

United States District Court,
N.D. California.

COMMAND AUDIO CORPORATION,
Plaintiff.

v.
SONY ELECTRONICS, INC.,
Defendant.

No. C 02-0599 MJJ

Aug. 5, 2003.

James B. Lewis, Rianne Elizabeth Nolan, Susan Baker Manning, Susan V. Vaughan, Bingham McCutchen LLP, San Francisco, CA, for Plaintiff.

Anthony I. Fenwick, Matthew Rawlinson, Stephen C. Willey, Latham and Watkins, Matthew B. Lehr, Davis Polk & Wardwell, Menlo Park, CA, for Defendant.

SECOND CLAIM CONSTRUCTION ORDER

MARTIN J. JENKINS, District Judge.

INTRODUCTION

On April 3, 2003, the Court issued a claim construction order with respect to eight disputed terms within (1) U.S. Patent No. 5,590,195 ("195 patent"), issued December 31, 1996 and entitled "Information Dissemination Using Various Transmission Modes"; and (2) U.S. Patent No. 6,330,334 ("334 patent"), issued December 11, 2001 and entitled "Method and Systems for Information Dissemination Using Television Signals" ("April Order"). The parties now seek construction of three additional terms.

LEGAL STANDARD

The construction of a patent claim is a matter of law for the Court. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). To determine the meaning of a patent claim, the Court considers three sources: the claims, the specification, and the prosecution history. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995) (*en banc*), *aff'd*, *Markman*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577.

First, the Court looks at the words of the claims. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). "[T]he analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to particularly point out and distinctly claim the subject matter which the patentee regards as his invention." *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1201-2 (Fed.Cir.2002) (internal quotations and citations omitted). Thus, there is a

"heavy presumption" that claim terms bear their ordinary meaning, as understood by persons skilled in the relevant art. *Id.* at 1202; *see also Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325.

Second, it is always necessary to review the specification to determine if the presumption of ordinary meaning is rebutted. *Texas Digital Systems*, 308 F.3d at 1204. The presumption is only rebutted in situations where the inventor (1) acting as his own lexicographer, clearly set forth an "explicit definition" of the term that is different from its ordinary meaning; or (2) has disavowed or disclaimed scope of coverage by using words of "manifest exclusion or restriction...." *Id.* "But if the meaning of the words themselves would not have been understood to persons of skill in the art to be limited only to the examples or embodiments described in the specification, reading the words in such a confined way would mandate the wrong result and would violate our proscription of not reading limitations from the specification into the claims." *Id; see also Teleflex*, 299 F.3d at 1326 ("limitations from the specification are not to be read into the claims ...").

Third, the court may consider the prosecution history of the patent, if in evidence. *Vitronics*, 90 F.3d at 1582. "Although the prosecution history can and should be used to understand the language used in the claims, it too cannot enlarge, diminish, or vary the limitations in the claims." *Markman*, 52 F.3d at 980 (internal quotations and citations omitted). However, a concession made or position taken to establish patentability in view of prior art on which the examiner has relied, is a substantive position on the technology for which a patent is sought, and will generally generate an estoppel. In contrast, when claim changes or arguments are made in order to more particularly point out the applicant's invention, the purpose is to impart precision, not to overcome prior art. Such prosecution is not presumed to raise an estoppel, but is reviewed on its facts, with the guidance of precedent. *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1220 (Fed.Cir.1995) (citations omitted).

Ordinarily, the Court should not rely on expert testimony to assist in claim construction, because the public is entitled to rely on the public record of the patentee's claim (as contained in the patent claim, the specification, and the prosecution history) to ascertain the scope of the claimed invention. *Vitronics*, 90 F.3d at 1583. "[W]here the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper." *Id.* Extrinsic evidence should be used only if needed to assist in determining the meaning or scope of technical terms in the claims, and may not be used to vary or contradict the terms of the claims. *Id.* (quoting *Pall Corp.*, 66 F.3d at 1216); *Markman*, 52 F.3d at 981. However, the Court is free to consult reference materials, such as dictionaries, for assistance in determining the ordinary meaning of a claim term and such sources are not considered extrinsic evidence. *Texas Digital Systems*, 308 F.3d at 1202, 1203. Further, the intrinsic record must be consulted to determine which definition is most consistent with the use of the word by the inventor. *Id.* at 1203. However, "[i]f more than one dictionary definition is consistent with the use of the word[] in the intrinsic record, the claim term[] may be construed to encompass all such consistent meanings." *Id.*

The Court also has the discretion to admit and rely upon prior art proffered by one of the parties, whether or not cited in the specification or the file history, but only when the meaning of the disputed terms cannot be ascertained from a careful reading of the public record. *Vitronics*, 138 F.3d at 1584. Referring to prior art may make it unnecessary to rely on expert testimony, because prior art may be indicative of what those skilled in the art generally believe a certain term means. *Id.* Unlike expert testimony, these sources are accessible to the public prior to litigation to aid in determining the scope of an invention. *Id.*

Finally, "[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim (except as documented in the prosecution history)." *Markman*,

50 F.3d at 985 (citation omitted). "Rather the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean." *Id.* at 986.

ANALYSIS

A. "a set of menus describing the database" FN1

FN1. This term "a set of menus describing the database" is used in claim 1 of the '195 patent. *See Declaration of Matthew Rawlinson ("Rawlinson Decl."), Exh. 4 ('195 patent).* In their papers, the parties both assert that the disputed term is "a set of menus describing the *stored* database." Motion at 4:5-7; Opposition at 2:15-26. However, the word "stored" does not appear in the disputed term.

The Court has already construed the term "database" to mean "a conventional *hierarchical database* in which data [is] organized into records, known as segments, that represent nodes in a hierarchy or tree." April Order at 9:16-17 (emphasis added). Necessary to the Court's construction of the term "database" was a finding that the "set of menus"-which describes the "data"-is also hierarchical. FN2 Thus, "describing" is the only word in the disputed term that remains unresolved.

FN2. The April Order states: "Specifically, Defendant points to the fact that the inventor sought to overcome prior art by providing 'a set of *hierarchical* menus describing the data, and for accepting selections from the menus,' Jefferson Decl., Ex. 3 at CA 00414 (quotation omitted). During the hearing on this matter, Defendant argued that the "set of menus" is directly related to the type of 'database.' The Court agrees." *Id.* at 9:1-5.

Plaintiff argues that the parties stipulated to a definition of "set of menus" that was not necessarily hierarchical—"a collection more than one menu." *See Joint Claim Construction, Exh. A at 5.* However, in light of the Court's prior construction of "database" this fact is of no moment.

Plaintiff contends that the ordinary meaning of "a set of menus describing the database" is a "'set of menus' that includes items *descriptive of portions* of the stored 'database'" Motion at 4:18-20 (emphasis added). Defendant, on the other hand, asserts that the term is properly defined as "a set of menus in which the individual menus and menu selections *correspond* with segments of the stored hierarchical database." Opposition at 2:13-15 (emphasis added).

Defendant argues that Plaintiff's definition allows too loose a relationship between the "database" and the "set of menus." Specifically, Defendant contends that, under Plaintiff's construction, the "set of menus" would not necessarily have to describe the entire "database." Opposition at 3:12-14 ("[i]n [Plaintiff's] view, if just two items in a set of menus are 'descriptive' of two pieces of data in the database, the limitation is met, no matter how many other items are included in the menus, and no matter how small a part of the database those two pieces of data constitute"). FN3 The Court agrees.

FN3. Defendant also implies that there is a substantive difference between "describing" (used in the disputed term) and "descriptive" (used in Plaintiff's proposed construction). The Court disagrees. *See Declaration of Susan Baker Manning ("Baker Decl."), Exh A (American Heritage College Dictionary (Third Edition), Houghton Mifflin Company) at 376 ("describe ... 1.[t]o give an account of in speech or writing. 2.[t]o convey and idea or impression of; characterize ..."; "descriptive ... 1. [i]nvolving or characterized by description; serving to describe.") (emphasis added).*

Because the term "describing" is not modified by any limiting language, it implies that the "set of menus" must collectively describe the entire database. Although Plaintiff's proposed construction can be read in a manner consistent with this requirement (*i.e.*, each "portion of the stored database" is described by an "item" from the "set of menus"), it is not limited to such a reading. However, Defendant's proposed construction is also problematic in that the word "correspond" (used in Defendant's proposed construction) is not synonymous with "describing." FN4 Therefore, the Court must fashion its own construction.

FN4. Although menu items must necessarily correspond with portions of the database, the term is not limited to the "one-to-one" relationship suggested by Defendant's proposed construction.

Because the word "describing" is not a term of art, the Court may look to standard English dictionaries for the word's ordinary meaning. Texas Digital Systems, 308 F.3d at 1202-3. The *American Heritage College Dictionary* defines "describe," in the relevant context, as (1) "[t]o give an account of in speech or writing;" or (2) "[t]o convey an idea or impression of; characterize." Baker Decl., Exh. A. Similarly, the *Oxford English Dictionary Online* (Oxford University Press, 2003) defines "describe" in the following manner: "[t]o set forth in words, written or spoken, by reference to qualities, recognizable features, or characteristic marks; to give a detailed or graphic account of." Rawlinson Decl., Exh. 15.

Because nothing in the specification or prosecution history manifestly excludes, or even puts into question, the ordinary meaning of the word "describe," the Court construes "a set of menus describing the database" to mean the following: "a set of menus that, when taken as a whole (*i.e.*, collectively), give an account, or convey an idea or impression, of the entire database."

B. "a Separate Audio Programming channel of the television carrier"; "an SAP associated with television signals" FN5

FN5. The term "a Separate Audio Programming channel of the television carrier" is used in claim 5 of the '195 patent, and the term "an SAP associated with television signals" is used in claim 30 of the '334 patent. *See* Rawlinson Decl., Exhs. 4 ('195 patent), 6 ('334 patent).

The parties dispute with respect to these two terms is limited to the scope of the term "Separate Audio Programming channel" (hereinafter, "SAP channel" or "SAP subchannel"). FN6 Plaintiff contends that "persons of ordinary skill in the art understand and use 'SAP channel' to [include] any channel that carries [separate audio programming]." Reply at 12:9-13. Defendant, however, contends that the term is more limited:

FN6. Although the term "an SAP associated with television signals" does not include the word "channel" following "SAP," there is no question that claim 30 of the '334 patent is referring an "SAP channel" and not separate audio programming generally. *See* '334 patent, Claim 30 ("wherein the audio is carried in an SAP associated with television signals received at the tuner")

Separate Audio Programming channel (also known as the 'Second Audio Program' or 'SAP' subchannel) is the channel containing the frequency-modulated second audio program subcarrier. The second audio

program subcarrier is the particular subcarrier of the *standard terrestrial analog television signal* designated by the BTSC (Broadcast Television System Committee of the Electronics Industries Association) to carry the second audio program, if any.

Opposition at 7:5-10 (emphasis added).

In support of its definition, Defendant relies primarily on the Office of Engineering and Technology's ("OET") Bulletin No. 60, Revision A (February 1986), entitled *Multichannel Television Sound Transmission and Audio Processing Requirements for the BTSC System* (hereinafter, "the Bulletin"). See Rawlinson Decl., Exh. 8. The Bulletin contains the "standards for the BTSC system," including (1) definitions, (2) transmission standards, (3) transmission system requirements/multichannel sound requirements, and (4) modulation levels. *Id.* at A434-47.

The Bulletin defines a "multiplex transmission" as "[t]he simultaneous transmission of the TV program main channel audio signal and one or more subchannel signals." *Id.* at A435. One of the four subchannels discussed in the Bulletin is the "SAP subchannel," FN7 which is defined as "[t]he channel containing the frequency-modulated second audio program subcarrier." *Id.* at A436. Therefore, according to the Bulletin, an "SAP broadcast" is "[t]he multiplex transmission of a second audio program utilizing the second audio program subchannel." *Id.* at A435. The Bulletin also indicates that the "SAP subchannel" exists at a specific location on the terrestrial analog broadcast signal. *Id.* at A437 ("[t]he subcarrier frequency shall nominally be equal to the fifth harmonic of the horizontal line rate"; "the second program encoded signal shall frequency modulate the subcarrier to a peak derivation of (plus-or-minus sign) 10kHz")

FN7. The additional subchannels are the (1) stereophonic subchannel, (2) non-program related subchannel; and (3) pilot subcarrier. Rawlinson Decl., Exh. 8 at A435.

Analog cable broadcasts are no different (*i.e.*, the "SAP channel" is similarly situated in both terrestrial and analog cable transmissions). See Rawlinson Decl., Exh. 9 (Walter Ciciora, et al., *Modern Cable Television Technology*, Morgan Kaufman Publishers, Inc., 1999) at A452 ("[a] limited bandwidth (10 kHz) monaural second audio program (SAP) channel is frequency modulated onto a carrier at five times the horizontal scan frequency"). The only distinction is the mode of transmission (*i.e.*, a cable signal is transmitted over wires as opposed to terrestrially). Thus, the Bulletin's limitation to terrestrial signals is of no moment.FN8

FN8. This is also consistent with the Court's prior ruling that the terms "data from a television carrier" and "television signals" were not limited to terrestrial audio signals. See April Order 4:9:21-10:10.

The more difficult question is whether the term "SAP channel" is broad enough to include digital broadcast transmissions. In order to resolve this question, the Court must first explain how a digital broadcast system works in context (*e.g.*, digital satellite television). First, the analog programming, including the information inserted into the "SAP channel," is "converted into a high-quality, uncompressed digital stream" at a central location or broadcast center. Baker Decl., Exh. G (Karim Nice & Tom Harris, *How Satellite TV Works* (online)) at 3. After the digitalized programming is compressed and encrypted, the broadcast center transmits the signal directly to a satellite; the satellite, in turn, retransmits the signal to individual satellite dishes. *Id.* at 4. The end component is the receiver, which de-scrambles the encrypted digital signal and "converts it into an analog format that a standard television can recognize." *Id.* at 6.

Although the programming, including information inserted into the "SAP channel," still exists while in

digital form, it is no longer cognizable in the same way. In other words, the broadcast signal described in the Bulletin does not exist in the digital medium. *Id.* at 4 (describing the digital data in terms of megabits per seconds (Mbps)). However, it is evident that, even in the context of a digital broadcast system, the programming both begins and ends in analog format. Thus, the dispute here revolves around the interim period during which the programming is digitized.

Unfortunately, the parties provide little information regarding the implication of digitalization on the definition of "SAP channel ." Although the technical sources submitted by Defendant (the Bulletin and pages from *Modern Cable Television Technology*) provide a clear explanation of analog broadcast signals (including the contours of the term "SAP channel"), they are silent with respect to digitalization of an analog signal.

Plaintiff's expert, Charles Jablonski, is equally uninformative. First, Mr. Jablonski asserts that "the only difference between the SAP channel of an analog television carrier and the SAP channel in a digital broadcast is that in the latter signal the SAP channel has been digitalized." Declaration of Charles H. Jablonski ("Jablonski Decl.") para. 5. This statement, of course, belies the fact that the "SAP channel," which exists as part of an analog signal, does not exist in the same way in the digital medium, although the content remains.

Moreover, Mr. Jablonski concludes that "[b]ecause users can listen to Second Audio Programming channels either when they are broadcast as BTSC standard subchannels or when they are digitized for satellite or digital cable broadcast, persons of ordinary skill in the art understand and use 'SAP channel' to mean both the standard subchannel (i.e., spectrum allocation) and any channel that carries SAP." *Id.* para. 6. However, it is clear from the intrinsic record that the term "SAP channel," as used in the '195 and '334 patent, is not broad enough to include *any* channel that carries separate audio programming. The claims themselves distinguish the "SAP channel" from other locations that might carry the prescribed "data" or "audio." See Rawlinson Deck, Exh. 4 ('195 patent), Claim 4 ("wherein the tuner extracts data from a *vertical blanking interval of the television carrier*"); Exh. 6 ('334 patent), Claim 35 ("wherein the audio is carried in an *FM subcarrier associated with television signals*") (emphasis added). This distinction would be rendered meaningless if these additional locations were also defined as "SAP channels" whenever they carried separate audio programming. See CAE Screenplates Inc. v. Heinrich Fielder GmbH & Company KG, 224 F.3d 1308, 1317 (Fed.Cir.2000) ("[i]n the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings")

However, the disputed claims themselves provide the Court with some guidance on this issue. First, claim 5 of the '195 patent, as a dependant of claim 1, describes a "receiver" which is comprised, in part, of a "tuner [which] extracts data from a Separate Audio Programing channel." See Rawlinson Decl., Exh. 4. Moreover, claim 30 of the '334 patent describes a "receiver" that is comprised, in part, of "a controller coupled to the television tuner and which provides audio from a signal received at the television tuner, wherein the audio is carried in an SAP associated with televison signals received at the tuner." Thus, the only requirement with respect to the two disputed terms respectively is that the "tuner" "extract[]" or "receive []" "data" or "audio" from the "SAP channel." In other words, the events that transpire prior in time to extraction or receipt by the "tuner," including prior digitalization, are not the subject of these terms.

Therefore, the Court defines "SAP channel" as "the part of the analog signal specifically designed to carry second audio programming," but notes that this definition must be applied in light of the preceding discussion.FN9

FN9. The Court also notes that the '195 and '334 patents contain broader, independent claims which respectively refer to a "tuner" that "extract[s]" or "receive[s]" "data" or "audio" from a transmitted signal, with no reference to the "SAP channel" or any other part of an analog signal. *See* Rawlinson Decl., Exh. 4 ('195 patent), Claim 1 ("a tuner for extracting data in a *transmitted signal*"); Exh. 6 ('334 patent), Claim 40 ("a controller coupled to the television tuner and which provides *audio from a signal at the television tuner*") (emphasis added).

CONCLUSION

Based on the analysis above, the Court adopts the foregoing constructions of the disputed claim terms.

IT IS SO ORDERED.

N.D.Cal.,2003.

Command Audio Corp. v. Sony Electronics, Inc.

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