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United States District Court,  
E.D. Texas,  
Marshall Division.

PERSONALIZED MEDIA COMMUNICATION, LLC

v.

MOTOROLA, INC., et al.

No. 2:08-CV-70-CE.

Sept. 30, 2011.

[Expand Construed Terms](#)

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**MEMORANDUM OPINION AND ORDER**

CHARLES EVERINGHAM IV, United States Magistrate Judge.

**I. INTRODUCTION**

\*1 On February 19, 2008, plaintiff Personalized Media Communication, LLC (“PMC”) filed suit against defendants Motorola Incorporated, EchoStar Corporation, and DISH Network Corporation, alleging infringement of U.S. Patent Nos. 4,965,825 (the “#825 Patent”); 5,109,414 (the “#414 Patent”); 5,233,654 (the “#654 Patent”); 5,335,277 (the “#277 Patent”); and 5,887,243 (the “#243 Patent”). Just prior to the *Markman* hearing, defendant Motorola and PMC settled their dispute. Therefore, this claim construction order will address only defendant EchoStar Corporation and DISH Network Corporation's (collectively “Defendants”) claim construction arguments.

The patents-in-suit disclose a number of inventions that relate, among other things, to the delivery of programming content to consumers. This includes the concept of delivering “personalized” broadcast programming. The parent application for the patents-in-suit was filed in 1981 and issued as U.S. Patent No. 4,694,490 (the “#490 Patent”). The #490 Patent was supplemented by a continuation-in-part application in 1987, which issued as the #825 Patent. The asserted patents all share the same specification. For convenience, all specification citations herein are to the #825 Patent unless otherwise noted.

The asserted patents have an extensive litigation history. PMC has filed four prior lawsuits asserting some or all of the patents-in-suit in this case. Three of those cases involved substantive rulings on the patents, including claim construction. In 1996, PMC litigated against DIRECTV and Thomson Consumer Electronics in the U.S. International Trade Commission (the “ITC litigation”). *In the Matter of Certain Digital Satellite System (DSS) Receivers and Components Thereof*, Inv. No. 337-TA-392 (U.S. Int'l Trade Comm'n). The Administrative Law Judge in that matter issued an Initial Determination, including a claim construction. After the ITC found no violation of PMC's patents, the Federal Circuit affirmed the ITC findings of non-infringement and invalidity but vacated and remanded other aspects of the decision. *See Personalized Media Commc'ns, LLC v. Int'l Trade Comm'n*, 161 F.3d 696 (Fed.Cir.1998). PMC dismissed the ITC action and a parallel patent suit against these defendants in May 1999.

On December 4, 2000, PMC filed a suit against DIRECTV and Thomson asserting different claims in the District of Delaware. *Pegasus Dev. Corp. v. DirecTV Inc.*, No. 00-10200-GMS (D.Del.) (the “Delaware litigation”). On

March 28, 2002, PMC filed suit in the Northern District of Georgia against certain cable television set-top box manufacturers, including Scientific–Atlanta. *Personalized Media Communications, LLC v. Scientific–Atlanta, Inc.*, No. 1:02–cv–824–CAP (N.D.Ga.) (the “Atlanta litigation”). In both cases, the courts addressed claim construction using special masters, and a report was issued on claim construction in each action. Defendants were not parties to these prior actions.

\*2 The court held a *Markman* hearing on May 6, 2011. Thereafter, PMC filed a motion sever and stay eight asserted claims, including [825 Patent](#), Claim 3; [414 Patent](#), Claim 13; [654 Patent](#); Claim 59; and [7277 Patent](#), Claims 24, 25, 41, 42 and 43 (Dkt. No. 230). The court granted PMC’s motion to stay the eight asserted claims identified in its motion. As such, the following terms that appear exclusively in the stayed claims will not be addressed in this claim construction order: (1) carrier receiving means; (2) carrier transmission receiving means; (3) demodulating means; (4) instruct-to-generate-and-transmit signal; (5) instruct-to-generate signal; (6) means for demodulating; (7) predetermined time interval; (8) recorder means; and (9) unit identification information signal. After considering the submissions and the arguments of counsel, the court issues the following order concerning the claim construction issues.

## II. GENERAL PRINCIPLES GOVERNING CLAIM CONSTRUCTION

“A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using or selling the protected invention.” *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1340 (Fed.Cir.1999). Claim construction is an issue of law for the court to decide. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970–71 (Fed.Cir.1995) (en banc), *aff’d*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

To ascertain the meaning of claims, the court looks to three primary sources: the claims, the specification, and the prosecution history. *Markman*, 52 F.3d at 979. The specification must contain a written description of the invention that enables one of ordinary skill in the art to make and use the invention. *Id.* A patent’s claims must be read in view of the specification, of which they are a part. *Id.* For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Id.* “One purpose for examining the specification is to determine if the patentee has limited the

scope of the claims.” *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882 (Fed.Cir.2000).

Nonetheless, it is the function of the claims, not the specification, to set forth the limits of the patentee’s invention. Otherwise, there would be no need for claims. *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed.Cir.1985) (en banc). The patentee is free to be his own lexicographer, but any special definition given to a word must be clearly set forth in the specification. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed.Cir.1992). Although the specification may indicate that certain embodiments are preferred, particular embodiments appearing in the specification will not be read into the claims when the claim language is broader than the embodiments. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054 (Fed.Cir.1994).

\*3 This court’s claim construction decision must be informed by the Federal Circuit’s decision in *Phillips v. AWH Corporation*, 415 F.3d 1303 (Fed.Cir.2005) (en banc). In *Phillips*, the court set forth several guideposts that courts should follow when construing claims. In particular, the court reiterated that “the *claims* of a patent define the invention to which the patentee is entitled the right to exclude.” 415 F.3d at 1312 (emphasis added) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1115 (Fed.Cir.2004)). To that end, the words used in a claim are generally given their ordinary and customary meaning. *Id.* The ordinary and customary meaning of a claim term “is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Id.* at 1313. This principle of patent law flows naturally from the recognition that inventors are usually persons who are skilled in the field of the invention and that patents are addressed to and intended to be read by others skilled in the particular art. *Id.*

The primacy of claim terms notwithstanding, *Phillips* made clear that “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.* Although the claims themselves may provide guidance as to the meaning of particular terms, those terms are part of “a fully integrated written instrument.” *Id.* at 1315 (quoting *Markman*, 52 F.3d at 978). Thus, the *Phillips* court emphasized the specification as being the primary basis for

construing the claims. *Id.* at 1314–17. As the Supreme Court stated long ago, “in case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims.” *Bates v. Coe*, 98 U.S. 31, 38, 25 L.Ed. 68 (1878). In addressing the role of the specification, the *Phillips* court quoted with approval its earlier observations from *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed.Cir.1998):

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. 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.

*Phillips*, 415 F.3d at 1316. Consequently, *Phillips* emphasized the important role the specification plays in the claim construction process.

The prosecution history also continues to play an important role in claim interpretation. Like the specification, the prosecution history helps to demonstrate how the inventor and the PTO understood the patent. *Id.* at 1317. Because the file history, however, “represents an ongoing negotiation between the PTO and the applicant,” it may lack the clarity of the specification and thus be less useful in claim construction proceedings. *Id.* Nevertheless, the prosecution history is intrinsic evidence that is relevant to the determination of how the inventor understood the invention and whether the inventor limited the invention during prosecution by narrowing the scope of the claims. *Id.*

\*4 *Phillips* rejected any claim construction approach that sacrificed the intrinsic record in favor of extrinsic evidence, such as dictionary definitions or expert testimony. The *en banc* court condemned the suggestion made by *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed.Cir.2002), that a court should discern the ordinary meaning of the claim terms (through dictionaries or otherwise) before resorting to the specification for certain limited purposes. *Phillips*, 415 F.3d at 1319–24. The approach suggested by *Texas Digital*—the assignment of a

limited role to the specification—was rejected as inconsistent with decisions holding the specification to be the best guide to the meaning of a disputed term. *Id.* at 1320–21. According to *Phillips*, reliance on dictionary definitions at the expense of the specification had the effect of “focus[ing] the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent.” *Id.* at 1321. *Phillips* emphasized that the patent system is based on the proposition that the claims cover only the invented subject matter. *Id.* What is described in the claims flows from the statutory requirement imposed on the patentee to describe and particularly claim what he or she has invented. *Id.* The definitions found in dictionaries, however, often flow from the editors' objective of assembling all of the possible definitions for a word. *Id.* at 1321–22.

*Phillips* does not preclude all uses of dictionaries in claim construction proceedings. Instead, the court assigned dictionaries a role subordinate to the intrinsic record. In doing so, the court emphasized that claim construction issues are not resolved by any magic formula. The court did not impose any particular sequence of steps for a court to follow when it considers disputed claim language. *Id.* at 1323–25. Rather, *Phillips* held that a court must attach the appropriate weight to the intrinsic sources offered in support of a proposed claim construction, bearing in mind the general rule that the claims measure the scope of the patent grant.

The patents-in-suit include claim limitations that fall within the scope of 35 U.S.C. § 112, ¶ 6. “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure ... in support thereof, and such claim shall be construed to cover the corresponding structure ... described in the specification and equivalents thereof.” 35 U.S.C. § 112, ¶ 6. The first step in construing a means-plus-function limitation is to identify the recited function. *See Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed.Cir.1999). The second step in the analysis is to identify in the specification the structure corresponding to the recited function. *Id.* The “structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1210 (Fed.Cir.2003) (citing *B. Braun v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)). The patentee must clearly link or associate structure with the claimed function as part of the quid pro quo for allowing the patentee to express the

claim in terms of function pursuant to § 112, ¶ 6. See *id.* at 1211; see also *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1377 (Fed.Cir.2001). The “price that must be paid” for use of means-plus-function claim language is the limitation of the claim to the means specified in the written description and equivalents thereof. See *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583 (Fed.Cir.1997). “If the specification does not contain an adequate disclosure of the structure that corresponds to the claimed function, the patentee will have ‘failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112,’ which renders the claim invalid for indefiniteness.” *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1382 (Fed.Cir.2009) (quoting *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed.Cir.1994) (en banc)). 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 the structure. See *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed.Cir.1999); *Biomedino*, 490 F.3d at 953. Fundamentally, it is improper to look to the knowledge of one skilled in the art separate and apart from the disclosure of the patent. See *Medical Instrumentation*, 344 F.3d at 1211–12.

**Plaintiff's Proposed Construction**

Any attempt to construe this simple and straightforward phrases is more likely to confuse, not assist, the jury.

The parties' primary dispute with regard to “transmission” is whether the patents-in-suit are limited to the dominant American TV standard in 1987—*analog NTSC*—or cover digital transmissions as well. Defendants argue that the patents are so limited and, therefore, urge the court to construe the term “transmission” to mean “sequential transfer of uncompressed content for a single program.” Defendants note that the various transmissions and the equipment for processing these transmissions are often described in the patents-in-suit as “conventional” and “well known in the art.” See, e.g., ‘825 Patent at 7:11–17 (the purpose of the invention is “combining [ ] relevant user specific information and conventional broadcast programming”); *id.* at 11:8–16 (the Wall Street Week embodiment “receives a conventional television broadcast transmission”); *id.* at 11:62–68; *id.* at 12:5–13 (the Wall Street Week program “is transmitted by conventional television network feed

“[A] challenge to a claim containing a means-plus-function limitation as lacking structural support requires a finding, by clear and convincing evidence, that the specification lacks disclosure of structure sufficient to be understood by one skilled in the art as being adequate to perform the recited function.” *Budde*, 250 F.3d at 1376–77.

**III. TERMS IN DISPUTE**

**a. “Transmission” Terms**

\*5 The following terms will be addressed in this section of the court's claim construction order: “information transmission” (‘825 Patent, Claims 3 and 14–17); “broadcast transmission” (‘654 Patent, Claims 7, 10, 59); “selected broadcast or cablecast transmission” (‘277 Patent, Claim 43); “programming transmission” (‘277 Patent, Claims 24–26.); “television program transmission” (‘277 Patent, Claims 11, 14, 19, 20, 22, 23, 41, 42); “separately defined television program transmission” (‘277 Patent, Claim 20.).

**i. “Transmission”**

**Defendants' Proposed Construction**

“Transmission” means “sequential transfer of uncompressed content for a single program.”

transmission means”); ‘490 Patent at 10:28–30 (“The means for and method of transmission of programing [sic] described here is well known in the art.”). Defendants argue that a person of ordinary skill in the art reading the patents in 1987<sup>1</sup> would have understood that “transmissions” were limited to the conventional television and radio transmissions available at the time. According to Defendants, in 1987 a person of ordinary skill in the art would have understood that a conventional television transmission was an NTSC transmission, which uses a process called uniform linear scanning that requires the use of transmissions that are sequential, uncompressed, and limited to a single program.

Defendants further point out that the patents recognize that the Federal Communications Commission (“FCC”) regulates television transmissions. See ‘825 Patent at 7:36–40 (describing methods for maintaining the logs mandated by the



FCC). In 1987, the FCC required television transmissions to comply with the NTSC standards—no other type of television transmission was permitted in the United States. Thus, Defendants argue that, even assuming *arguendo* that other types of transmissions existed, they would not have been understood as conventional in 1987. As such, Defendants argue that the patents-in-suit are limited to analog NTSC and, therefore, the court must construe “transmission” in a manner that reflects this limitation.

\*6 Defendants rely on *Kopykake Enters., Inc. v. Lucks Co.*, 264 F.3d 1377, 1382–83 (Fed.Cir.2001), for its contention that the use of the words “conventional” and “well known in the art” in the specification demonstrates the patentee’s intention to limit the transmission-related claim elements to analog NTSC transmissions. In *Kopykake*, the limitation at issue required “screen printing” of images on foodstuffs and the accused product used “ink jet printing.” *Id.* at 1380. The issue was, therefore, whether the claimed “screen printing” literally covered ink jet printing. *Id.* The specification explicitly defined the term “screen printing” to “encompasses not only conventional screen printing, but also includes any other conventional printing process and any other conventional means.” *Id.* Although ink jet systems were well known in the field of paper printing, it was not a conventional printing process for applying images to foodstuffs. *Id.* at 1383–84. The court therefore held that ink jet printing was not covered by the claim term at issue. *Id.* at 1384.

In this case, however, Defendants have failed to identify any definition of “transmission” that expressly limits the scope of the term to “conventional” transmission systems known in 1987. As such, this case more closely mirrors the circumstances presented in *Superguide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 878–81 (Fed.Cir.2004). There, the federal circuit held that where the patentee does not clearly limit his invention to what was “conventional” at the time of the invention, the claims are not so limited. *Id.* at 879. Although the patents-in-suit disclose several embodiments in which certain transmissions, programming, or broadcasting are described as “conventional” or “well known in the art,” these are only examples showing how the inventions could be implemented using conventional technology. In fact, there are instances in the specification where the “conventional” and “well known in the art” qualifiers are not used. *See, e.g.*, ‘825 Patent at 216:50–66 (describing receiver stations displaying “*any form of electronically transmitted programming*” that “may be received *via any electronic transmission means* including wireless or cable means”) (emphasis added); *id.*

at 188:58–61 (concepts of invention “apply to *all forms of electronically transmitted programming*” ) (emphasis added).

Furthermore, although Defendants argue that digital television technology was in its nascent stage in 1987, they concede that it was, at the least, known by persons of ordinary skill in the art as early as 1981. In fact, the Federal Circuit in *Superguide* observed that “the first digital television standard was created in 1981” and that they had “little doubt that those skilled in the art knew of the existence of digital video data” as of 1985. *Superguide*, 358 F.3d at 877. Most importantly, the Federal Circuit explained that:

\*7 Had the patentees intended to limit the disputed claim terms to ‘analog’ technology, they could have easily done so by explicitly modifying the disputed claim language with the term ‘analog.’ ... The law ‘*does not require that an applicant describe in his specification every conceivable and possible future embodiment of his invention.*’ ... We find no reason here to limit the scope of the claimed invention to analog technology, when ‘regularly received television signals,’ *i.e.*, video data, is broad enough to encompass both formats and *those skilled in the art knew both formats could be used for video.*

*Id.* (emphasis added). Defendants’ offer no arguments as to why the court should ignore the Federal Circuit’s well reasoned analysis, which concludes that digital data transmission was known as early as 1981. Considering this, the court rejects Defendants’ contention that the patentee’s use of the terms “conventional” and “well known in the art” limit the scope of the invention to analog NTSC.

The other dispute regarding the Defendants’ proposed construction of “transmission” is whether the “transmission” must be limited to a single program. This “single program” limitation arises from Defendants’ rejected argument that the claims are limited to analog NTSC. Even if Defendants’ analog NTSC argument had not been rejected, there is no support in the specification for the proposed “single program” limitation. Defendants argue there is no support in the patents-in-suit for the proposition that a transmission may include more than one program on a single channel. The patents,

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