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VS Media, Inc.

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

SOUTHERN DIVISION

ACACIA MEDIA TECHNOLOGIES CORPORATION,

Plaintiff,

v.

NEW DESTINY INTERNET GROUP, ET AL.,

Defendants.

AND ALL RELATED CASE ACTIONS.

Case No. SA CV-02-1040 JW (MLGx)

CLAIM CONSTRUCTION BRIEF OF AEBN, INC.; ADEMIA MULTIMEDIA, LLC.; AUDIO COMMUNICATIONS, INC.; CYBERHEAT, INC.; GAME LINK, INC.; INNOVATIVE IDEAS INTERNATIONAL; LIGHTSPEED MEDIA GROUP, INC.; NEW DESTINY INTERNET GROUP, LLC; VS MEDIA, INC.

Date: February 6, 2004
Time: 10:00 a.m.
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I. INTRODUCTION

This case is ripe for dispositive claim constructions pursuant to *Markman v. Westview Instruments Inc.*

The transmission of compressed video and audio data over the Internet and its precursors has been commonplace for more than a decade. Using commercially-available software, almost anyone can set up a computer and build a website (or, before the Internet, a Bulletin Board Service ("BBS")) that will show a movie clip or play an audio file to persons who access the particular site. In many respects, this is the beauty of the Internet—whereas previously video and audio transmission was limited to those with substantial resources, now it is available to all.

Plaintiff Acacia, such as it is, enables none of this. It does not manufacture servers or any of the other hardware necessary to the function of the Internet, or the BBSs that preceded it. Nor does it provide software to enable Internet users to build their websites so that they can make available to others compressed video or audio information. It does not create video or audio content, nor does it even sell it. In fact, Acacia has no goods or services for sale whatsoever.

Nevertheless, by virtue of a patent family (the "Yurt patents") that it purchased for an undisclosed amount at the end of 2001, Acacia claims to be entitled to 2% of defendants' (and others) gross revenue received from their transmission of compressed video and/or audio data over the Internet. According to published press reports, Acacia hopes to generate $200 million annually through these patents, by threatening and bringing litigations such as this one. (Declaration of Todd Miller, Ex. M at 522.)[1] This is Acacia's "business model"—one which it claims to have used in the past to generate nearly $25 million for licenses on the so-called "V-chip" before

[1] All citations to exhibits in the remainder of the brief are attached to the Declaration of Todd G. Miller.

its patent was held invalid. (Ex. N at 530.) It is a "business model" that has been widely condemned.[2] (Ex. O at 531-36.)

In bringing and prosecuting these cases, Acacia has employed a plainly result-driven view of the patent claims at issue, designed not to give the invention a fair scope consistent with the intrinsic evidence, but instead to ensnare technologies not contemplated by the inventors. Indeed, until Acacia purchased the patents, no one had ever suggested that any of the Yurt patents covered the routine transmission of video or audio data over the Internet.

That is because the Yurt patents do not have such a broad scope. As just one example, we note that the applicants were awarded the '992 patent only after repeated representations that, unlike the Internet systems against which the patent is asserted, their transmission system did not limit end users to accessing the transmission system at the particular location of their reception systems. In this fashion, according to the inventors, a user of the claimed transmission system could remotely access the transmission system from, for example, her telephone, and send a video to her home for later viewing.

In light of this acknowledged claim scope, as well as other marked differences that are apparent from a proper claim construction, Acacia's infringement claims here are dead on arrival. Nevertheless, it persists in its claims, not to protect any commercial position—as noted above, Acacia has none—but rather as part of an unseemly effort to extract "licenses" from politically unpopular small businesses through the expense of the litigation process. This is no basis upon which to bring an infringement charge, and this Court should not be party to it. Defendants respectfully request that the Court construe the claims consistent with the intrinsic evidence, thereby disposing of Acacia's claims.

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[2] As part of this business model, Acacia filed at least twenty continuation applications claiming priority to the '992 patent after purchasing the portfolio.

II. THE PATENT-IN-SUIT: U.S. PATENT NO. 5,132,992[3]

The fundamental tools of claim construction set out by the Federal Circuit are well known: the patent claims, the specification, and the prosecution history, which includes the prior art. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-80 (Fed. Cir. 1995) (in banc), *aff'd*, 517 U.S. 370 (1996). We begin with the prior art, the foundation of what was known to those skilled in the art at the time the applications were filed.

A. The Prior Art Disclosed Numerous Systems For On–Demand Transmission and Reception of Video and Audio Information.

The '992 patent, the first patent in the Yurt family,[4] issued on July 21, 1992 to Paul Yurt and H. Lee Browne, principals with a company known as Greenwich Technologies, Inc. ("Greenwich"), from an application filed on January 7, 1991. As a general matter, the '992 patent discloses and claims a transmission and receiving system that allows users to access and download material, such as movies, television programs, and music, on demand. According to the patent, the object of the system was to provide users greater flexibility in the way the material is accessed and greater control over the playback of the material. (Ex. A ("the '992 patent") at 1:62-2:4, 5:14-21.)

While Acacia has often claimed that the '992 patent is a "pioneering" patent, *see* Exhibit P at 537, when it was filed in early 1991, there were dozens of video or audio-on-demand systems in the public domain and literally hundreds of publicly available references that disclosed various aspects of video and audio-on-demand

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[3] As ordered by the Court, defendants have limited this brief to the '992 patent-in-suit.

[4] Over the next eight years, Yurt and Browne received four additional patents claiming priority to the '992 patent: (a) U.S. Patent No. 5,253,275 (the '275 patent") issued on October 12, 1993; (b) U.S. Pat. No. 5,550,863 ("the '863 patent") issued on August 27, 1996; (c) U.S. Pat. No. 6,002,720 ("the '720 patent) issued on December 14, 1999, and (d) U.S. Pat. No. 6,144,702 (the '702 patent) issued on November 7, 2000, which has also been asserted by Acacia in this litigation.

systems. Indeed, a consultant hired by Greenwich, the David Sarnoff Research Center, stated of the allowed, but not issued '992 patent in April, 1992: "Based on our review of published material ... , we do not consider the overall system architecture to be novel in a scientific/technological sense. Similar concepts for storing, accessing, transmitting and displaying compressed video and audio information are widely understood by researchers in the telecommunications and multimedia fields." (Ex. I at 383.) Notably, the applicants did not disclose this report, or any of the over twenty-five references cited therein, to the Patent Office during prosecution of the '992 patent in violation of their duty of candor under 37 C.F.R. § 1.56.[5]

While the prior art of record describes several of these existing systems, other prior art systems not before the examiner are perhaps more relevant, particularly in light of the breadth Acacia has ascribed to the claims. With respect to the undisclosed art, for example, users of BBSs of the mid to late 1980s—precursors of the modern day Internet—routinely downloaded to their computers compressed digital audio and video files from other computers remote from theirs. (*See* Ex. V at 559-566, Ex. W at 567-573.) Users would simply program their modems to dial into the particular BBS, and once accessed, the user could select from thousands of files. (*Id.*) Text files could be viewed in real time, while larger compressed audio and video files were typically downloaded to the user's computer, decompressed, and played back at the user's leisure. (*Id.*) The arrival of the Internet, and its ability to allow users to directly access all servers connected to it, rendered the BBS systems obsolete. And while these systems thus disappeared, the ability to download audio

[5] For example, after noting this lack of novelty to applicants' invention, the Sarnoff report states that the concepts outlined in the '992 patent had been demonstrated in practice, such as the video-on-demand prototype then being shown at Bell Communications Research by Dr. A. Gelman. (Ex. I at 383.) This information, however, was withheld from the PTO.

and video files remained, basically unchanged, and is now the target of this litigation.[6]

Large corporations had also developed similar systems to market products and profit from this available technology. For example, in February, 1988, JCPenney Co. implemented an interactive multimedia presentation and communications system that allowed cable subscribers in the Chicago area to shop from their homes. (Ex. J at 433-434.) JCPenney Co. invested over $100 million into the project. (*Id.*) The specifics of the system are detailed in U.S. Pat. No. 5,195,092 to Wilson et al. and assigned to Telaction Corporation, which was owned by JCPenney Co.

The system disclosed in Wilson delivers product presentations to the subscriber's television set at the user's request. These presentations include video images and motion video sequences of the requested items, along with music and commentary. (Ex. H at 1:19-24, 35:54-64.) The product presentations are created at a production facility from source material, such as photographs, drawings, textual material, compacts discs, video tapes, etc. (*Id.* at 13:43-50.) The video source material is digitized and time sequenced with audio source material for playback. (*Id.* at 9:64-10:5; 13:57-66). The synchronized presentation is then stored as a block of data, compressed, and transmitted to a mass storage location where the presentation is stored with an object name for retrieval and recovery purposes. (*Id.* at 7:36-43, 9:54-57, 13:62-14:10, 18:30-45, 37:2-10.) Upon request, the system retrieves a presentation from mass storage and transmits it to the subscriber's presentation player. (*Id.* at 22:67-23:14, 45:22-38.) The presentation player captures, stores, and decompresses the digital information it receives to reconstruct the requested presentation. (*Id.* at 39:39-44.)

With respect to the prior art of record, the applicants called out four references as particularly noteworthy in the background section of the '992 patent: U.S. Pat. No.

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[6] That the BBSs may possible be no longer readily available for defendants to present as prior art is just one of the many examples of the prejudice that has resulted from the long delay in the assertion of Acacia's infringement claims.

4,963,995 to Lang, U.S. Pat. No. 4,506,387 to Walter, U.S. Pat. No. 4,521,806 to Abraham, and U.S. Pat. No. 4,890,320 to Monslow et al.

Lang discloses a video recorder/transmitter that can receive and store compressed digital video programs via cable, antenna, or fiber optic lines. (Ex. C at Abstract.) To view the program, the video recorder/transmitter decompresses and converts the digital signals into an analog format for viewing on a conventional television set. (*Id.* at 8:7-16.) The video recorder/transmitter can also transmit compressed digital video to other video recorders through a modem. (*Id.* at 8:29-57.)

Walter discloses a digital video-on-demand cable system that allows users to request and download video programs from a compressed digital library via high-speed fiber optic cable. (Ex. D at abstract; 7:17-36.) The requested program is stored in the memory at the user's receiving system and the system indicates to the user that the program is ready for viewing. (*Id.* at 8:12-19.) When the user presses "Start" on the receiver, the stored program is read from memory, decompressed, and may be viewed in either analog or digital format. (*Id.* at 8:19-35.)

Abraham discloses a communication system that broadcasts video programs to subscribers upon request. The system includes a program library that contains video and audio programs that subscribers may order by dialing a program selection code on their telephone. (Ex. E at 2:61-67, 3:6-26, 4:7-11.) The system receives the subscriber's selection, converts the selected program into a digital format, and once converted, compresses the program for transmission to the subscriber. (*Id.* at 4:11-34.) A device at the subscriber's location receives the transmitted program. (*Id.* at 3:20-26.) The device decompresses the program and stores it in memory for playback by the subscriber. (*Id.* at 3:42-60.)

Monslow discloses a system that allows a viewer to choose a program from a collection and view the program at a desired time. (Ex. F at 2:50-57.) The viewer selects the desired program from a program collection and orders the program over

the telephone. (*Id.* at 6:4-13.) Once ordered, the system transmits the program over a CATV network on a channel for viewing by the subscriber. (*Id.* at 6:47-59.)

B. The Applicants Rested Patentability of Their Claimed Transmission and Receiving Systems on the Alleged Convenience to the User.

Because of this crowded field, the '992 patent applicants rested the patentability of their invention, not, as the Sarnoff Report put it, on any novel "system architecture," but rather on a number of features that they alleged were novel and that allegedly increased the convenience of existing audio and video on-demand technology. Two of these features related to the transmission system and two related to the reception system.

The two allegedly "novel" features that related to the transmission system were: (1) allowing users to order audio/video material and have that information sent to a location selected by the user; and (2) providing users a comprehensive library of source material that was accessible to users as part of the transmission system. The two allegedly novel features of the reception system were: (1) the ability of the user to play back a transmitted item at a time of her choosing; and (2) the use of VCR-like controls, such as stop and pause.

The applicants emphasized each of these features in the background of the '992 application. On the transmission side, they criticized Walter for requiring the viewer to "be at [the viewer's premises] for both ordering and viewing the audio/video material," while they criticized Lang for allegedly failing to provide a transmission system with "one or more libraries wherein a plurality of system subscribers may access information stored in the film and tape library or libraries, and play back the selected information at a time and place selected by the subscriber." ('992 patent at 1:18-29, 1:48-56.) On the reception side, they criticized Abraham for having a receiver that "has no storage capability" (and thus would not allow playback at any time), and Monslow and Lang for failing to provide for "the stop, pause and multiple viewing functions of existing VCR technology." (*Id.* at 1:39-47.)

During the prosecution of the '992 patent, the inventors reiterated these alleged novel features in a Petition to Make Special ("PTMS") they filed shortly after filing their application. (Ex. B at 149-175.) A PTMS allows an applicant to request an accelerated examination under certain conditions, including a requirement that the applicant direct its claim to a single invention, or if not, make an election of a single invention. *See* Manual of Patent Examination and Procedure § 708.02.VIII (attached as Ex. K at 474-75.) In exchange, however, the applicant must certify that she conducted a pre-examination search, and then provide copies of closely related prior art references along with "a detailed discussion of the references [pointing out with particularity] how the claimed subject matter is patentable over the references." (*Id.*)

In the PTMS, the applicants praised their system as providing "the user greater access to and control over audio and video information than is possible in conventional systems." (Ex. B at 150.) As in the background section of the '992 patent, the applicants repeatedly distinguished the claimed transmission system from the prior art systems by pointing out that they did not provide the user a choice of where the requested information is sent, but rather limited the user to viewing or listening to information at the location from which the information was ordered. Some examples of these statements are:

- "With the present invention, a user can request audio and video information to be sent to a selected destination." (*Id.*)
- "Further, in Monslow et al, the viewer-chosen program is transmitted to the television receiver of the requesting viewer. The requestor therefore does not have a choice of where the information that they request is sent." (*Id.* at 156.)
- "The Walter system further requires the viewer to be at that location [i.e., the viewer's premises] for both ordering and viewing the audio/video material." (*Id.* at 157.)

The applicants also highlighted the user-accessible nature of the library of original source material:

- "The transmission system includes a source material library from which a user makes a selection." (*Id.* at 150.)
- "Particularly, Lang does not teach that user requests will cause items stored in a source material library to be sent from a transmitter to a receiving system, as called for in independent claim 22." (*Id.* at 155.)

Other parts of the PTMS emphasize the allegedly novel aspects of the receiving system, including the ability of a user to play a transmitted item at any time convenient to her:

- "Further, the user is not constrained to having programs played at a particular time because the system has buffering capability. By employing such buffering, the user has individualized control over the replay of requested programs. (*Id.* at 150.)
- "[T]he Monslow et al. system requires multiple users in multiple locations to view the requested material at the time it is broadcast, rather than allowing each viewer to choose his or her own viewing time. ... Monslow et al. does not provide for buffering a selected program so that the user can play it back at a desired time." (*Id.* at 155-56.)

Despite their efforts to distinguish the prior art in the PTMS, the examiner initially rejected all of the applicants' pending claims in view of Lang and U.S. Pat. No. 4,947,244 issued to Fenwick et al. (*Id.* at 183-85.) Fenwick discloses a video-on-demand system for use in hotels and similar environments. (Ex. G at 3:19-36.) In the hotel setting, this system provides multiple hotel guests the ability to select, order, and view movies in their respective rooms only, and does not allow them to select the location they view a movie. (*Id.* at 3:19-28.)

To overcome this rejection, the applicants conducted an interview with the examiner, then amended the pending claims and argued over the cited references.

(Ex. B at 225-238.) As they had with Walter and Monslow, the applicants distinguished the system in Fenwick by stating that it did not disclose a system in which a user can select the location to which the movie is sent." (*Id.* at 213.) After first stating that "the requesting remote location of Fenwick et al is not analogous to the remote location of the present invention," the applicants then stated that "Fenwick et al also does not disclose a system in which a user can select a remote location to which a selected item is sent. Rather in Fenwick at al, a selection can only be sent to the video monitor 102 from which the user issues commands." (*Id.* at 213.) Of course, this criticism of Fenwick is precisely how audio and video is transmitted over the Internet.

The applicants also distinguished the "library means" of claim 1 from the library means taught in Lang. As noted above, Lang discloses a system capable of storing video from either analog or digital sources in compressed digitized form. (Ex. C at 3:38-4:16, 4:28-5:8, 7:1-66.) The '992 patent applicants argued that the Lang storage system was not analogous to the library means of claim 1 because Lang only "envisioned" a source material library, whereas the applicants incorporated one in their transmission system. (Ex. B at 209.)

After the argument, the pending claims were once again rejected by the examiner, this time in view of two different references: Abraham and U.S. Patent No. 4,028,733 issued to Ulicki. In response, the applicants amended the pending claims and principally argued that: (1) a user of Abraham did not have the ability to play back transmitted data at any time the user wanted; and (2) that Abraham and Ulicki taught the real-time transmission of information stored in its original format rather than transmitting information that is processed and then stored in a compressed format. (*Id.* at 237.) After another interview and a minor amendment by the examiner, the '992 patent issued.

C. The Issued Claims of the '992 Patent Incorporate the Convenience Features the Applicants Stated Were Novel.

As issued, the '992 patent contains six independent claims (claims 1, 19, 25, 41, 47, and 54), three of which are apparatus claims (claims 1, 25, and 47) and three of which are corresponding method claims (41, 54, and 19). The three claim groups are geared to different parts of the system and contain, either together or separately, the allegedly novel aspects of the various parts of the system emphasized by the applicants. Claims 1 and 41 cover the transmission system and method, claims 25 and 54 cover the receiving system and method, and claims 19 and 47 cover the combination of the two in what the applicants called a distribution system and method.

In describing the claimed transmission system, which is the subject of most of the infringement allegations here,[7] the '992 patent is long on verbiage used to describe the hoped for functions of the transmission system shown in FIG. 2a, but short on substance. The patent includes pages upon pages about possible modes of operation, almost always couched with the word "preferred" or "preferably," but there is often little about key aspects of the overall system architecture and how one can make the concepts work.

As depicted in the patent, much of the transmission portion of the system is shown in the figure below:

[7] Acacia has asserted independent claim 1 and 41, as well as certain dependent claims, against all defendants represented by Fish & Richardson P.C. Acacia has also asserted independent claim 19 and certain claims that depend from it against AEBN, Inc. and Game Link, Inc.

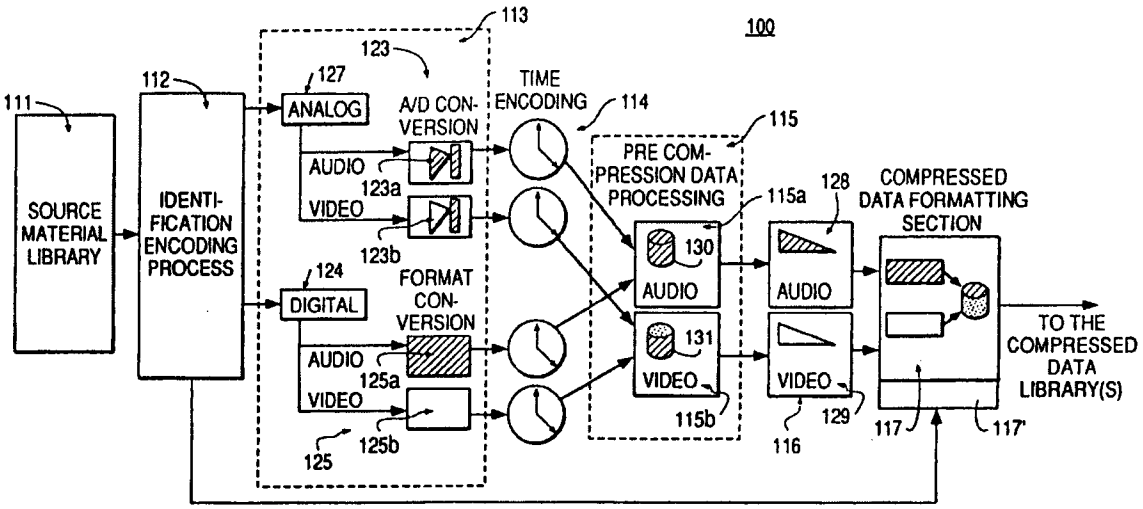

FIG. 2a

With reference to claim 1 and the figure above, the transmission system (100) includes a "source material library" (111) that contains items such as television programs, movies, audio recordings, still pictures, books, documents of various sorts, musical instruments, and other physical objects. ('992 patent at 6:12-15.) These items are typically stored in their original format and must be converted to a compatible media format before being processed by the system, though the applicant did not describe how this was to be done, nor claim it in any of the claims. (*Id.* at 6:15-19.)

Connected to the source material library is a structure the applicants call an "identification encoder" (112) that allegedly performs two functions. First, the "identification encoder" retrieves the information in the items stored in the source material library. The patent, however, does not disclose any structure for doing this. Once retrieved, the "identification encoder" assigns, at a minimum, a "unique identification code," but may also be used to encode a file address, a popularity code, and program notes to the retrieved information. (*Id.* at 6:35-47.) A "converter" (113) is connected to the identification encoder and receives the encoded information for further processing. (*Id.* at 6:55-68.) The "converter" converts both the analog and

digital information into a "predetermined digital format," though no specific format is identified in the '992 patent. (*Id.*)

Next, a structure described as the "ordering means" places the formatted data into a "sequence of addressable data blocks," a function that is not shown in FIG. 2a, but is contained in claims 1 and 41. (*Id.* at 7:59-62.) After the data is placed in this sequence, the data blocks are addressed by the time encoder (114). (*Id.* at 7:62-63.) This time encoding process, which is not claimed in claims 1 or 41, allows the realignment of the audio and video information after the audio and video data is separated and compressed by a precompression processor (115) and a compressor (116). (*Id.* at 8:2-6.)

The precompression processor stores, or "buffers," the sequenced data blocks received from the ordering means and performs additional formatting of the data as required by the compressor. (*Id.* at 8:67-9:2.) The audio and video data blocks are then compressed and sent to what is called the "compressed data storage means" (117).[8] (*Id.* at 10:23-30.) The compressed data storage means realigns and merges the sequences of compressed audio and video data blocks so that they are in the same file. (*Id.*) The realigned data is then preferably sent to compressed data library (118) for storage in one or more files. (*Id.* at 10:36-39, 20:32-37, FIG. 2b.) The data files are stored in the compressed data library with the unique identification code assigned by the identification encoder. (*Id.* at 6:35-39, 10:26-30.) Each of the data files is stored in the compressed data library with its "unique address code," which the applicants described as a file address for uniquely identifying a compressed data file in that library. (*Id.* at 10:46-54.) From the compressed data library, the files are transmitted to the user. (*Id.* at FIG. 2b.)

We turn now to the disputed claim limitations and defendants' proposed constructions.

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[8] In contrast to the written description of the '992 patent, FIG. 2a refers to element 117 as the compressed data formatting section.

III. LEGAL STANDARDS OF CLAIM CONSTRUCTION

A. Claim Language, Ordinary Meaning, and the Role of the Patent Specification

Claim construction is a matter of law exclusively for the Court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996). Courts construe the words of a claim in light of the "intrinsic evidence" of record, i.e., the claims, specification, and prosecution history. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). The starting point for claim construction is always the language of the claims themselves. *Bell Atlantic Network Services, Inc. v. Covad Comm. Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001). Words of the claims, both asserted and unasserted, are examined in their entirety and in the context of the surrounding language. *Vitronics*, 90 F.3d at 1582; *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1251 (Fed. Cir. 1998). There is a heavy presumption in favor of the ordinary meaning of claim language as understood by one of skill in the art. *Bell Atlantic*, 262 F.3d at 1268. However, it is always necessary to review the specification to determine the meaning of a claim term, as it is "the single best guide to the meaning of a disputed term." *Vitronics*, 90 F.3d at 1582.

Dictionaries and treatises may be used, like the claims themselves, the specification, and the prosecution history, to determine the ordinary and customary meaning of a claim term. *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed. Cir. 2002). Dictionary definitions may not be used in the abstract; rather, a definition must have a connection to the disclosure of the patent itself. *Brookhill-Wilk 1, LLC. v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1300 (Fed. Cir. 2003). Consulting a dictionary is simply a first step in the claim construction analysis. *Id.* Resort must always be made to the surrounding text of the claims in question, the other claims, the written description, and the prosecution history to determine the correct meaning of a term. *Id.* As the Federal Circuit reiterated just one month ago:

> Words often have different meanings to different people and in different contexts, accounting for the multiple ordinary meanings found in dictionaries. Dictionary definitions, while reflective of the ordinary meanings of words, do not always associate those meanings with context or reflect the customary usage of words by those skilled in a particular art. The words used in the claims must be considered in context and are examined through the viewing glass of a person skilled in the art. It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims of a patent ... In construing claim terms, the general meanings gleaned from reference sources, such as dictionaries, must always be compared against the use of the terms in context, and the intrinsic record must always be consulted to identify which of the different possible dictionary meanings is most consistent with the use of the words by the inventor. Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.

Ferguson Beauregard v. Mega Systems, LLC, 315 F.3d 1327, 1338 (Fed. Cir. 2003) (internal citations and quotations omitted).

B. The Prosecution History

The prosecution history is often of critical significance and should be consulted to determine the meaning of the claims. *Vitronics*, 90 F.3d at 1582. It may provide guidance as to the meaning of an ambiguous term. *E.I. DuPont De Nemours & Co. v. Phillips Petro.*, 849 F.2d 1430, 1438 (Fed. Cir. 1998) ("[A]rguments made during prosecution shed light on what the applicant meant by its various terms."). Alternatively, it may indicate that the patentee has disclaimed a potential claim construction in an amendment to the claim or in an argument to overcome or

distinguish a reference. *Southwall Techs., Inc. v. Cardinal IG, Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995). Where the patentee has unequivocally disavowed a certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender. *Omega Eng'g, Inc., v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003).

In addition, the prosecution histories of related patents are relevant to the construction of common terms. *See Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990) (holding that, when two patents use the same claim terms, the prosecution histories of both are relevant); *Advanced Cardiovascular Systems, Inc. v. Medtronic, Inc.*, 265 F.3d 1294, 1305 (Fed. Cir. 2001) ("The prosecution history of a related patent can be relevant if, for example, it addresses a limitation in common with the patent in suit."); *Abtox, Inc. v. Exitron Corp.*, 131 F.3d 1009, 1010 (Fed. Cir. 1997), modifying 122 F.3d 1019 (Fed. Cir. 1997) ("[I]t would be improper to construe this term differently in one patent than another, given their common ancestry.").

C. "Means-Plus-Function" Claims, 35 U.S.C § 112, ¶ 6

Determining whether a claim limitation is subject to § 112, ¶ 6 is a claim construction issue for the Court. *Personalized Media Communications, LLC v. Int'l Trade Com'n*, 161 F.3d 696, 702 (Fed. Cir. 1998). Because patentees often seek to escape the narrowing function of § 112, ¶ 6 in litigation, it is presumed that where a claim element employs the word "means," the applicant intended to invoke the statutory mandates for means-plus-function clauses. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003) (citing *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427 (Fed. Cir.1997)).

"Construction of a means-plus-function limitation involves two steps. First, the court must identify the claimed function." *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002). "Ordinary principles of claim construction govern interpretation of the claim language used to describe the

function." *Id.* "After identifying the claimed function, the court must then determine what structure, if any, disclosed in the specification corresponds to the claimed function." *Id.* To qualify as corresponding, the structure must not only perform the claimed function, but "the specification must clearly associate the structure with the performance of the function." *Id.*

When reviewing the specification for corresponding structure, "[t]he correct inquiry is to look at the *disclosure* of the patent and determine if one of skill in the art would have understood the *disclosure* to encompass [the corresponding structure] and not simply whether one of skill in the art would have been able to [implement the corresponding structure]." *Medical Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d. 1205, 1212 (Fed. Cir. 2003). "It is important to determine whether one of skill in the art would understand the specification itself to disclose the structure, not simply whether that person would be capable of implementing that structure." *Id.* Stated otherwise, "[i]t is not proper to look to the knowledge of one skilled in the art apart from and unconnected to the disclosure of the patent." *Id.*

Where the specification does not clearly link corresponding structure, the patent claim invalid. *Id.* "If, however, this inquiry reveals that no embodiment discloses corresponding structure, the claim is invalid for failure to satisfy the definiteness requirement of § 112, ¶ 2." *Cardiac Pacemakers*, 296 F.3d at 1114. *see also CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1159 (Fed. Cir. 1997), *rehearing & suggestion for rehearing en banc denied*, 120 F.3d 1260 (Fed. Cir. 1997) ("[W]e are obliged to construe the term 'elasticity' consistently throughout the claims [of the two related patents-in-suit].").

D. Extrinsic Evidence

If the meaning of the claim limitation is apparent from the intrinsic evidence alone, it is improper to rely on extrinsic evidence to vary the meaning of the claim limitation. *Bell Atlantic,* 262 F.3d at 1268-1269. District judges are, however, free to consider extrinsic evidence "to help the court come to the proper understanding of the

claims." *Riverwood Int'l Corp. v. R.A. Jones & Co., Inc.*, 324 F.3d 1346, 1358 (Fed. Cir. 2003); *Vitronics Corp.*, 90 F.3d at 1584. Extrinsic evidence is particularly useful to aid a Court in understanding a complex technology. *See Pitney Bowes, Inc. v. Hewlett-Packard, Inc.*, 182 F.3d 1298, 1309 (Fed. Cir. 1999).

Pursuant to the Court's request, this brief discusses limitations that can be construed without reference to extrinsic evidence.

IV. DEFENDANTS' PROPOSED CLAIM CONSTRUCTIONS

Pursuant to the Court's request, the parties have selected claim limitations from independent claims 1 and 41 of the '992 patent for construction. This brief addresses the six limitations identified below. We provide claims 1 and 41 below with the proposed limitations for construction in bold and underlined:

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**;

compression means, coupled to the ordering means, for compressing the formatted and sequenced data blocks;

compressed data storing means, coupled to the data compression means, for storing as files the compressed, sequenced data blocks received from the data compression means with the unique identification code assigned by the identification encoding means; and

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

41. A method of transmitting information to **remote locations**, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

retrieving the information in the items from the source material library;

assigning a **unique identification code** to the retrieved information;

placing the retrieved information into a predetermined format as formatted data;

placing the formatted data into a **sequence of addressable data blocks**;

compressing the formatted and sequenced data blocks;

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

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

A. "Remote Locations": The Court Should Construe This Limitation To Mean More Than One Location Selectable By the User.

Asserted claims 1 and 41 of the '992 patent require "[a] transmission system for providing information to be transmitted to "remote locations" and a "method of transmitting information to "remote locations." The claim limitation "remote locations" also appears throughout the claims of the '275 patent, the '863 patent, and the '720 patent, all of which are continuations of the '992 patent. From the filing of the '992 patent through the prosecution of the '720 patent—nearly a decade—the term "remote locations" has been used by the applicants to mean more than one location selectable by the user. Inspired by its recent lawsuits and the current method of transmission over the Internet, Acacia seeks to change the meaning of "remote locations" to mean "locations remote from the transmission system." The

Court should not allow Acacia to rewrite the '992 patent and repudiate the statements made during the prosecution of the '992 and '720 patents.

1. Any ordinary meaning of "remote locations" is ambiguous because "remote" is a relative term that does not explain from where the locations are remote.

The claim limitation "remote location" is made up of two words: "remote" and "locations." To defendants' understanding, the parties do not dispute that the word "locations" simply is the plural of location and has a commonly understood meaning of more than one place or site. Rather, the parties' dispute centers around the term "remote" and its impact on the claim term "remote locations" as a whole.

Webster's Third New International Dictionary from 1993 defines the term "remote" as "far removed in space, time, relation or likeness." (Ex. Q at 543.) Accordingly, as the dictionary points out, the word "remote" is a relative term. Something is "remote" from something else, either in space, time, relation or likeness. But absent the claims specifying from where the more than one locations are remote, the dictionary definition does not provide meaningful guidance (let alone, resolution) as to the claim limitation's correct meaning. *Altiris*, 318 F.3d at 1374-75.

2. The claims of the '992 patent demonstrate that the term "remote locations" means "more than one location selectable by the user."

The other claims of the '992 patent provide the answer to the relative question posed by the use of the word "remote" and requires the term "remote locations" to mean "more than one location selectable by the user." *See Vitronics*, 90 F.3d at 1582 ("[W]e look to the words of the claims themselves, both asserted and non-asserted, to define the scope of the patented invention."); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 987 (Fed. Cir. 1988) ("The scope of a particular claim can often be determined on inspection of other claims.").

The '992 patent includes six independent claims. The preamble of each of these claims defines the location or locations to which the information may be transmitted by the transmission system. In addition to claims 1 and 41, claims 19 and

47 also use the phrase "remote locations," while claims 25 and 54 use the phrase "a location remote from the source material library."

Claim 19 of the '992 patent provides, in relevant part:

> A distribution method responsive to requests from a user identifying items in a transmission system containing information to be sent from the transmission system to receiving systems at remote locations, the method comprising the steps of:
>
> * * *
>
> sending a request, by the user to the transmission system, for at least a part of the stored information to be transmitted to one of the receiving systems at one of the remote location [sic] selected by the user;

As is readily seen in claim 19, the term "remote locations" provides antecedent basis for the sending element, which requires that the stored information be transmitted to one of the receiving systems "at one of the remote locations selected by the user." Because "remote locations" in the preamble of claim 19 provides antecedent basis for this limitation, the limitation "remote locations" must include more than one location that can be selected by the user. *Tulip Computers Int'l B.V. v. Dell Computer Corp.*, 236 F. Supp.2d 364, 389 (D. Del. 2002) (discussing the role of antecedent basis in claim construction); *see also Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1356-57 (Fed. Cir. 1999) (noting the importance of antecedent basis in claim construction). This tells the world that the more than one locations includes at least one location remote from the user such that the user can select the location for transmission.

Because like terms in the same patent should be construed consistently, the same interpretation must then apply to the "remote locations" limitation of claims 1 and 41. *Inverness Medical Switzerland GmbH v. Princeton Biomeditech Corp.*, 309 F.3d 1365, 1371 (Fed. Cir. 2002) ("A claim term used in multiple claims should be

construed consistently"); *Southwall Techs.*, 54 F.3d at 1579 ("The fact that we must look to other claims using the same term when interpreting a term in an asserted claim mandates that the term be interpreted consistently in all claims.").

Indeed, non-asserted independent claims 25 and 54 demonstrate that when the applicants meant "a location remote from the transmission system," which is Acacia's proposed construction, they did not use the "remote locations" terminology, but chose the phrase "a location remote from the source material library." ('992 patent at 23:13, 26:27.) For example, the preamble of claim 25 provides:

> The receiving system responsive to user input identifying a choice of an item stored in a source material library at a transmission system to be played back at a user location remote from the source material library, ... the receiving system comprising:

Here, Acacia asks the Court to apply the same construction to "remote locations" as it would to "a user location remote from the source material library." The applicants, however, used different words and different words are presumed to have a different meaning. *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998) ("There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims."). As demonstrated succinctly by the claims of the '992 patent, "remote locations" means more than one location selectable by the user.

3. The written description of the '992 patent confirms the Defendants' proposed construction of "remote locations."

As demonstrated above, in the '992 patent specification, the applicants heavily criticized the prior art for not providing the user the ability to select the location to which the video or audio was sent. According to the applicants, Walter was deficient because it "requires the viewer to be at that location [i.e., the user's premises] for both ordering and viewing the audio/video material." ('992 patent at 1:21-29.) And Lang was not up to snuff because it did not disclose "a system ... wherein a plurality

of system subscribers may access information ... and play back the selected information at a time and place selected by the subscriber." (*Id.* at 1:51-56.)

But the applicants did not limit their trumpeting of this allegedly novel feature of their invention to their criticisms of the prior art. After discussing the prior art, the '992 specification emphasizes that one of the main objects of the invention was "to provide a picture and sound transmission system ... to any location chosen by the user that has a specified receiver." (*Id.* at 1:67-2:4.) The written description of the '992 patent then further explains of the transmission system that: "Accordingly, the user may remotely access the transmission system 100 from a location differenct [sic] than the location of reception system 200 where the material will be sent and/or played back. Thus, for example, a user may preferably call transmission system 100 from work and have a movie sent to their house to be played back after dinner or at any later time of their choosing." (*Id.* at 5:14-21.)

These statements highlight what the applicants believed to be novel about the transmission portion of their system and what the claims plainly require—the ability to have material delivered to more than one location selectable by the user. The patent specification confirms defendants' proposed construction.

4. The prosecution history further confirms the meaning of "remote locations."

During the prosecution of the '992 patent, the meaning of "remote locations" asserted by the applicants was consistent with the meaning expressed in the patent's claims and written description. As demonstrated above, in the PTMS, the applicants repeatedly relied on the ability of the user of the transmission system to select locations in distinguishing the Monslow and Walter references, just as they had in the patent specification. According to the applicants, the user of the Monslow system "does not have a choice of where the information that they requested is sent." (Ex. B at 156.) (emphasis added). To have a "choice" of where the information is sent requires that there be more than one location selectable by the user. And Walter disadvantageously "requires that the viewer be at [the same] location for both

ordering and viewing the audio/video material." (*Id.* at 157.) Again, according to the applicants, the viewer in Walter has no choice of where the information is sent.

A PTMS is a request for "special treatment" that induces reliance on its statements. *See General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 1411 (Fed. Cir. 1994). The statements in the PTMS characterizing the alleged invention during prosecution of the '992 patent confirm the scope of the "remote locations" limitation. *See Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1475, 1477 (Fed. Cir. 1998) (explaining that statements made by the applicant in a PTMS distinguishing prior art limited the construction of a claim); *Mark I Marketing Corp. v. R.R. Donnelley & Sons Co.*, 66 F.3d 285, 291-92 (Fed. Cir. 1995) (holding that the prosecution history, including arguments made in a PTMS, showed that the patentee surrendered certain claim coverage).

As also demonstrated above, the applicants remained consistent in their interpretation of "remote locations" throughout the prosecution of the '992 patent. When the examiner rejected pending claims 7 and 18-21 as obvious in view of Lang in combination with Fenwick,[9] the applicants responded that: "the requesting remote location of Fenwick et al. is not analogous to the *remote location* of the present invention. ... Fenwick et al. also does not disclose a system in which a user can *select* a remote location to which a selected item is sent. Rather in Fenwick et al., a selection can only be sent to the video monitor 102 [the monitor in the guest room] from which the user issues commands." (Ex. B at 212-213) (emphasis added).

These statements by the applicants, all made to argue patentability over the prior art, should not be ignored by the Court. *E.I. DuPont*, 849 F.2d at 1438 ("[A]rguments made during the prosecution history are relevant in determining the meaning of the terms at issue. Those arguments, and other aspects of the prosecution history, . . . must be examined to ascertain the true meaning of what the inventor intended to convey in the claims. . . . Regardless of the examiner's motives,

arguments made during prosecution shed light on what the applicant meant by its various terms.") A construction of "remote locations" as merely a location remote from the transmission system would render these criticisms of Walter, Fenwick, and Monslow meaningless. The prosecution history further confirms defendants' proposed construction of "remote locations."

5. The prosecution of the '720 patent further confirms Defendants' proposed construction of "remote locations."

In the years following the issuance of the '992 patent, the applicants continued to rely on the "remote locations" feature of their "invention" to win further patents in the family. During the prosecution of the '720 patent five years later, for example, the applicants heavily relied on this feature to overcome the Wilson reference, which had now issued and was of record in that prosecution. *See* discussion at 6, *infra*. The examiner, focusing on the "remote locations" limitation, had rejected pending independent claim 33 as being anticipated by Wilson. (Ex. L at 478.) Pending claim 33 had the exact same preamble as claim 1 of the '992 patent. (*See e.g.*, *Id.* at 497-98.)

The applicants responded to the examiner's rejection by relying on the "remote locations" feature. The applicants argued:

> Wilson et al. teaches a system significantly different from the present invention. For example, Wilson et al. requires that the shopper be connected to the system resources by telephone for the duration of the transaction. This limits both telephone use by the subscriber as well as the availability of system resources to other subscribers. Furthermore, in Wilson et al. the subscriber is required to be physically present at the location to which information is transmitted.
>
> In contrast, the present invention provides a flexible system in which a user can remotely access information. That is, the user can request

[9] Pending claim 18 issued as claim 19 in the '992 patent and includes the same "remote locations" limitation that appears in asserted claims 1 and 41.

transmission of information to a site remote from the requesting site. Additionally, with the present invention the user does not have to be connected by telephone when information is transmitted from the library to the selected remote location. This frees up system resources for use by others and makes the system much more convenient to use than that disclosed in Wilson et al.

(Ex. L at 487.)

When these arguments were deemed "not persuasive" by the examiner, *Id.* at 494, chiefly because the examiner did not believe that the argued feature was necessarily in the claims, the applicants responded to the examiner's comments by stating:

"Applicants disagree because the claimed invention has always recited transmission of data to remote locations. This feature is neither disclosed nor suggested in Wilson, which require [sic] the subscriber to be physically present at the location to which information is transmitted. To advance prosecution of this application, Applicants have amended independent claim 33 to clarify that the remote location to which the information is transmitted is different from the accessing location at which the user is positioned when making the request. As detailed above, this limitation of claim 33 is not disclosed in or suggested by Wilson."

(*Id.* at 502) (emphasis added).

In conjunction with this argument, the applicants replaced "remote locations" with "a remote location selected by the user" in pending claim 33. (*Id.* at 497.) Although the amendment indicated that the user selects the remote location for transmission, the applicant's argument did not make that point clear. Accordingly, the examiner rejected amended claim 33 as being anticipated by U.S. Pat. No. 5,133,079 issued to Ballantyne. (*Id.* at 508-09.) Ballantyne discloses a system where

a user can request the transmission of information through the phone lines, and which does not require the user to make the request at the viewing location. (*Id.*) Like Wilson, Ballantyne was not of record in prosecution of the '992 patent.

In response to this rejection, the applicants distinguished Ballantyne by arguing that:

> [T]he [Ballantyne] system automatically downloads the requested video to the customer's premises with a matching UIN. The customer cannot request that the video be sent to another premises. Rather, the video can only be sent to the predetermined user premises containing the customer video storage system with the matching UIN.
>
> Conversely, the claimed invention includes a transmission system that transmits information to any premises chosen by the user that has a specified receiver. ... *See* Appl. No. 08/630,590, page 4, ll. 4-5. In order to place an order, the user enters a customer ID code and makes a selection by entering a corresponding identification code for the desired item. Upon receiving the confirmation, the user selects the desired delivery time and *destination*. *Id.* at page 30, line 15-page 31, line 10 (*See also* page 31, line 14; page 32, line 26, page 33, line 6). That destination is not limited to a predetermined user premises. Thus, the Ballantyne patent fails to teach a transmission system as claimed in independent claim 43, which transmits information to a *premises selected by the user* with that premises not being limited to a pre-determined user premises.

(*Id.* at 517-18) (emphasis in original).

These arguments, from later patents in the chain which confirm the proper construction of the phrase "remote locations," are further evidence that the court may consider. *See Jonsson v. Stanley Works*, 903 F.2d 812, 818 (Fed. Cir. 1990); *see also CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1159 (Fed. Cir. 1997), *rehearing*

& suggestion for rehearing en banc denied, 120 F.3d 1260 (Fed. Cir. 1997) ("[W]e are obliged to construe the term 'elasticity' consistently throughout the claims [of the two related patents-in-suit]."); *Arthur A. Collins, Inc. v. Northern Telecom Ltd.*, 216 F.3d 1042, 1044 (Fed. Cir. 2000) (finding a common construction of a limitation in two claims of two patents was appropriate because two patents shared the same written description).

Simply put, for nearly ten years the applicants relied on the fact that the phrase "remote locations" meant "more than one location selectable by the user." To allow Acacia now to essentially repudiate that meaning would be a manifest injustice, and clearly erroneous claim construction.

B. "Library Means for Storing Items Having Information" and "Storing Items Having Information in a Source Material"

1. "Library Means for Storing Items Having Information": The Court Should Construe the This Limitation Pursuant to § 112, ¶ 6 and Find that the Corresponding Structure is the "Source Material Library."

Claim 1 of the '992 patent requires "a library means for storing items containing information." ('992 patent at 20:17-18.) The inclusion of this element in the claimed transmission system (and the corresponding method step of claim 41) is a historical anachronism. In the thirteen years that have transpired since the applicants first filed the '992 patent, the costs of data storage have reduced exponentially. (Ex. U at 557.) Whereas once thousands of dollars of storage space might have been necessary to store a single compressed digital movie, now, a plurality of movies can be stored easily on a typical computer hard drive.

Accordingly, at the time of the '992 patent filing, the only plausible method of making significant amounts of materials available to users of a compressed video on-demand system was to maintain source material in its native form, which could be made available to users in response to user requests. In claim 1, the applicants included this necessary feature to their invention as the "library means for storing items having information."

Because this claim term uses the word "means," a presumption arises that the applicants used the term advisedly to invoke the statutory mandate of § 112, ¶ 6. *Sage Prods.*, 126 F.3d at 1427. This presumption may only be rebutted if the claim element recites structure sufficient to perform the claimed function in its entirety. *Id.*

Here, the claimed function is "storing items containing information." The term "store" means to place or leave in a location for later use. (Ex. Q at 545.) For the items stored in the library means to be of "later use" to the transmission system, the identification encoding means of the transmission system must be able to readily access the items and retrieve the information in the items upon request by a user. ('992 patent at 20:17-21.) Therefore, the claimed function of "storing items containing information" is properly construed to mean that the library means must have items containing information that may be readily accessed for use by the transmission system, i.e., the library is part of the transmission system.

The claim does not recite structure sufficient to perform this claimed function. While the claim recites the term "library," a structural term, a generic library does not perform this function. Webster's defines a "library" as "a room, a section or series of sections of a building, or a building itself given over to books, manuscripts, musical scores, or other literary and sometimes artistic materials (as paintings or musical recordings) usually kept in some convenient order for use but not for sale." (Ex. Q at 542.)

While clearly a generic library is capable of retaining items at a particular location, a generic library does not make these items available for use by the claimed transmission system. In the context of the claimed function, only a specific type of library—the source material library, which contains the original source material available on the transmission system—is alleged by the applicants to perform this function. ('992 patent at 5:66-6:10.) Accordingly, the claim term remains in means-plus-function format.

Confirming this construction is the applicants' statements during prosecution about the "library means." During the prosecution of the '992 patent, the applicants stated that Lang did not disclose a "library means" because Lang only envisioned an off-site video library, but had not disclosed that the library itself was part of the transmission system. As stated in the PTMS: "Lang does not disclose a receiving system which is responsive to user requests for items from a source material library. While Lang mentions that video libraries are 'envisioned,' there is no disclosure of how material would be requested or retrieved from such libraries." (Ex. B at 155.) And then again when the examiner rejected the claims: "The AVRU 11 of Lang and the claimed library means are not analogous. . . . Lang 'envisions' a library at some time in the future . . . , but such a library is clearly not AVRU 11. Moreover, applicants submit that the incorporation of a library into the system in Lang is only envisioned because of a lack of knowledge of how to incorporate such a library. Applicants, however, have solved the problems left open in Lang."[10] (*Id.* at 209.)

The statements made by the applicants in regard to Lang confirm what the plain language of the claims required—that the library means must be readily accessible by the transmission system. *Alpex Computer Corp. v. Nintendo Co. Ltd.*, 102 F.3d 1214, 1221 (Fed. Cir. 1998) (holding that positions taken before the PTO may bar an inconsistent claim construction under § 112, ¶ 6.) As demonstrated above, a generic library does not perform this claimed function.

According to the patent specification, the structure that performs this claimed function is source material library 111. "As shown in Fig. 2a, the source material library means included in transmission system 100 preferably includes a source material library 111." ('992 patent at 6:8-10.) The specification goes on to state that: "the source material library may include different types of materials including television programs, movies, audio recordings, still pictures, files, books, computer

[10] Notably, the AVRU 11 of Lang was an improved video recorder/transmitter that could store multiple, digitized compressed video files. (Ex. C at 3:28-37, 5:9-24, 6:8-29.)

tapes, computer disks, documents of various sorts, musical instruments, and other physical objects." (*Id.* at 6:10-15.) Accordingly, the "library means" element of claim 1 requires that the claimed transmission system have a "source material library"—the original source items available in the transmission system organized in a library.

2. "Storing Items Having Information in a Source Material Library": This Claim Step Should be Interpreted to Mean that the Transmission System Has Readily Accessible for Use Original Source Items of the Transmission System in a Library.

Claim 41 requires the step of "storing items having information in a source material library." Each of the steps of the method of claim 41 are required by the preamble to be explicitly "performed by [the] transmission system," a limitation added to the claim by amendment near the end of the prosecution. (Ex. B at 231.)

As with the corresponding apparatus of claim 1, "storing" in the context of claim 41 means to place or leave in a location for later use. (Ex. Q at 545.) Here, it is the items having information that are stored, and they are stored in a source material library. And this source material library must be part of the transmission system.

The source material library, as demonstrated above, is the organized collection of original source materials that the transmission systems converts, compresses, and then transmits. As its name implies and as the written description makes clear, it is not simply an off-site library, such as a public library or a video store that bears no relation to the transmission system. Rather, it is the library of original source materials that is available for use by the transmission system, as needed. By necessity, it contains the original source material of the items that have been converted and compressed into the compressed data library, and may contain other materials that might be used by the transmission system at another time, if requested by a user. Accordingly, "storing items having information in a source material

library" should be interpreted to mean that the transmission system has readily accessible for use original source items of the transmission system in a library.

C. The "Identification Encoding Means" Limitation Lacks Corresponding Structure and Is Invalid Under §112, ¶ 2.

As part of the transmission system of claim 1 of the '992 patent, the applicants included a structure they identified as an "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." This claim element necessarily appears in dependent claims 2 through 18, many of which have been asserted by Acacia.

The parties agree that the "identification encoding means" limitation is written in "means-plus-function" format and is subject to 35 U.S.C. §112, ¶ 6. The parties also agree the claimed functions are: (1) retrieving the information in the items from the library means and (2) assigning a unique identification code to the retrieved information. The only item thus remaining for construction is the structure that corresponds to these functions. Defendants contend that there is none.

As is undisputed, the "identification encoding means" of claim 1 of the '992 patent performs two functions. First, it retrieves the information in the items from the library means. As described previously, the "library means" may include a number of items, such as books, video tapes, compact discs, etc. Notably, the identification encoding means does not retrieve the items themselves, but rather retrieves the information from the item. In the example of a videotape, the identification encoding means would not physically retrieve the videotape from the library means, but would retrieve the information stored on the videotape.

After retrieving the information, the identification encoding means then assigns a "unique identification code" to the retrieved information. Defendants proposed construction of unique identification code is set forth later in this brief.

The only "structures" disclosed by the '992 patent specification for performing these functions are something called an "identification encoder 112" and a

corresponding box numbered 112 and labeled "Identification Encoding Process." ('992 patent at 6:35-68, FIG. 2a.) The term "identification encoder" does not appear in a relevant technical dictionary (i.e., "IEEE") and has no apparent meaning to those of skill in the art. *See Altiris,* 318 F.3d at 1374. It is simply a term that was made up by the applicants, which was well within their right to do as their own lexicographers.[11] The written description repeatedly attributes the claimed functions of "retrieving" and "assigning" to the identification encoder 112 and the box labeled the same, but is silent as to what exactly the identification encoder 112 is or how it performs these functions. (*See, e.g.*, i*d.* at 6:38-39, 6:59-61, 7:1-3, 7:12-14, 7:48-50, 10:28-30, 11:5-8, 12:28-30, 18:63-68.)

For example, the claimed identification encoder must be able to retrieve information from the videotapes, compact disks, books, computer tapes and other similar items in the library means. (*Id.* at 6:10-15.) Accordingly, the identification encoder must include a structure or structures that operate like a VCR, computer disk drive, optical scanner, or tape players to retrieve the information. The '992 patent, however, provides no disclosure of structure that can be used to retrieve information. It simply states that this process is performed during the identification encoding process. (*Id.* at 2:31-32.) Similarly, the '992 patent provides absolutely no disclosure of a structure for assigning a unique identification code to the information once it is retrieved from the items. There is no description of a device or circuitry that assigns the unique identification code, no indication whether the function is performed by a computer processing executable instructions, and no disclosure of any other structure that may perform the function. The '992 patent is silent.

Where "no embodiment discloses corresponding structure, the claim is invalid for failure to satisfy the definiteness requirement of § 112, ¶ 2." *Cardiac*

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[11] This is evident from Acacia's proposed definition of identification encoder in claim 1 of the '702 patent: a device capable of expressing a number, symbol, or name that uniquely identifies certain information. (Ex. T at 556.)

Pacemakers, 296 F.3d at 1114. Because there is no structure disclosed in the '992 patent that corresponds to the claimed functions of "retrieving" and "assigning," the "identification encoding means" limitation of claim 1 is invalid for failure to satisfy the definiteness requirement of § 112, ¶ 2. Likewise, the asserted claims that depend from claim 1, namely claims 2, 4, 6, 8-10, and 18, should be found invalid.

In searching the specification for disclosed structure that performs these functions, it is important that the Court not read into the specification that which is not there. "The correct inquiry is to look at the *disclosure* of the patent and determine if one of skill in the art would have understood the *disclosure* to encompass [the corresponding structure] and not simply whether one of skill in the art would have been able to [implement the corresponding structure]." *Medical Instrumentation*, 344 F.3d. 1205, 1212 (Fed. Cir. 2003) (emphasis in original). "It is important to determine whether one of skill in the art would understand the specification itself to disclose the structure, not simply whether that person would be capable of implementing that structure." *Id.* Stated otherwise, "[i]t is not proper to look to the knowledge of one skilled in the art apart from and unconnected to the disclosure of the patent." *Id.*

In this regard, Judge Clevenger recently explained in *Medical Instrumentation* that "[t]he public should not be required to guess as to the structure for which the patentee enjoys the right to exclude. The public instead is entitled to know precisely what kind of structure the patentee has selected for the claimed functions, when claims are written according to section 112, paragraph 6." *Id.* at 1220. "Precision in claiming is not an unreasonable price to pay to gain the benefits of claiming in functional terms under section 112, paragraph 6." *Id.*

Here, the applicants have clearly failed to live up to their responsibilities under the statute. The claims of the patent employing the "identification encoding means" term are invalid.

D. "Unique Identification Code": The Court Should Construe this Limitation to Mean a One-of-a-kind Identifier Assigned to the Information Retrieved From an Item Before Compression That is Different From a File Name or Address, a Popularity Code, Program Notes, Item Title, or Unique Address Code.

Claims 1 and 41 of the '992 patent contain the claim limitation "unique identification code" ("UIDC"). According to the patent, the UIDC is assigned to the group of information representing a particular item that is allegedly retrieved by the identification encoding means from the source material library. ('992 patent at 6:48-54). The UIDC is then used by the transmission system to identify the information representing a particular item as it is processed and stored in the transmission system. ('992 patent at 6:35-39; 10:28-30, 11:22-23, 18:63-69; *see also* Ex. B at 151.) Because the UIDC is "unique" it may only be assigned to one group of information retrieved from an item at any one time so that the transmission system can identify that group of information (and, hence, the information item as a whole) as it passes through the transmission system.

Notably, the term "unique identification code" does not have any ordinary meaning available from a technical dictionary. *Altiris*, 318 F.3d at 1374. For example, the definition of the term in the IEEE dictionary refers to it as a term used in power plants. (Ex. R at 551.) And while the standard dictionary definitions of the words used to make up the term—"unique," "identification," and "code"—provide some guidance, merely looking to the definitions of these words and putting them together absent resort to the specification is not appropriate under the Federal Circuit's authorities. *Id.* at 1375. The relevant definitions of these words from Webster's are as follows:

- Unique: being the only one (Ex. Q at 546.)
- Identification: a means of identifying (*Id.* at 541.)
- Code: any system of symbols for meaningful communication (*Id.* at 540.)

Indeed, the specification of the patent demonstrates that the applicants employed the term "UIDC" to describe a code that performed a particular set of

functions, and importantly, did not perform other functions, not implicit in any way from the definitions of the words "unique," "identification," and "code." For example, the '992 specification and claims make clear that a UIDC is something other than a file name or address, popularity code, program note, title, or what it calls a "unique address code." The written description of the '992 patent states that "the method of encoding the information involves assigning a unique identification code and a *file address to the item, assigning a popularity code, and inputting the program notes*. This process is identical for any of the different media types stored in the source material library 111." ('992 patent at 6:49-54) (emphasis added). Thus, implicit in the written description is that a UIDC is not the same thing as a "file address," "popularity code," or a "program note." Similarly, the written description distinguishes UIDCs from such other then-commonly known identifiers as titles and facts about the item. "[A] user may preferably access an item via its unique identification code, *via its title*, or the user may use *other known facts* for accessing an item." (*Id.* at 11:22-25) (emphasis added). The written description also distinguishes UIDCs from "unique address codes," which are file addresses that uniquely identify the compressed data files stored in the compressed data library. (*Id.* at 10:46-50.) Unlike UIDCs, which are assigned by the identification encoder, the system operator assigns unique address codes to files that are stored in the compressed data library 118. (*Id.* at 10:58-61.)

The claim language itself also makes clear that the UIDC must be different from a file name or address. In claim 1, each group of information retrieved from a particular item must have a single, unique identification code. This information is then placed in a predetermined format, placed into a sequence of addressable data blocks, and compressed. Next, the compressed information may be stored as multiple files with the single assigned unique identification code. (*Id.* at 20:33.) The applicants amended the "compressed data storing means" limitation to specifically recite the function of "storing as files" rather than "storing as a file." (Ex. B at 228.)

Notably, the applicants did not amend the term "unique identification code" to read "unique identification codes" after this amendment. (*Id.*)

Because the single group of information having a single, unique identification code may be stored as multiple files, a "unique identification code" cannot be the file name or a file address. Indeed, identifiers such as file names and file addresses were well known at the time the '992 patent was filed, and the applicants did not use these terms in the claims.

Accordingly, the unique identification code must serve the functions of uniquely identifying the group of information retrieved from an item, while not being the same thing as all of the other distinguished "codes." Therefore, the UIDC should be defined as a one-of-a-kind identifier assigned to the group of information representing a single item that is different from a file name or address, popularity code, program note, item title, or unique address code.

E. "Sequence of Addressable Data Blocks": The Court Should Construe this Limitation to Mean a Continuous Series of Memory Units that Contain Digital Information That Can Be Given an Identifier.

The claim limitation "sequence of addressable data blocks" appears in claims 1 and 41 of the '992 patent in the phrase: "ordering means ... for placing the formatted data into a sequence of addressable data blocks." ('992 patent at 20:26-27, 24:65-66.) This claim term is made up of the following constituent words and phrases: "sequence," "addressable," and "data blocks."

The term "sequence" is defined by Webster's as a continuous or connected series. (Ex. Q at 544.) The term "addressable" modifies the term "data blocks," and in the context of claims 1 and 41 means that the data blocks may be given an address to identify them amongst other blocks containing information retrieved from a single item. (Ex. R at 549) (defining "address" as "an identification as represented by a name, label, or number, for a register, location in storage, or any other data source or destination such as the location of a station in a communication network" or "a means

of identifying information or a location in a control system."). In the context of data communications, the term "block" means a group of contiguous characters formed for transmission purposes. (Ex. R at 550.)

Accordingly, the Court should construe "sequence of addressable data blocks" to mean a continuous series of memory units that contain digital information that can be given an identifier. This construction is consistent with the figures provided by the '992 patent that show sequences of blocks. (*See, e.g.*, '992 patent Fig. 8e, 19:57-60.) Given that the '992 patent does not describe the term "sequence of addressable data blocks" in any conflicting way and given that the prosecution history does not meaningfully discuss the term, the claim limitation should be given its ordinary meaning. *ACTV, Inc. v. Walt Disney Co.*, 2003 WL 22300131, *7 (Fed. Cir. 2003).

V. CONCLUSION

For the forgoing reasons, the defendants request that the Court construe the disputed claim limitations as requested herein.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was this date served upon all counsel of record by placing a copy of the same in the United States Mail, postage prepaid, and sent to their last known address as follows:

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