UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF WISCONSIN

E-IMAGEDATA CORP,

Plaintiff / Counter-Defendant,

v. **Case No. 16-CV-576**

DIGITAL CHECK CORP
doing business as
ST Imaging,

Defendant / Counter-Plaintiff.

CLAIM CONSTRUCTION ORDER

I. Introduction

Plaintiff e-ImageData Corp holds the rights to three relevant patents: U.S. Patent Nos. 8,537,279 (the '279 patent) (ECF No. 1-1); 9,179,019 (the '019 patent) (ECF No. 1-2), and 9,197,766 (the '766 patent) (ECF No. 1-3). These patents relate to machines used to digitally display a microform image (e.g., microfilm or microfiche). e-Image sells a line of machines that use the patented technology.

Defendant Digital Check Corp, which does business as ST Imaging and will be referred to here as ST Imaging, is a competitor of e-Image and also sells machines that

digitally display microform images. In this lawsuit e-Image alleges that ST Imaging's machines infringe upon e-Image's patents. Preliminary to the resolution of the merits of a patent infringement suit it is necessary for the court to construe the meanings of disputed terms in the relevant patent claims. *See Markman v. Westview Instruments*, 517 U.S. 370, 372 (1996).

"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) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 115 (Fed. Cir. 2004)). "[T]he words of a claim 'are generally given their ordinary and customary meaning.'" *Id.* (quoting *Vitronics Corp. v. Conceptronic*, 90 F.3d 1576 (Fed. Cir. 1996)). In the patent context, "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.* at 1313.

Sometimes the meaning of a term is clear based upon the accepted understanding of common words. *Phillips*, 415 F.3d at 1314. But oftentimes the court must look beyond the plain words to understand how someone skilled in the relevant art would understand the disputed claim language. *Id.* In doing so, the court considers the context of the terms, including the other claims. *Id.* Differences among claims might prove useful in discerning the meaning of particular claim terms. Beyond the claims,

"highly relevant to the claim construction analysis" is the patent specification. *Id.* at 1315. Moreover, in construing a claim a court must also consider whether the patentee self-defined a term within the patent or intentionally disclaimed or disavowed an aspect of the claim. *Id.* at 1316.

Beyond the patent itself, the history of the patent's prosecution before the Patent and Trademark Office (PTO) may help the court in understanding how the PTO and the inventor understood the patent. *Phillips*, 415 F.3d. at 1317. However, in relying upon the prosecution history, the court must be mindful that the history does not necessarily represent conclusions as to the meaning of the patent but instead might reflect ongoing negotiations between the PTO and the inventor. *Id.*

Courts may also consider extrinsic evidence, including testimony of an expert or the inventor, dictionaries, or learned treatises, when construing a claim. *Phillips*, 415 F.3d at 1317-19. However, such extrinsic evidence is "less significant than the intrinsic record" of the patent itself and its prosecution history and is unlikely be helpful unless considered in the context of the intrinsic evidence. *Id.* (quoting *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004)). "It is well settled that the role of a district court in construing claims is not to redefine claim recitations or to read limitations into the claims to obviate factual questions of infringement and validity …." *Am. Piledriving Equip., Inc. v. Geoquip, Inc.*, 637 F.3d 1324, 1331 (Fed. Cir. 2011).

The parties agree as to how three relevant terms should be construed:

Term	Claims	Stipulated Construction
"the first shaft"	Claim 6 of the '019 Patent	"the first motor shaft"
"the support structure"	Claim 49 of the '766 Patent	"the microform media support structure"
"first carriage"	Claim 44 of the '279 Patent; claims 1, 22, 24, 32, 41, 63, and 64 of the '019 Patent	"first movable support structure"

The parties dispute how six other relevant terms should be construed:

"second carriage" (claims 7, 10, 11, 14, 23, 32, 41, 63, 64, and 81 of the '019 Patent)	
e-Image's Proposed Construction	**ST Imaging's Proposed Construction**
"a second movable support structure"	"a movable support structure, separate and distinct from the first carriage"
"diffusing element" (claim 40 of the '019 Patent)	
e-Image's Proposed Construction	**ST Imaging's Proposed Construction**
"a device that spreads or scatters light to create a more uniform illumination source"	"frosted glass"
"lead member" (claim 44 of the '279 Patent; claims 1, 2, 3, 14, 22–24, 27, 32, 41, 43, and 63 of the '019 Patent)	
e-Image's Proposed Construction	**ST Imaging's Proposed Construction**
"guiding element"	"a component that guides and drives a mechanically coupled device"

"drive mechanism" (claims 1, 2, 5, 7, 9, 10, 15, 32, 41, 44, and 63 of the '019 Patent)	
e-Image's Proposed Construction	**ST Imaging's Proposed Construction**
"parts connected to a motor for moving a component"	"mechanism that applies force to drive the lead member"
"digital microform imaging apparatus" (claim 44 of the '279 Patent; claims 1, 41, 63, 64, and 91 of the '019 Patent; claims 41 and 49 of the '766 Patent)	
e-Image's Proposed Construction	**ST Imaging's Proposed Construction**
The preamble limits the claims.	The preamble is not limiting.
"at least somewhat maintain focus while adjusting zoom" (claim 19 of the '019 Patent)	
e-Image's Proposed Construction	**ST Imaging's Proposed Construction**
"keep the image generally focused while adjusting zoom"	Plain and ordinary meaning

Aside from the term "digital microform imaging apparatus," which appears in all three patents, the other disputed terms appear only in the '019 patent. The parties agree that the terms should be construed consistently throughout the patents in suit. (ECF No. 22 at 9-10 (all pagination reflects the ECF pagination).) Therefore, the '019 patent will be the focus of this court's analysis.

The parties submitted briefs setting forth their proposed constructions of the disputed claim terms (ECF Nos. 20, 22) and responding to each other's proposed constructions (ECF Nos. 23, 24). In addition, the court held a claim construction hearing on August 31, 2016, at which each side presented its views as to certain disputed terms. (ECF No. 37.) The matter is now ready for resolution.

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