UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

MASTERMINE SOFTWARE, INC.,	Case No. 13-CV-0971 (PJS/TNL)
Plaintiff,	
v.	ORDER
MICROSOFT CORPORATION,	
Defendant.	

Adam R. Steinert, Lora M. Friedemann, Kurt J. Niederluecke, Grant D. Fairbairn, Ted C. Koshiol, and Nikola L. Datzov, FREDRIKSON & BYRON, P.A., for plaintiff.

Erica Wilson, Eric S. Walters, and Benjamin J. Byer, DAVIS WRIGHT TREMAINE LLP; Barbara Podlucky Berens and Carrie L. Zochert, BERENS & MILLER, P.A., for defendant.

Plaintiff MasterMine Software, Inc. ("MasterMine") brings this lawsuit against defendant Microsoft Corporation ("Microsoft") for infringement of two patents: U.S. Patent No. 7,945,850 ("the '850 patent") and U.S. Patent No. 8,429,518 ("the '518 patent").[1] In broad strokes, the patents relate to a process by which a user of customer relationship management ("CRM") software can automatically cause a spreadsheet

[1]The '850 and '518 patents are reproduced at ECF Nos. 1-1 and 1-3, respectively. Because the two patents share a common specification, the parties have generally discussed only the '850 patent. *See* ECF Nos. 177 at 3 n.2, 183 at 11 n.2. The Court will follow suit, save in its discussion of indefiniteness.

application (such as Microsoft Excel or Lotus 1-2-3) to generate a pivot table displaying CRM data.

This matter is before the Court for construction of contested claim terms in accordance with *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Microsoft also seeks a declaration that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid for indefiniteness because each claim covers two different classes of patentable subject matter.

This *Markman* proceeding is unusually challenging, given that the evidence that the Court must consider includes highly technical terms (including lines of computer code). Thus, with the consent of the parties, the Court appointed Charles M. McMahon, a partner in the Chicago office of McDermott Will & Emery, to serve as a neutral technical advisor. ECF No. 175. The technical advisor prepared a written report in which he made recommendations regarding the construction of contested terms and regarding Microsoft's indefiniteness challenge. ECF No. 197 (Report). The Court conducted a lengthy claim-construction hearing, at which the parties presented extensive arguments, and at which the technical advisor was asked numerous questions about his report by the Court and the parties. ECF No. 208 (Hr'g Tr.). The technical advisor has been extremely helpful, and the Court expresses its gratitude to him and to the parties for consenting to his appointment.

The Court adopts the technical advisor's report except insofar as that report is inconsistent with this order. The technical advisor's report fairly and accurately describes the patents, the prosecution history, the relevant legal principles, and the parties' main arguments. The Court will not revisit those matters, but instead assumes that the reader is familiar with the report.

For the reasons that follow, the Court largely agrees with the technical advisor's recommendations regarding the construction of the disputed terms, although in a few instances the construction adopted by the Court differs somewhat from the construction recommended by the technical advisor. The Court does not, however, agree with the technical advisor that Microsoft's indefiniteness challenge should be rejected. Instead, the Court finds that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid for indefiniteness.

I. CLAIM CONSTRUCTION

In general, claim language means whatever it would have meant, ordinarily and customarily, to a person of ordinary skill in the art at the time that the patent application was filed. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc). In some cases, the ordinary and customary meaning of claim language to a person of ordinary skill in the art may be identical to the meaning of that language to a lay person who is not skilled in the art. *Id.* at 1314.

Neither the parties nor the technical advisor has devoted much attention to defining a person of ordinary skill in the art for purposes of this *Markman* proceeding. The technical advisor says that "a person of ordinary skill in the art of the 850 and 518 patents would have been familiar with CRM, database, and spreadsheet software, and would have had at least some experience in the field of software development." Report at 13. Neither party seems to disagree, and thus the Court adopts the technical advisor's recommendation.

A. "Pivot Table"

The parties dispute a number of terms, but their dispute over the meaning of "pivot table" overshadows their other disputes. All of the asserted claims require that a reporting module in the CRM software "automatically generate a pivot table within the electronic worksheet." '850 patent col. 8 ll. 44-45, col. 10 ll. 6-7, col. 11 ll. 23-24; '518 patent col. 8 ll. 40-42. Both partes agree that, if a reporting module generates a pivot table that is populated with data, the reporting module has generated a "pivot table." But MasterMine goes further and asserts that, if a reporting module generates the *shell* of a pivot table—that is, a skeleton that *can* display data, but that does *not* display data—the reporting module has nevertheless generated a "pivot table." Microsoft disagrees; in its view, no data means no "pivot table."

Resolving this dispute is difficult, for at least three reasons: First, persons skilled in the art use the phrase "pivot table" both in the sense advanced by Microsoft (a table populated with data) and in the sense advanced by MasterMine (an empty shell capable of being populated with data). Second, no one involved in the prosecution of the '850 or '518 patents appears to have focused on this issue; the issue simply was not on their minds, and thus they did not address the issue directly, and they provided little in the way of indirect evidence. Finally, the scraps of intrinsic and extrinsic evidence cited by the parties are in tension; no matter how the Court resolves this dispute, its resolution will be difficult to reconcile with something in the record.

After devoting many hours to this issue, the Court ultimately agrees with the technical advisor that a person of ordinary skill in the art would understand "pivot table" to mean *data* displayed in a particular manner. The Court therefore adopts the technical advisor's recommended construction:

"pivot table"	"an interactive set of data displayed in rows and columns that can be rotated and filtered to summarize or view the data in different ways"

As the technical advisor explained, his recommendation conforms to the language of the patent, not only from the perspective of a person of ordinary skill in the art, but also from the perspective of the typical lay person who would use the invention. *See* Report at 20-24. After all, the purpose of the invention is to create "electronic

reports" in the form of pivot tables, as reflected in the patent's abstract: "In general, the system automates the process of creating electronic reports, such as an electronic worksheet, in a format that can be directly manipulated and viewed from spreadsheet application." '850 patent abstract. "Report" connotes the imparting of information; there would not be much to "report" if, as MasterMine contends, a pivot table was a computer "object" that included no CRM data. A business owner asking for a "report" would likely be disappointed if he or she were sent such a computer object or handed a printout of a blank table. Moreover, the illustration that is offered in the patent as an example of a pivot table created by the invention clearly depicts a table populated with data. *Id*. fig. 10. Though just an example, the illustration suggests that a pivot table, once created, displays data.

The adopted construction also conforms to the prosecution history, for the reasons explained by the technical advisor. *See* Report at 24-25. In an effort to overcome a prior-art rejection by the United States Patent and Trademark Office ("PTO"), MasterMine distinguished the relevant prior art in part as follows:

> Conlon describes a user interface for a spreadsheet application that allows a user *to drag and drop fields to manually create a pivot table* on a spreadsheet. Conlon requires that the user interacts with the spreadsheet application directly, and that the user manually selects each of the fields.

ECF No. 178-9 at 12 (footnote omitted; emphasis added). MasterMine thus represented

to the PTO that a pivot table is "create[d]" when the user selects fields by dragging and dropping them into the spreadsheet—i.e., when the user *populates* the table. This necessarily implies that, prior to the shell being populated, no pivot table has been created.

The technical advisor concluded that this statement by MasterMine qualifies as a prosecution disclaimer or disavowal. The Court is not so sure. To qualify as a disclaimer or disavowal, a statement to the PTO must be "both so clear as to show reasonable clarity and deliberateness, and so unmistakable as to be unambiguous evidence of disclaimer." *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1322 (Fed. Cir. 2012) (quoting *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325-26 (Fed. Cir. 2003)). The Court questions whether MasterMine's statement meets that strict standard. Still, MasterMine's statement is highly probative evidence as to what "pivot table" means in the context of the asserted claims. *See Fenner Invs., Ltd. v. Cellco P'ship*, 778 F.3d 1320, 1323 (Fed. Cir. 2015) ("Any explanation, elaboration, or qualification presented by the inventor during patent examination is relevant, for the role of claim construction is to capture the scope of the actual invention that is disclosed, described, and patented." (quotation omitted)).

Two of the arguments advanced by MasterMine against the technical advisor's recommendation have given the Court pause. First, MasterMine notes that the patent

discloses computer code and introduces that code with this language: "The following illustrates example syntax for a Visual Basic command to create a pivot table within an Excel worksheet in a SQL environment: . . . ." '850 patent col. 4 ll. 65-67. The parties agree that executing the exemplary code would not produce a pivot table that displays data; MasterMine asserts that the code would (when combined with other code) create the shell of a pivot table. The patent thus teaches how "to create a pivot table," MasterMine says, and the thing that is created by executing the code looks like an empty shell. MasterMine further argues that the technical advisor's construction of "pivot table" would exclude the very pivot table created by executing the computer code, and MasterMine reminds the Court that a construction of a claim term that would exclude a preferred embodiment is usually incorrect. *See, e.g.*, *MobileMedia Ideas LLC v. Apple Inc.*, 780 F.3d 1159, 1181 (Fed. Cir. 2015); *Vidtronics Corp v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

The problem with MasterMine's argument is that the code is not really a preferred embodiment of the invention. *See* Hr'g Tr. at 131:6-132:6. Instead, as the technical advisor explained, ". . . it [is] an example of a part of code that would fit into a larger structure and be part of a generation of a pivot table. . . . [F]or this really to work in operation, there would have to be a lot more code, a lot more information and actual connection." *Id.* at 132:2-132:6. The parties agree with the technical advisor that,

executed on its own, the code in the patent would not produce anything, let alone produce the "electronic report" that is the end product of the invention. By contrast, an embodiment is typically a "tangible manifestation of an invention" or the "part of a patent application or patent that describes a concrete manifestation of the invention." *Black's Law Dictionary* 636 (10th ed. 2014). A line of code that produces nothing cannot, in and of itself, be considered a "tangible" or "concrete" manifestation of an invention.

Second, MasterMine contends that, in describing the operation of the invention, the patent distinguishes *creating* a pivot table from *populating* a pivot table. For example, the specification explains that "[a]fter generating table **14**, reporting module **8A** invokes and cooperates with reporting modules **8B** and **8C** to format and organize table **14** (**25**)." '850 patent col. 3 ll. 42-44. Similarly, the specification explains that "[a]fter reporting module **8A** creates table **14** within worksheet **12**, reporting module **8B** applies the formatting parameters specified by the toolkit selected by the user in order to format the electronic worksheet **12** (**41**)." *Id.* col. 5 ll. 40-44. According to MasterMine, the specification thus distinguishes between, on the one hand, "generating" or "creat[ing]" the pivot table, and, on the other hand, "formatting" that table. In MasterMine's view, "formatting" means "populating with data."

This is a respectable argument, but it is not without problems. For example, "formatting" is an unusual term to use to describe the decision about what data will be

included in a table. In normal parlance, "formatting" refers not to *what* data will be displayed, but to *how* data will be displayed—that is, to the number of columns and rows, whether each column and row will be labeled, whether the font used for any such labels will differ from the font used for the data, and so forth. *See American Heritage Dictionary of the English Language* 691 (4th ed. 2006) (defining "format" to mean "[t]o determine the arrangement of (data) for . . . display"). In other words, before data can be *formatted* (or *organized*) it has to *exist*. *See* Report at 23; Hr'g Tr. at 132:8-133:9. Most naturally read, then, when the specification refers to formatting and organizing a pivot table, it is referring to manipulating data that appears in a pivot table.

Moreover, it is difficult to reconcile MasterMine's definition of "formatting" with other parts of the patent. For example, claim 1 of the '850 patent describes the patented method and makes clear that the method results in a pivot table that is populated with data. The method described in claim 1 includes the steps of "presenting the pivot table to a user," "receiving within the spreadsheet application a selection from the user of the selected CRM data contained within the pivot table," and "creating a second worksheet that displays the CRM data as a number of rows in columnar format according to fields within the CRM database . . . ." '850 patent col. 8 ll. 55-65. Yet claim 1 never uses the verb "format."[2] If "formatting" a pivot table means populating it with data, and if

[2]Claim 1 does refer to a "worksheet that displays the CRM data as a number of (continued...)

claim 1 does not call for any "formatting" of the pivot table, then how does the pivot table get populated with data?

In the end, the Court concludes that, although MasterMine's proposed construction of "pivot table" is undeniably supported by some evidence in the record, the evidence supporting the technical advisor's proposed construction is more compelling. The Court therefore adopts that construction.

B. "Automatically Generate"

As noted, all of the asserted claims require that a reporting module "automatically generate a pivot table within the electronic worksheet." '850 patent col. 8 ll. 44-45, col. 10 ll. 6-7, col. 11 ll. 23-24; '518 patent col. 8 ll. 40-42. The parties dispute the meaning of "automatically generate."

The technical advisor argues that to "automatically generate" a pivot table means to generate that pivot table "without any user interaction with the spreadsheet application." The technical advisor's report is convincing on this point. Therefore, the Court adopts the technical advisor's proposed construction in substance; the Court has

---

[2](...continued)
rows in columnar format according to fields within the CRM database . . . ." '850 patent col. 8 ll. 63-65. But this use of "format" as a noun is not helpful to MasterMine's argument. In fact, this use of "format" is consistent with the Court's sense of the term. After all, "columnar format" refers to *how* data is displayed in a table, not to *what* data is displayed in a table.

modified the proposed construction only so that it does not provide a redundant definition of "pivot table." The Court's construction is as follows:

"automatically generate a pivot table"	"to create a pivot table within an electronic worksheet without any user interaction with the spreadsheet application"

C. "CRM" Terms

The Court also agrees with the technical advisor's analysis of the terms "CRM software application," "CRM data," and "CRM database," and adopts the technical advisor's recommended constructions with one exception: The Court has modified the technical advisor's proposed construction of "CRM software application" to replace "dedicated to" with "for." Accordingly, the Court construes the terms as follows:

"CRM software application"	"computer program for managing customer relationship information"
"CRM data"	"information maintained by a customer relationship management (CRM) application"
"CRM database"	"database dedicated to storing customer relationship management (CRM) data"

The Court agrees with the technical advisor and MasterMine that, in the context of the patent, "CRM software application" refers to a discrete class of specialty software products that manage customer-relationship information. The construction must capture this specialized function and exclude other, general-use software that could

conceivably be used to store and manage customer-relationship information (e.g., Microsoft Word).

The Court is also sympathetic to Microsoft's concern that MasterMine's proposed construction of "CRM software application" as a "computer program *designed for* managing customer relationship information" introduces a subjective element into the definition of a claim term. The technical advisor's substitution of "dedicated to" in place of "designed for" is a step in the right direction. Still, in the Court's opinion, a simple "for" better conveys that what matters is the objective purpose of a software application rather than the subjective intent of its inventors.

D. "Worksheet" Terms

The Court agrees with the technical advisor's recommended construction of the terms "worksheet" and "workbook," except that the Court has made a minor change to the proposed construction of "worksheet." The Court construes the terms as follows:

"worksheet"	"a single page or sheet for displaying data organized into rows and columns"
"workbook"	"an organized collection of one or more related worksheets"

In construing "worksheet," the Court replaces the phrase "that displays" in the technical advisor's recommended construction with the phrase "for displaying." The purpose of this modification is to make clear that a worksheet remains a worksheet

even if, at any particular moment, it is not actually displayed on a computer screen (because, for example, the user is viewing another worksheet in the same workbook). Moreover, in construing "workbook," the Court (like the technical advisor) rejects Microsoft's argument that a "workbook" must always be "a file." A workbook might be a file, but it does not have to be; for example, a workbook might be displayed on a screen for a few moments but not saved, thus not creating a "file." *See* Hr'g Tr. at 145:17-146:1.

E. "Report" Terms

The Court adopts the technical advisor's recommended construction of the terms "report toolkit," "report template," and "report parameters," and therefore construes those terms as follows:

"report toolkit"	"a pre-defined set of one or more report templates"
"report template"	"a predesigned electronic worksheet that specifies the rows, columns, and data to be displayed"
"report parameters"	"values that determine characteristics or features of the report"

Like the technical advisor, the Court rejects MasterMine's contention that a "template" can be a list of instructions about how to create a report. One of the elements of claim 12 requires a programmable processor to cause "the spreadsheet application to create a new workbook and copy the selected report template into the

workbook as the electronic worksheet." '850 patent col. 11 ll. 19-20. To "copy" a template into a workbook as a worksheet is not the same as to provide detailed instructions to the spreadsheet application about how to construct a worksheet from scratch. Instead, the term "copy" implies that the template is itself a worksheet, and that the spreadsheet application creates a new worksheet by "copy[ing] . . . the template into the workbook."

II. INDEFINITENESS

Under 35 U.S.C. § 101, only certain classes of inventions are patentable. Those classes include, among others, "systems" and "methods." *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1383-84 (Fed. Cir. 2005). Section 112(b), for its part, requires that a claim "particularly point[] out and distinctly claim[] the subject matter which the inventor or a joint inventor regards as the invention." Thus, although "[a] single *patent* may include claims directed to one or more of the classes of patentable subject matter," a single *claim* "may [not] cover more than one subject matter class." *Microprocessor Enhancement Corp. v. Tex. Instruments Inc.*, 520 F.3d 1367, 1374 (Fed. Cir. 2008) (emphasis added).

A single claim that covers two different subject-matter classes is invalid as indefinite under § 112 because it "is not sufficiently precise to provide competitors with an accurate determination of the metes and bounds of protection involved . . . ." *IPXL*,

430 F.3d at 1384 (quotation omitted). For example, if a claim covers both an apparatus and a method, "a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus." *Id.* At the *Markman* hearing, MasterMine's attorney succinctly explained the justification for the doctrine as follows:

> [T]he reason that it's impermissible to have a mix is . . . that [a] mix creates an impossibility of determining when infringement occurs, whether it occurs by the product as sold or whether infringement occurs when that method is being performed. . . . [T]he jury can't say ["]this device in the box infringes.["] The device only infringes when it's in operation. So then is it a device claim or a method claim? You can't tell.

Hr'g Tr. at 173:5-17.

This description of the doctrine is inaccurate in only one respect: As the Supreme Court recently held in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014), an alleged infringer need not demonstrate that it is "impossib[le]" to determine when infringement occurs—or, as the Federal Circuit formerly held, that a claim is "insolubly ambiguous"—in order to successfully challenge a patent as indefinite. Rather, "a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with *reasonable certainty*, those skilled in the art about the scope of the invention." *Id.* at 2124

(emphasis added). The Supreme Court explained that demanding a higher degree of clarity in claim language furthered important public policy concerns:

> [A] patent must be precise enough to afford clear notice of what is claimed, thereby apprising the public of what is still open to them. Otherwise there would be a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims. And absent a meaningful definiteness check, . . . patent applicants face powerful incentives to inject ambiguity into their claims. Eliminating that temptation is in order, and the patent drafter is in the best position to resolve the ambiguity in patent claims.

Id. at 2129 (quotations, alterations, and footnotes omitted).

Reflecting the importance of providing clear notice of what a patent claims, the Federal Circuit has held that a claim that covers more than one subject matter is invalid. For example, in *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, the Federal Circuit deemed the following system claim to be indefinite because it included a method element: "The *system of claim 2* [including an input means] wherein the predicted transaction information comprises both a transaction type and transaction parameters associated with that transaction type, and *the user uses the input means* to either change the predicted transaction information or accept the displayed transaction type and transaction parameters." 430 F.3d 1377, 1384 (Fed. Cir. 2005) (emphasis and alteration in original). And in *Rembrandt Data Technologies, LP v. AOL, LLC*, the Federal Circuit deemed the following device claim to be indefinite because it included a method

element: "A data transmitting device for transmitting signals corresponding to an incoming stream of bits, comprising: first buffer means for partitioning said stream into frames . . . and *transmitting the trellis encoded frames*." 641 F.3d 1331, 1339 (Fed. Cir. 2011) (emphasis added).

Two points demonstrated by *IPXL* and *Rembrandt* are worth emphasizing. First, a prohibited method step within a system or device claim is often signaled by an active verb ("*uses* the input means"; "*transmitting* the trellis encoded frames"). Second, a prohibited method step can describe a step performed by a user of the system or device ("*the user* uses") or a step performed by the system or device itself ("*[a] data transmitting device* . . . transmitting"). *See also HTC Corp. v. IPCom GmbH & Co., KG*, 667 F.3d 1270, 1277 (Fed. Cir. 2012) (suggesting that a claim that "recite[d] a mobile station and then ha[d] the mobile station perform the six enumerated functions" would be indefinite); *In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1308 (Fed. Cir. 2011) ("Like the language used in the claim at issue in *IPXL* ('wherein . . . the user uses'), the language used in Katz's claims ('wherein . . . callers digitally enter data' and 'wherein . . . callers provide . . . data') is directed to user actions, not system capabilities." (ellipses in original)).

Here, Microsoft argues that claim 8 of the '850 patent (as well as its dependent claim 10) and claim 1 of the '518 patent (as well as its dependent claims 2 and 3)[3] are invalid for indefiniteness because each claim impermissibly includes method elements in a system or device claim. The Court agrees with the technical advisor that this issue is very close, in part because the relevant Federal Circuit case law draws almost impossibly fine distinctions between permissible and impermissible claim language. Ultimately, however, the Court agrees with Microsoft that this case is not materially distinguishable from *IPXL* and *Rembrandt*, and that the challenged claims are therefore invalid for indefiniteness.

Claim 8 of the '850 patent is a system claim that discloses "a *system* comprising":

> a reporting module installed within the CRM software application . . . ;
>
> wherein the reporting module installed within the CRM software application *presents* a set of user-selectable database fields as a function of the selected report template, *receives from the user a selection* of one or more of the user-selectable database fields, and *generates* a database query as a function of the *user selected* database fields . . . .

---

[3]The briefs of the parties focus on the two independent claims: claim 8 of the '850 patent and claim 1 of the '518 patent. As a general matter, however, if an independent claim is invalid for indefiniteness, so are its dependent claims, unless a limitation added by one of the dependent claims "cures" the indefiniteness of the independent claim. MasterMine has suggested no reason why, if the independent claims challenged by Microsoft are indefinite, the dependent claims challenged by Microsoft are not also indefinite.

'850 patent col. 7 l. 64, col. 9 ll. 39, 44-45, 61-67 (emphasis added).

MasterMine maintains that the passage quoted above does not describe method steps but instead merely describes the capabilities of the system. *See Microprocessor*, 520 F.3d at 1375 ("[A]pparatus claims are not necessarily indefinite for using functional language."). But language elsewhere in claim 8 undermines MasterMine's characterization and shows that MasterMine knew how to describe functional capabilities when it wanted to. In the same claim—hardly more than ten lines before the quoted passage—the patent discloses that "the reporting module installed within the CRM software application *is adapted to*, in response to a report generation request, examine a schema and data structures of the CRM database . . . ." '850 patent col. 9 ll. 48-51 (emphasis added). And fewer than twenty lines later (still in claim 8), the patent discloses that "when invoking the spreadsheet software application, the reporting module *is adapted to* communicate report parameters from the CRM software application to the spreadsheet software application . . . ." *Id.* col. 10 ll. 14-17 (emphasis added).

By contrast, the challenged passage provides (for example) that "the reporting module installed within the CRM software application . . . *receives* from the user a selection of one or more of the user-selectable database fields," not that the reporting module is *adapted* to receive such a selection from the user. This leaves the nature of

infringement unclear: Is the claim infringed by a *thing* (a system that practices each element of claim 8) or by *acts* (including the presentation of a set of user-selectable database fields, the receipt from the user of a selection of one or more of those fields, and the generation of a database query)?

MasterMine also makes much of the fact that claim 8 does not explicitly recite that a *user* perform a method step, as did the claim in *IPXL*. 430 F.3d at 1384 ("the user uses the input means"). This argument is unconvincing for two reasons. First, claim 8 as much as says that the user performs an active step—specifically, the step of selecting database fields. All of the elements of claim 8 cannot be met unless the reporting module within the CRM software application "receives from the user a selection," and the reporting module obviously cannot "receive[] from the user a selection" unless and until the user *makes* a selection. Second, *Rembrandt* makes clear that a method step is impermissible in a system claim whether performed by a user or by the system itself. 641 F.3d at 1339 ("[a] data transmitting device . . . transmitting the trellis encoded frames"); *see also HTC*, 667 F.3d at 1277. Here, the system itself performs a series of active steps, including "present[ing]" options to the user, "receiv[ing]" input from the user, and "generat[ing]" a database query. Claim 8 thus impermissibly introduces method elements into a system claim, rendering the claim indefinite under *IPXL* and *Rembrandt*.

Claim 1 of the '518 patent similarly introduces method elements into a device claim. Claim 1 discloses "a computing *device* comprising":

> a reporting module associated with the CRM software application, . . .
>
> wherein the reporting module associated with the CRM software application is adapted to, in response to a report generation request, access a schema and data structures of the CRM database . . . ,
>
> wherein the reporting module associated with the CRM software application *presents* a set of database fields in accordance with the selected report template, *receives* a selection of one or more of the database fields, and *generates* a database query in accordance with the selected database fields, . . .
>
> wherein the reporting module is adapted to communicate report parameters from the CRM software application to the spreadsheet software application . . . .

'518 patent col. 8 ll. 9-53 (emphasis added).

The problems are the same. Here, too, MasterMine demonstrated that it knew how to describe functional elements: "the reporting module associated with the CRM software application *is adapted to* . . . access a schema and data structures" and "the reporting module *is adapted to* communicate report parameters." And yet here, too, the functional elements stand in contrast with what appear to be method elements: "the reporting module associated with the CRM software application *presents* a set of database fields," "*receives* a selection of one or more of the database fields," and

"*generates* a database query in accordance with the selected database fields." As a result, here, too, the nature of infringement is left unclear: Is the claim infringed by a *thing* (a computing device that practices each element of claim 1) or by *acts* (including the presentation of a set of database fields, the receipt of a selection of one or more of the database fields, and the generation of a database query)?

In short, the Court cannot meaningfully distinguish this case from *IPXL* and *Rembrandt*. The Court therefore holds that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid for indefiniteness.

ORDER

Based on the foregoing, and on all of the files, records, and proceedings herein, IT IS HEREBY ORDERED THAT:

1. The disputed terms in the '815 and '518 patents are construed as described in the body of this order.

2. The Court DECLARES that claims 8 and 10 of the '850 patent and claims 1, 2, and 3 of the '518 patent are invalid for indefiniteness under 35 U.S.C. § 112.

Dated: May 6, 2016

s/Patrick J. Schiltz
Patrick J. Schiltz
United States District Judge