's language. The PTO noted that *Root*, *supra,* disclosed an electronic positioning device, a physiological monitor and display unit (Doc. 21, Ex. 2, M-4), which this Court concludes would be an assemblage of inter-related components. Paragon specifically amended Claim One to require that the electronic positioning device and psychological monitor are provided as a "data acquisition unit" to be worn by the subject. (Doc. 21, Ex. 2, P. 5). A further description indicates that the data acquisition unit is a single structure and that the electronic positioning device would likewise be a single structure which is separate from the display unit. The patentee further distinguishes itself from the *Root* patent by separating the data acquisition unit from the display unit which in *Root* are apparently provided in a single unit.

Often the Court can assume that the words in a patent claim must be used in the same way as they are used in the specification. *Fonar Corp. v. Johnson & Johnson,* 821 F.2d 627 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1027 (1988); *Terlep v. Brinkmann Corp.*, 418 F.3d 1379 (Fed. Cir. 2005); *Victronics Corp.,* 90 F.3d at 1582. However, the prosecution history must also be considered in interpreting claims. *Markman*, 52 F.3d at 980, *Victronics Corp.*, 90 F.3d at 1582. Claim amendments and arguments made during the prosecution may be examined to determine the meaning of the terms and the claims. *Phillips.,* 415 F.3d at 1317. Claim limitations may be construed to exclude a preferred embodiment if the prosecution has compelled such a result. *North American Container v. Plastipak Packaging, Inc., et al.* 415 F.3d 1335, 1346 (Fed. Cir. 2005). Therefore, claims should not be construed one way to obtain allowance and in a different way against accused offenders "if the inventor had disavowed or disclaimed scope of coverage by using words or expressions of manifest exclusion or restriction representing a clear disavowal of

claim scope". *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002). If interpretation of a claim was disclaimed during the prosecution, that interpretation may be excluded by the Court. *Southwall Technologies, Inc. v. Cardinal IG Company*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

Prosecution disclaimer is an accepted concept in claim construction where the disavowal is unambiguous. *Elbex Video Ltd. v. Sensormatic Electronics Corp.*, 508 F.3d 1366, 1372-1373 (Fed. Cir. 2007). In this case, Paragon was responding directly to the PTO's notification of problems due to the preexisting *Root* patent. Correspondence between the PTO and the patentee clearly and unmistakably disavows the concept of an assemblage of inter-related parts and embraces a single structure unit concept.

Therefore, the Court concludes that "**data acquisition unit**" means one structure that includes the electronic positioning device and the physiological monitor.

CLAIM LANGUAGE:

(b)[5] ***a display unit*** configured [6] ***for*** [7] ***displaying real-time data*** provided by said electronic positioning device and said physiological monitor, said display unit [8] ***separate from said data acquisition unit***

DISPUTED TERM

[5] - A DISPLAY UNIT
(Claim 1, 10, 11, 18, 20, 22, 23, 29 and 32)

PARAGON'S PROPOSED CONSTRUCTION:

[5] The terminology "a display unit" means an assemblage of inter-related components that unify the function of displaying data from the electronic positioning device and the physiological monitor. (Col. 7, lines 61-62; col. 8, lines 4-5).

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