United States District Court,
S.D. New York.

AT & T CORP,
Plaintiff.
v.
MICROSOFT CORPORATION,
Defendant.

No. 01 Civ.4872 WHP

Feb. 19, 2004.

Background: In an action for infringement of a reissue patent for a digital speech codec, the District Court, 2003 WL 21459573 (S.D.N.Y.), construed claims of the patent.

Holding: On patent owner's application for reconsideration, the District Court, Pauley, J., held that the term "excitation," when used as a noun, meant an input signal of a system or apparatus that did not require use of voiced/unvoiced coded signals and a noise generator, and when used as an adjective meant relating to an input signal of a system or apparatus that did not require use of voiced/unvoiced coded signals and a noise generator.
Application granted.

32,580. Construed.

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MEMORANDUM AND ORDER

PAULEY**, J.**

Plaintiff AT & T Corp. ("AT & T") brings this patent infringement action against Microsoft Corporation ("Microsoft"), alleging that certain of Microsoft's products containing speech codecs FN1 infringe its United States Patent No. Reissue 32,580 (the "580 patent"). The 580 patent at issue in this litigation is a reissue of U.S. patent 4,472,832 (the "832 patent"), issued with 39 claims. The 580 patent added claims 40-43, without amending the first 39 claims. Microsoft denies infringement of the 580 patent and seeks dismissal of the complaint together with a declaratory judgment of noninfringment, invalidity and unenforceability of the 580 patent. *See* AT & T Corp. v. Microsoft Corp., 01 Civ. 4872(WHP), 2003 WL 21459573 (S.D.N.Y. June 24, 2003). Familiarity with this Court's prior Memoranda and Orders is presumed.FN2

FN1. "A speech codec is a software program that is capable of coding-converting a speech signal into a more compact code-and decoding-converting the more compact code back into a signal that sounds like the original speech signal." Amended Complaint ("Am.Compl.") para. 14.

FN2. *See, e.g.,* AT & T Corp. v. Microsoft Corp., 01 Civ. 4872(WHP), 2003 WL 21459573 (S.D.N.Y. June 24, 2003) (construing claims in the 580 patent); *AT & T Corp. v. Microsoft Corp.,* 01 Civ. 4872(WHP) (S.D.N.Y. Sept. 3, 2003) (amending construction of the term "representative"); *AT* & T Corp. v. Microsoft Corp., 290 F.Supp.2d 409 (S.D.N.Y.2003) (granting partial summary judgment limiting damages pursuant to the patent marking statute, 35 U.S.C. s. 287(a)); AT & T Corp. v. Microsoft Corp., 01 Civ. 4872(WHP), 2004 WL 188078 (S.D.N.Y. Feb. 2, 2004) (granting partial summary judgment prohibiting Microsoft from asserting the defenses of equitable estoppel and implied license); AT & T Corp. v. Microsoft Corp., 01 Civ. 4872(WHP), 2004 WL 232725 (S.D.N.Y. Feb. 9, 2004) (granting partial summary judgment prohibiting Microsoft from asserting the defense and counterclaim of inequitable conduct); *AT & T Corp. v. Microsoft Corp.,* 01 Civ. 4872(WHP) (S.D.N.Y. Feb. 17, 2004) (denying partial summary judgment on invalidity).

On June 24, 2003, this Court issued a Memorandum and Order on claim construction that, *inter alia,* construed the term "excitation" in the 580 patent to mean "an input signal of a system or apparatus without additional values," as a noun, and "relating to an input signal of a system or an apparatus without additional values" when used as an adjective. *AT & T Corp. v. Microsoft Corp.,* 01 Civ. 4872(WHP), 2003 WL 2145973, at *14-16 (S .D.N.Y. June 24, 2003). AT & T asks this Court to reconsider its construction of the claim term "excitation," on the ground that "the Court added a negative limitation ('without additional values') not supported by the prosecution history." (AT & T Opposition to Microsoft's Motion for Summary Judgment of Noninfringement ("AT & T Opp.") at 20.) FN3 For the reasons set forth below, AT & T's application for reconsideration is granted.FN4

FN3. During an August 29, 2003 pre-motion conference, AT & T requested that this Court reconsider its construction of the term "excitation ." At the parties' request, this Court allowed the parties to address AT & T's application for reconsideration in their summary judgment briefing. Accordingly, the parties addressed construction of the term "excitation" in their memoranda on Microsoft's Motion for Summary Judgment of Noninfringement.

FN4. This Memorandum and Order memorializes a ruling made during a conference call with the parties on

February 17, 2004.

"[T]o be entitled to reconsideration, the movant must demonstrate that the Court overlooked controlling decisions or factual matters that were put before it on the underlying motion, which, had they been considered 'might reasonably have altered the result reached by the court." ' Chere Amie, Inc. v. Windstar Apparel, Corp., 01 Civ. 0040(WHP), 2002 WL 31108187, at (S.D.N .Y. Sept. 23, 2002) (quoting Consol. Gold Fields v. Anglo Am. Corp., 713 F.Supp. 1457, 1476 (S.D.N.Y.1989)); *accord* Local Civil Rule 6.3. Reconsideration is within the sound discretion of the district court. Dietrich v. Bauer, 76 F.Supp.2d 312, 327 (S.D.N.Y.1999). Because it appears that this Court "overlooked certain technical distinctions made in the prosecution history statements" during claim construction, reconsideration is appropriate here. (AT & T Opp. at 20.)

The facts underlying this Court's construction of the term "excitation" were set forth in detail in this Court's Memoranda and Order, dated June 24, 2003. AT & T, 2003 WL 21459573, at *14-15. AT & T contends that this Court's addition of the phrase "without additional values" in its construction is not supported by the prosecution history of the 580 patent. AT & T proposes that this Court construe "excitation" to mean "an input signal of a system or apparatus *that does not require use of voiced/unvoiced coded signals and a noise generator,*" because nothing in the prosecution history prohibits the use of all "additional values." (AT & T Opp. at 23 (emphasis added); Transcript of Oral Argument, dated Dec. 22, 2003 ("Tr.") at 4.) Microsoft urges this Court to maintain its current construction of "excitation", and include the phrase "without additional values." This Court agrees with AT & T that the inclusion of the phrase "without additional values" renders its construction of the term "excitation" overbroad.

During prosecution, the patentees attempted to distinguish their invention from U.S. Patent No. 3,324,302 (the "Atal '302"):

Atal '302 ... discloses a linear prediction speech analysis and synthesis arrangement in which predictive parameters [1] for a speech pattern interval are generated. Pitch period signals [2] representative of the location of glottal pulses in the applied speech pattern are independently generated. Signals corresponding to voiced and unvoiced amplitudes [3] are produced responsive to the pitch period and prediction parameter signals. Voiced/unvoiced signals are required to define the type of excitation to be applied to the decoding filter and a noise generator is needed to substitute for unvoiced excitation. All these signals are coded and utilized to construct a replica of the speech pattern [5]. The excitation signal of the instant application is *completely distinguished* from the multitude of signals required in Atal 302 to perform the same function and advantageously provides improved operation in which *voiced, unvoiced and partially voiced intervals may be accurately constructed using a single excitation signal*.

(MS Ex. 2: Pros. Hist. 110-11 (emphasis added).) As this Court noted in its June 24, 2003 Memorandum and Order, the patentees used both equivocal and unequivocal language in differentiating their invention from the prior art. AT & T, 2003 WL 21459573, at *14-15. This Court found that viewing the prosecution history as a whole, however, the patentees disavowed the use of all multiple signals. AT & T, 2003 WL 21459573, at *14-15. In making that finding, this Court also looked to other sections of the prosecution history:

[T]he voiced/unvoiced coded signal and noise generator are eliminated and more exact replicas can be synthesized at bit rates lower than required for residual signal encoding.

(MS Ex. 2: Pros. Hist. at 112.)

The decoding receiver of Atal '302 requires a noise generator, and a switching arrangement responsive to a voiced/unvoiced decision signal to provide the pitch pulse excitation signal for voiced periods and a noise excitation signal for unvoiced periods. *The instant invention advantageously eliminates voiced/unvoiced coding, noise generation* for unvoiced intervals and switching between such intervals and provides better quality speech reconstruction at selectable bit rates and *is completely distinguished from Atal '302*.

(MS Ex. 2: Pros. Hist. at 112-13.) *See* AT & T, 2003 WL 21459573, at *15. Upon reconsideration, however, the cited portions of the prosecution history support a more limited disclaimer of scope.

A court must consider the prosecution history of the patent "to determine whether the applicant clearly and unambiguously 'disclaimed or disavowed [any interpretation] during prosecution in order to obtain a claim allowance." ' Middleton, Inc. v. Minnesota Mining & Mfg. Co., 311 F.3d 1384, 1388 (Fed.Cir.2002) (quoting Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 452 (Fed.Cir.1985)) (alteration in original). Disclaimer during prosecution of the patent may include instances where "the patentee distinguished [a] term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention." *CCS Fitness,* 288 F.3d at 1366-67. Prosecution disclaimer must be narrowly tailored, however, to exclude only claim scope that has been "clearly and unmistakably" disclaimed. Omega Eng'g, Inc. v. Rayteck Corp., 334 F.3d 1314, 1324-26 (Fed.Cir.2003) ("[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable."); *accord* Sunrace Roots Enter. Co. v. SRAM Corp., 336 F.3d 1298, 1306-07 (Fed.Cir.2003). "[W]here 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 surrender*." Omega Eng'g, 334 F.3d at 1324-26 (Fed.Cir.2003) (finding that the prosecution history indicated a "clear and unmistakable," narrow disclaimer of claim scope); *accord* Anchor Wall Sys., Inc. v. Rockwood Retaining Walls, Inc., 340 F.3d 1298, 1310-11 (Fed.Cir.2003).

This Court's earlier construction of the term "excitation" is overbroad, and must be limited to encompass only the extent to which the patentees clearly and unmistakably disavowed a particular claim scope. Omega Eng'g, 334 F.3d at 1324-26. The prosecution history teaches that AT & T only unequivocally disavowed a definition of "excitation" requiring the use of the particular combination of signals essential to practice the Atal 302 patent, which includes use of voiced/unvoiced signals and a noise generator. Indeed, the patentees averred that their invention was "completely distinguished" from the Atal 302 patent's combination of signals. (MS Ex. 2: Pros. Hist. at 110-11.) However, in reference to the 580 patent's use of single or multiple signals, the patentees stated more generally that the "voiced, unvoiced and partially voiced intervals *may* be constructed using a single excitation signal." (MS Ex. 2: Pros. Hist. at 110-11.) The patentees did not indicate that voiced, unvoiced and partially voiced intervals *must* be constructed using a single excitation signal. The patentees' use of equivocal language in the prosecution history to explain the 580 patent's use of single and/or multiple signals is not the type of clear and unmistakable disavowal essential to limit the use of *all* types of additional values from the claim scope. Omega Eng'g, 334 F.3d at 1324-26 (noting that "the doctrine of prosecution disclaimer" does not apply "where the alleged disavowal of claim scope is ambiguous"); Anchor Wall, 340 F.3d at 1310-11 (same). The prosecution history undeniably supports the contention that the patentees never unequivocally disclaimed use of all "additional values" in the prosecution history. (MS Ex. 2: Pros. Hist. 110-13.) Indeed, during prosecution of the 580 patent, the

patentees only clearly disavowed use of voiced/unvoiced coded signals and a noise generator, which are essential to practice the Atal '302 patent. (MS Ex. 2: Pros. Hist. at 110-13.) Because the prosecution history supports a limited disclaimer of claim scope, construction of the term "excitation" may only be limited to provide that the 580 patent does not require voiced/unvoiced coded signals and a noise generator. (MS Ex. 2: Pros Hist. 110-13.) Omega Eng'g, 334 F.3d at 1324-26.

CONCLUSION

AT & T's application for reconsideration of this Court's construction of the term "excitation" in the 580 patent is granted. Upon reconsideration, this Court reconstrues the term "excitation" when used as a noun to mean "an input signal of a system or apparatus that does not require use of voiced/unvoiced coded signals and a noise generator," and when used as an adjective to mean "relating to an input signal of a system or apparatus that does not require use of voiced/unvoiced coded signals and a noise generator."

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