United States District Court,
S.D. Ohio, Western Division.

Jack BEERY,
Plaintiff.
v.
THOMSON CONSUMER ELECTRONICS, INC,
Defendant.
THOMSON LICENSING SA,
Plaintiff.
v.
Jack BEERY,
Defendant.

No. 3:00CV327, 3:02CV311

Aug. 18, 2004.

Joseph N. Hosteny, Arthur A. Gasey, William W. Flachsbart, Niro, Scavone, Haller & Niro, Chicago, Illinois, for the plaintiff.

Arland Stein, Deborah Pollack-Milgate, Barnes & Thomburg, Indianapolis, IN, and Richard A. Huser, Associate General Counsel, Thomson, Inc., Indianapolis, IN, for the defendant.

REPORT AND RECOMMENDATIONS FN1

FN1. Attached hereto is a NOTICE to the parties regarding objections to this Report and Recommendations.

OVINGTON**, Magistrate J.**

I. INTRODUCTION AND PROCEDURAL BACKGROUND

In 1991, the United States Patent and Trademark Office ("the PTO") granted to Jack Beery as inventor a patent for an Apparatus for Controlling a Television Receiver, United States Patent Number 5,068,734 ("the '734 patent"). This "invention permits television viewers to tune in a television program using a user-created label in place of the television channel number." *Beery v. Gemstar Development Corp.,* 1995 U.S.App. LEXIS 33147 at (Fed.Cir., Nov. 9, 1995).

In 1998, the United States PTO granted to Beery as inventor a reissued patent for a Television Receiver Having Memory Control For Tune-By-Label Function, United States Patent Reissue Number 35,952 ("the '952 patent"). The main, but not only, feature of this invention is that it allows television viewers to assign their own name, acronym, or number to television channels. This makes it easier for television viewers to

select their favorite television channels or programs making television viewing more enjoyable, at least in theory.

Presently pending are two consolidated patent cases concerning Beery's tune-by-label inventions. In the first case, Beery maintains that Defendant Thomson Consumer Electronics, Inc. ("Thomson") infringed the '952 patent through the unauthorized manufacture, use, sale, and offer for sale of television, videocassette recorder, and digital satellite systems. (3:00cv00327; FN2 Doc. # 1 at 2). Thomson denies that it infringed the '952 patent and asserts, through a counterclaim, that the '952 patent is invalid. (Doc. # 7 at 2-6).

FN2. The parties have filed the motions presently at issue in both the infringement and interference cases. For simplicity sake, unless otherwise indicated, docket numbers cited throughout this Report will refer to the documents in the infringement case, 3:00cv00327.

The second presently pending case is a patent interference case, in which Thomson Licensing SA alleges the existence of a dispute between it and Beery over the priority of their respective patents. Thomson Licensing is the owner of a patent by David J. Duffield, namely a Tuner Control Apparatus Having Tune-By-Label Capability And Using Alphabetical Label Storage, United States Patent Number 4,914,517 ("the Duffield patent"). Thomson Licensing claims that the Duffield patent has priority over the '952 patent, and that as a result, the '952 patent is invalid through its interference with the Duffield patent. Beery also contends, through a counterclaim, that the Duffield patent lacks identity of claims with Beery's '952 and '734 patents.

On March 7, 2003, the Court consolidated these two cases for purposes of discovery and claim construction. These cases are presently pending on a multitude of Briefs, Memoranda, Exhibits concerning claim construction issues as well as on the record of a *Markman* hearing, during which the parties presented evidence and oral argument.

These consolidated cases are also before the Court upon the following Motions and the record as a whole:

-> Beery's Motion to Exclude Extrinsic and Unreliable Evidence (3:00cv327, Doc. # 282; 3:02cv00311, Doc. # 123);

-> Thomson's Motion to Exclude Deposition Testimony (3:00cv327, Doc. # 286; 3:02cv00311, Doc. # 127);

-> Beery's Motion for Leave to File and Cite Additional Case (3:00cv327, Doc. # 307; 3:02cv00311, Doc. # 148);

-> Thomson's Motion for Leave to File Response to Beery's Reply in Support of His Motion to Cite an Additional Case (3:00cv327, Doc. # 312; 3:02cv00311, Doc. # 154);

-> Beery's Motion for Leave to File Corrected Reply (3:00cv00327, Doc. # 314; 3:02cv00311, Doc. # 156); and

-> Beery's Motion for Leave to file Supplemental Briefing on Claim Construction (3:00cv00327, Doc. # 315; 3:02cv00311, Doc. # 157).

II. THE '952 PATENT

A. *Beery's Various Patents*

To understand the parties' contentions regarding claim language construction, it is essential to understand the two lines of patents Beery applied for and obtained with regard to the tune-by-label function. One line resulted in the '734 patent; the other line led to the '952 patent, which, according to Berry, Thomson has infringed. These two lines of patents came into being as follows.

Both lines of patents began with a single patent application Beery filed in 1989. During the prosecution of this application, Beery filed a continuation-in-part application generally seeking a patent covering subject matter not covered by his original application.FN3 Beery explains that his continuation-in-part application led to the issuance, in September 1991, of a patent for a Television Receiver Having Memory Control For Tune-By-Label Feature, United States Patent Number 5,045,947)("the "7 patent").

FN3. "A continuation application is one that is filed during the pendency of an application previously filed by the same inventor, called the original or 'parent' application, and which discloses and claims only subject matter disclosed and claimed in the original or parent application. A continuation-in-part application, on the other hand, is an application that is filed during the pendency of the original or parent application of the same inventor, disclosing and claiming some subject matter common to the parent application, as well as some subject matter not common to and not supported by the parent." Reynolds Metals Company v. Continental Group, Inc., 525 F.Supp. 950, 970 (N.D.Ill.1981); *see* Am.Jur.2d Patents s. 325 (2004).

Soon thereafter, the other patent line came into being. In November 1991, the PTO granted Beery's original application and issued the '734 patent for an Apparatus for Controlling a Television Receiver. Approximately two years later, the '734 patent became the subject of the so-called Gemstar litigation. During the Gemstar litigation, Beery unsuccessfully attempted to establish that Defendant Gemstar Development Corporation infringed the '734 patent. Beery explains that because of the claim language construction set by the District Court and Federal Circuit during the Gemstar litigation, he needed to obtain a reissue patent to broaden what he had attempted to describe in the '734 patent. He consequently applied in the PTO for a reissue of the "7 patent.

Approximately five years later, the PTO granted Beery's reissue application and issued the presently disputed '952 patent for a Television Receiver Having Memory Control For Tune-By-Label Function.

B. *The '952 Patent Generally*

The '952 patent consists of fifty-three claims describing a tune-by-label function for controlling a television receiver. The inventions described in the '952 patent generally seek to make it easier for television viewers to select a desired channel or program despite the potentially confusing amount and uses of television channel numbers in the present age of traditional television, cable television, and satellite television. At its simplest, the tune-by-label function is understood as an invention that allows a television viewer to program a remote control with his or her own labels in place of channel numbers. Beery stresses, however, that the invention is much more than a labeling system.

Claim 1 of the '952 patent is representative of structure or apparatus inventions incorporating the tune-by-label function. Claim 1 describes "a television control system apparatus for selecting a television channel

corresponding to a preassigned channel tuning designation...." (Doc. # 1, Exhibit A at column 14).

The '952 patent also describes various methods by which the tune-by-label function operates. Claim 10, for example, describes, "A system for controlling a television receiver capable of tuning from a multi-channel input a television channel corresponding to a preassigned channel tuning designation upon receipt of a channel tuning control signal...." Id. at col. 17.

The preferred embodiment of the '952 patent describes and depicts, in part, a television remote control that incorporates the tune-by-label function. Id. at Figure 1 and cols. 6-7. The preferred embodiment also describes alternative methods by which the tune-by-label function operates. Id. at cols. 4-13.

C. *The '952 Patent's Discussion of its Background*

A review of the '952 patent's discussion of its background is helpful to gaining an understanding of the numerous claims described in this patent.

Historically, television channels were identified by channel numbers. These numbers matched a particular channel frequency with a specific number on the controls of a television receiver. Channel "7," for example, could be matched with the frequency broadcasting the signal from an NBC television station. This matching system worked well during the infancy of television because of the relatively few number of television stations and because governmental control agencies originally assigned channel codes to minimize interference among the limited number of channels in use. Government agencies accomplished this by establishing adequate geographic separation between television stations using identical channel numbers. A simplistic example could involve NBC broadcasting on channel 7 in the New York City region and ABC broadcasting on channel 7 in the Los Angeles area.FN4

FN4. This and the following examples do not appear in the specification and are not intended to reflect current channel designations but are offered here for the sole purpose of simplifying the '952 patent's background.

Today, with the advent of cable and satellite television, geographic separation of different television stations using the same channel number may no longer be possible. Stations that once broadcasted only locally are now able to broadcast nationally. Again, simplistically speaking, NBC broadcasting on channel 7 in the New York City region may now be able, through the use of cable or satellite television services, to nationally broadcast its New York City channel 7 programming thereby creating a conflict over the use of channel 7 by ABC in the Los Angeles area. Thus, a viewer from New York City who is visiting Los Angeles may tune to channel 7 seeking to watch NBC programming and be confused to find ABC programming.

In addition, cable television service providers offer its channels on frequencies different from tradition over-the-air television broadcasting. Cable service providers assign stations to channels available within their particular cable frequency bands. Cable service providers seek to minimize confusion by assigning over-the-air stations to the same channel number as the station's non-cable designation. A cable provider in the New York City region may, for example, assign its channel "7" to broadcast programming from the local NBC affiliate also broadcasting channel 7. Cable service providers then provide different, non-conflicting channel numbers to broadcasts from different geographic regions.

In addition, some cable channels, such as ESPN or HBO, are not available in any location over traditional VHF television and are not affiliated with any specific channel number. Cable providers therefore may not assign a specific channel number to these channels. HBO, for example, may be channel 45 in New York City, channel 65 in Chicago, or channel 72 in Los Angeles.

A problem-one in which the tune-by-label function seeks to solve-arises when a cable provider assigns its various channels to numbers with which viewers may not be familiar. Cable service providers attempt to remedy this problem by providing a conversion chart, which typically lists its channels by numbers and describes the corresponding television station. The '952 patent describes the resulting problem as follows: "This can be awkward and inconvenient for the viewer, particularly in metropolitan areas having more than one cable service provider, or for travelers and others who may not be familiar with the local system." (Doc. # 1, Exh. A at column 2). A similar problem exists for viewers who receive television programs with a satellite receiver.

To make television viewing less awkward and more convenient, the tune-by-label function allows viewers to assign their own channel codes, which could be any name, acronym, or number up to six characters long. A viewer using the tune-by-label function in this manner can display a particular channel by simply typing the name, acronym, or number of the channel code on the television remote control keypad, and the channel code is displayed on the remote control's display panel. (Doc. # 1, Exh. A at FIG. 3).

The tune-by-label function was developed to make changing television channels more convenient for viewers, especially viewers with cable and satellite services. A television remote control that includes the tune-by-label function is used like a conventional television remote control. It can also be used universally, meaning that it can be used with any television system, including cable and satellite systems.

The above discussion does not include every feature of the tune-by-label function. Indeed, Beery emphasizes, "The '952 [patent] is much more than a simple labeling, which is what much of the prior art is about." (Doc. # 192 at 1). One such feature is, as described in the specification, "the ability to designate particular channels such that they may only be selected by entry of a password. Any selectable channel may be made such a restricted channel, thereby enabling, for example, a parent to restrict access to certain channels by children." (Doc. # 1, Exh. A at col. 8).

Another feature described in the specification is the "scroll" feature, which provides a user with the ability to place certain channels into a "scroll." This gives the user the ability to scroll through frequently watched channels by pressing a single key. *See* id. at col. 8.

III. THE GEMSTAR LITIGATION

In 1993, Beery filed a patent infringement case alleging, in part, that Defendant Gemstar Development Corporation's VCR Plus+(R) Controller infringed the '734 patent. Beery, however, was unsuccessful in establishing that Gemstar's VCR Plus+(R) Controller infringed the '734 patent.

Beery argued during the Gemstar litigation-as he does in the instant case-that the term "operator" in the '734 patent referred to anyone or anything that chooses a channel select designation. (Doc. # 192, Exh. B at 14). To show infringement Beery needed the term "operator" to refer "to anyone or anything" who chooses a channel select designation because Gemstar's VCR Plus +(R) Controller did not allow the person using it to choose his or her own television channel label; instead, Gemstar preassigned its own "VCR Plus +(R)-

assigned guide channel numbers ..." Id. at 15. Thus, Beery based his infringement theory on the contention that the '734 patent describes a television system controlled by an operator like Gemstar, who chooses a channel select designation, as in the VCR Plus +(R)-assigned guide channel numbers. Both the District Court and the Federal Circuit Court of Appeals disagreed.

The District Court reasoned as follows:

Upon a thorough review of the entire '734 patent, the Court disagrees with Beery's view that an 'operator' includes anyone or anything that chooses a channel designation. Under Beery's definition, calling Gemstar the 'operator' is tantamount to calling General Electric the operator of the Court's coffee machine. The '734 Patent's use of the term 'operator' cannot be so broadly construed. Similarly, calling the viewer the 'operator' under Beery's definition because that viewer chooses to use the Gemstar guide channel number designations as opposed to some other designation completely misses the point. The user of a VCR Plus+(R) system would not buy a VCR Plus+(R) device if that user did not intend to use the VCR Plus+(R) channel guide numbers in conjunction with the PlusCode(TM) to program that VCR. Beery's argument that a VCR Plus+(R) user could program in the 'Valley Codes' devised by Beery ... makes no sense because the user would then be unable to use the PlusCode(TM) designations for setting the VCR to tape a program. The purpose of the VCR Plus+(R) device is to make programming a VCR easier. The Court finds that the term 'operator' as that term is used throughout the '734 Patent does not have such a broad reach.

(Doc. # 192, Exh. B at 14-15).

The Federal Circuit affirmed by finding as follows:

The District Court ... did not improperly narrow the claims by construing them to require that the person using the claimed device must be the same person who selected the channel designation. Nothing in the District Court's construction of the claims suggests that the same person has to perform both tasks. What the claim language requires is that an operator of the device select a channel designation of his choice....

The VCR Plus+(R) controller does not infringe the '734 patent claims as construed. It is undisputed that the VCR Plus+(R) controller will work only when preassigned channel designations ... are used.... Although Beery urges that the accused device can be programmed using other preassigned designations that might be published in program listings, that does not change the fact that the accused device cannot store and process whatever labels an operator might desire; the use of labels other than the designated ones would not enable the device to tune in the desired television channels, as required by the '734 patent. The inability of the accused device to function with labels of the operator's choice thus precludes a finding of literal infringement.

For the same reasons, the VCR Plus+(R) controller does not infringe the '734 patent under the doctrine of equivalents. The VCR Plus+(R) controller does not perform the function of Beery's invention-to allow the operator to select channel designations of his choice.

Beery v. Gemstar Development Corp., 1995 U.S.App. LEXIS 33147 at *7-*9.

IV. BEERY'S INFRINGEMENT ASSERTIONS

Thomson describes Beery's infringement assertions as follows:

Mr. Beery has accused three of Thomson's product lines of infringing his '952 patent: VCR recorders with VCR Plus feature, television sets with Guide Plus feature, and digital satellite receivers with the favorite channel feature. Mr. Beery asserts that the VCR Plus recorders infringe seventeen claims, the Guide Plus televisions infringe twenty-three claims, and the digital satellite receivers infringe eight claims of the '952 patent.

(Doc. # 193 at 5)(footnotes omitted).

V. CLAIM CONSTRUCTION PRINCIPLES AND ANALYSIS

A. *Intrinsic Evidence*

"It is well settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, *i.e.,* the patent itself, including the claims, the specification, and if in evidence, the prosecution history.... Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). "In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence [such as expert opinions]." Id. at 1583.

"Even with the intrinsic evidence, however, there is a hierarchy of analytical tools." Digital Biometrics v. Identix, Inc., 149 F.3d 1335, 1344 (Fed.Cir.1998). "[A] construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves, but consults these sources to give the necessary context to the claim language." Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1552 (Fed.Cir.1997).FN5 The starting point "is always with the language of the asserted claim itself...." Phonometrics, Inc. v. Northern Telecom., 133 F.3d 1459, 1464 (Fed.Cir.1998).

FN5. overruled in part on other grounds by Cybor Corp. v. FAS Techs., 138 F.3d 1448, 1456 (Fed.Cir.1998)(en banc).

B. *The Claim Language Itself*

"It is the claims that measure the invention." Sjolund v. Musland, 847 F.2d 1573, 1578 (Fed.Cir.1988). "Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth. No matter how great the temptations of fairness or policy making, courts do not rework claims. They only interpret them." *E.I. DuPont de Nemours & Co. v.. Phillips Petroleum Co.,* 849 F.2d 1440, 1443 (Fed.Cir.1988).

"[W]ords of the claims themselves, both asserted and nonasserted, ... define the scope of the patented invention." Vitronics, 90 F.3d at 1582. "[T]he words of a claim are generally given their ordinary and accustomed meaning...." Carroll Touch, Inc. v. Electro Mechanical Systems, Inc., 15 F.3d 1573, 1577 (Fed.Cir.1993). A technical term is generally given its ordinary meaning as understood "by persons skilled in the art...." Phillips Petroleum Co. v. Huntsman Polymers Corp., 157 F.3d 866, 871 (Fed.Cir.1998). "The touchstone for discerning the usage of claim language is the understanding of those terms among artisans of ordinary skill in the relevant art at the time of invention." Metabolite Laboratories, Inc. v. Laboratory Corp. of America Holdings, 370 F.3d 1354, 1360 (Fed.Cir.2004).

"General descriptive terms will ordinarily be given their full meaning; modifiers will not be added to broad terms standing alone.... In short, courts must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms." Johnson Worldwide Assocs. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999) (citations omitted). This is a "heavy presumption in favor of the ordinary meaning of claim language...." Zebco Corp., 175 F.3d at 989; *see* Metabolite, 370 F.3d at 1360.

C. *The Patent Specification*

"In most cases, the best source for discerning the proper context of claim terms is the patent specification wherein the patent applicant describes the invention. In addition to providing contemporaneous technological context for defining claim terms, the patent may also define a claim term in the specification 'in a manner inconsistent with its ordinary meaning." ' Metabolite, 370 F.3d at 1360 (citations omitted).

When does a patent specification permit or require a deviation from the heavy presumption favoring the ordinary meaning of claim language? "[I]t is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." Vitronics, 90 F.3d at 1582. Upon such review, deviation from the presumed ordinary meaning of claim language arises in either of two situations:

The first arises if the patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term.... The second is where the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used.... In these two circumstances, a term or terms used in the claim invites-or indeed, requires-reference to intrinsic ... evidence ... to determine the scope of the claim language.

Zebco Corp., 175 F.3d at 990 (internal citations omitted). When the specification is consulted it acts "as sort of a dictionary, which explains the invention and may define terms used in the claims." Markman v. Westview Instruments, 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd.,* 517 U.S. 370 (1996). Consulting the specification as a "dictionary," however, may not foment a revolution in claim language interpretation. "The caveat is that any special definition given to a word must be clearly defined in the specification," id. at 980, and the specification "can supply understanding of unclear claim terms, but should never trump the clear meaning of claim terms." Zebco Corp., 175 F.3d at 990 (parenthetically paraphrasing *E.I. DuPont,* 849 F.2d at 1433).

Caution must therefore be exercised to remain faithful to the distinct roles of patent specifications versus patent claims. While "[c]laims must be read in view of the specification ...," the specification does not set the boundaries of a particular patent, "[t]hat is the function and purpose of claims." Markman, 52 F.3d at 979-80. In light of these distinct purposes, two taboos-"reading in" and "reading out"-emerge. "Reading in" prohibits using the specification to import additional limitations into clear and unambiguous claim language: "[A]ll that appears in the specification is not necessarily within the scope of the claims and thus entitled to protection. What is not claimed, even though disclosed [in the specification] as part of the 'invention,' cannot be enjoined." Novo Nordisk of N. Am. v. Genetech, Inc., 77 F.3d 1364, 1369 (Fed.Cir.1996). "Reading out" prohibits the reverse: The specification may not be used to extract or nullify limitations set forth in clear and unambiguous claim language. Texas Instruments, Inc. v. United States ITC, 988 F.2d 1165, 1171 (Fed.Cir.1993).

D. ***The Prosecution History***

"To construe claim language, the court should also consider the patent's prosecution history, if it is in evidence.... This 'undisputed public record' of proceedings in the ... [PTO] is of primary significance in understanding the claims.... The court has broad power to look as a matter of law to the prosecution history of the patent in order to ascertain the true meaning of language used in the patent claims...." Markman, 52 F.3d at 980 (internal citations omitted). The PTO's undisputed record of its proceedings is "often of critical significance in determining the meaning of the claims." Vitronics, 90 F.3d at 1582.

"As in the case of the specification, the patent applicant's consistent usage of a term in prosecuting the patent may enlighten the meaning of that term." Metabolite, 370 F.3d at 1360 (citation omitted).

E. ***The Ending Point***

"Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the invention 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." *Renishaw,* 158 F.3d at 1243.

VI. ANALYSIS: CLAIM CONSTRUCTION AND THE INFRINGEMENT CASE

A. *Collateral Estoppel and the Gemstar Litigation*

1.

The Parties' Contentions

Thomson relies in part on claim construction performed during the Gemstar litigation. Thomson contends that during the Gemstar litigation, "both the district court and the Federal Circuit found that the words 'channel select designation' in the claims of the '734 patent mean that Mr. Beery's patented control system is limited to a system that allows the operator, the viewer, to program his or her own selected labels for tuning a television receiver to a television channel, so that a television receiver can be later tuned via those labels to that television channel by the operator or another viewer." (Doc. # 193 at 9). Thomson argues that this construction of the phrase "channel select designation" established by the Gemstar litigation is subject to collateral estoppel, and Beery is therefore barred from relitigating its meaning in this case.

For reasons discussed below, Beery argues that collateral estoppel does not bar claim language construction concerning the '952 patent in the instant case.

2.

Collateral Estoppel

Collateral estoppel precludes a party from relitigating an issue previously resolved on the merits by a court of competent jurisdiction. Allen v. McCurry, 449 U.S. 90, 94 (1980). In patent infringement cases, regional

federal circuit law applies to determining whether collateral estoppel bars relitigation of issues. RF Delaware, Inc. v. Pacific Keystone Technologies, Inc., 326 F.3d 1255, 1261 (Fed.Cir.2003). Thus, Sixth Circuit law applies to the issue of whether collateral estoppel precludes this Court from reconsidering claim language interpretations reached by the courts in the Gemstar litigation. *See id*.

"[A] decision of a federal court is entitled to collateral estoppel effect if four elements are satisfied: (1) the precise issue raised in the present case must have been raised and actually litigated in the prior proceeding; (2) determination of the issue must have been necessary to the outcome of the prior proceeding; (3) the prior proceeding must have resulted in a final judgment on the merits; and (4) the party against whom estoppel is sought must have had a full and fair opportunity to litigate the issue in the prior proceeding." Smith v. SEC, 129 F.3d 356, 362 (6th Cir.1997) (citation omitted).

The party asserting collateral estoppel bears the burden of establishing each of these elements. *E.g.,* Central Transport, Inc. v. Four Phase Systems, Inc., 936 F.2d 256, 260 (6th Cir.1991); *cf*. Pacific Keystone Technologies, Inc., 326 F.3d at 1261 (applying 11th Circuit law).

3.

Analysis

Beery maintains that the correct construction of the term "operator" in the '952 patent is a person who actuates/programs one or more codes or channel designations into or from a memory. Such persons may include, for example, a viewer or a cable provider. Although the courts during the Gemstar litigation rejected this construction when construing the '734 patent, *supra,* s. III, Beery argues that collateral estoppel does not apply because the '734 patent does not describe the same invention as the '952 patent. According to Beery, the prosecution history of the '952 patent describes how the claims were broadened to overcome the interpretation of the '734 patent established by the Gemstar litigation. Beery reasons that because of this, many of the '952 patent claims are new, and consequently, the meaning given to the '734 patent claim language during the Gemstar litigation does not control construction of the '952 patent claim language in the present case.

To support these contentions Beery argues that when he added claims to the reissue application for the '952 patent, he told the PTO that these claims were meant to overcome the limitation imposed by the Gemstar court. Beery informed the PTO as follows:

I erroneously did not present claims to my invention which included a method in which 'said step of generating said first control output signal is performed by a first person, and wherein said step of generating said second control output signal is performed by a second person,' and in which 'said step of generating said first control output signal is performed by a first person, and wherein said desired channel select designation *is predetermined by a second person*.' It did not occur to me to include these limitations in the claims application for either the '734 or the "7 patents at the time they were prepared and prosecuted, and I did not discuss the possibility of presenting one or more claims incorporating these limitations in the applications for the '734 or the "7 patents with [my attorney].

(Doc. # 192 at 11)(emphasis added). Beery points to claims 52 and 53 of the '952 patent as containing this language and emphasizes that the '734 patent did not contain these claims.

A review of claims 52 and 53 of the '952 patent and a comparison of these claims to those in the '734 patent

reveals that neither claim is present in the '734 patent.FN6

FN6. Claim 5, upon which claims 52 and 53 depend states in pertinent part:
A method of controlling a television receiver capable of tuning from a multi-channel input a television channel corresponding to a preassigned channel tuning designation upon receipt of a channel tuning control signal, the system comprising of steps:
generating ... a first control output signal comprising a first data set representative of at least one desired channel select designation for at least one of said channel tuning designations;
generating ... a second control output signal comprising a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations....

(Doc. # 1, Exh. A at Col. 18).
Claim 52 states:

The method of claim 5, wherein said step of generating said first control output signal is performed by a first person, and wherein said step of generating said second control output signal is performed by a second person.

(Doc. # 1, Exh. A at Col. 38). This claim describes a feature not described by the '734 patent-a second person who performs the step of generating a second control output signal.

Claim 53 states:

The method of claim 5, wherein said step of generating said first control output signal is performed by a first person, and wherein said desired channel select designation is predetermined by a second person.

Id. Claim 53 describes a feature not described by the '734 patent-a second person who predetermines the desired channel select designation.

The '952 patent specification removes any doubt that the Gemstar litigation's construction of the term "operator" is not controlling in this case. This is so because the specification contains a description of at least one feature the courts in the Gemstar litigation rejected. The specification states:

A further alternative to programming the control system through a data port is to program the system through the cable itself. Such an alternative might be useful, for example, where the cable service company itself wishes to program its subscriber's control systems to match the designations it uses for channels which it provides....

(Doc. # 1, Exh. A at col. 13). This language describes an example of the invention set forth in claim 53, where the cable television service provider is the second person who predetermines the desired channel select designation.

In light of the above two examples, at least some of the '952 patent claim language was not at issue during the Gemstar litigation, and as a result collateral estoppel does not apply in the instant case.

Thomson argues, "Constructions of the same patent claim words, *even as between different patents,* are

binding if there are no material differences between the specifications of the two patents as it relates to the patent claim words in issue." (Doc. # 193 at 12). This contention does not assist Thomson's effort to apply collateral estoppel because (as discussed above) material differences exist between the claim language and specifications of the '734 and '952 patents. In addition, the cases upon which Thomson relies- Edberg v. CPI-Alternative Supplier, Inc., 156 F.Supp.2d 190, 196-98 (D.Conn.2001); Webb Co. v. So. Sys., Inc., 742 F.2d 1388, 1399 (Fed.Cir.1984); Westwood Chem., Inc. v. United States, 525 F.2d 1367, 1371-72 (Ct.Cl.1975)-are distinguished from the instant case. Thomson's cases did not involve completed litigation over one patent, like the Gemstar litigation, and later litigation over a reissued patent, like the '952 patent, which grew from prior granted continuation-in-part application.

Thomson contends that collateral estoppel applies due to the need for uniformity of claim language construction as described at the very core of Markman v. Westview Instruments, Inc., 517 U.S. 370, 391 (1996). Although the need for uniformity in claim language construction is a concern here particularly given that these two patents were born from the same progenitor (Beery's original patent application), these two patents are sufficiently distinct in some material respects to warrant consideration of the merits of the parties' claim-construction contentions. In addition, even if claim language interpretation in this case results in broader constructions than those reached during the Gemstar litigation, this will not be an affront to uniformity of claim language construction given that an inventor who obtains a reissued patent is entitled to protection based on broader claim language. *See* 35 U.S.C. s. 251.

Thomson also relies on cases such as Pfaff v. Wells Electronics, Inc., 5 F.3d 514 (Fed.Cir.1993),FN7 holding that "where a determination of the scope of patent claims was made in a prior case, and the determination was essential to the judgment there on the issue of infringement, there is collateral estoppel in a later case on the scope of such claims." 5 F.3d at 518 (citation omitted). However, *Pfaff* does not require the application of collateral estoppel in the instant case because the scope of at least claims 52 and 53 of the '952 patent was not considered during the Gemstar litigation. The simple reasons for this are that the '734 patent does not contain these claims and that these claims did not exist until the '952 patent was issued three years after the Gemstar litigation concluded.

FN7. Reversed in part on other grounds, Cardinal Chem Co. v. Morton Int'l., 508 U.S.. 83 (1993).

Accordingly, because the proper construction of at least some of the '952 patent claim language was not actually litigated during the Gemstar litigation, collateral estoppel does not preclude construction of the '952 patent claim language in the instant case.

B. "*Operator" and "Channel Select Designation*"

Many claims in the '952 patent use the word "operator" together with the phrase "channel select designation." It appears, for example, in claim 11 as follows:

A system for controlling a television receiver capable of tuning from a multi-channel input a television channel corresponding to a preassigned channel tuning designation upon receipt of a channel tuning control signal, the system comprising:

memory means for storing at least one *operator-assigned channel select designation* for at least one of said channel tuning designations;

operator-actuated control means for generating a control output signal comprising one of (a) a first data set representative of a desired *channel select designation* for one of said channel tuning designations, and (b) a second data set representative of a desired viewing channel identified by an operator selected one of said channel select designations;

processor means for receiving said control output signal from operator-actuated control means, and upon receipt of said first data set, causing said memory means to store said desired *channel select designation* as corresponding to said one channel tuning designation, and upon receipt of said second data set, retrieving from said memory means the one of said channel tuning designations corresponding to said *operator selected channel select designation,* and generating said channel tuning control signal to correspond to said one channel tuning designation;

wherein said memory means includes means for initially storing a *channel select designation* for each of said channel tuning designations which is identical thereto;

said operator-actuated control means including means for generating a memory clear signal;

said processor means including means for receiving said memory clear signal, and in response thereto, clearing said memory and restoring therein said channel select designation for each of said channel tuning designations which is identical thereto.

(Doc. # 1, Exh. A at col. 18 (emphasis added)).

Beery contends-as he did during the Gemstar litigation-that a "channel select designation" is a control signal for picking a channel tuning designation which may be programmed into memory by a viewer, or by someone else, such as the cable service operator. In this manner, Beery argues that the term "operator" when used with the phrase "channel select designation" includes not only a person actually operating the system, such as the viewer, but also third parties such as cable service providers.

Thomson argues that proper definition of the phrase "channel select designation" was established by the courts during the Gemstar litigation and must therefore be limited to a television control system that allows the operator, the viewer, to program his or her own selected labels for tuning a television receiver to a television channel by the operator or another viewer. Thomson explains that this definition applies to the phrase "channel select designation" in all its various forms including, "operator-assigned channel select designation" and "operator selected channel select designation" and "desired channel select designation."

The prior conclusion, *supra,* s. VI(A), that collateral estoppel does not preclude construction of the '952 patent claim language in this case does not mean that the Gemstar courts' claim construction must be rejected; it simply means that this Court is not required to accept it under the doctrine of collateral estoppel. Thus, the Gemstar courts' claim construction provides insight into the proper construction of the phrase "channel select designation," at least to the extent that the '952 patent claims use this phrase in the same manner as the '734 patent. This it certainly does, and Beery seems to acknowledge this through his recognition that the '952 patent "includes the text of the '734 patent...." (Doc. # 192 at 8).

Beery, however, further asserts that the '952 patent includes "the additional text in the "7 [patent], and many new claims present in neither the '734 nor the "7 [patents]." Id. He argues, "Thomson attempts to shoe-horn

the "7 and '952 into the '734, as though the '952 never existed." (Doc. # 268 at 7). This contention is well taken.

The question is whether the '952 patent claim language reaches beyond the text of the '734 patent sufficient to justify Beery's expansion of the phrase "channel select designation" to include a channel tuning designation by a viewer *or someone else, such as a cable operator*. The phrase "channel select designation" as it appears in the '952 patent claims must be understood to include tuning designation by operators, viewers, or third-parties like cable television service providers. Looking first to the claim language, little clue is given to whether the phrase "channel select designation" only includes operators or viewers who enter tuning designations. This is because the phrase is conjoined with other terms such as "desired channel select designation" (claim 5) or "operator-assigned channel select designation" (claim 11) or "operator selected channel select designation" (claim 30). Reading these phrases only in the context of their surrounding claim language does not provide any meaningful guidepost to its meaning. Consequently, the specification must be consulted. *See* Zebco Corp., 175 F.3d at 990 (and cases cited therein).

The '952 patent specification describes a broader array of inventions incorporating the tune-by-label function than the '734 patent describes. One such invention involves programming by a cable service provider. The '952 patent specification states:

A further alternative to programming the control system through a data port is to program the system through the cable itself. Such an alternative might be useful, for example, where the cable service company itself wishes to program its subscriber's control systems to match the designation it uses for channels which it provides, or the designations used by local newspapers in providing program information. One cable channel may be reserved for transmitting the necessary data. The control system may be made responsive to such channel either on a periodic basis, or upon receiving an instruction program itself from the incoming data stream.

One cable provider may wish to provide multiple programmed series, useful for example where a cable provider serves an area covered by newspapers using different designations in their television listings. While this approach can be implemented in a number of ways, one possibility is to reserve a separate cable channel for each channel designation series. This will in fact enable the user to select the series desired, by tuning to the appropriate channel for programming of the control unit.

(Doc. # 1, Exh. A at col. 13, ll. 13-33).

To accept Thomson's construction and limit the "channel select designation" to operators and viewers, the Court would need to overlook this descriptive language in the specification. Because this explanation illuminates how a cable service provider can program its customers' television control systems with the cable provider's own channel select designations, the specification supports Beery's construction of this phrase. Both the absence of limiting terms in the claim language and this description in specification were sufficient to place a reader on notice that the phrase "channel select designation" was not limited to operators and viewers but also included third parties such as cable service providers. *Cf.* Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1311 (Fed.Cir.1999)(seemingly identical claim terms not interpreted same in light of specification and prosecution history).

Accordingly, the phrase "channel select designation" when combined with the word "operator" refers to a control signal for picking a channel tuning designation which may be programmed into memory by a

viewer, or by someone else, such as the cable service operator.

C. "*Cue*" *and* "*Select Code*"

Beery contends that the word "cue" refers to a list or grouping of one or more channel tuning designations located within a memory. Beery's proposed definition must be rejected because it fails to reflect the definition of the word "cue" in the specification, which states:

'Cue' is the listing in memory of the various programmed entries made by the viewer, wherein each select code is stored along with its corresponding channel code and display code.

(Doc. # 1, Exh. A at col. 6).

Beery's proposed definition is broader than the definition set forth in the specification because Beery's definition does not require a viewer to program the list of entries in the memory. By choosing to be his own lexicographer in the specification, Beery set the definition of the term "cue" by which he must live. *See* Zebco Corp., 175 F.3d at 990. He is bound to his written word, and he may not broaden its meaning beyond the one he wrote in the specification.

Beery contends that the term "cue" is not limited in the claim language by the requirement that a viewer must enter the select code or the display code. This is seen, Beery maintains, in the memory means of claims 8, 9, 20, and 29, which contain no requirement that a viewer must enter information into the cue. This leads Beery to conclude that a cue may contain information entered not only by a viewer but also by a third party such as a cable service provider. This contention lacks merit upon review of the memory means in claims 8, 9, 20, 29, even though the memory means in each of these claims does not specifically use the word viewer as the person who must enter information into the cue. Having specifically defined the term "cue" in the specification, the '952 patent claim language must be understood in light of that definition in each of its claims. Indeed, one reason for permitting an inventor to act as his or her own lexicographer is to make claim language more concise, and hence more easily understood. Such definitions accomplish concision by allowing the inventor to write claim language using the term or phrase without repeating its definition in each claim. However, once an inventor chooses a particular definition, and explicitly and clearly writes it into the specification, a claim term or phrase thus defined may not be expanded unless other claim language presents a basis for doing so. As a result, because the specification's explicit and clear definition of the word "cue" requires a viewer to make programmed entries, the absence of a reference to a "viewer" in claims 8, 9, 20, 29 does not provide a basis for altering the specification's definition.

Turning to the phrase "select code," Thomson contends that the specification's definition of the phrase "select code" applies. As with the term "cue," Beery acted as his own lexicographer by specifically defining the phrase "select code." He is therefore limited to the specific definition of this phrase as it appears in the specification. *See* Zebco Corp., 175 F.3d at 990.

Accordingly, the word "cue" in the '952 patent is "the listing in memory of the various programmed entries made by the viewer, wherein each select code is stored along with its corresponding channel code and display code." (Doc. # 1, Exh. A at col. 6). The phrase "select code" in the '952 patent refers to "the channel designation chosen by the viewer for subsequent use in selecting a particular channel." *Id*.

D. "*Scroll Sequence*"

Claims 37 and 38 use the phrase "scroll sequence." Claim 37, for example, describes a "memory means for storing a marker value for at least one of said channel tuning designations, and means for retaining said channel tuning designations in a plurality of scroll sequences...." (Doc. # 1, Exh. A at col. 30).

Beery asserts that the phrase "scroll sequence" does not require a viewer to program it, but more broadly refers to one or more channel tuning designations which are retained in the memory means.

Thomson argues that a scroll sequence must consist of entries made by a viewer. Thomson bases this contention on the specification by arguing, " 'Scroll sequence is ... given a specific meaning in the '952 patent's explicit description of 'scroll sequence' using the precise special definitions given to 'cue' and 'select code." ' (Doc. # 272 at 11). Thomson reasons, "a 'scroll sequence' is expressly described by the '952 patent as a 'cue' with a 'marker bit' or 'scroll marker.' The 'scroll sequence,' like the 'cue," ... is ... defined by the '952 patent to include 'the listing in memory of various programmed entries *made by the viewer,* wherein each select code is stored along with its corresponding channel code and display code." (Doc. # 193 at 17 (original italics)).

The manner in which the phrase "scroll sequence" appears in the context of the '952 patent provides no hint about its meaning. Indeed, it is a technical phrase inviting reference to the specification to learn its meaning. *See* Zebco Corp., 175 F.3d at 990 (and cases cited therein).

Contrary to Thomson's contentions, the phrase "scroll sequence" is not specifically defined in the specification, for several reasons. First, it is not among the four terms and phrases explicitly listed and defined in the specification. This list includes only "channel code," "select code," "display code," and "cue." By not including in this list a clear and explicit definition of the phrase "scroll sequence," Beery did not act as his own lexicographer with regard to this phrase. *See* Zebco Corp., 175 F.3d at 990.

Second, the specification's description of the term "scroll" beginning at column 9, line 16 does not contain a sufficiently explicit and clear limitation of "scroll sequence" to only be a feature capable of use by viewers. This is so because the specification describes the "scroll" as a feature of the preferred embodiment. This portion of the specification states, in part, "Yet another feature of the preferred embodiment is the ability of the operator to designate only certain channels to be placed into a 'scroll' so that the operator may later 'scroll' by actuating a single key through a number of frequently watched channels. Those channels to be placed in the scroll are flagged with a marker bit...." (Doc. # 1, Exh. A at col. 9). The specification continues using the term "operator" to describe how entries are programed into a scroll. *See id*. Use of the term operator in this description of the preferred embodiment does not require the scroll sequence to be used by viewers only but is merely an example of how this particular preferred embodiment can be used. Without such a requirement, the preferred embodiment merely serves as an example of how this feature can be used. "[C]laims are not to be interpreted by adding limitations appearing only in the specification.... Thus, although the specifications may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments." Electro Medical Sys. SA v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054 (Fed.Cir.1994). Because the claim language of the '952 patent does not limit the phrase "scroll sequence" to use by viewers only, the specification's use of the term "operator" when describing the preferred embodiment provides no ground for limiting the "scroll" feature to use by viewers only.

In addition, Thomson's focus on the specification's use of the terms "cue" and "viewer" along with the phrase "select code" does not convince the Court that the specification sets a more limited definition of the

phrase "scroll sequence." Although the specification's preferred embodiment of a "scroll" includes a program that enters the channel code, select code, display code, and scroll marker into the channel selection cue, *see* Doc. # 1, Exh. A, col. 9 at ll. 27-29, and although both "cue" and "select code" are specifically defined in the specification to include use by the "viewer," the specification's use of the broader term "operator" to describe the preferred embodiment of the "scroll" establishes that the scroll feature is not limited by the narrower definitions of "cue" and "select code." To hold otherwise would require limiting the term "operator" to viewers only; a limitation that is not supported by the claim language or the specification, *see supra,* s. VI(B).

Lastly, this construction of the phrase "scroll sequence" naturally aligns with the patent's description of the invention, which again is a reissue patent that not only includes but goes well beyond the apparatus described in the '734 patent. *See Renishaw,* 158 F.3d at 1243. Thomson's proposed limitation of "scroll sequence" to use by viewers only ignores this broader reissued nature of this reissue patent.

Accordingly, the phrase "scroll sequence" as used in the '952 patent does not require a viewer to program it but more broadly refers to one or more channel tuning designations, which are retained in the memory means.

E. "*Marker Value*"

Numerous claims of the '952 patent contain the phrase "marker value." Claim 8, for example, associates a "marker value" with a channel tuning designation as follows:

tuner means for receiving a processor signal and a multi-channel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

memory means for storing a *marker value* for at least one of said channel tuning designations, and means of retaining said channel tuning designations in a plurality of ordered cues....

(Doc. # 1, Exh. A at col. 16)(emphasis added). Claim 10 associates a "marker value" with a channel select designation as part of its memory means as follows:

wherein said memory means includes means for storing a *marker value* for each of said channel select designations, and means of retaining said channel select designations in a plurality of ordered cues....

Id. at col. 17 (emphasis added). In addition, both claims 8 and 10 describe a "marker value" as being stored or retained for each channel tuning designation or channel select designation in a plurality of *ordered cues*. Other claims associate the phrase "marker value" with a plurality of *scroll sequences*. For instance, claim 37 describes its memory means as follows:

memory means for storing a marker value for at least one of said channel tuning designations, and means for retaining said channel tuning designations in a plurality of scroll sequences.

Id. at col. 30.

Despite claim language associating "marker values" with either cues or scroll sequences, Thomson construes

the phrase "marker value" as a single binary value or multiple binary values used to mark scroll sequences in cues. Thomson contends that the specification requires "marker bits" and "multiple bit markers" to mark entries in a cue to create a scroll sequence. As a result, according to Thomson, a "marker value" marks a listing not only of channel tuning designations but also a listing of a display code, channel code, and select code. A "marker value" is thus a flag for a cue to be included in a scroll sequence. These contentions, however, improperly seek to remove the alternative provided in the claim language whereby a marker value is stored in either plurality of ordered cues or scroll sequences.

The specification does not explicitly define "marker value." The preferred embodiment, however, explains that when an operator chooses a channel to place into a scroll, a "marker bit" is used to flag the particular channel the operator wants to place into a scroll. (Doc. # 1, Exh. A at col. 9, ll. 16-21). The specification also states that a marker bit may be a single marker bit "whereby a single scroll is provided ..." or multiple marker bits to create more than one scroll sequence to permit subject matter scrolls or favorite channels, for example. *Id*. at col. 12, ll. 53-63. Thus, a "marker value" may include one or more bits in a memory. Yet, this does not lead to the conclusion that a marker value must be used to mark scroll sequences in cues because the claim language indicates that a "marker value" is used to indicate that its associated channel tuning designation is included in either the cue (as in claims 8, 9, 20, 29) or a scroll sequence (as in claims 37, 38).

Accordingly, a "marker value" as used in the '952 patent refers to "a value or number associated with a channel select designation."

F. "*Tuner Means*"

The '952 patent contains a "tuner means" as an element of numerous claims. A representative example is claim 1, which states:

tuner means for receiving a processor signal and a multichannel input signal, and in response to said processor signal, tuning out all but one channel corresponding to a selected one of said preassigned channel tuning designations;

(Doc. # 1, Exh. A at col. 14). This and other similar claims describe the tuner means using the means-plus-function format permitted by 35 U.S.C. s. 112, para. 6.FN8 This format appears here because the claims recite the function to be performed in a general way without referring to a definite structure that performs the task of the tuner means. *See* Lockheed Martin Corp. v. Space Systems/Loral, Inc., 324 F.3d 1308, 1318 (Fed.Cir.2003). As a result, construing the phrase "tuner means" must be accomplished by referring to the specification in accordance with 35 U.S.C. s. 112, para. 6. *See id*. at 1319. The means-plus-function issue in this case is what is the literal or equivalent corresponding structure in the '952 patent specification that constitutes the "tuner means." *See* Mas-Hamilton Group v. LaGard, Inc., 156 F.3d 1206, 1211 (Fed.Cir.1998).

FN8. 35 U.S.C. s. 112, para. 6 states in part:
An element in a claim for a combination may be expressed as a means ... for performing a specified function without the recital of structure ... [or] material ... in support thereof, and such claim shall be construed to cover the corresponding structure ... [or] material described in the specification and equivalents thereof.
The structure of the "tuner means" is described in the specification as follows:

A tuner 18 receives a multi-channel input at 20 and tunes out all but a selected channel for viewing. It will be recognized that the multi-channel input received by the tuner 18 and 20 may be convention [sic] cable input signal, but may also be the input signal received from a satellite transmission receiver. Moreover, the present invention may be used with any television input signal, including a conventional over-the-air broadcast signal received through a conventional antenna.

(Doc. # 1, Exh. A at col.4, ll. 59-67).

Thomson proposes that the "tuner means" should be construed as limited to a tuner capable of receiving multiple television channel signals, capable of tuning out all but one channel corresponding to a selected one of said pre-assigned channel tuning designations, and capable of feeding received television broadcast signals to other circuits for further processing. Thomson explains that such "tuner means" do not include digital satellite receivers or radios or short-wave radios.

Beery disagrees. While he agrees that the specification discusses the "tuner means" structure as quoted above, Beery argues that "tuner means" structure includes satellite receivers. Beery contends that Thomson's assertion about digital satellite receivers is a fact question-i.e, whether Thomson's accused digital satellite receiver contain a tuner means-not a claim-construction question. Beery therefore proposes that the "tuner means" refers to a television that receives signals from any source, over the air, via cable, or from a satellite.

Review of the specification language quoted above reveals that it refers to input signals "received from a satellite transmission receiver." Rather than excluding *digital* satellite transmission receivers, this language included such receivers in its identification of satellite transmission receivers. The structure is therefore not limited as Thomson hopes to exclude structures capable of receiving input signals from digital satellite transmission receivers. This conclusion is not altered by other portions of the specification upon which Thomson relies. The specification states:

It will also be recognized that while frequent reference is made herein to a 'television receiver,' such reference is intended to include not only conventional television sets, but also videocassette recorders, satellite receivers, or any other apparatus capable of tuning a television signal from a multiple channel source.

(Doc. # 1, Exh. A at col. 14, ll. 5-10). Nothing in this language limits the structure of "tuner means" by excluding digital satellite receivers.

Accordingly, the function described by the "tuner means" in the '952 patent is to select a channel out of a multi-channel input. The structure of this "tuner means" includes the one described in the specification beginning at "tuner 18 ..." (col.4, ll.59-64) or its equivalent including a television that receives signals over the air, via cable, or from a satellite.

G. *The Parties' Contentions Concerning the Reissue '952 Patent*

1.

Reissue Patents Generally

The reissue statute states in part:

Whenever any patent is, through error ..., deemed wholly or partly inoperative or invalid, by reason of ... the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent ... No new matter shall be introduced into the application for reissue.

35 U.S.C. s. 251. The purpose of permitting an inventor to obtain a reissued patent is one of fairness-to assist the inventor in avoiding a forfeiture of his or her substantive rights to patent protection due to an error made without an intent to deceive. Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1575 (Fed.Cir.1991). "[T]he whole purpose of the statute, so far as claims are concerned, is to permit limitations to be added to claims that are too broad or to be taken from claims that are too narrow." *Id.* (quoting parenthetically In re Handel, 312 F.2d 943, 948 (CCPA 1963)).

A broadening reissue, however, is limited by s. 251's original-invention requirement. When the PTO reissues a patent under s. 251, the reissued patent must be "for the invention disclosed in the original patent...." 35 U.S.C. s. 251. This original-invention requirement asks "whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." In re Amos, 953 F.2d 613, 618 (Fed.Cir.1991). If not, s. 251 does not permit a broadening reissue. *See id.*

An inventor's or an attorney's failure to appreciate the scope of an invention at the time of the original patent grant is a common basis for broadening reissues. *See* C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1354 (Fed.Cir.1998); *see also* Wilder v. Lanier Business Products, 736 F.2d 1516, 1519 (Fed.Cir.1984).

2.

The Parties' Contentions

"When claims are amenable to more than one construction, they should when reasonably possible be interpreted so as to preserve their validity." Modine Manufacturing Co. v. United States Intern. Trade Comm., 75 F.3d 1545, 1557 (Fed.Cir.1996).

Thomson contends that Beery's proposed definitions of "channel select designation," "cue," and "scroll sequence" cannot be accepted because they would invalidate the '952 patent by failing to comply with the requirements of the reissue statute, 35 U.S.C. s. 251. Thomson maintains that Beery's proposed definitions seek to broaden the special definitions given to these claim terms in the patent specification. If this is correct, Thomson reasons, then the Court must adopt Thomson's proposed definitions because to accept Beery's proposed definitions would violate the rule of claim construction requiring courts to interpret claims when reasonably possible "so as to preserve their validity." Modine Manufacturing, 75 F.3d at 1557.

Beery contends that its proposed definitions would not render the '952 patent invalid because the very purpose of broadening reissue patents is to cover a different invention not previously claimed in the original patent, as long as the other requirements of s. 251 are met. According to Beery, he sought a broadening reissue in order to broaden the claim meanings set by the Gemstar litigation, and he informed the PTO about

the Gemstar litigation and the resulting claim constructs.

The problem with the parties' reissue contentions is that they are premature in light of the complexity involved in determining whether the requirements of the reissue statute have been met. The parties, of course, well understand that what is presently at issue is how to construe certain words and phrases of the '952 patent. Thomson's reissue arguments prematurely throw complex validity issues into the claim-construction fray. While this Judicial Officer is mindful of the claim-construction principle holding that claims amenable to more than one construction "should when reasonably possible be interpreted so as to preserve their validity ...," Modine Manufacturing, 75 F.3d at 1557, this principle does not dictate that reissue/validity matters be decided during the claim construction phase of this litigation. This is not to hint that Thomson's reissue/validity contentions are correct but is instead to say that proper claim construction can be obtained by application of the legal standards outlined above, *supra,* s. IV, without at this time a large diversion into what should remain separate reissue/validity issues. More simply put, the validity of the reissue '952 patent should not drive claim construction analysis in this case.

This temporarily postpones the main issue raised by Thomson's reissue contentions-whether the '952 patent as construed is invalid for failing to comply with the requirements of the reissue statute. Postponement is warranted given the expansive nature of the reissue arguments presented. This is partly seen in the parties' disagreement over the applicable legal standards. Beery, for example, maintains that Thomson has misstated the law of broadening reissues. Beery explains, "Thomson says on page 19: 'Nor can reissue claims be construed to cover a different invention than that previously claimed in the original patent.' Wrong. *That is exactly what a broadening reissue can do,* so long as the other requirements of s. 251 are met." (Doc. # 268 at 2 (Beery's emphasis)). This contention, along with Thomson's arguments, reveal the underlying reissue concern-did Beery's '952 patent broaden scope of the original patent beyond the limit allowed by the reissue statute?-a concern that should not be resolved in the service of claim construction, particularly given the presumptive validity of reissued patents. *See* 35 U.S.C. s. 282.

The expansive nature of the reissue matters raised by the parties is also seen in Thomson's reply that Beery's characterization of the '952 patent as a broadening reissue is wide of the mark. According to Thomson, the broader claims introduced in the '952 patent "were method claims or took the 'tuner means' element out of the claims [and] did not, and could not, change the meaning of the key claim words fixed by the special definitions set forth in the patent specification." (Doc. # 272 at 7). To resolve this contention would prematurely require a consideration of the original-invention requirement of the reissue statute. This is no small task given the complexity and length of these two patents and need for a potentially detailed comparison of the original patent-the "7 patent-with the reissue '952 patent. To determine if the '952 patent complies with the reissue statute would require an inquiry into "whether one skilled in the art, reading the specification, would identify the subject matter of the new claims as invented and disclosed by the patentees." Amos, 953 F.2d at 618. As one District Court has explained:

In other words, looking at the claims, drawings, and specification of the original patent, a person with ordinary skill in the art must be able to conclude that the inventor could have claimed the new subject matter in the original application. Amos, 953 F.2d at 618. 'Could have claimed' does not mean that a claim is merely indicated or suggested by the specification. To the contrary, the proper standard requires the specification to have been capable of supporting all the elements of the new subject matter had that matter been included in the original patent. As the Supreme Court observed more than half a century ago:

it is not enough that an invention might have been claimed in the original patent because it was suggested or

indicated in the specification. It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original.

Hester Industries, Inc. v. Stein, Inc., 963 F.Supp. 1403, 1412-13 (E.D.Va.1997)(emphasis in original) (quoting in part U.S. Industrial Chemicals v. Carbide & Carbon Chemicals Corp., 315 U.S. 668, 676 (1942)).

The parties' current briefing does not contain sufficiently detailed comparison of the "7 patent with the '952 patent to allow for an informed judicial decision concerning the above standards. Given that the prosecution history of the '952 patent contains more than 900 pages of information, the burden falls upon the parties to better explain their contentions and the applicable legal standards to determining whether the '952 patent complies with the reissue statute. Consequently, a determination of the reissue/validity of the '952 patent based on claim construction is not warranted at this time. No prejudice will ensue from delaying consideration of the parties' validity contentions until more thorough briefing by the parties. This is particularly so as to Thomson because if the claim constructions reached in this Report render the '952 patent invalid, Thomson will ultimately prevail on the merits of its validity defense, a result rendering Thomson's accused products non-infringing. Thus, given that the parties' reissue/validity dispute looms large on the horizon of these cases, Beery should take only some comfort with the large success of his claim-construction contentions, particularly if these constructions render the '952 patent invalid under the reissue statute.

Accordingly, the parties' contentions regarding the validity of the '952 patent under the reissue statute should not be addressed until the parties are given the opportunity to further brief their contention in light of the claim constructions reached above.

VII. THOMSON LICENSING SA'S INTERFERENCE CASE

A. *Introduction*

Thomson Licensing SA's interference case against Beery rests on the allegation that David J. Duffield invented the same system for tuning television channels by labels and that he filed his patent application before Beery filed and obtained the '734 and '952 patents. Thomson Licensing therefore brings an interference action under 35 U.S.C. s. 291 seeking a determination that the Duffield patent, which Thomson Licensing now owns, and Beery's '734 and the '952 patents have common subject matter. If so, and if as a factual matter the Duffield patent has priority of inventorship, then Beery's patents are invalid.

B. *Interference Actions Under* 35 U.S.C. s. 291

"Two or more patents 'interfere'-a term of art in patent law-when they claim the same subject matter." Albert v. Kevex Corp ., 729 F.2d 757, 759 n. 1 (Fed.Cir.1984).FN9

FN9. Although interference actions most often arise before the PTO, this Court has subject matter jurisdiction over interference actions under 35 U.S.C. s. 291. *See Albert,* 729 F.2d at 760-6. An interference between two patents must exist in order for this Court to have jurisdiction to enter an Order invalidating one patent under s. 291. *See id*. at 761-62 and n. 4.

"[I]n order to provoke an interference in district court under s. 291, the interfering patents must have the

same or substantially the same subject matter in similar form as that required by the PTO pursuant to 35 U.S.C. s. 135." Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 934 (Fed.Cir.2003)(quoting *Slip Track,* 304 F.3d at 1263). Whether potentially interfering patents contain the same or substantially the same subject manner is resolved under the so-called two-way test. *Id*. "As has been explained by the Board of Patent Appeals & Interferences, 'The claimed invention of Party A is presumed to be prior art vis-a-vis Party B and vice versa. The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must anticipate or render obvious the claimed invention of Party A." ' *Id*. (quoting Winter v. Fujita, 53 USPQ2d 1234, 1243 (U .S. Bd. Pat.App. & Int.1999)).

The first step in determining whether one patent anticipates or renders another patent obvious is determining the proper meaning of claim language. *Id*. at 933. Once any disputed claim language is properly construed the Court determines-as a matter of law-the common subject matter of the allegedly interfering patents. Slip Track Systems, Inc. v. Metal-Lite, Inc., 304 F.3d 1256, 1263 (Fed.Cir.2002). Indeed, in s. 291 cases "a single description of the interfering subject matter is necessary for a determination of priority." Slip Track Systems, 304 F.3d at 1264. In such proceedings, the PTO creates a "count," which "defines the interfering subject matter and corresponds to the patentable invention. The count may be identical to a single claim at issue or may be broader than the particular claims at issue." Slip Track Systems, 304 F.3d at 1263.

C. *Thomson Licensing's Assertions*

Thomson Licensing has proposed an interference count. (Doc. # 193 at 27). This count, however, is based on some claim-language contentions that lack merit. Thomson Licensing, for example, argues that the Duffield patent uses the phrase "label data" in the same manner as the phrase "channel select designation" as defined in the Gemstar litigation. As discussed above, *supra,* s. VI(B), the definition of "channel select designation" set by the Gemstar litigation does not apply to the proper construction of this phrase as used in Beery's '734 and '952 patents. The '952 patent uses this phrase together with the word "operator" to channel select designations selected by a viewer or a third party, such as a cable service provider. *Supra,* s. VI(B). As a result, Thomson Licensing's proposed count is based on an incorrect construction of the phrase channel select designations, and in doing so does not accurately reflect a key feature of the '952 patent, the system's feature allowing a cable service provider, or similar third parties, to select channel select designations.

In addition, since the resolution of the parties' dispute over other claim terms has largely favored Beery's proposed constructions, and Beery has not submitted a proposed "count," a more efficient procedure for resolving the parties' interference contentions would be to require them to submit proposed counts after they reevaluate their contentions in light of the claim constructions set forth in the Report.

VIII. SUMMARY

In sum, the disputed claim terms and phrases in the '952 patent are properly construed as follows:

-> The phrase "channel select designation" when combined with the word "operator" refers to a control signal for picking a channel tuning designation which may be programmed into memory by a viewer or by someone else, such as the cable service operator.

-> The word "cue" is the listing in memory of the various programmed entries made by the viewer, wherein each select code is stored along with its corresponding channel code and display code.

-> The phrase "select code" refers to the channel designation chosen by the viewer for subsequent use in

selecting a particular channel.

-> The phrase "scroll sequence" does not require a viewer to program it but more broadly refers to one or more channel tuning designations, which are retained in the memory means.

-> A "marker value" refers to a value or number associated with a channel select designation.

-> The function described by the "tuner means" is to select a channel out of a multi-channel input. The structure of this "tuner means" includes the one described in the specification beginning at "tuner 18 ..." (Doc. # 1, Exh. A, col.4, ll.59-64) or its equivalent including a television that receives signals over the air, via cable, or from a satellite.

IT IS THEREFORE RECOMMENDED THAT:

1. The construction of the parties' disputed claim of the '952 language as set forth herein be adopted;
2. Beery's Motion to Exclude Extrinsic and Unreliable Evidence (3:00cv00327, Doc. # 282; 3:02cv00311, Doc. # 123) be DENIED as moot;

3. Thomson Consumer Electronics' Motion to Exclude Deposition Testimony (3:00cv00327, Doc. # 286; 3:02cv00311, Doc. # 127) be DENIED as moot;

4. Beery's Motion for Leave to File and Cite Additional Case (3:00cv00327, Doc. # 307; 3:02cv00311, Doc. # 148) be GRANTED;

5. Thomson Consumer Electronics' Motion for Leave to File Response to Beery's Reply in Support of His Motion to Cite an Additional Case (3:00cv00327, Doc. # 312; 3:02cv00311, Doc. # 154) be DENIED;

6. Beery's Motion for Leave to File Corrected Reply (3:00cv00327, Doc. # 314; 3:02cv00311, Doc. # 156) be GRANTED; and

7. Beery's Motion for Leave to file Supplemental Briefing on Claim Construction (3:00cv00327, Doc. # 315; 3:02cv00311, Doc. # 157) be GRANTED.

NOTICE REGARDING OBJECTIONS

Pursuant to Fed.R.Civ.P. 72(b), any party may serve and file specific, written objections to the proposed findings and recommendations within ten days after being served with this Report and Recommendations. Pursuant to Fed.R.Civ.P. 6(e), this period is extended to thirteen days (excluding intervening Saturdays, Sundays, and legal holidays) because this Report is being served by mail. Such objections shall specify the portions of the Report objected to and shall be accompanied by a memorandum of law in support of the objections. If the Report and Recommendations are based in whole or in part upon matters occurring of record at an oral hearing, the objecting party shall promptly arrange for the transcription of the record, or such portions of it as all parties may agree upon or the Magistrate Judge deems sufficient, unless the assigned District Judge otherwise directs. A party may respond to another party's objections within ten days after being served with a copy thereof.

Failure to make objections in accordance with this procedure may forfeit rights on appeal. *See* United States v. Walters, 638 F.2d 947 (6th Cir.1981); Thomas v. Arn, 474 U.S. 140 (1985).

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Beery v. Thomson Consumer Electronics, Inc.

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