

405 F.Supp.2d 731, 2005 Markman 3481372
(Cite as: 405 F.Supp.2d 731)

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United States District Court,
E.D. Texas,
Marshall Division.
TRILOGY SOFTWARE, INC.
v.
SELECTICA, INC.
Civ.A. No. 2:04-CV-160.

Dec. 20, 2005.

Background: Owner of patents for product configuration and pricing software sued competitor for infringement. Competitor counterclaimed for infringement of its own patents.

Holdings: Construing claims, the District Court, Ward, J., held that:

- (1) product and part “relationships” were not limited to tables and bit vectors described in preferred embodiment;
- (2) “organizational groups” were groups of purchasing organizations where each group had characteristic;
- (3) means-plus-function claim was invalid for indefiniteness; and
- (4) “light client” was standalone Internet-capable device having relatively less bandwidth capability than desktop computer.

Claims construed.

West Headnotes

[1] Patents 291 🔑314(5)

291 Patents

291XII Infringement

291XII(C) Suits in Equity

291k314 Hearing

291k314(5) k. Questions of law or fact. [Most Cited Cases](#)

Patent claim construction is issue of law for court to decide.

[2] Patents 291 🔑165(3)

291 Patents

291IX Construction and Operation of Letters Patent

291IX(B) Limitation of Claims

291k165 Operation and Effect of Claims in General

291k165(3) k. Construction of language of claims in general. [Most Cited Cases](#)

Patents 291 🔑167(1)

291 Patents

291IX Construction and Operation of Letters Patent

291IX(B) Limitation of Claims

291k167 Specifications, Drawings, and Models

291k167(1) k. In general. [Most Cited Cases](#)

Patents 291 🔑168(2.1)

291 Patents

291IX Construction and Operation of Letters Patent

291IX(B) Limitation of Claims

291k168 Proceedings in Patent Office in General

291k168(2) Rejection and Amendment of Claims

291k168(2.1) k. In general. [Most Cited Cases](#)

To ascertain meaning of patent claims, court looks to three primary sources: claims, specification, and prosecution history.

[3] Patents 291 🔑167(1)

291 Patents

291IX Construction and Operation of Letters Patent

291IX(B) Limitation of Claims

291k167 Specifications, Drawings, and

Models

291k167(1) k. In general. [Most Cited](#)

Cases

Patent's claims must be read in view of specification, of which they are part.

[4] Patents 291  **165(2)**

291 Patents

291IX Construction and Operation of Letters


Patent

291IX(B) Limitation of Claims

291k165 Operation and Effect of Claims

in General

291k165(2) k. Claims as measure of patentee's rights. [Most Cited Cases](#)

Patents 291  **167(1.1)**

291 Patents

291IX Construction and Operation of Letters

Patent


291IX(B) Limitation of Claims

291k167 Specifications, Drawings, and

Models

291k167(1.1) k. Specification as limiting or enlarging claims. [Most Cited Cases](#)

It is function of claims, not specification, to set forth the limits of patentee's claims.

[5] Patents 291  **162**

291 Patents


291IX Construction and Operation of Letters

Patent

291IX(A) In General

291k162 k. Contemporaneous construction of inventor. [Most Cited Cases](#)

Patentee is free to be his or her own lexicographer, but any special definition given to word must be clearly set forth in specification.

[6] Patents 291  **167(1.1)**

291 Patents

291IX Construction and Operation of Letters

Patent


291IX(B) Limitation of Claims

291k167 Specifications, Drawings, and

Models

291k167(1.1) k. Specification as limiting or enlarging claims. [Most Cited Cases](#)

Although patent specification may indicate that certain embodiments are preferred, particular embodiments appearing in specification will not be read into claims when claim language is broader than embodiments.

[7] Patents 291  **157(1)**

291 Patents

291IX Construction and Operation of Letters

Patent

291IX(A) In General

291k157 General Rules of Construction

291k157(1) k. In general. [Most Cited](#)

Cases

Words used in patent claim are generally given their ordinary and customary meaning, i.e., meaning that words would have to person of ordinary skill in art in question on effective filing date of patent application.

[8] Patents 291  **167(1)**

291 Patents

291IX Construction and Operation of Letters

Patent

291IX(B) Limitation of Claims

291k167 Specifications, Drawings, and

Models

291k167(1) k. In general. [Most Cited](#)

Cases

It is proper in all cases to refer back to descriptive portions of patent specification to aid in solving doubt or in ascertaining true intent and meaning of language employed in claims.

[9] Patents 291  **168(2.1)**

291 Patents

291IX Construction and Operation of Letters

Patent

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[291IX\(B\) Limitation of Claims](#)

[291k168](#) Proceedings in Patent Office in General

[291k168\(2\)](#) Rejection and Amendment of Claims

[291k168\(2.1\)](#) k. In general. [Most](#)

[Cited Cases](#)

Prosecution history is relevant to determination of how inventor understood invention and whether inventor limited invention during prosecution by narrowing scope of patent claims.

[\[10\] Patents 291](#)  [159](#)

[291](#) Patents


[291IX](#) Construction and Operation of Letters Patent

[291IX\(A\)](#) In General

[291k159](#) k. Extrinsic evidence in general.

[Most Cited Cases](#)

Role of dictionary definitions when construing patent claim terms is subordinate to intrinsic record.

[\[11\] Patents 291](#)  [167\(1.1\)](#)

[291](#) Patents


[291IX](#) Construction and Operation of Letters Patent

[291IX\(B\)](#) Limitation of Claims

[291k167](#) Specifications, Drawings, and Models

[291k167\(1.1\)](#) k. Specification as limiting or enlarging claims. [Most Cited Cases](#)

Product and part “relationships,” called for in patent for product configuration software, were not limited to tables and bit vectors described in preferred embodiment.

[\[12\] Patents 291](#)  [101\(2\)](#)

[291](#) Patents

[291IV](#) Applications and Proceedings Thereon


[291k101](#) Claims

[291k101\(2\)](#) k. Construction in general.

[Most Cited Cases](#)

“Product relationship,” called for in patent for

product configuration software, was association between product and one or more parts, with product representing left-hand side of relationship, and set of parts representing right-hand side of the relationship.

[\[13\] Patents 291](#)  [101\(2\)](#)

[291](#) Patents


[291IV](#) Applications and Proceedings Thereon

[291k101](#) Claims

[291k101\(2\)](#) k. Construction in general.

[Most Cited Cases](#)

“Part relationships,” called for in patent for product configuration software, were associations that existed between first set of parts and second set of parts, with first set representing left-hand side of relationship and second set representing right-hand side of relationship.

[\[14\] Patents 291](#)  [101\(2\)](#)

[291](#) Patents


[291IV](#) Applications and Proceedings Thereon

[291k101](#) Claims

[291k101\(2\)](#) k. Construction in general.

[Most Cited Cases](#)

“Includes classification,” called for in patent for product configuration software, was classification in which second set of one or more elements was included when all members of first set of one or more elements existed in configuration.

[\[15\] Patents 291](#)  [101\(2\)](#)

[291](#) Patents


[291IV](#) Applications and Proceedings Thereon

[291k101](#) Claims

[291k101\(2\)](#) k. Construction in general.

[Most Cited Cases](#)

“Configuration state,” referred to in patent for product configuration software, was status of elements in current configuration.

[\[16\] Patents 291](#)  [101\(2\)](#)

[291](#) Patents

291IV Applications and Proceedings Thereon**291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“Includes relationship,” called for in patent for product configuration software, was relationship that caused elements on right-hand side of relationship to be included in configuration when all elements of left-hand side of relationship were already included.

[17] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon****291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“Excludes relationship,” called for in patent for product configuration software, was relationship that caused elements of right-hand side of relationship to be excluded when all elements of left-hand side were already included.

[18] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon****291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“Requires choice relationship,” called for in patent for product configuration software, was relationship in which number of elements had to be chosen from second set of elements on right-hand side of relationship when all elements of left-hand side were already included.

[19] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon****291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“Removed relationship,” called for in patent for

product configuration software, was relationship that caused elements of right-hand side of relationship to be removed when all elements of left-hand side were already included.

[20] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon****291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“Optional relationship,” called for in patent for product configuration software, was relationship in which number of elements could be chosen from second set of elements on right-hand side of relationship when all elements of left-hand side were already included.

[21] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon****291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“Active relationship,” called for in patent for product configuration software, was relationship in which all elements on left-hand side of relationship were selected.

[22] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon****291k101 Claims**

291k101(2) k. Construction in general.

Most Cited Cases

“NotActivatable relationship,” called for in patent for product configuration software, was relationship in which selection of certain left-hand side items resulted in invalid configuration state.

[23] Patents 291 ↪101(2)**291 Patents****291IV Applications and Proceedings Thereon**

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291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

Corresponding structure for “means for obtaining user input,” called for in patent for product pricing software, was general purpose computer, including keyboard or mouse. 35 U.S.C.A. § 112, ¶ 6.

[24] Patents 291 ↪101(2)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

Corresponding structure for “means for analyzing at least one selected element,” called for in patent for product pricing software, was general purpose computer programmed to perform steps of algorithm disclosed by relevant flow diagram. 35 U.S.C.A. § 112, ¶ 6.

[25] Patents 291 ↪101(2)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

“Organizational groups,” called for in patent for product configuration software, were groups of purchasing organizations where each group had characteristic.

[26] Patents 291 ↪101(6)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(6) k. Ambiguity, uncertainty or indefiniteness. **Most Cited Cases**

Claim in patent for product configuration software was invalid for indefiniteness, where specification failed to disclose sufficient structure corresponding to its “means for arranging” limitation; disclosed screen shot was insufficient representation of relev-

ant algorithm. 35 U.S.C.A. § 112, ¶¶ 2, 6.

[27] Patents 291 ↪101(2)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

“Application,” called for in patent for product configuration software, was computer program that was designed to allow end-user to perform some specific task.

[28] Patents 291 ↪101(2)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

Claim in patent for product configuration software, calling for transportation of graphical user-interface (GUI) application from server platform to client platform, required transportation of GUI application without also transporting object model and configurator.

[29] Patents 291 ↪101(2)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

“Ordering,” called for in patent for product configuration software, did not necessarily require purchasing.

[30] Patents 291 ↪101(2)

291 Patents

291IV Applications and Proceedings Thereon

291k101 Claims

291k101(2) k. Construction in general.

Most Cited Cases

“Applet,” called for in patent for product configura-

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