

# In the United States Court of Federal Claims

No. 19-859

(Filed: 29 February 2024)

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E-NUMERATE SOLUTIONS, INC., and  
E-NUMERATE, LLC,

Plaintiffs,

v.

THE UNITED STATES,

Defendant.

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Claim Construction; *Markman* Hearing;  
Indefiniteness; Antecedent Basis;  
Means-Plus-Function

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*Sean T. O’Kelly*, with whom was *Gerard M. O’Rourke*, O’Kelly & O’Rourke, LLC, both of Wilmington, DE, for plaintiffs.

*Shahar Harel*, Trial Attorney, Intellectual Property Section, with whom were *Carrie Rosato*, Trial Attorney, *Scott Bolden*, Of Counsel, *Nelson Kuan*, Of Counsel, *Gary L. Hausken*, Director, Commercial Litigation Branch, and *Brian M. Boynton*, Principal Deputy Assistant Attorney General, Civil Division, U.S. Department of Justice, all of Washington, DC, for defendant.

## CLAIM CONSTRUCTION OPINION AND ORDER

**HOLTE, Judge.**

Plaintiffs e-Numerate Solutions, Inc. and e-Numerate, LLC accuse the government of patent infringement. The government argues eighteen claim terms in four asserted patents are indefinite pursuant to 35 U.S.C. § 112 or must be construed pursuant to § 112, paragraph 6. While the parties raised numerous terms for construction, the Court’s procedures for claim construction, modeled after the rules of Judge Alan Albright of the United States District Court for the Western District of Texas, aided the Court in efficiently handling this claim construction.<sup>1</sup> The Court previously issued a claim construction opinion and order construing disputed terms not implicated by the government’s indefiniteness arguments,<sup>2</sup> following agreement by the parties at a status conference to split the *Markman* hearing into two days.<sup>3</sup> The Court then held a

<sup>1</sup> See also *Haddad v. United States*, 164 Fed. Cl. 28 (2023); *Giesecke & Devrient GmbH v. United States*, 163 Fed. Cl. 430 (2023); *Wanker v. United States*, 152 Fed. Cl. 219 (2021); *Thales Visionix, Inc. v. United States*, 150 Fed. Cl. 486 (2020); *CellCast Techs., LLC v. United States*, 150 Fed. Cl. 353 (2020).

<sup>2</sup> *e-Numerate Sols., Inc. v. United States*, 165 Fed. Cl. 237 (2023).

<sup>3</sup> 7 Oct. 2022 Status Conference Tr. (“SC Tr.”) at 101:14–19, ECF No. 100 (“THE COURT: So the Court hopes to divide the *Markman* hearing into two days with . . . the terms in day one, as much as we can get through them, and

second *Markman* hearing to construe the disputed terms related to indefiniteness. This Claim Construction Opinion and Order construes the parties' disputed terms implicating indefiniteness. For the reasons below, the Court finds: Terms 1 and 2 have antecedent basis in their respective independent claims and are not indefinite; Terms 3 and 4 are not indefinite because the means-plus-function terms are supported by algorithmic disclosure; and Terms 5, 6, and 7, as means-plus-function terms, are indefinite for lack of disclosed structure. Additionally, Terms 8–16 recite “code for,” and the parties dispute whether the language should invoke means-plus-function interpretation under § 112, paragraph 6. The parties both agreed a term reciting “code for” and a term reciting “means for,” may have different definiteness conclusions, despite reciting the same functions. In this context, the Court finds the government has not met its burden to prove “code for” invokes § 112, paragraph 6. As the indefiniteness arguments for Terms 8–16 rely solely on interpreting the terms as means-plus-function, the Court accordingly finds Terms 8–16 definite. Based on the conclusions for each of these terms, and for the reasons below, the Court accordingly finds claim 26 of the '816 Patent and claim 18 of the '383 Patent invalid as indefinite.

## I. Overview of Claims<sup>4</sup>

The Court outlined the patents and claims at issue in its first claim construction Order. *See e-Numerate Sols., Inc. v. United States*, 165 Fed. Cl. 237, 244–58 (2023). Prior to the second *Markman* hearing, the parties filed supplemental briefing on three additional terms which the government alleges are indefinite. *See* Def.'s Suppl. Claim Constr. Br. on Indefiniteness (“Gov't's Suppl. Indef. Br.”), ECF No. 111; Pl.'s Br. in Opp'n to Gov't's Suppl. Claim Constr. Br. (“Pl.'s Suppl. Indef. Br.”), ECF No. 112. The claims at issue in this indefiniteness claim construction Order are:

- U.S. Patent No. 7,650,355, claim 15 (Term 1), claim 42 (Term 1);
- U.S. Patent No. 8,185,816, claim 12 (Term 2), claim 26 (Terms 3 and 5);
- U.S. Patent No. 9,262,383, claim 1 (Terms 8–10), claim 18 (Terms 4, 6, and 7); and
- U.S. Patent No. 9,268,748, claim 11 (Terms 11–18).

## II. Applicable Law<sup>5</sup>

### A. Indefiniteness

“A patent shall be presumed valid. . . . The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” 35 U.S.C. § 282(a). Issued patents grant the patentee “certain exclusive rights,” which may be enforced through civil actions for infringement pursuant to 35 U.S.C. § 271. *Microsoft Corp. v. I4I Ltd. P'ship*, 564 U.S. 91,

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then in day two, indefiniteness. Does that make the most sense? [THE GOVERNMENT]: Yes. [PLAINTIFFS]: Yeah.”).

<sup>4</sup> For the factual and procedural history of the case as well as a summary of the technology of the asserted patents, refer to the Court's first Claim Construction Opinion and Order. *See e-Numerate Sols., Inc. v. United States*, 165 Fed. Cl. 237, 243–46 (2023).

<sup>5</sup> For the law of claim term interpretation, refer to the Court's first Claim Construction Opinion and Order. *See e-Numerate Sols., Inc. v. United States*, 165 Fed. Cl. 237, 258–59 (2023).

96 (2011). In the previous claim construction Order, the Court outlined the applicable law for claim construction generally. *e-Numerate Sols. v. United States*, 165 Fed. Cl. 237, 258–60 (2023).

This claim construction Order solely addresses indefiniteness. “[I]ndefiniteness is a question of law and in effect part of claim construction.” *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir. 2012). “Indefiniteness must be proven by clear and convincing evidence.” *Sonix Tech. Co. v. Publ’ns Int’l, Ltd.*, 844 F.3d 1370, 1377 (Fed. Cir. 2017). A patent specification must conclude with claims distinctly pointing out the subject matter of the invention. 35 U.S.C. § 112, ¶ 2.<sup>6</sup> Patent claims must apprise “a skilled artisan [of] the scope of the claimed invention with reasonable certainty.” *Sonix Tech. Co.*, 844 F.3d at 1376. If the claim language fails to apprise a skilled artisan with reasonable certainty, the patent claim is indefinite under § 112, paragraph 2. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). The incorporation of general knowledge “sufficiently well established in the art and referenced in the patent” will help render a claim definite. *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, 875 F.3d 1369, 1377 (Fed. Cir. 2017).

Claim construction may contain indefiniteness inquiries, but other invalidity arguments under § 112, such as lack of enablement or lack of adequate written description, are separate and distinct. *See ePlus, Inc.*, 700 F.3d at 517; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1327 (Fed. Cir. 2005) (“[W]e have certainly not endorsed a regime in which validity analysis is a regular component of claim construction.”); *see also Metabolite Lab’ys, Inc. v. Lab’y Corp. of Am. Holdings*, 370 F.3d 1354, 1361 (Fed. Cir. 2004); *Sw. Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1297–98 (Fed. Cir. 2000). Despite invalidity conceptually overlapping with indefiniteness, parties must use the proper standard when arguing invalidity. *See, e.g., Augme Techs., Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1340 (Fed. Cir. 2014) (“Appellants’ arguments appear to be based on the wrong legal standard, i.e., written description or enablement as opposed to indefiniteness.”); *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1358 n.2 (Fed. Cir. 1999) (“[D]efiniteness and enablement are analytically distinct requirements [of validity], even though both concepts are contained in 35 U.S.C. § 112.”).

## B. Means-Plus-Function Claims

Patent claims may be directed to a combination comprising a series of elements. “A patentee may express an ‘element in a claim for a combination’ ‘as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof.’” *HTC Corp. v. IPCom GmbH & Co., KG*, 667 F.3d 1270, 1278 (Fed. Cir. 2012) (quoting 35 U.S.C. § 112, para. 6). Known as means-plus-function claiming, this claim drafting technique pursuant to § 112, paragraph 6 results in a claim construction covering “the

<sup>6</sup> The paragraphs of 35 U.S.C. § 112 were replaced with newly designated subsections when the America Invents Act (AIA), Pub. L. No. 112–29, took effect on 16 September 2012. The four asserted patents the government argues implicate indefiniteness in this case all claim a priority date before the AIA was enacted, so the Court refers to the pre-AIA version of § 112. *See e-Numerate Sols., Inc. v. United States*, 165 Fed. Cl. 237, 261 (2023) (“The government suggested the Court clarify HTML, XML, and SGML predate 21 May 1999, the priority date claimed for all asserted patents except the ‘842 Patent, and plaintiffs agreed.” (emphasis added)).

corresponding structure, material, or acts described in the specification and equivalents thereof.” 35 U.S.C. § 112, para. 6.

The presence of the word “means” creates a rebuttable presumption indicating invocation of § 112, paragraph 6 but is not the “essential inquiry” in “assess[ing] . . . whether the limitation in question is a means-plus-function term.” See *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). Instead, the analysis turns on “whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Id.* Sufficient structure is recited “if the claim term is used in common parlance or by persons of skill in the pertinent art to designate structure, even if the term covers a broad class of structures and even if the term identifies the structures by their function.” *Skky, Inc. v. MindGeek, S.A.R.L.*, 859 F.3d 1014, 1019 (Fed. Cir. 2017) (quoting *TecSec, Inc. v. Int’l Bus. Machs. Corp.*, 731 F.3d 1336, 1347 (Fed. Cir. 2013)). If both the claim and the specification fail to disclose sufficient structure to perform the claimed function, then the claim is indefinite. *Williamson*, 792 F.3d at 1352.

### III. Disputed Claim Term #1: “the step of receiving”

Plaintiffs’ Proposed Construction	Defendant’s Proposed Construction
Not indefinite. In claim 15, the step referred to is “receiving a series of numerical values having tags indicating characteristics of the numerical values” in claim 1. In claim 42, the step referred to is “receiving a series of numerical values having tags indicating characteristics of the numerical values” in claim 28.	Indefinite.

The government disputes the construction of this claim term in claims 15 and 42 of the ’355 Patent. Rev. Joint Cl. Constr. Statement Ex. A (“Rev. J. Cl. Constr.”) at 6.

The following claim limitation highlights selected usage of the term in context:

wherein *the step of receiving* comprises receiving tags indicating characteristics selected from the group consisting of: (1) value, (2) semantics, (3) format, (4) measurement, (5) structure, and (6) provenance.

’355 Patent col. 57 ll. 34–37 (emphasis added).

#### A. Parties’ Arguments

The parties’ primary dispute is whether “the step of receiving” has antecedent basis in one of two terms in the corresponding independent claim. Specifically, claim 1 and claim 28 of the ’355 Patent recite both “receiving a series of numerical values having tags indicating characteristics of the numerical values” and “receiving a macro defined to perform an operation on the series of numerical values.” ’355 Patent col. 56 ll. 36–56, col. 58 ll. 46–67. Plaintiffs

argue “the phrase in the dependent claim refers to the first receiving step: ‘receiving a series of numerical values having tags indicating characteristics of the numerical values’” because “[t]hat [antecedent] phrase explicitly refers to ‘tags indicating characteristics,’” as the dependent claims do. Pls.’ Opening Claim Constr. Br. on Indefiniteness (“Pls.’ Indef. Br.”) at 11–12, ECF 79. According to plaintiffs “[t]here is simply no reason that a person [having] ordinary skill in the art [(PHOSITA)] would think that the limitations of claims 15 and 42 would (or could) refer to” the other “receiving” step, because the other “receiving” step addresses only the macro, not tags and their characteristics. *Id.* at 12. Plaintiffs assert the limitations at the end of independent claims 1 and 28—“the step of receiving the macro comprises . . .”—see ’355 Patent col. 56 ll. 50–56, col. 58 ll. 60–67, further supports a lack of ambiguity in the dependent claims because the macro “receiving” step is already clarified. Pls’ Indef. Br. at 12. e-Numerate’s expert proposes the Court read the phrase in the dependent claim as referring to the first receiving step; in other words, reading “receiving a series of numerical values having tags indicating characteristics of the numerical values,” as explicitly referring to “tags indicating characteristics of numerical values.” Decl. of Michael Smith (“Smith Decl.”) ¶ 37, ECF No. 81-9. Additionally, e-Numerate’s expert testifies “claims 15 and 42 further limit the characteristics recited in that phrase in the independent claims” and, accordingly, a PHOSITA would readily understand such. *Id.*

The government argues the claim term could plausibly refer to the macro “receiving” step instead, because independent claims 1 and 28 require the macro to include meta-data, which “may include information such as the source of the macro[] and correspond to the provenance characteristic recited in [c]laims 15 and 42.” Def.’s Responsive Claim Constr. Br. on Indefiniteness (“Gov’t’s Resp. Indef. Br.”) at 8, ECF No. 83. The government further cites as support the inclusion of a “macro source” element and a “line item” in the “Document Type Definition” (DTD) disclosed in the ’355 Patent specification. *Id.* at 8–9. The government asserts the claim term could also refer to the first “receiving” step from independent claims 1 and 28, so the term is ambiguous and therefore indefinite. *Id.* at 9. The government proffers its expert’s opinion “a P[H]OSITA could not reasonably determine the scope of the ‘step of receiving’ limitation of claims 28 and 42.” *Id.* The government’s expert contends “it remains unclear which is the proper antecedent basis for the term ‘the step of receiving comprises receiving tags’ as recited in claims 15 and 42 as it could refer to either the first or second ‘receiving’ clause in the relevant independent claim.” Martin Decl. ¶ 45, ECF No. 81-7.

Plaintiffs contend the government’s expert’s “opinion is not consistent with the clear meaning of the claim language involved and should be disregarded.” Pls.’ Indef. Br. at 12 (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005)). Additionally, plaintiffs reply, the government’s “construction is contrary to the natural and logical reading of the claim language itself and should be rejected.” Pls.’ Reply Claim Constr. Br. on Indefiniteness (“Pls.’ Reply Indef. Br.”) at 3–4, ECF No. 89 (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (“[A] claim construction analysis must begin and remain centered on the claim language itself, for that is the language the patentee has chosen to particularly point[] out and distinctly claim[] the subject matter which the patentee regards as his invention.” (internal quotation marks omitted) (citation omitted))). Plaintiffs further argue: “The issue is not how claims *could* be read, but rather how they *would* be read from the perspective of a” PHOSITA. Pls.’ Sur-Reply Claim Constr. Br. on Indefiniteness (“Pls.’ Sur-Reply Indef. Br.”)

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