

APPLICABLE LAW

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Innova/Pure Water Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). In claim construction, courts examine the patent’s intrinsic evidence to define the patented invention’s scope. *See id.*; *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861 (Fed. Cir. 2004); *Bell Atl. Network Servs., Inc. v. Covad Commc’ns Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001). This intrinsic evidence includes the claims themselves, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1314; *C.R. Bard, Inc.*, 388 F.3d at 861. Courts give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art at the time of the invention in the context of the entire patent. *Phillips*, 415 F.3d at 1312–13; *Alloc, Inc. v. Int’l Trade Comm’n*, 342 F.3d 1361, 1368 (Fed. Cir. 2003).

The claims themselves provide substantial guidance in determining the meaning of particular claim terms. *Phillips*, 415 F.3d at 1314. First, a term’s context in the asserted claim can be very instructive. *Id.* Other asserted or unasserted claims can also aid in determining the claim’s meaning because claim terms are typically used consistently throughout the patent. *Id.* Differences among the claim terms can also assist in understanding a term’s meaning. *Id.* For example, when a dependent claim adds a limitation to an independent claim, it is presumed that the independent claim does not include the limitation. *Id.* at 1314–15.

“[C]laims ‘must be read in view of the specification, of which they are a part.’” *Id.* (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc)). “[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Id.* (quoting *Vitronics*

Corp. v. Conceptoronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996)); *see also Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002). This is true because a patentee may define his own terms, give a claim term a different meaning than the term would otherwise possess, or disclaim or disavow the claim scope. *Phillips*, 415 F.3d at 1316. In these situations, the inventor's lexicography governs. *Id.* Also, the specification may resolve ambiguous claim terms "where the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the words alone." *Teleflex, Inc.*, 299 F.3d at 1325. But, "[a]lthough the specification may aid the court in interpreting the meaning of disputed claim language, particular embodiments and examples appearing in the specification will not generally be read into the claims." *Comark Commc'ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988)); *see also Phillips*, 415 F.3d at 1323. The prosecution history is another tool to supply the proper context for claim construction because a patent applicant may also define a term in prosecuting the patent. *Home Diagnostics, Inc., v. Lifescan, Inc.*, 381 F.3d 1352, 1356 (Fed. Cir. 2004) ("As in the case of the specification, a patent applicant may define a term in prosecuting a patent.").

Although extrinsic evidence can be useful, it is "less significant than the intrinsic record in determining the legally operative meaning of claim language." *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc.*, 388 F.3d at 862). Technical dictionaries and treatises may help a court understand the underlying technology and the manner in which one skilled in the art might use claim terms, but technical dictionaries and treatises may provide definitions that are too broad or may not be indicative of how the term is used in the patent. *Id.* at 1318. Similarly, expert testimony may aid a court in understanding the underlying technology and determining the

particular meaning of a term in the pertinent field, but an expert's conclusory, unsupported assertions as to a term's definition is entirely unhelpful to a court. *Id.* Generally, extrinsic evidence is "less reliable than the patent and its prosecution history in determining how to read claim terms." *Id.*

Defendants also contend that some claims at issue are invalid for indefiniteness. A claim is invalid under 35 U.S.C. § 112 ¶ 2 if it fails to particularly point out and distinctly claim the subject matter that the applicant regards as the invention. The party seeking to invalidate a claim under 35 U.S.C. § 112 ¶ 2 as indefinite must show by clear and convincing evidence that one skilled in the art would not understand the scope of the claim when read in light of the specification. *Intellectual Prop. Dev., Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, 336 F.3d 1308, 1319 (Fed. Cir. 2003).

CLAIM TERMS

"mobile station"

"Mobile station" is "a mobile wireless device that is at least a transmitting device and may include a receiving device." The parties agreed to this construction at oral argument. *Tr. Markman Hr'g* 80–81, Nov. 8, 2012.

"communication station"

TracBeam argues no construction is necessary. Defendant Google proposes "networked cellular telephony base stations."

The parties dispute whether a communication station *is* a networked cellular telephony base station, or whether a networked cellular telephony base station is merely *one embodiment* of a communication station. Google contends that communication stations are called base stations in the specification, so the term "communication station" should be construed using a reference

to “base stations” in the Definition section of the ‘231 Patent.² *See* Docket No. 317 (“Response”) at 3 (noting the phrase “base station” appears over 400 times in the specification, while the phrase “communication station” does not appear in the specification). The ‘231 Patent defines “infrastructure” as:

...the network of telephony communication services, and more particularly, that portion of such a network that receives and possesses wireless communications with wireless mobile stations. In particular, *this infrastructure includes telephony wireless base stations* (BS) such as those for radio mobile communication systems based on CDMA, AMPS, NAMPS, TDMA, and GSM *wherein the base stations provide a network or cooperative communication channels* with an air interface with the MS....

‘231 Patent, at 9:56–64 (emphasis added). Google contends its construction is proper because it is taken directly from the ‘231 Patent’s Definition section. Response at 4. Google also contends that TracBeam’s proposed construction is non-enabling because the specification does not disclose a communication system. *See id.* (quoting *Magsil Corp. v. Hitachi Global Storage Techs., Inc.*, 687 F.3d 1377, 1381 (Fed. Cir. 2012) (“The scope of the claims must be less than or equal to the scope of enablement to ensure that the public knowledge is enriched by the patent specification to a degree at least commensurate with the scope of the claims.”)).

TracBeam argues that “communication station” and “networked cellular telephony base station” are not interchangeable; rather, a networked cellular telephony base station is one embodiment of a communication station. *See* Docket No. 315 (“Brief”) at 4. (“‘Communication’ is not limited to ‘cellular telephony’ communication and ‘station’ is not limited to a ‘base station.’”). In support, TracBeam notes that the ‘231 Patent discloses a mobile base station that can be “incorporated into a vehicle.” ‘231 Patent, at 18:6–7. TracBeam contends it would be improper to limit the Claims to a particular embodiment absent an express disavowal of claim

² During prosecution, the phrase “base station” was changed to “communication station.” Response at 3 n.11.

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