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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

BELL NORTHERN RESEARCH, LLC,
Plaintiff,
v.
LG ELECTRONICS INC., LG
ELECTRONICS U.S.A., INC., and
LG ELECTRONICS MOBILE
RESEARCH U.S.A., LLC,
Defendants.

Case No.: 18-CV-2864-CAB-BLM

**CLAIM CONSTRUCTION ORDER
AND ORDER ON MOTION FOR
SUMMARY JUDGMENT OF
INDEFINITENESS
[Doc. 82]**

On January 16, 2020, the Court held a hearing to construe certain disputed terms and phrases of U.S. Patent No. 7,945,285 and U.S. Patent No. 6,549,792, at issue in this lawsuit. The Court further heard argument on defendant’s motion for summary judgment that certain claims of the ‘792 patent and U.S. Patent No. 7,039,435 are indefinite and therefore invalid. Having considered the submissions of the parties, the arguments of counsel, and for the reasons set forth at the hearing and summarized herein, the Court enters the claim constructions listed below and denies the motion to summary judgment.

1 A. Claim Construction Order

2 1. U.S. Patent No. 7,945,285¹

3 The '285 patent is for an apparatus and method of "Integrating a Digital Encoded-
4 Audio Bit Stream Player in a Radio-Frequency Telephone Handset." The '285 patent is a
5 continuation of an application filed on October 7, 2004 which issued as U.S. Patent No.
6 7,702,363, which is a continuation of an application filed on November 23, 1999, which
7 issued as U.S. Patent No. 7,945,284. The patents are directed at cordless telephones and a
8 need to "expand the uses of a cordless telephone beyond that afforded by conventional
9 cordless telephones." (Col. 1:56-57.) Specifically, integrating a digital audio bit stream
10 player within the remote handset or matching base unit of a cordless phone. (Col. 1:61-
11 65.)

12 During the prosecutions of the '284 and '363 patents, the applicants repeatedly
13 distinguished prior art references by stating the prior art related to cellular telephones
14 connected to cellular relay towers and not cordless telephones. The applicants emphatically
15 reiterated to the examiner that the remote handset and matched base unit of the invention
16 was not a cellular telephone and a cellular relay tower, and inventions within the "cellular
17 telephone art" did not apply to their invention. [Doc. No. 83-4 at 4-5; Doc. No. 83-5 at 4-
18 5; Doc. No. 83-12 at 4, 6.]

19 The claims of the '284 and '363 patents are for cordless telephones. In their February
20 16, 2010 application for the '285 patent, the applicants claimed the cordless telephone of
21 the invention as a "radio-frequency telephone handset." The applicants however
22 represented to the patent examiner that no new matter was introduced in this application to
23 retain the 1999 priority filing date. Having previously, repeatedly and strenuously
24 represented that these patents are not in the cellular telephone arts and that the base unit of
25 the handset is not a cellular relay tower, the Court finds that by claiming the disclosed
26

27 _____
28 ¹ Doc. No. 1-11.

1 cordless telephone of the invention as an RF telephone handset and an RF unit connected
2 to a network, the applicants cannot recapture that which they disclaimed.

3 The Court therefore construes:

- 4 **1. RF telephone handset as the remote handset of a cordless telephone using**
5 **radio-frequency technology; and**
6 **2. RF unit connected to a network as the matching base unit of a cordless**
7 **telephone using radio-frequency technology.**

8 In light of the construction limiting the RF telephone handset and base unit to a
9 cordless phone, the Court declined to reach the construction issue regarding the step of
10 “muting the digital encoded-audio bit stream music playing from the digital encoded-audio
11 bit stream player **when the RF telephone handset received a telephone call,**” as moot.

12 2. U.S. Patent No. 6,549,792²

13 The ‘792 patent is for an Accelerometer Influenced Communication Device. Filed
14 in 1999, the patent is directed at an apparatus and method for enhancing the operation of
15 wireless telephones. Claim 1 of the patent claims

16 A **cordless telephone**, comprising:
17 a handset with an accelerometer;
18 a transceiver;
19 a controller; and
20 a ring detection unit adapted to provide a ring indication to said controller;
21 wherein there is a transition of said cordless telephone between an on-hook state
22 and an off-hook state based on an output of said accelerometer showing an active
23 movement of said handset.

24 Claim 9 of the patent claims

25 A wireless handset, comprising:
26 a wireless transceiver;
27 a controller; and
28 an accelerometer,

² Doc. No. 1-10.

1 wherein the controller is adapted to receive an output from the accelerometer
2 showing an active movement of said wireless telephone and affect a state of said
3 wireless transceiver based on a change in a **motion history**.

4 Based on the plain language of the claim and the specification, the Court construed
5 **cordless telephone as a telephone comprising a remote handset and corresponding**
6 **matched base unit.**

7 Also based on the plain language of the claim and the specification, the Court
8 construed **motion history as a stored pattern of movement or lack of movement.**

9 B. Motion for Summary Judgment of Indefiniteness

10 Defendant contended that certain terms of the ‘792 patent and the ‘435 patent fail to
11 inform those skilled in the art about the scope of the invention with reasonable certainty as
12 required by 35 U.S.C. § 112, therefore rendering the claim indefinite and invalid. *Nautilus*
13 *Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014).

14 1. The ‘792 Patent

15 Defendant argued that the **ring detection unit** of claims 1 and 4 of the ‘792 patent
16 is a “means plus function” element, pursuant to § 112 ¶ 6, and no corresponding structure
17 for this unit is provide in the specification thereby rendering the claims indefinite. Plaintiff
18 argued that “ring detection” provides sufficient structural information for the unit to apprise
19 one of skill in the art that it is an integrated circuit or portion thereof in the handset and
20 such circuitry was well known in the art at the time the patent was filed. The Court was
21 not persuaded, considering the totality of the specification, that § 112 ¶ 6 applied to this
22 element. Defendant did not establish by clear and convincing evidence that these claims
23 are indefinite.

24 Defendant also argued that the term **active movement** that appears in claims 1, 9
25 and 15 of the ‘792 patent is indefinite because no one of skill in the art can ascertain from
26 the patent what level of movement meets the requirement of “active.” The Court however
27 concluded in the context of the invention a person of skill would understand **active**, not as
28 a level of movement, but a temporal qualifier, meaning **current or present movement**.

1 Defendant did not establish by clear and convincing evidence that these claims are
2 indefinite.

3 Defendant also argued that the terms **to affect the state** or **influencing a transition**,
4 found in claims 4, 9, and 14 of the '792 patent are indefinite. The Court found in the
5 context of the invention and the specification as a whole a person of skill in the art would
6 understand these terms to mean changing the state of the handset from on-hook to off-hook
7 or vice versa depending on information received from components of the handset.
8 Defendant did not establish by clear and convincing evidence that these claims are
9 indefinite.

10 2. The '435 Patent³

11 The '435 patent is for a Proximity Regulation System for use with a portable cell
12 phone and a method of operation thereof. Filed in 2001, the patent is directed at increased
13 health concerns regarding the power used to transmit the radio frequency of cell phones
14 when operated close to the body of the cell phone user. "For example, when held close to
15 the ear, many users have health concerns about the high level of radio frequency energy
16 causing damage to brain cells." [Col. 1:14-40.] The patent claims a system and method to
17 automatically reduce the transmit power level of a portable cell phone when located near a
18 human body thereby decreasing the perception of health risks associated with the use
19 thereof. [Col. 1:63-67.]

20 Claim 1 of the '435 patent claims

21 A portable cell phone, comprising:

22 a power circuit that provides a network adjusted transmit power level as a function
23 of a position to a communications tower; and

24 a proximity regulation system including:

25 a location sensing subsystem that determines a location of said portable cell phone
26 **proximate a user**; and

27 a power governing subsystem, coupled to said location sensing subsystem, that
28 determines a proximity transmit power level of said portable cell phone based on

³ Doc. No. 1-9.

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