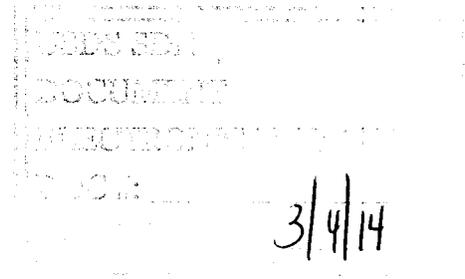


UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



_____ x

HOCKEYLINE, INC.,

Plaintiff,

-against-

13 Civ. 1446 (CM)

STATS LLC,

Defendant.

_____ x

SUPPLEMENTAL MARKMAN RULING

McMahon, J.:

On The court asked the parties for presentation of extrinsic evidence to permit the construction of the one term I was unable to construe on the basis of the intrinsic record: “plurality of hierarchical menu-based screens.” I also asked the parties to address the term “said processor.”

Let me dispose of the latter issue first. I agree with Hockeyline that STATS’ attempt to have the court construe the term “said processor” in terms of the manner in which it is programmed (namely, according to the algorithm described at col. 6:20-7:16 of the patent) is inappropriate.

“Said processor” as used throughout the ‘107 patent refers back to the term “a processor”, which appears literally at the outset of Claim 1 of the patent:

1. An electronic scorekeeping device for gathering, processing, and Distributing statistical information related to a sports game, comprising:

a processor:

Therefore, the issue is really whether there is any special meaning to “a processor.”

There is not.

The term “processor” in the phrase “a processor” obviously refers to a central processing unit, the “brains” of a general purpose computer, the part that interprets and executes programming instructions. A processor is a piece of hardware. It is equipment. It is a structure. As plaintiff points out, the word “processor” is often construed by courts either as bearing its

plain and ordinary meaning, or as “the part of a general purpose computer that interprets instruction.” (Hockeyline’s Construction of “Said Processor” Brief at pages 3-4, and citations therein). It is not a means plus function term; “a processor” is not claimed in functional language, and any processor can be used to perform the claimed functions.

Therefore, “said processor” will be defined as “the processor referred to in Claim 1 of the ‘107 patent, which is the central processing unit of any general purpose computer.” The word “processor” will not be further defined in terms of how it is programmed, because “a processor” is not so limited.

Now on to the plurality of hierarchical menu-based screens.

I start by defining some of the words used in the phrase.

In the context of the disputed claim term, “screens” are not physical screens – that is, they are not electronic devices that can display data, such as a piece of hardware, a television set, a laptop screen, a phone touch display screen, a tablet screen. In the context of the term “hierarchical menu-based screen,” the screen is what has come to be called a “screen shot” by today’s computer users – it is the data that is displayed at any particular time on a physical screen. I reject STATS’ argument that there is anything “indefinite” about the use of the word “screens” in the disputed claim term; the word bears several meanings, and even STATS’ expert, Dr. H.E. Dunsmore of Purdue University, testified that a person skilled in the art would have understood that “screens” had more than one meaning and that the intended meaning could easily be derived from context. In the ‘107 patent, the physical piece of hardware is the “display means,” while the particular data that is displayed on the “display means” is referred to as the “screen.” To interpret the word “screens” to mean a piece of hardware renders the disputed claim term nonsensical, while interpreting it as displays of data (screen shots) causes the disputed claim term to make perfect sense.

In this case the “screens” are “menu-based.” That means the data displayed consists of “menus.” A menu is nothing more than a list of available options, from which a user can make a selection – just as a diner selects what to have for dinner from the list of options on a restaurant menu.

Confirmation for this construction of the word “menu” is found in the ‘107 patent’s specification, which describes a “main menu which present the options available to the user.” 5:49-50. The screen displaying that main menu is referred to as a “menu-based screen.”

“Hierarchical” -- the word that the court did not intuitively understand the first time around -- also has a meaning commonly understood by those skilled in the art, and both Dr. Dunsmore and plaintiff’s expert, Dr. Ravin Balakrishnan of the University of Toronot, agree on what it is. “Hierarchical” is a way of organizing or ranking information within a particular system, so that some information is above or below other information. Balakrishnan, ¶ 8. In the 2001 version of Webster’s New World Computer Dictionary (an extrinsic source more or less contemporaneous with the filing of the ‘107 patent, which occurred in 2000), the term “hierarchy” is defined as “a method of organizing data so that the most general category is at the

top of the list; beneath this category are second-level subcategories, each of which may contain additional subcategories.” Balakrishnan Ex. C. That contemporaneous dictionary definition is consistent with how the term is used in the ‘107 patent itself: the specification contains a “Main Menu” screen, which lists several options. Click on any option and the user is taken to a new screen, which has multiple options from which another, more specific choice can be made. And so on.

So the term “plurality of hierarchical menu-based screens” would appear to mean “multiple electronic screen shots consisting of lists of options from which a user can select, organized in a hierarchy, so that the first screen shot contains the most general menu and subsequent screen shots contain more specific menus.” STATS argues that the verb used in this definition should be “arranged” and Hockeyline prefers “displayed;” to resolve this dispute, I use the synonymous term “organized,” which appears in the technical dictionary.

The parties disagree over whether the word “hierarchical” modifies the word “menu” or the phrase “menu-based screens.” Originally I thought that this grammatical point made a difference, but I have changed my mind.

Both experts agree that persons skilled in the art would recognize the term “hierarchical menu,” which they define essentially in the same manner: “a list of options (menu), including items and sub-items that reference information, organized according to a hierarchy.”

The difference between the parties’ experts lies in their opinion about whether a hierarchical menu can be implemented in various ways, or only in one way. Dr. Dunsmore insists that a “hierarchical menu” is limited to one, very specific type of menu organized according to a hierarchy: a menu containing a large number of options in a single list that is too large to fit on a single screen, so the user selects from a choice set at the top of the hierarchy, which causes a second choice set to become available within the same display. The distinction Dr. Dunsmore draws between “hierarchical menu-based screens” and screens showing “hierarchical menus” appears to be this: in the former, the choice of a menu option on the first screen takes one to an entirely different second screen, where the next, more specific choices can be found; while in the latter, when the user chooses from among the first set of menu options, the second, more specific set of menu options pops up on a portion of the same screen – rather, I imagine, like a tool bar works in the word processing program I am using right this minute.

It does not seem to me that there is any meaningful difference here. A screen that supercedes by an entirely different screen (Dr. Dunsmore’s definition of “hierarchical menu-based screen”) obviously presents a different “screen shot,” or display of data, than the screen on which the original menu appeared; but a screen that is altered by the addition of “pop-up” data when a menu option is pressed (Dr. Dunsmore’s definition of “hierarchical menu”) also presents a different “screen shot” or data display than does the screen on which the first portion of the “hierarchical menu” appears.

What does seem obvious is that Dr. Dunsmore’s attempt to restrict the recognized term “hierarchical menu” in the very limited way he does is an attempt by STATS to restrict the scope of the claimed invention to the preferred embodiment disclosed in the specification. Absent some

indication in the claim language or the prosecution history that such was intended, it is error to restrict claim language to the preferred embodiment. CITE. I agree with Dr. Balakrishnan that nothing in the claim language of the '107 patent limits the invention to the preferred embodiment, and no evidence has been introduced suggesting that the patentee was acting as his own lexicographer when he used what turns out to be a fairly common phrase known to persons skilled in the art (a fact of which the court was unaware when I wrote the original Markman opinion). Dr. Dunsmore's discussion of the Canadian patent application over which the '107 patent claims priority, is interesting but ultimately unpersuasive in view of the fact that it represents but another effort to limit the invention to the preferred embodiment.

I previously thought that it mattered whether the adjective "hierarchical" modifies "menu" or the phrase "menu-based screens." Now that I am aware that persons skilled in the art are familiar with a term "hierarchical menu" – a fact of which I was not aware when I wrote the original Markman opinion -- I don't think it makes the slightest bit of difference. The phrase means "a plurality of data displays – more than one – in which the displayed data consists of hierarchical menus." "Hierarchical menus" are "lists of options organized such that the most general option appear first and increasingly specific sub-options appear as previous options are selected." If I can write the phrase mathematically, it is as though it were [(hierarchical menu)-based] screens: i.e., the screens are based on hierarchical menus.

I have reviewed Dr. Dunsmore's recitation of his search through PTO records for other patents that use the phrase "menu-based screens" and I credit his explanation of what he found. However, because I was unaware at the time I wrote the original Markman opinion that the phrase "hierarchical menu" was familiar to persons skilled in the relevant art -- and because I find his effort to define "hierarchical menu" strained at best -- I am not persuaded that the phrase "hierarchy of menu-based screens" (from the '060 patent) means the same thing as "a plurality of hierarchical menu-based screens." Indeed, I think it likely that the patentee would have used phraseology more closely skin to the wording of the '060 patent if he intended to convey what the '060 patentee was trying to convey.

I will, therefore, tell the jury the following:

Ladies and gentlemen, the next term I have to define for you is "a plurality of hierarchical menu-based screens." The words "plurality" is a special word in patentees: it means "more than one." "Screens," as used in this particular context, does not refer to hardware, to electronic display devices – like the physical screen on your cell phone or computer – in other words, "screens" as used here is not a "display means," which I have already defined for you. Instead, "screens" means what we would today call a "screen shot" – the data that appears on a display means at any given moment. A "menu" is a list of options from which you can choose, just like in a restaurant." "Hierarchical" means "organized or ranked in such a way that the most general information appears first, beneath which are more detailed sub-categories, beneath which are even more detailed sub-categories, and so on." Putting all those words together, "a plurality of hierarchical menu-based screens" means "multiple electronic screen shots, consisting of menus, or lists of options from which a user can make a selection. The menus are organized in a hierarchy, so that the first screen shot contains the most general menu categories, and subsequent screen shots contain a more specific menu categories."

This concludes the Markman phase of this case. The parties have 14 days to provide the court with a proposed discovery schedule.

Dated: March 3, 2014

A handwritten signature in black ink, appearing to be "C. M. M.", written over a horizontal line.

U.S.D.J.

BY ECF TO ALL COUNSEL