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11
12 **UNITED STATES DISTRICT COURT**
13 **CENTRAL DISTRICT OF CALIFORNIA**
14 **SOUTHERN DIVISION**

15 **ACACIA MEDIA TECHNOLOGIES**
16 **CORPORATION,**

17 **Plaintiff,**

18 **vs.**

19 **NEW DESTINY INTERNET GROUP,**
20 **et. al.,**

21 **Defendants.**

22 **AND ALL RELATED CASE ACTIONS.**

Case No. SACV 02-1040 JW (MLGx)

PLAINTIFF ACACIA MEDIA
TECHNOLOGIES
CORPORATION'S CLAIM
CONSTRUCTION BRIEF

DATE: February 6, 2004
TIME: 10:00 a.m.
CTRM: Hon. James Ware

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1 **I. BACKGROUND TO ACACIA'S U.S. PATENT NO. 5,132,992**

2 Today, transmitted digital video is taken for granted. We can view digital
3 video material from many transmission sources, such as the Internet, cable television,
4 and satellite television. Using those sources, we can now select a movie and watch it
5 at a time of our choosing, without ever leaving our home.

6 This was not the case in early 1990. Then, if a person wished to view a
7 selected movie at their home at a time of their choosing, they would have to rent or
8 purchase the movie on videotape or a laserdisc. This required one, and sometimes
9 two, trips from the home to the video store. While these methods of viewing movies
10 were accepted and widely used in the United States at that time and now, there
11 remained a pressing, long felt need for a system which would permit persons to view
12 movies at their homes at a time of their choosing—without having to leave their
13 homes.

14 In early 1990, Paul Yurt and H. Lee Browne sought to solve this problem. Yurt
15 and Browne collaborated to develop a digital communication system that would,
16 among other things, permit a person to receive transmissions of audio, video, and/or
17 audiovisual programs at their home, or other location, which the person could play
18 back as it was being received or which the person could retain for playback at a later
19 time of the person's choosing.

20 On January 7, 1991, Yurt and Browne filed a patent application with the United
21 States Patent and Trademark Office for their invention entitled: "Audio and Video
22 Transmission and Receiving System." This application issued as United States Patent
23 No. 5,132,992 on July 21, 1992 (the '992 patent). (the '992 patent is attached to the
24 Appendix as Exhibit 1; the file history for the '992 patent is attached to the Appendix
25 as Exhibit 2).¹ Four additional continuation patents have issued thereafter, including
26
27

28 ¹ All references to Exhibits in this brief refer to the Exhibits attached to the
accompanying Appendix of Exhibits, which is filed concurrently herewith.

1 U.S. Patent No. 6,144,702, which issued on November 7, 2000 (the '702 patent)².

2 Yurt and Browne invented a comprehensive digital transmission and receiving
3 system with many features³:

- 4 1. the user may remotely select audio/video material from any location that
5 has either telephone service or a computer. ('992 patent, 1:62-66⁴);
- 6 2. the system transmits over one or more existing communication
7 channels.⁵ ('992 patent, 1:67-2:4; 15:65-16:15; 16:53-68; 19:24-27;
8 Figs. 2b and 6);
- 9 3. the system transmits, receives, and plays back only audio information,
10 only video information, or a combination of audio and video information.
11 ('992 patent, 2:11-15);
- 12 4. the system can transmit information in a fraction of real time to any
13 specified receiver. ('992 patent, 1:67-2:4);
- 14 5. the system permits the user to play back the information at any time
15 selected by the user. ('992 patent, 2:5-8);

16
17 ² In this case, Acacia contends that defendants are infringing claims of the '992
18 and '702 patents. The '702 patent, being a continuation of the '992 patent, has the
19 same effective filing date as the '992 patent -- January 7, 1991 -- and has the same
20 specification and figures as the '992 patent (although the same text is printed at
different columns and line numbers for each patent). This motion relates only to the
claims of the '992 patent.

21 ³ These features are not limiting with respect to any of the claims of the patents,
22 unless explicitly stated in any claim. Nothing in the specification of the '992 patent
23 requires that every embodiment of the invention include these features. See, E-Pass
24 Technologies, Inc. v. 3Com Corporation, 343 F.3d 1364, 1370 (Fed. Cir. 2003) ("An
invention may possess a number of advantages or purposes, and there is no
requirement that every claim directed to that invention be limited to encompass all of
them.")

25 ⁴ Throughout this brief, Acacia shall cite to the '992 patent using the convention
of column:line-line or column:line - column:line.

26 ⁵ The '992 patent identifies non-limiting examples of communication channels,
27 such as standard telephone, ISDN, B-ISDN, microwave, DBS (direct broadcast
28 satellite), cable television systems, metropolitan area networks, local area networks,
high speed modems, communication couplers, VHF, or UHF broadcasting systems.
('992 patent, Fig. 2b; 4:661-63; 15:65-16:15 and 16:53-69).

1 6. the system permits the user to retain a copy of the information for
2 multiple playbacks in the future. ('992 patent, 2:8-10);

3 7. the system permits the conversion of disparate input source material⁶ into
4 a compatible format for ease of transmission, receipt, and playback by
5 many users at many locations. (see, e.g., '992 patent, 5:66-6:22); and

6 8. the system permits the user to play back the program using playback
7 controls similar to those used on a standard recorder, such as play, fast
8 forward, rewind, stop, pause, and play slow. ('992 patent, 17:35-38).

9 This feature-laden invention of Yurt and Browne is disclosed in the '992 patent,
10 which details how source material programs are formatted and transmitted to remote
11 locations, and how the formatted programs are requested, received and played back.

12 There are 58 claims in the '992 patent, comprising six categories of system and
13 method claims [transmission system claims (1-18); distribution method claims (19-
14 24); receiving system claims (25-40); method of transmission claims (41-46);
15 distribution system claims (47-53); and method of receiving information claims (54-
16 58)]. To best introduce the Court to the novel technology invented by Yurt and
17 Browne and to explain the way it works in an understandable manner, it is desirable
18 that we examine a disclosed embodiment of their invention which is relevant to the
19 claims-at-issue in this case,⁷ and, more particularly, examine in that embodiment the

21 ⁶ The '992 patent identifies non-limiting examples of different types of source
22 material items of information: "television programs, movies, audio recordings, still
23 pictures, files, books, computer tapes, computer disks, documents of various sorts,
24 musical instruments, and other physical objects [musical instruments and physical
25 objects are meant to refer to live events, which can be recorded]. . . The different
26 media formats preferably include digital or analog audio and video tapes, laser disks,
27 film images, optical disks, magnetic disks, computer tapes, disks, and cartridges."
28 ('992 patent, 6:12-15 and 6:19-22).

21 ⁷ In this case, Acacia contends that all of the defendants are involved with
22 streaming video and therefore are infringing claims 1, 2, 4, 6, 8, 9, 10, 18, 41, 42, 43,
23 44, 45, and 46 of the '992 patent and claims 14 and 41 of the '702 patent.
24 Additionally, Acacia contends that defendants Game Link, Inc. and AEBN, Inc. also
25 infringe claims 19, 22, and 24 of the '992 patent and claims 1-4, 6, 8-13, 15, 17-32,
26 and 34-40, because these are the only defendants who, in addition to providing users
27 with streaming videos, also permit users to store a copy of the selected video.

described system elements and steps to: (1) store source material programs (e.g. items of information) in a library; (2) assign each item of information a unique identification code so that the program can be located and accessed later; (3) convert and format separate items into a compatible digital format, (4) place the formatted material in an order or sequence (i.e., using time codes); (5) compress the formatted, ordered data blocks; (6) store the formatted, ordered, and compressed data blocks as a file in a storage library; (7) transmit at least a portion of the file to a remote location; (8) receive the compressed, digital information; (9) store (temporarily or for longer periods of time) at least a portion of the information; (10) decompress the information; and (11) play back the information using playback controls. Notably, this description of embodiment does not limit the scope of the claims, which are broader. This description is provided for illustrative purposes only.

1. Description Of System Elements And Steps From The Disclosed Embodiments Of The '992 Patent

a) Store Source Material Programs (e.g., Items Of Information) In A Library

Like the local Blockbuster outlet "stores" videos, the source material library (111) of the '992 patent stores "items of information [which] may include analog and digital audio and video information as well as physical objects such as books and records." ('992 patent, 6:2-4). The source material library (111) stores "different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer tapes, computer disks, documents of various sorts, musical instruments, and other physical objects."⁸ ('992 patent, 6:12-15). Items of information may be in different media formats, such as digital or analog video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and

⁸ This storage may be permanent or temporary: "... a preferred embodiment of the present invention preferably includes source material library means for temporary storage of items prior to conversion." ('992 patent, 5:66 - 6:1).

1 cartridges. ('992 patent, 6:19-22).

2 **b) Assign Each Item Of Information A Unique**
3 **Identification Code So That The Program Can Be**
4 **Located And Accessed Later**

5 Just as a librarian uses the Dewey Decimal System to separately identify each
6 book in a library, each item of information is separately assigned a unique
7 identification code which may be used to identify, request, locate, and access the item
8 throughout the system. ("Prior to being made accessible to a user of the transmission
9 and receiving system of the present invention, the item must be . . . given a unique
10 identification code by identification encoder 112.") ('992 patent, 6:35-39; See also,
11 6:40-54; 10:58-65; 11:22-28; 14:22-28; 18:53-68).

12 Individual items of information are also separately retrieved from the source
13 material library. Retrieving the information in the items is "analogous to taking books
14 off of a shelf at the local public library after the person has decided that he or she
15 would like to read them." ('992 patent, 18:53-59). An example of retrieved
16 information from the source material library is a motion picture film. ('992 patent,
17 7:35-37).

18 **c) Convert And Format Separate Source Material**
19 **Programs Into A Compatible Digital Format**

20 The items of information in the source material library may be in many
21 different analog or digital formats. In order to be transmitted in a form that can be
22 transmitted, received and played back, the items of information need to be converted
23 to a predetermined, compatible digital format for further processing by the converter
24 (113), which includes input receivers (124 and 127) (for analog or digital items) and
25 formatters (123 and 125). ('992 patent, 6:55 - 7:58).

26 **d) Order The Formatted Material (i.e., Assign Time Codes)**

27 Because audio/video content has a time element (i.e., frames/second or
28 samples/second), the time relationship of data blocks within the audio/video content

1 must be preserved throughout the system. Each data block is time encoded, using a
2 time encoder, so that a relative relationship of one addressable data block to another is
3 created. By this process, each item of information, previously transmitted, is now
4 placed into a sequence of addressable data blocks, i.e., it is time encoded by a time
5 encoder (114): "Time encoding by time encoder 114 is achieved by assigning relative
6 time markers to the audio and video data." ('992 patent, 8:16-19; See also, 7:59 - 8:15
7 and 8:20-56). Time encoding of the data blocks is important, because "[r]ealignment
8 of audio and video data, system addressing of particular data bytes, and user
9 addressing of particular portions of items are all made possible through time
10 encoding."⁹ ('992 patent, 8:20-23).

11 **e) Compress The Formatted, Ordered Data Blocks**

12 Bandwidth limits transmission capabilities. Therefore, to facilitate
13 transmission, the addressable, time encoded data blocks are data compressed in
14 compressor 116 (audio data may be compressed separately (128) from the video data
15 (129)). ('992 patent, 9:41 - 10:16). No specific compression algorithm is required,
16 although the '992 patent discloses that "video data compression preferably involves
17 applying two processes: a discrete cosine transform, and motion compensation."¹⁰
18 ('992 patent, 10:7-9). Further, the compression algorithm operates on blocks of data:
19 "Audio and video information is preferably converted into blocks of data organized in
20 groups for compression processing by audio compressor 128 and video compressor
21 129, respectively. These blocks are organized as frames, and a number of frames are
22

23 ⁹ After being placed into a sequence of addressable data blocks, the sequenced
24 data blocks may then be sent to a precompression processor 115. In the
25 precompression processor, the data blocks are buffered prior to being compressed and
26 they may be undergo additional formatting, e.g., aspect ratio conversion. ('992
27 patent, 8:57 - 9:40). The precompression processor is shown in Figure 2a, but it is not
28 part of either claim 1 or claim 41 of the '992 patent.

¹⁰ Discrete cosine transform and motion compensation are utilized in most of the
popular compressors in use today, particularly MPEG-2, Windows Media, Real, and
Apple.

1 contained respectively in the buffers 130 and 131. By analyzing a series of frames it
2 is possible to optimize the compression process.” (‘992 patent, 9:50-57).

3 **f) Store The Formatted, Ordered, And Compressed Data**
4 **Blocks As A File In A Storage Library**

5 Following compression, the addressable, time encoded data blocks of one of the
6 items may be formatted into a single file (i.e., the audio and video data is recombined)
7 in the compressed data formatting section (117). (‘992 patent, 10:17-30). The file
8 may then be stored in a compressed data library (Figure 2b) (118). The compressed
9 data library is preferably a mass storage device for storing multiple files. (‘992
10 patent, 10:31-45).

11 Each file stored in the compressed data library is addressable by the unique
12 identification code assigned to that item. (‘992 patent, 10:28-30; 11:22-25). The
13 system operates on multiple items by executing on each item individually. This is
14 apparent from the methodology taught in the patent: each item of information is
15 given a unique identification code; each item, following compression, is placed in a
16 file; each file is addressable through the unique identification code; and users may
17 access and request the file using the unique identification code. In other words, when
18 items are to be made available for transmission, a first item is retrieved from the
19 source material library, it is assigned a unique identification code, it is converted,
20 ordered, compressed, and placed into a file and stored in the compressed data library
21 with the assigned unique identification. Additional items are then individually
22 processed in this same manner.

23 **g) Transmit At Least A Portion Of The File To A Remote**
24 **Location**

25 The file (or at least a portion of the file) is then transmitted to a remote location
26 using a transmitter (112). A transmission data converter (119) may encode data for
27 the transmitter. (‘992 patent, 15:55-60). The transmitter places the formatted data
28 onto a communications channel, i.e. standard telephone, ISDN, B-ISDN, microwave.

1 DBS (direct broadcast satellite), cable television systems, metropolitan area networks,
2 local area networks, high speed modems, communication couplers, VHF, or UHF
3 broadcasting systems. ('992 patent, Fig. 2b; 4:61-63;15:65-16:15 and 16:53-69). The
4 type of transmitter used will depend upon the particular communication channel being
5 utilized for transmission. ('992 patent, 16:53-61).

6 **h) Receive The Compressed, Digital Information**

7 A reception system is located at the remote location. One example of the
8 reception system is depicted in Figure 6 of the '992 patent. The reception system
9 includes a transceiver (201) which may receive the information in the file transmitted
10 by the transmitter as compressed, formatted data blocks (122, Figure 2b). ('992
11 patent, 4:64-69; 17:67 - 18:8). A receiver format converter (202) may convert the
12 compressed formatted data blocks into a format suitable for playback by the user in
13 real time. ('992 patent, 18:9-13).

14 **i) Store (Temporarily Or For Longer Periods Of Time) At**
15 **Least A Portion Of The Received Information**

16 The received, converted information may then be stored prior to decompression
17 and prior to playback. The user may chose to play back the information at a later
18 time, and, if so, all of the received information is stored in storage 203 ('992 patent,
19 18:14-21). In the alternative, the information may be decompressed in real time as it
20 is distributed by the transmission system, in which case, a portion of the received
21 information is buffered (temporarily stored) while another portion is decompressed
22 for immediate viewing as it is distributed by the transmission system. ('992 patent,
23 4:68 - 5:9).

24 **j) Decompress The Information**

25 When the user requests playback, the information may be sent to the data
26 formatter (204) which distinguishes audio information from video information. ('992
27 patent, 18:22-26). The separated audio and video information may then be
28 decompressed by the decompressor (208 for video information and 209 for audio

1 information). ('992 patent, 18:27-29). The time encoding of the data blocks, prior to
2 compression, allows for the realignment of the audio and video prior to playback.
3 ('992 patent, 8:20-23).

4 **k) Playback The Information Using Playback Controls**

5 The decompressed information may then be sent to output converters (211-214)
6 where the information is output in real time in a format compatible with a playback
7 device (i.e., a computer monitor, a television, or audio speakers). ('992 patent, 18:29-
8 35). Additionally, the receiving system may include playback controls, which permit
9 the user, for example, to play, fast forward, rewind, stop, pause, and play slow the
10 output information. ('992 patent, 17:35-43 and 18:36-45).

11 **2. Description Of System Elements And Steps From The Figures**
12 **And A Representative Claim Of The '992 Patent**

13 The systems and methods described above are reinforced by Figure 2a of the
14 '992 patent, which Acacia has reproduced below.¹¹ For the convenience of the Court,
15 Acacia has color-coded Figure 2a and the elements of representative claim 1 of the
16 '992 patent to show the correspondence between the elements of the claim and Figure
17 2b.

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20 ///

21 ///

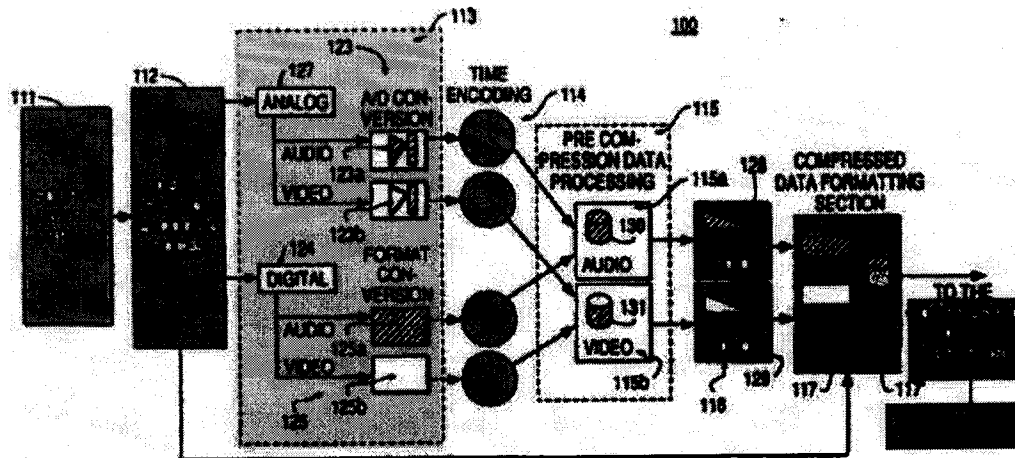
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27 ¹¹ Acacia has added the "transmitter" (shown in red in the lower right corner of
28 the Figure). The transmitter and the compressed data library are shown in Figure 2b
of the '922 patent. Figure 2b is a continuation of the exemplary system shown in
Figure 2a.

Figure 2a Of The '992 Patent



Claim 1 Of The '992 Patent

1. A transmission system for providing information to be transmitted to remote locations, the transmission system comprising:

library means for storing items containing information;

identification encoding means for retrieving the information in the items from the library means and for assigning a unique identification code to the retrieved information;

conversion means, coupled to the identification encoding means, for placing the retrieved information into a predetermined format as formatted data;

ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks;

[REDACTED]; and

transmitter means, coupled to the compressed data storing means,

1 for sending at least a portion of one of the files to one of the remote
2 locations.

3 **II. PRINCIPLES OF CLAIM CONSTRUCTION**

4 As this Court is aware, the Federal Circuit has established well-settled
5 principles for construing patent claims in order to achieve a proper construction.
6 Acacia has provided the case law most relevant to the claim construction issues
7 presented in this case.

8 The claims of the patent define the scope of an invention and therefore courts
9 begin the construction process by examining the language of the claim itself. Alloc.
10 Inc. v. International Trade Commission, 342 F.3d 1361, 1368 (Fed. Cir. 2003);
11 Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed. Cir.
12 2000).

13 **A. Claim Terms Are Presumed To Carry Their Ordinary And** 14 **Customary Meaning**

15 Courts indulge a “heavy presumption” that a claim term carries its ordinary and
16 customary meaning. CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366
17 (Fed. Cir. 2002); Johnson Worldwide, 175 F.3d at 989 (“a court must presume that the
18 terms in the claim mean what they say, and, unless otherwise compelled, give full
19 effect to the ordinary and accustomed meaning of claim terms.”); Alloc, 342 F.3d at
20 1368, quoting Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1367 (Fed. Cir.
21 2003) (“‘Claim language generally carries the ordinary meaning of the words in their
22 normal usage in the field of the invention’ at the time of the invention.”)

23 In determining what the ordinary and customary meaning of a claim term is,
24 “the context of the surrounding words in a claim also must be considered.” Arlington
25 Industries, Inc. v. Bridgeport Fittings, Inc., 345 F.3d 1318, 1325 (Fed. Cir. 2003). A
26 court may “immerse itself in the specification, the prior art, and other evidence, such
27 as the understanding of skilled artisans at the time of invention, to discern the context
28 and normal usage of the words in the patent claim.” Alloc, 342 F.3d at 1368, citing,

1 Hoescht Celanese Corp. v. BP Chemicals, Inc., 78 F.3d 1575, 1579 (Fed. Cir. 1996).

2 Courts are cautioned, however, not to import limitations from the specification
3 or prosecution history when discerning the ordinary and customary meaning of a
4 claim term. Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1201 (Fed.
5 Cir. 2002) (“Consulting the written description and prosecution history as a threshold
6 step in the claim construction process, before any effort is made to discern the
7 ordinary and customary meanings attributed to the words themselves, invites a
8 violation of our precedent counseling against importing limitations into the claims.”)

9 Dictionaries and scientific treatises may also help supply the pertinent context
10 and usage for claim construction. Alloc, 342 F.3d at 1368, citing, Texas Digital, 308
11 F.3d at 1201 and Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309
12 (Fed. Cir. 1999).¹² Dictionary definitions may even be used by a court to establish a
13 claim term’s ordinary meaning, so long as the dictionary definition does not
14 contradict any definition found in or ascertained by a reading of the patent documents.
15 CCS Fitness, 288 F.3d at 1366; Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576,
16 1584 n. 6; and so long as the dictionary definition is consistent with the use of the
17 words by the inventor. Texas Digital, 308 F.3d at 1204, citing, Dow Chemical Co. v.

18
19 ¹² Dictionaries may even be the most meaningful sources of information to aid the
20 court in better understanding the technology and the terminology used by those skilled
in the art:

21 When a patent is granted, prosecution is concluded, the intrinsic record is
22 fixed, and the public is placed on notice of its allowed claims.
23 Dictionaries, encyclopedias and treatises, publicly available at the time
the patent is issued, are objective resources that serve as reliable sources
24 of information on the established meanings that would have been
attributed to the terms of the claims by those of skill in the art. Such
25 references are unbiased reflections of common understanding not
influenced by expert testimony or events subsequent to the fixing of the
26 intrinsic record by the grant of the patent, not colored by the motives of
the parties, and not inspired by litigation. Indeed, these materials may be
27 the most meaningful sources of information to aid judges in better
understanding both the technology and the terminology used by those
skilled in the art to describe the technology.

28 Texas Digital, 308 F.3d at 1202-03.

1 Sumitomo Chemical Co., 257 F.3d 1364, 1372-73 (Fed. Cir. 2001) and Multiform
2 Dessicants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1433 (Fed. Cir. 1998); See also,
3 Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1300 (Fed. Cir.
4 2003).

5 **B. The Presumption That Claim Terms Carry Their Ordinary And**
6 **Customary Meaning May Be Overcome**

7 While a court begins with the ordinary and customary meaning of the claim
8 term, it must also examine the intrinsic record to determine whether anything in the
9 record overcomes the presumption that the term has the ordinary meaning. Arlington
10 Industries, 345 F.3d at 1326.

11 There are limited circumstances where the “heavy presumption” that a claim
12 term is given its ordinary and accustomed meaning may be overcome and the court
13 may supply a definition of a claim term or phrase different than its ordinary and
14 accustomed meaning. CCS Fitness, 288 F.3d at 1366. In each circumstance there
15 must be textual language from the patent specification that is clearly associated with a
16 claim term and its proffered construction. Johnson Worldwide, 175 F.3d at 989.

17 First, a claim term will not receive its ordinary meaning if the patentee acted as
18 his own lexicographer and clearly set forth a definition of the disputed claim term in
19 either the specification or prosecution history. Id.; Johnson Worldwide, 175 F.3d at
20 990.

21 Second, a claim term will not carry its ordinary meaning if the intrinsic
22 evidence shows that the patentee (i) distinguished that term from prior art on the basis
23 of a particular embodiment, (ii) expressly disclaimed subject matter, or (iii) described
24 a particular embodiment as important to the invention. CCS Fitness, 288 F.3d at
25 1366-67.

26 In evaluating whether this second situation exists sufficient to depart from the
27 ordinary means of a term, a court must proceed with caution—on the one hand, a
28 court must interpret the claims in light of the specification, however, on the other

1 hand, a court must avoid impermissibly importing limitations from the specification
2 into the claims. Alloc, 342 F.3d at 1370. Only statements which evince a “clear and
3 unmistakable surrender of subject matter” or a “clear disavowal of claim scope” will
4 cause a claim term to be given a meaning different than its ordinary meaning.
5 Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1325 (Fed. Cir. 2002)
6 (“We hold that claim terms take on their ordinary and accustomed meanings unless
7 the patentee demonstrated an intent to deviate from the ordinary and accustomed
8 meaning of a claim term by redefining the term or by characterizing the invention in
9 the intrinsic record using words or expressions of manifest exclusion or restriction,
10 representing a clear disavowal of claim scope.”); Cordis Corp. v. Medtronic AVE,
11 Inc., 339 F.3d 1352, 1363 (Fed. Cir. 2003) (“To invoke argument-based estoppel, the
12 prosecution history must evince a ‘clear and unmistakable surrender of subject
13 matter.’”); See also, IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1439
14 (Fed. Cir. 2000); Middleton, Inc. v. Minnesota Mining and Manufacturing Co., 311
15 F.3d 1384, 1388 (Fed. Cir. 2002).

16 Further, although it is proper to use the specification to interpret what the
17 patentee meant by a word or a phrase in the claim, a court cannot give a claim term a
18 meaning different than its ordinary meaning simply because the specification
19 describes a certain embodiment as being preferred or only describes one or a few
20 embodiments. E.I. Du Pont De Nemours & Co. v. Phillips Petroleum Co., 849 F.2d
21 1430, 1433 (Fed. Cir. 1988) (“It is entirely proper to use the specification to interpret
22 what the patentee meant by a word or phrase in the claim. But this is not to be
23 confused with adding an extraneous limitation appearing in the specification, which is
24 improper.”);¹³ If, however, the specification makes clear that the claimed invention is
25 narrower than the claim language might imply, it is entirely permissible and proper to
26

27 ¹³ A patentee need not “describe in the specification every conceivable and
28 possible future embodiment of his invention.” CCS Fitness, 288 F.3d at 1366,
quoting, Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1344 (Fed. Cir. 2001).

1 limit the claims. Alloc, 342 F.3d at 1366, citing, SciMed Life Sys., Inc. v. Advanced
2 Cardiovascular Sys., Inc., 242 F.3d 1337, 1345 (Fed. Cir. 2001).

3 Next, a claim term will not have its ordinary and accustomed meaning if the
4 term “chosen by the patentee so deprives the claim of clarity.” CCS Fitness, 288 F.3d
5 at 1367. In such cases, the court must construe the claim term consistent with the
6 meaning found in the intrinsic patent record. J.T. Eaton & Co. v. Atlantic Paste &
7 Glue Co., 106 F.3d 1563, 1568 (Fed. Cir. 1997) (Because “[the disputed claim term]
8 is a term with no previous meaning to those of ordinary skill in the prior art[,] its
9 meaning, then, must be found [elsewhere] in the patent.”); North American Vaccine,
10 Inc. v. American Cyanamid Co., 7 F.3d 1571, 1576 (Fed. Cir. 1993) (using the
11 specification for guidance “when the meaning of a claim term is in doubt.”)

12 Lastly, claim terms which are phrased using the word “means” give rise to a
13 presumption that the inventor used the term advisedly to invoke the statutory
14 mandates for means-plus-function clauses set forth in 35 U.S.C. § 112, ¶ 6. Sage
15 Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420, 1427 (Fed. Cir. 1997). This
16 presumption is not conclusive. Where “a claim recites a function, but then goes on to
17 elaborate sufficient structure, material, or acts within the claim itself to perform
18 entirely the recited function, the claim is not in a means-plus-function format.”
19 Enviroco Corp. v. Clestra Cleanroom, Inc., 209 F.3d 1360, 1365 (Fed. Cir. 2000),
20 quoting, Sage Products, 126 F.3d at 1427-28; CoLe v. Kimberly-Clarke Corporation,
21 102 F.3d 524, 531 (Fed. Cir. 1196); Rodime PLC v. Seagate Technology, Inc., 174
22 F.3d 1294, 1302-03 (Fed. Cir. 1999).

23 In construing means-plus-function claim limitations, a court must first define
24 the particular function claimed, and thereafter identify “the corresponding structure,
25 material, or acts described in the specification.” Sage Products, 126 F.3d at 1428.¹⁴

27 ¹⁴ Whether or not the specification adequately sets forth structure corresponding
28 to the claimed function necessitates consideration of that disclosure from the
viewpoint of one skilled in the art. Budde v. Harley-Davidson, Inc., 250 F.3d 1369,
1376 (Fed. Cir. 2001), citing, North American Vaccine, 7 F.3d 1579; In re Ghiron,

Means-plus-function claim limitations are construed, pursuant to 35 U.S.C. § 112, ¶ 6, as covering “the corresponding structure, material, or acts described in the specification and equivalents thereof.”

In the end, a persuasive claim construction is one which defines terms in the context of the whole patent:

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. [citation omitted]. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction. [citations omitted]. A claim construction is persuasive, not because it follows a certain rule, but because it defines terms in the context of the whole patent.

Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

III. ACACIA'S CONSTRUCTION OF THE EIGHT CLAIM PHRASES AT ISSUE¹⁵

A. “REMOTE LOCATIONS”

The phrase “remote locations” is found in claims 1, 19, 22, 25, 41, 47, and 54 of the '992 patent. (Exhibit 4 shows the use of this phrase throughout the '992 patent). The phrase “remote locations” should be construed to mean “positions or sites distant in space from the position(s) or site(s) of the transmission system.”

In claim 1, the phrase “remote locations” is used in the phrases:

442 F.2d 985, 991 (C.C.P.A. 1971) (stating that “if such selection would be ‘well within the skill of persons skilled in the art’, such functional-type block diagrams may be acceptable and, in fact, preferable if they serve in conjunction with the rest of the specification to enable a person skilled in the art to make such a selection and practice the claimed invention with only a reasonable degree of routine experimentation.”) Failure to disclose adequate structure corresponding to the recited function results in the claim being of indefinite scope and thus invalid under 35 U.S.C. § 112 (1). Thus, such a challenge to the patent requires a finding by clear and convincing evidence that the specification lacks disclosure of sufficient structure to be understood by one skilled in the art as being adequate to perform the recited function. Budde, 250 F.3d at 1376-77.

¹⁵ Exhibit 3 to Acacia's Appendix shows Acacia's construction for each of these initial eight phrases at issue in this brief.

1 A transmission system for providing information to be transmitted
2 to remote locations;

* * *

3 transmitter means, coupled to the compressed data storing means,
4 for sending at least a portion of one of the files to one of the
5 remote locations.

6 In claim 41, the phrase "remote locations" is used in the phrases:

7 A method of transmitting information to remote locations; the
8 transmission method comprising the steps, performed by a
9 transmission system,

* * *

10 sending at least a portion of the file to one of the remote locations.

11 The Court must begin with the ordinary and customary meaning of the words of
12 the phrase "remote locations." Arlington Industries, 345 F.2d at 1326. The term
13 "remote" has a relevant dictionary definition: "1 : separated by an interval or space
14 greater than usual" (Webster's Ninth New Collegiate Dictionary, Merriam-Webster,
15 Inc., at 996 (1983) (hereinafter "Webster's"); Exhibit ____). Another way of
16 expressing this definition is "distant in space." The term "location" has a relevant
17 dictionary definition: "1 a : a position or site occupied or available for occupancy or
18 marked by some distinguishing feature." (Webster's, at 700; Exhibit 12). The
19 ordinary and customary meaning of "remote locations" is therefore "positions or sites
20 that are distant in space."

21 In the context of claims 1 and 41, the term "remote locations" is described in
22 relation to the transmission system: "A transmission system for providing
23 information to be transmitted to remote locations . . ." and "A method of transmitting
24 information to remote locations; the transmission method comprising the steps,
25 performed by a transmission system." Thus, in the context of the claims, the phrase
26 "remote locations" must be relative to the location of the transmission system and
27 therefore, consistent with its ordinary and customary meaning and in the context of
28 claims 1 and 41 of the '992 patent, the phrase "remote locations" means "positions or
sites distant in space from the position(s) or site(s) of the transmission system." CCS

1 Fitness, 288 F.3d at 1366.

2 To determine whether the ordinary and customary definition of “remote
3 locations” is consistent with the use of these words by the inventors, the Court must
4 also consult the intrinsic patent record. Texas Digital, 308 F.3d at 1204.

5 In the specification of the ‘992 patent, the inventors describe the fact that, at the
6 time of the invention, video tapes must be obtained by rental or purchase and that
7 “remote accessing has not yet been integrated into an efficient system.” (‘992 patent,
8 1:11-17). One of the objects of the invention is therefore to allow the user to
9 “remotely select audio/video material from any location that has either telephone
10 service or a computer.” (‘992 patent, 1:62-66; emphasis added). The specification
11 further describes that the transmitter means sends at least a portion of a file to at least
12 one remote location and that information is sent from the transmission system 100 to
13 remote locations. (‘992 patent, 15:61-65; 18:46-50).¹⁶ Thus, the intrinsic patent
14 documents wholly reinforce the ordinary and customary definition of “remote
15 locations.”

16 **B. “Library Means For Storing Items Containing Information”**

17 The phrase “library means for storing items containing information” is found in
18 claim 1 of the ‘992 patent. (Exhibit 5 shows the use of this phrase throughout the
19 ‘992 patent). Acacia contends this is not a means plus function limitation, because the
20 sufficient structure is disclosed in the claim. The phrase is comprised of three

21
22 ¹⁶ There are embodiments described in the specification wherein a user “may
23 remotely access the transmission system 100 from a location different than the
24 location of the reception system 200 where the material will be sent and/or played
25 back” and “[a]fter the desired item is found, the user selects the item for transmission
26 at a specific time and location.” (‘992 patent, 5:14-17; 15:20-22). These are merely
27 different embodiments of the invention described in the specification, and nothing in
28 the specification limits the invention to these embodiments. Brookhill-Wilk, 334 F.3d
at 1300 (construing the phrase “remote location” as having its ordinary and customary
meaning and refusing to limit the construction to embodiments of the specification.)
Further, other embodiments, set forth in the specification and described above, do not
require that the user be able to select the location for receipt of the transmission.
(‘992 patent, 15:61-65; 18:46-50).

1 separate terms/phrases: (1) library; (2) storing; and (3) items containing information.
2 Each is discussed below.

3 1. **The Meaning Of The Term “Library”**

4 The term “library” should be construed as “a place where materials are kept or
5 a collection of such materials.” The term “library” has a relevant dictionary
6 definition: “**1 a:** a place in which literary, musical, artistic, or reference materials (as
7 books, manuscripts, recordings, or films) are kept for use, but not for sale **b:** a
8 collection of such materials.” (Webster’s, at 688; Exhibit 12).

9 In the specification of the ‘992 patent, the inventors used the term in its
10 ordinary and customary way. They stated that items are stored in the source material
11 library. (‘992 patent, 6:52-54; 6:62-64; 18:1-3; 18:53-59; 19:51-54). The inventors
12 further described the library as having a geographical location which can be remote
13 from a database or remote from a receiving system. (‘992 patent, 2:65-66; 6:23-30;
14 15:13-15). They also described libraries as being able to communicate via any
15 available method with any other library in the transmission system. (‘992 patent,
16 6:28-34).

17 2. **The Meaning Of The Term “Storing”**

18 The term “storing” should be construed as having its ordinary and customary
19 meaning -- “providing storage room for.” The term “store” has a relevant dictionary
20 definition: “**4:** to provide storage room for: HOLD <elevators for *storing* surplus
21 wheat>.” (Webster’s, at 1162; Exhibit 12). This particular definition of “store”
22 applies, because the claim uses the term “library,” which connotes storage, and
23 because the specification states that the “invention preferably includes source material
24 library means for temporary storage of items prior to conversion and subsequent
25 storage in a compressed data library means.” (‘992 patent, 5:66-6:2; emphasis added;
26 See, also, 6:52-54; 6:62-64; 18:1-3; 18:53-59; 19:51-54). Indeed, the example of the
27 usage of this meaning of “store” in the dictionary (“elevators for *storing* surplus
28 wheat”) is in the same form as that in the claim.

1 **3. The Meaning of the Phrase “Items Containing Information”**

2 The phrase “items containing information” should be construed as follows:
3 “units or members of a group or groups which contain information. Information is the
4 meaning assigned to data by known conventions.” The term “item” has a relevant
5 dictionary definition: “**2** A separate particular in an enumeration, account, or series:
6 **ARTICLE**” (Webster’s at 643; Exhibit 12). Another way of expressing this definition
7 is “one unit or a member of a group.” The term “items” is the plural of “item” and
8 therefore “items” are “units or members of a group or groups.”

9 The term “information” has a relevant dictionary definition: “**(1)** the meaning
10 assigned to data by known conventions.” (IEEE Standard Dictionary of Electrical and
11 Electronic Terms, Fourth Edition, at 473 (1988) (hereinafter “IEEE Dictionary”);
12 Exhibit 13).

13 The specification uses this phrase consistent with its ordinary and customary
14 meaning. It states that items of information are stored in the source material library
15 means and may be in either analog or digital form. (‘992 patent, 5:66 - 6:7; 6:62-64;
16 19:51-56; Fig. 8e). The items stored are materials, such as “television programs,
17 movies, audio recordings, still pictures, files, books, computer tapes, computer disks,
18 documents of various sorts, musical instruments, and other physical objects” which
19 are converted to or recorded on a media format. (‘992 patent, 6:10-22). These are
20 non-limiting examples of the items containing information which are stored in the
21 library means (or source material library).

22 According to the specification of the ‘992 patent, each item must be assigned
23 its own unique identification code and each item is stored in the compressed data
24 library as a file comprising the compressed, formatted, sequenced data blocks for that
25 item. (‘992 patent, 6:35-39; 10:23-26). Each file is addressable through the unique
26 identification code assigned to the item whose data blocks are stored within the file
27 and such file is accessed and requested via this unique identification code. (10:26-30;
28 11:22-25; and 14:22-28).

1 Each item may also have a name, title, production credits (i.e., names of
2 producer, directors, actors, etc.), and other identifying information which may be
3 stored for each item. (6:39-54; 10:66-11:4; 12:8-27; 58-65; 15:3-22). Each item's
4 unique identification code or unique address code, title, name, production credits, etc.
5 may be stored and may be used to request and access the item throughout the
6 transmission and receiving system. ('992 patent, 10:23-30; 10:62 - 11:9; 11:22-25;
7 12:8-27; 14:22-28; 14:34-48; 15:3-22). Each item may also be given a popularity
8 code and each item may be stored in its compressed form on a different library
9 depending upon its popularity. ('992 patent, 6:39-54; 12:28-57).

10 In one example, the specification describes an "item" as a "program." The '992
11 patent describes the steps of finding and selecting a "desired item" and shows in
12 Figure 4 that this entails finding a "desired program" and selecting the "program for
13 transmission." See, '992 patent, 15:6-10 and 20-22. In other words, a program is an
14 example of an item.

15 4. Conclusion -- The Meaning Of The Phrase "Library Means 16 For Storing Items Containing Information"

17 The claim phrase "library means for storing items containing information" uses
18 the words "means for" and thus there is a rebuttable presumption that the inventors
19 intended to invoke the means-plus-function construction pursuant to 35 U.S.C. § 112,
20 ¶ 6. Here, the presumption is rebutted by the fact that the claim term "library"
21 elaborates sufficient structure, material, or acts within the claim itself to perform
22 entirely the recited function of storing items containing information.

23 The term "library" is used in the claim. A library, as discussed above, is "a
24 place where materials are kept or a collection of such materials." A library is
25 therefore a structure -- a place or a collection. The specification states that the library
26 has a geographical location and that multiple libraries in a system may communicate
27 with one another. ('992 patent, 2:65-66; 6:23-30; and 15:13-15).

28 A place or a collection is a sufficient structure to perform the claimed function

1 of “providing storage room for items containing information.” See, Kimberly-Clark,
2 102 F.3d at 1006-07 (holding that the limitation “perforation means for tearing” was
3 not a means-plus-function claim because the word “perforation” constituted sufficient
4 structure.); Envirco, 209 F.3d at 1365 (holding that Section 112, ¶ 6 does not apply
5 where sufficient physical structure was recited (baffle) and the claim described the
6 particular structure of this particular baffle); Rodime, 174 F.3d at 1303-04 (holding a
7 claim recited sufficient structure where the limitation was “positioning means” and
8 the claim “provided a list of the structure underlying the means”).

9 Therefore, the claim phrase “library means for storing items containing
10 information” is not construed under Section 112, ¶ 6. The phrase “library means for
11 storing items containing information” is therefore construed as:

12 a place where items of information are kept or which constitutes a
13 collection of items of information where items are units or members of a
14 group or groups and information is any meaning assigned to data by
known conventions.

15 C. “Storing Items Having Information In A Source Material Library”

16 The phrase “storing items having information in a source material library” is
17 found in claim 41 of the ‘992 patent. (Exhibit 6 shows the use of this phrase
18 throughout the ‘992 patent).

19 The phrase is comprised of three separate terms/phrases: (1) storing; (2) items
20 having information; and (3) source material library, all of which should be defined in
21 their ordinary and customary usage.

22 1. The Meaning Of The Term “Storing”

23 The term “storing” in the context of this phrase of claim 41 is being used to
24 describe a definite action -- the act of “storing.” The dictionary definition for this use
25 of the term “storing” is “3: to place or leave in a location (as a warehouse, library, or
26 computer memory) for preservation or later use or disposal.” (Webster’s, at 1162;
27 Exhibit 12).

1 **2. The Meaning Of The Phrase “Items Having Information”**

2 There is no material difference between the phrases “items containing
3 information” (from claim 1) and “items having information” from claim 41. As
4 previously discussed, the phrase “items having information” is construed as “units or
5 members of a group or groups which have information. Information is the meaning
6 assigned to data by known conventions.” (‘992 patent, 6:12-15 and 6:19-22)

7 **3. The Meaning Of The Phrase “Source Material Library”**

8 The term “source” has a relevant dictionary definition: “**1 b (1):** a point of
9 origin or procurement: beginning.” (Webster’s, at 1127; Exhibit 12). The term
10 “material” has a relevant dictionary definition: “**1 a (1):** relating to, derived from, or
11 consisting of matter. . . **3 b:** relating to or concerned with physical rather than spiritual
12 or intellectual things.” (Webster’s, at 733; Exhibit 12). The term “library” has a
13 relevant dictionary definition: “**1 a:** a place in which literary, musical, artistic, or
14 reference materials (as books, manuscripts, recordings, or films) are kept for use, but
15 not for sale **b:** a collection of such materials.” (Webster’s, at 688; Exhibit 12). Thus,
16 the phrase “source material library” is construed as: “a place where source material is
17 kept or a collection of source material. Source material are physical things at the
18 point of origin or procurement.”

19 **4. Conclusion -- The Meaning Of The Phrase “Storing Items**
20 **Having Information In A Source Material Library”**

21 Pursuant to the above, the phrase “storing items having information in a source
22 material library” is construed as:

23 the act of placing items having information in a source
24 material library for later use where a source material library
25 is a place where source material is kept or a collection of
26 such material, source material are physical things at the
27 point of origin or procurement, items having information are
28 units or members of groups which have information, and
information is any meaning assigned to data by known
conventions.

1 **D. “Unique Identification Code”**

2 The phrase “unique identification code” is found in claims 1 and 41 of the ‘992
3 patent. (Exhibit 7 shows the use of this phrase in the ‘992 patent). It is used in its
4 ordinary and customary usage, and should be construed as “symbols used to identify,
5 such symbols being unique in the sense that no two identification codes are identical
6 when assigned.”

7 In claim 1, the phrase “unique identification code” is used in the phrases:

8 identification encoding means for retrieving the information in the
9 items from the library means and for assigning a unique
10 identification code to the retrieved information;

 * * *

11 compressed data storing means, coupled to the data compression
12 means, for storing as files the compressed, sequenced data blocks
13 received from the data compression means with the unique
14 identification code assigned by the identification encoding means

15 In claim 41, the phrase “unique identification code” is used in the phrases:

16 assigning a unique identification code to the retrieved
17 information;

 * * *

18 storing, as a file, the compressed, formatted, and sequenced data
19 blocks with the assigned unique identification code;

20 The term “unique” has a relevant dictionary definition: “1: being the only one.”
21 (Webster’s, at 1290; Exhibit 12). The term “identification” has a relevant dictionary
22 definition: “1 a: an act of identifying.” (Webster’s, at 597; Exhibit 12). The term
23 “code” has a relevant dictionary definition: “3 b: a system of symbols (as letters,
24 numbers, or words) used to represent assigned and often secret meanings.”
25 (Webster’s, at 255; Exhibit 12).

26 The specification of the ‘992 patent states that a unique identification code is
27 assigned by the identification encoder 112 and that the compressed sequenced data
28 received from the compression means is stored as a file with the unique identification
code. (‘992 patent, 2:43-45). The specification further describes the purposes for the

1 unique identification codes as: (1) making files addressable: “[t]he file is addressable
2 through the unique identification code assigned to the data by the identification
3 encoder 112” (‘992 patent, 10:28-30); (2) permitting a user to have access to an item:
4 “a user may preferably access an item via its unique identification code, via its title, or
5 the user may use other known facts for accessing an item” (‘992 patent, 11:22-25);
6 and (3) permitting a user to request transmission of a selected item: “The user request
7 may preferably be made from a catalog sent to each of the subscribers of the system.
8 The user will preferably identify his choice and enter the corresponding identification
9 code of the item (step 3060)” (‘992 patent, 14:22-26).¹⁷

10 Thus, to achieve the purposes of the unique identification code as set forth in
11 the specification (i.e., to make files addressable, and permit access and requests), the
12 identification code is unique in the sense that no two identification codes are identical
13 when assigned (the claim language is “assigning a unique identification code.”).

14 **E. “Identification Encoding Means For Retrieving The Information In**
15 **The Items From The Library Means And For Assigning A Unique**
16 **Identification Code To The Retrieved Information”**

17 The phrase “identification encoding means for retrieving the information in the
18 items from the library means and for assigning a unique identification code to the
19

20 ¹⁷ The ‘992 patent specification describes other codes or addresses which also are
21 used for the same purposes -- the “unique address code,” the “file address,” the
22 “library system address,” and the “compressed data library address.” (‘992 patent,
23 6:48-52 and 10:46-65). These other codes are merely other embodiments of the
24 unique identification code, which alone, or in combination, make items addressable
25 and permit user access and requests for items. (‘992 patent, 10:46-65 and 11:25-28).
26 Like the unique identification code, the unique address code is assigned by the
27 identification encoder 112. (‘992 patent, 6:49-50; 11:58-61). Like the unique
28 identification code, the unique address code is described as being a file address “for
uniquely identifying the compressed data items stored in the compressed data library
section of a library system” and as also permitting users access to the item and
making the files addressable. (‘992 patent, 10:46-65; 11:25-28). In a preferred
embodiment, the identification encoder assigns both a unique identification code and
a file address. (‘992 patent, 6:49-50). Thus, the claim phrase “unique identification
code” encompasses the unique address code, the file address, the library system
address, and the compressed data library address, either alone or in combination.

1 retrieved information” is found in claim 1 of the ‘992 patent. (Exhibit 8 shows the
2 use of this phrase throughout the ‘992 patent).

3 This phrase includes the terms “means for” and therefore the phrase is
4 presumed to be construed as a means-plus-function claim element pursuant to 35
5 U.S.C. § 112, ¶ 6. This presumption is not rebutted and this claim phrase is construed
6 as a means-plus-function claim element. Thus, the Court must first define the claimed
7 function in this phrase. Sage Products, 126 F.3d at 1427-28.

8 **5. The Two Claimed Functions -- “Retrieving The Information In**
9 **The Items From The Library Means” And “Assigning A**
10 **Unique Identification Code To The Retrieved Information”**

11 There are two functions performed by the identification encoding means, which
12 are found in the claim element itself -- (1) retrieving the information in the items from
13 the library means; and (2) assigning a unique identification code to the retrieved
14 information.

15 **I) The Meaning Of The Phrase “Retrieving Information In**
16 **The Items From The Library Means”**

17 The ordinary and customary meaning of the term “retrieve” is “to get and
18 bring back; *esp*: to recover (as information) from storage.” (Webster’s, at 1008;
19 Exhibit 12).

20 In the context of the ‘992 patent, the information is in items, and the items are
21 different media types which may be stored in the library means: “The different media
22 formats preferably include digital or analog video tapes, laser disks, film images,
23 optical disks, magnetic disks, computer tapes, disks, and cartridges.” (‘992 patent,
24 6:19-22).

25 The specification of the ‘992 patent discusses the function of retrieving
26 information as being analogous to taking books off of a shelf at the local public
27 library:

28 As illustrated in FIG. 7, the first step of the distribution method 400
involves retrieving the information for selected items in the source

1 material library 111, upon a request by a user of the distribution system
2 (step 412). This is analogous to taking books off of a shelf at the local
3 public library after the person has decided that he or she would like to
4 read them.

5 ('992 patent, 18:53-59).

6 The specification further provides an example of retrieved information as being
7 a "motion picture film": "If, for example, the retrieved information to be converted
8 from the source material library 111 is a motion picture film," ('992 patent,
9 7:35-37). A motion picture film is described in the specification as one of the media
10 formats on which items of information may be stored prior to conversion. ('992
11 patent, 6:2-22). Thus, the retrieved information is in one of these exemplary media
12 formats when it is retrieved. (See, '992 patent, 6:12-15 and 6:19-22).

13 In the context of the '992 patent specification, the information in the items is
14 retrieved from the library means, one item at a time. In the conversion process
15 described in the specification of the '992 patent, each individual item of information
16 must be assigned its own unique identification code and each item of information
17 must be stored in a compressed data library with its unique identification code:

18 Prior to being made accessible to a user of the transmission and
19 receiving system of the present invention, the item must be stored
20 in at least one compressed data library 118, and given a unique
21 identification code by identification encoder 112."

22 ('992 patent, 6:35-39).

23 Following conversion, the converted data is stored in the compressed data
24 library 118 as a file and "[t]he file is addressable through the unique identification
25 code assigned to the data by the identification encoder 112." ('992 patent, 10:28-30;
26 See also, 11:22-25; 14:22-28; 14:34-48). The unique identification code therefore
27 makes each item of information accessible to users. ('992 patent, 11:22-25).

28 Thus, for each item to be assigned a unique identification code and to be stored
with this unique identification code, the information must be retrieved, one item at a
time -- i.e., the information in a first item is retrieved, and thereafter the information

1 in at least one additional item is retrieved. The phrase “retrieving the information in
2 the items from the library means” means getting and bringing back a first item from
3 the library means and thereafter getting and bringing back at least one additional
4 items from the library means.

5 **m) The Meaning Of The Phrase “Assigning A Unique**
6 **Identification Code To The Retrieved Information”**

7 The ordinary and customary meaning of the term “assign” is “1. to set apart for
8 a particular purpose; designate.” (The American Heritage Dictionary of the English
9 Language, New College Edition, Houghton Mifflin Company, at 79 (1976),
10 hereinafter American Heritage; Exhibit 14).

11 The phrase “unique identification code” is construed above as meaning
12 “symbols used to identify, such symbols being unique in the sense that no two
13 identification codes are identical when assigned.”

14 The specification describes the assigning of a unique identification code to
15 retrieved information. In particular, the specification states that an item must be given
16 a unique identification code. (‘992 patent, 6:35-39). The act of giving the item a
17 unique identification code is referred to as “storage encoding” in the patent
18 specification. (‘992 patent, 6:39-43). Storage encoding (e.g., assigning a unique
19 identification code to the item) may be performed “just prior to conversion of the item
20 for transmission to reception system 200, at any time after starting the conversion
21 process, or after storing the item in the compressed data library 118.”¹⁸ (‘992 patent,
22 6:43-47). Storage encoding, in addition to being performed by identification encoder

23
24 ¹⁸ There is nothing in claim 1 (or claim 41) which requires that the unique
25 identification code be assigned prior to conversion. The claim is silent as to when the
26 unique identification code is assigned. According to this portion of the specification,
27 the unique identification may be assigned prior to conversion, after starting the
28 conversion process, or after storing the item in the compressed data library. Thus,
claim 1 (and claim 41) should be construed so that the unique identification code is
assigned at any of these times. See, Interactive Gift Express, Inc. v. CompuServe Inc.,
231 F.3d 859, 875-76 (Fed. Cir. 2000) (“unless the steps of a method actually recite
an order, the steps are not ordinarily construed to require one.”).

1 112 is performed by a system operator. ('992 patent, 6:39-41; 8:42-45; 10:58-61;
2 11:13-17).

3 Thus, the phrase "assigning a unique identification code to the retrieved
4 information" means that "for a first item, symbols are designated which uniquely
5 identify the first item and, for at least one additional item, other symbols are
6 designated to uniquely identify that additional item."

7 **6. The Structures Disclosed For Performing The Two Claimed** 8 **Functions**

9 As discussed above, the items containing information are described in the
10 specification as having different media types which may be stored in the library
11 means: "The different media formats preferably include digital or analog video tapes,
12 laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and
13 cartridges." ('992 patent, 6:19-22).

14 The function of retrieving the information in the items is described in the
15 specification of the '992 patent as being performed by a person, e.g, a system operator
16 or computer software, depending upon the media type of the item. ('992 patent, 6:39-
17 41; 8:42-45; 10:58-61; 11:13-17; 17:54-64; 18:53-59).

18 For items stored on video tapes, laser disks, film images, optical disks,
19 magnetic disks, computer tapes, and cartridges, i.e., items which may be physically
20 handled by a person (as a book would be handled by a person), the structure is a
21 person (e.g., system operator). ('992 patent, 6:39-41; 8:42-45; 10:58-61; 11:13-17;
22 18:53-59).

23 A person cannot physically handle a computer file stored on a computer disk (a
24 file is one form of a material disclosed as being stored in the library '992 patent, 6:13).
25 Thus, for computer files stored on a computer disk, one of ordinary skill in the art
26 would understand that computer software used to retrieve the file from the computer
27 disk is "analogous to taking books off a shelf at the local public library." See also
28 17:54-64 ("The system may also preferably include dispatching control

1 software ...The dispatch software may also coordinate ... source material library 111
2 utilization, ...”).

3 The '992 patent describes the function of assigning a unique identification code
4 to the retrieved information as being performed by an identification encoder 112
5 and/or a system operator. ('992 patent, 6:35-43; 8:42-45; 10:58-61; 11:13-17; 18:63-
6 69).

7 Thus, the “identification encoding means” is construed as a person (e.g. system
8 operator) or computer software having identification encoding capabilities, or a
9 combination of both and all equivalents thereto.

10 **F. “Sequence Of Addressable Data Blocks”**

11 The phrase “sequence of addressable data blocks” is found in claims 1 and 41
12 of the '992 patent. (Exhibit 9 shows the use of this phrase throughout the '992
13 patent). In connection with this phrase, the inventors acted as their own
14 lexicographer.

15 In claim 1, the phrase “sequence of addressable data blocks” is used in the
16 phrase:

17 ordering means, coupled to the conversion means, for placing the
18 formatted data into a sequence of addressable data blocks;

19 In claim 41, the phrase “sequence of addressable data blocks” is used in the phrase:

20 placing the formatted data into a sequence of addressable data
21 blocks

22 The inventors discussed the phrase “sequence of addressable data blocks” in the
23 specification of the '992 patent with respect to the “ordering means.” The inventors
24 stated that the “ordering means in the preferred embodiment includes time encoder
25 114.” ('992 patent, 7:62-63). The time encoder 114 “places the blocks of converted
26 formatted information from converter 113 into a group of addressable data blocks.”
27 ('992 patent, 7:66 -- 8:1).

28 Importantly, when describing the step of placing the data into a sequence of

1 addressable data blocks, the inventors defined the preferred addressing scheme as
2 employing time encoding: “[t]he preferred addressing scheme employs time
3 encoding.” (‘992 patent, 8:1-2; emphasis added). In other words, the inventors are
4 acting as their own lexicographer by defining the addressing scheme in the phrase
5 “sequence of addressable data blocks” as time encoding. See, e.g., CCS Fitness, 288
6 F. 3d at 1366.

7 The inventors described how the time encoder achieves time encoding by
8 assigning relative time markers to the series of audio and video data (i.e., audio
9 samples and video frames) from the converter:

10 The converted formatted information of the requested material is
11 then preferably in the form of a series of digital data bytes which
12 represent frames of video data and samples of audio data. A
13 preferred relationship of the audio and video bytes to each other is
14 shown in FIG. 8. Incoming signals are input and converted in
15 sequence, starting with the first and ending with the last frame of
16 the video data, and starting with the first and ending with the last
17 sample of the audio data. Time encoding by time encoder 114 is
18 achieved by assigning relative time markers to the audio and video
19 data as it passes from the converter 113 through the time encoder
20 114 to the precompression processor 115.

21 (‘992 patent, 8:7-19; emphasis added).

22 The inventors described a video frame as an example of a data block of video
23 data when they described Figure 8a:

24 FIG. 8a shows the block structure of video data where a video
25 frame 812 is composed of a plurality of video samples 811, and a
26 second of video 813 is composed of a plurality of video frames
27 812.¹⁹

28 ¹⁹ As background, a frame of video is essentially one picture or “still” out of a
video stream. Television signals in the United States have a frame rate of 30 frames
per second. Film has a frame rate of 24 frames per second. In Figure 8a, reference
numeral 813 shows “one second of video” and shows that there are a total of 30
frames in that one second of video. Thus, by referring to video frames as video data
blocks in the specification, the inventors meant that conventional video frames, such
as a television video frame, could comprise a video data block.

1 ('992 patent, 19:40-43; emphasis added). Similarly, the inventors described an audio
2 sample as an example of a data block of audio data when they described Figure 8b:

3 FIG. 8b shows the block structure of audio data where an audio
4 data frame 822 is composed of a plurality of audio sample 821, and
5 a second of audio 823 is composed of a plurality of audio data
frames 822.²⁰

6 ('992 patent, 19:40-43; emphasis added).

7 Time encoding permits the system to identify a frame by its frame number.
8 Frames are a subset of, and contained within, the items stored within the compressed
9 data library. ('992 patent, 8:48-50). Thus, the inventors described the addressing
10 scheme provided by time encoding as providing addressability of the data
11 blocks/frames within an item and making items addressable throughout the
12 transmission system:

- 13 (1) time encoding makes possible system addressing of particular data bytes
14 ('992 patent, 20-22);
- 15 (2) time encoding allows user addressing of particular portions of items
16 ('992 patent, 8:21-22);
- 17 (3) time encoding makes possible the ability to address any particular block
18 of audio or video data ('992 patent, 8:24-26);
- 19 (4) time encoding allows users to move through data in various modes by
20 moving through frame addresses at various rates ('992 patent, 8:34-36);
21 and
- 22 (5) time encoding makes items and subsets of items retrievable and
23

24 ²⁰ As background, an audio sample is the value of an analog audio signal at a
25 given moment in time. A typical sample rate for audio stored on a music CD is
26 44,100 samples per second. In Figure 8b, reference numeral 823 shows "one second
27 of audio" and shows that one second of audio is comprised of 30 audio frames. Each
28 audio frame is shown in 822 as comprising 1,470 samples. If there are 30 audio
frames and each audio frame has 1,470 samples, then in the one second of audio
depicted in Figure 8b, there are 44,100 samples. Thus, by referring to audio samples
as audio data blocks in the specification, the inventors meant that conventional audio
samples, such as a music CD audio sample, comprise an audio data block.

1 addressable throughout the transmission system ('992 patent, 8:50-52).²¹

2 Thus, the addressability being provided by time encoding and described by the
3 inventors is the addressability of video frames and/or audio samples within an item.
4 (See, e.g., '992 patent, 8:48-50).

5 Giving further support to the inventor's intent to define sequence of
6 addressability through time encoding, time encoding addressability is distinguished
7 from two other types of addressability which are also described in the specification.
8 The first type of addressability not provided by time encoding is the ability to locate
9 an item stored within the compressed data library using its unique identification code.
10 ('992 patent, 10:26-30). The second type of address is the address of the user, which
11 is included in a user request for the item. ('992 patent, 12:24-25).

12 The addressability described by the inventors that is provided by time encoding
13 is also different than the dictionary meaning for address: "(2)(a) an identification, as
14 represented by a name, label, or number, for a register, location in storage, or any
15 other data source or destination such as the location of a station in a communication
16 network." (IEEE Dictionary, at 23; Exhibit 13).

17 The claim construction presumption that the phrase "sequence of addressable
18 data blocks" be given its ordinary and customary meaning is therefore overcome. The
19 inventors have acted as their own lexicographer in defining what they meant by the
20 phrase "sequence of addressable data blocks."

21 Thus, in accordance with the discussion in the specification of a sequence of
22 addressable data blocks ('992 patent, 7:56-8:52, Figs. 8a and 8b), the phrase
23 "sequence of addressable data blocks" means:

24 a series of digital data bytes which represent frames of video data
25

26 ²¹ Time encoding provides other benefits in addition to addressability. For
27 instance, time encoding makes possible realignment of audio and video data after
28 separate audio and video compression ('992 patent, 8:2-6; 8:20-21). Time encoding
also enables subsequent compression of the information to be improved, because data
reduction processes may be performed in the time dimension. ('992 patent, 8:52-55).

1 and/or samples of audio data wherein relative time markers
2 assigned to the audio and/or video data makes the frames of video
3 data and/or samples of audio data addressable within a particular
4 item of information.

5 **G. “Compressed Data Storing Means ... For Storing As Files The**
6 **Compressed, Sequenced Data Blocks With The Assigned Unique**
7 **Identification Code”**

8 The phrase “compressed data storing means ... for storing as files the
9 compressed, sequenced data blocks with the assigned unique identification code” is
10 found in claim 1 of the ‘992 patent. (Exhibit 10 shows the use of this phrase in the
11 ‘992 patent).

12 This phrase includes the terms “means for” and therefore the phrase is
13 presumed to be construed as a means-plus-function claim element pursuant to 35
14 U.S.C. § 112, ¶ 6. This presumption is not rebutted and this claim phrase is construed
15 as a means-plus-function claim element. Thus, the Court must first define the claimed
16 function in this phrase. Sage Products, 126 F.3d at 1427-28.

17 **1. The Claimed Function -- “Storing As Files The Compressed,**
18 **Sequenced Data Blocks With The Assigned Unique**
19 **Identification Code”**

20 The claimed function is found in the claim phrase itself “for storing as files the
21 compressed, sequenced data blocks with the assigned unique identification code.”

22 **a) The Meaning Of The Phrase “Compressed, Sequenced**
23 **Data Blocks”**

24 The phrase “compressed, sequenced data blocks” has antecedent basis in the
25 items containing information which were retrieved by the identification encoding
26 means, formatted by the conversion means, ordered by the ordering means, and
27 compressed by the compression means. Thus, to understand the meaning of
28 “compressed, sequenced data blocks,” the Court *must consider* the context of the
surrounding words in the claim and read all portions of the written description in a

1 manner that renders the patent internally consistent. Arlington Industries, 345 F.3d at
2 1325; Budde, 250 F.3d at 1379-80 (“In construing terms used in patent claims, it is
3 necessary to consider the specification as a whole, and to read all portions of the
4 written description, if possible, in a manner that renders the patent internally
5 consistent.”)

6 In claim 1, as discussed above with respect to the identification encoding
7 means, the transmission system must operate on multiple items in a sequential manner
8 -- i.e., one item at a time. This is because the specification of the ‘992 patent requires
9 that each item be assigned a unique identification code (‘992 patent, 6:35-39), because
10 each item is stored as a file comprised of the compressed and sequenced data blocks
11 in the compressed data library and is addressable through its assigned unique
12 identification code (‘992 patent, 10:23-30), and because each file comprising each
13 item is accessible and capable of being requested by a user using the unique
14 identification code. (‘992 patent, 11:22-25; 14:22-28).

15 Reading claim 1 in its entirety, the phrase “retrieving the information in the
16 items from the library means”, as discussed above, means that the information in a
17 first item is retrieved from the library means and that at least the information in one
18 additional item is thereafter retrieved from the library means. The identification
19 encoding means assigns a unique identification code to the retrieved information for
20 the first item and thereafter assigns another unique identification code for the next
21 additional item, and so on. The retrieved information for the first item is placed in a
22 predetermined format as formatted data by the conversion means and then the
23 retrieved information for the next item is placed in a predetermined format as
24 formatted data, and so on. The formatted data for the first item is then placed into a
25 sequence of addressable data blocks by the ordering means and the formatted data for
26 the next item is placed into a sequence of addressable data blocks, and so on. The
27 formatted and sequenced data blocks for the first item is then compressed by the
28 compression means and the formatted and sequenced data blocks for the next item is

1 then compressed by the compression means, and so on.

2 **b) The Meaning Of The Term "Storing"**

3 The term "storing" in the context of this phrase of claim 1 is being used to
4 describe a definite action -- the act of "storing." The dictionary definition for this use
5 of the term "storing" is "to place or leave in a location (as a warehouse, library, or
6 computer memory) for preservation or later use or disposal." (Webster's, at 1162;
7 Exhibit 12). This is consistent with the use of the term "storing" with respect to
8 "files" in the specification: "After the data is processed into a file, by the compressed
9 data storing means 117, it is preferably stored in a compressed data library 118."
10 ('992 patent, 10:36-39).

11 The term "storing" is therefore construed as "the act of placing or leaving in a
12 location for later use."

13 **c) The Meaning Of The Term "File"**

14 The term "file" in the context of computers has its ordinary and customary
15 meanings: "2 c: a collection of related data records (as for a computer)." (Webster's,
16 at 462; Exhibit 12) and "a set of related records treated as a unit." (IEEE, at 372;
17 Exhibit 13). This is consistent with the use of the term "file" in the specification of
18 the '992 patent: "After compression processing by compressor 116, the compressed
19 audio and video data is preferably formatted and placed into a single file by the
20 compressed data storing means 117."

21 The term "file" is therefore construed as "a collection of data or a set of related
22 records treated as a unit."

23 **d) The Meaning Of The Term "With" In The Phrase**
24 **"Storing As Files . . . With The Assigned Unique**
25 **Identification Code"**

26 As used in the phrase "storing as files, . . . with the assigned unique
27 identification code," the term "with" is used "4 a: as a function word to indicate
28 combination, accompaniment, presence, or addition." (Webster's, at 1355).

1 The specification states that the audio and video data received from the
2 compressor is formatted and placed into a single file and describes additional
3 information that may be stored in the file. The specification never states that the
4 unique identification code is stored within the file -- instead, the specification states
5 that the file is addressable through the unique identification code:

6 After compression processing by compressor 116, the compressed
7 audio and video data is preferably formatted and placed into a
8 single file by the compressed data storing means 117. The file
9 may contain the compressed audio and/or video data, time
10 markers, and the program notes. The file is addressable through
the unique identification code assigned to the data by the
identification encoder 112.

11 ('992 patent, 10:23-30; emphasis added; See also, 10:17-22; 19:5-10 and 11:22-
12 25: "a user may preferably access an item via its unique identification code.").

13 Thus, in accordance with the specification of the '992 patent, the term "with" is
14 used in this phrase to mean "combination, accompaniment, presence, or addition" in
15 the sense that the file stored in the compressed data library is addressable through its
16 assigned unique identification code.

17 2. The Structure Disclosed For Performing The Claimed 18 Function

19 Having identified the claimed function for the compressed data storing means,
20 the Court must identify the corresponding structure, material, or acts described in the
21 specification to perform this function. Sage Products, 126 F.3d at 1427-28.

22 The structure of the compressed data storing means is described in the
23 specification of the '992 patent as being:

- 24 (1) a compressed data formatter, which places the audio and video data for
25 an item into a file, the file being addressable through the unique
26 identification code. ('992 patent, 10:23-30; 7:48-58; 12:65-69; Figure
27 2a, item 117); and
- 28 (2) a compressed data library, in which the files for the items are stored and

1 from which users may access the files using the unique identification
2 code assigned to the file ('992 patent, 10:34-45; 11:22-28; 12:32-57;
3 13:1-28; Fig. 2b, Item 118). The compressed data library is described in
4 the specification as a network or mass storage devices connected together
5 via a high speed network ('992 patent, 10:39-42; 13:9-27); Winchester or
6 magneto-optical disks ('992 patent, 12:42-47), digital cassette tapes
7 ('992 patent, 12:48-57); or large capacity storage ('992 patent, 19:11-17;
8 Fig. 7, Item 414).

9 Thus, the compressed data storing means:

10 a compressed data formatter and a compressed data library,
11 i.e., a large capacity storage or mass storage device, and all
equivalents thereto.

12 **H. "Storing, As A File, The Compressed, Formatted And Sequenced**
13 **Data Blocks With The Assigned Unique Identification Code"**

14 The phrase "storing, as a file, the compressed, formatted and sequenced data
15 blocks with the assigned unique identification code" is found in claim 41 of the '992
16 patent. (Exhibit 11 shows the use of this phrase in the '992 patent).

17 The phrase "compressed, formatted and sequenced data blocks with the
18 assigned unique identification code" has antecedent basis in the items having
19 information which were retrieved, placed in a predetermined format, placed into a
20 sequence of addressable data blocks, and compressed by the compression means.

21 Thus, to understand the meaning of this phrase, the Court must consider the context of
22 the surrounding words in the claim and read all portions of the written description in a
23 manner that renders the patent internally consistent. Arlington Industries, 345 F.3d at
24 1325; Budde, 250 F.3d at 1379-80.

25 **1. The Meaning Of The Phrase "Compressed, Formatted And**
26 **Sequenced Data Blocks"**

27 In claim 41, the steps of retrieving, assigning, placing into a predetermined
28 format, placing into a sequence of addressable data blocks, and compressing are what

1 creates the compressed, sequenced and formatted data blocks. In these steps, multiple
2 items are acted upon, but in a sequential manner -- i.e., one item at a time. This is
3 because the specification of the '992 patent requires that each item have assigned a
4 unique identification code ('992 patent, 6:35-39), because each item is stored in the
5 compressed data library as a file comprising the compressed, formatted, and
6 sequenced data blocks for the item, which is addressable through its assigned unique
7 identification code ('992 patent, 10:23-30), and because each item must be accessible
8 and capable of being requested by a user using the unique identification code. ('992
9 patent, 11:22-25; 14:22-28).

10 The phrase "storing, as a file, the compressed, formatted and sequenced data
11 blocks with the assigned unique identification code" therefore refers to storing as a
12 file the compressed, formatted and sequenced data blocks for a first item, and then
13 storing as a file the compressed, formatted, and sequenced data blocks for at least one
14 additional item.

15 The terms "storing," "file," and "with" are construed above with respect to
16 "compressed data storing means" and their construction is the same for the "storing"
17 element of claim 41.

18 **2. Conclusion -- The Meaning Of The Phrase "Storing, As A File,**
19 **The Compressed, Formatted And Sequenced Data Blocks**
20 **With The Assigned Unique Identification Code"**

21 In accordance with the above, the phrase "storing, as a file, the compressed,
22 formatted and sequences data blocks with the assigned unique identification code" is
23 construed as:

24 the compressed, formatted and sequenced data blocks for a
25 first item are placed into a file (a collection of data or a set of
26 related records treated as a unit which is placed in a location
27 for later use), the file for the first item being addressable
28 through the unique identification code assigned to the first
item. Thereafter, the compressed, formatted and sequenced
data blocks for at least one additional item are each placed
into a file, each file being placed in a location for later use,
the file for each additional item being addressable through the
unique identification code assigned to each additional item.

1 **IV. CONCLUSION**

2 For the foregoing reasons and authorities, Acacia respectfully requests that its
3 proposed claim constructions be adopted by this Court.

4 DATED: January 8, 2003

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5
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