

United States District Court,
S.D. Texas, Houston Division.

TIP SYSTEMS, LLC,

v.

PHILLIPS BROOKS/GLADWIN.

Feb. 21, 2006.

Gary M. Samms, Jeffrey S. Batoff, Matthew A. Kelly, III, Nicholas Poduslenko, Obermayer Rebmann Maxwell & Hippel LLP, Philadelphia, PA, Natalie Jerae Carlson, William A. Worthington, Strasburger & Price LLP, Houston, TX, for Plaintiffs.

Paul E. Krieger, Morgan Lewis & Bockius LLP, Clayton Rowland Hearn, Roberts Markel Guerry PC, S. Loyd Neal, III, Dunn Neal et al., Houston, TX, Aubrey Pittman, The Pittman Law Firm PC, Neal James Suit, Bell Nunnally and Martin, Dallas, TX, J. Keith Mayo, Tyler, TX, for Defendants.

ORDER

VANESSA D. GILMORE, **District Judge.**

Pending before the Court are the Defendants' *Markman* Joint Claim Construction Brief (**Instrument No. 82**) and Plaintiffs' *Markman* Brief on Claim Interpretation (**Instrument No. 88**). The Court held a *Markman* hearing on December 2, 2005.

I.

This litigation centers on United States Patent No. 6,009,169 (the "'169 patent") and United States Patent No. 6,152,828 (the "'828 patent"). (Instrument No. 82, at 1). Both the '169 and '828 patents are held by Plaintiffs TIP Systems, LLC and TIP Systems Holding Co., Inc. (collectively "TIP Systems" or "Plaintiffs") (*Id.*). TIP Systems brings this patent infringement lawsuit against Defendants Independent Technologies, Inc., SBC Communications Inc., Southwestern Bell Telephone, L.P., SWBT Texas, LLC, SBC Services, Inc., Ameritech Payphone Services, Inc., Pacific Telesis Group, Inc., SWBT Purchasing & Leasing Limited Partnership, Evercom, Inc., Evercom Systems, Inc., Evercom Holdings, Inc., T-Netix, Inc., T-Netix Telecommunications Services, Inc., and TZ Holdings, Inc. (collectively "Defendants"). (*Id.*). The '169 patent application was filed on February 3, 1998, and the patent issued on December 28, 1999 (Instrument No. 88, Exhibit A). The '828 patent application was filed on November 11, 2000, and the patent issued on January 28, 2003. (Instrument No. 88, Exhibit B).

The '169 patent covers an "inmate phone." (Instrument No. 88, Exhibit A). The phone is supplied to correctional and other facilities to prevent prisoners from hanging themselves with "the handset cord or break[ing] the handset cord off and us[ing] the telephone handset as a weapon." (*Id.*, at lines 11-14). The '828 patent covers a "wall mounted telephone." (*Id.*, Exhibit B). The '828 patent is a continuation-in-part of

the '169 patent. (Instrument No. 88, at 3). Because they are interrelated, Plaintiffs were "required to file a 'terminal disclaimer' on the '828 patent such that it would expire on the same date as the '169 patent." (Id.). A terminal disclaimer is required "when two related patents cover nearly the same invention." (Id.). Plaintiffs explain that, the invention in both the '169 and '828 patents is unlike a speakerphone in that for the unit to operate properly, the user is required to place "his or her head to the unit in the same proximity as with a conventional phone." (Id., at 4). Therefore, Plaintiffs go on to explain that with its invention, "conventional telephone cords are no longer necessary to access and utilize telephone services." (Id.).

Language contained in Claims 1 and 12 of the '169 patent is at issue for the purposes of this *Markman* claim construction proceeding. The term "handset" and the phrase "earpiece ... and mouthpiece ... permanently extend out through the front wall" within Claim 1 are disputed. The language of Claim 1 provides as follows,

1. An inmate phone of the type having a housing in an interior wall of a prison, a push-button dialing pad mounted within a front wall of the housing with the push button digits of the push-button dialing pad extending out of the front wall, a telephone *handset* being a handle with an earpiece at one end and a mouthpiece at an opposite end, a handset cord electrically connected between the push-button dialing pad and the telephone handset, wherein the improvement comprises means for permanently mounting the telephone *handset* vertically within the front wall of the housing, so that the earpiece positioned at top and the mouthpiece positioned at bottom will permanently extend out through the front wall of the housing to be used by inmates within the prison hands free while the *handset* while the *handset* cord is also permanently maintained within the housing, to prevent the inmates from having direct access to the telephone *handset* and the *handset* cord, in which the inmates can no longer hang themselves with the *handset* cord and break the *handset* cord off and use the telephone *handset* as a weapon.

(Instrument No. 88, Exhibit A, at 5) (emphasis added). The same terminology as in Claim 1 is in dispute in Claim 12 of the '169 patent. Claim 12 of the '169 patent provides as follows,

12. An inmate phone of the type having a housing in an interior wall of a prison, a push-button dialing pad mounted within a front wall of the housing with the push button digits of the push-button dialing pad extending out of the front wall, a telephone *handset* being a handle with an earpiece at one end and a mouthpiece at an opposite end, a *handset* cord electrically connected between the push-button dialing pad and the telephone *handset*, wherein the improvement comprises:

a. means for permanently mounting the telephone *handset* vertically within the front wall of the housing, so that the earpiece positioned at top and the mouthpiece positioned at bottom will permanently extend out through the front wall of the housing to be used by inmates within the prison hands free while the *handset* cord is also permanently maintained within the housing, to prevent the inmates from having direct access to the telephone *handset* and the *handset* cord, in which the inmates can no longer hang themselves with the *handset* cord and break the *handset* cord off and use the telephone *handset* as a weapon; and

b. means extending through the front wall of the housing, for manually actuating the dial tone of the inmate phone independently of the telephone *handset*.

(Id., at 6) (emphasis added). The parties are also in disagreement about the term "annular seal," located within Claims 3 and 13 of the '169 patent.

Plaintiffs assert that the term "handset" should be construed within the context and purpose of the '169 patent. (Instrument No. 88, at 1). More specifically, TIP Systems believes that because "[t]he purpose and function of the telephone invention disclosed in the '169 patent is for individuals confined within a correctional or other facility to use the phone hands free, and to prevent user-access to phone cords and handsets, the term "handset" should be interpreted to mean "an earpiece and mouthpiece and equivalents." (Id., at 1). Moreover, Plaintiffs argue that the patent is written in means-plus-format. (Id., at 1-2). Therefore, Plaintiffs claim that although the patent specifications describe the means for mounting a handset within the phone housing using a conventional handset with a handle, earpiece, and mouthpiece in one piece, "the equivalent of a mounted, one-piece handset arrangement is that of an earpiece and mouthpiece separately mounted to the phone housing." (Id., at 2). Thus, Plaintiffs state that this alternative embodiment, although not claimed in the patent, should be included in order to construe properly the term "handset." (Id.). Lastly, TIP Systems avers that a secondary purpose of the invention is to eliminate a removable handset. (Id.). As a result, Plaintiffs argue that the function of the term "handset" within the context of the '169 patent "should not be held limited to an embodiment where the handle, earpiece and mouthpiece are actually in one piece." (Id.).

Defendants argue that based on the patent specifications of the '169 patent, the word "handle" should not be eliminated from the definition of a "handset." (Instrument No. 89, at 1). Further, Defendants claim that the '169 patent invention (the inmate telephone) would not function as set forth in the patent specifications if "handset" did not include a handle. (Id., at 2). Defendants refer to the drawings of the invention to argue that "[t]he only structure of the '169 patent that corresponds to the 'means for permanently mounting the telephone handset' is bracket assembly 40, which holds the handset in place by engaging handle 26." (Id.). Therefore, Defendants conclude that if the handset did not have a handle, the "means for permanently mounting the telephone handset" would not work. (Id.). Moreover, Defendants claim that the intrinsic evidence (i.e., patent specifications and drawings) is "clear and unambiguous," and therefore any reliance on extrinsic evidence to support a claim construction argument with respect to the term "handset" is improper. (Id.).

Language contained in both claims 1 and 6 of the '828 patent is also in dispute. The language of Claim 1 of the '828 patent provides as follows,

1. A telephone for permanent mounting to a mounting surface in environments wherein the telephone is subject to abuse, comprising:

a housing, a mouthpiece, an earpiece, an electronic circuit board, a push button dialing pad, a phone line and a dial tone actuating switch;

said housing including a housing front wall;

said housing front wall including a front wall inner surface;

said housing front wall including a plurality of aural apertures, a plurality of push-button apertures and dial tone actuating switch aperture;

said mouthpiece and said earpiece mounted to said front wall;

said mouthpiece and said earpiece extending outward from said housing through said aural apertures such

that a user places his or her ear next to said aperture for said earpiece;

said earpiece and said mouthpiece each being secured to said aural apertures by an *annular seal*;

said earpiece and said mouthpiece presenting an external relief surface for positioning said ear and a mouth of said user;

said mouthpiece and said earpiece electrically connected to said electronic circuit board ...

said dial tone actuating switch electrically connected to said phone line and said electronic circuit board; ...

(Instrument No. 88, Exhibit B, at 4-5) (emphasis added).

First, Defendants contend that the language in claims 1 and 6 of the '828 patent and in claims 1 and 12 of the '169 patent relating to the earpiece and mouthpiece extending outward through the front wall should be construed to mean that "both the earpiece and mouthpiece should pass through the apertures in the front wall such that they project out from the front wall." (Instrument No. 82, at 6). Further, Defendants state that they believe a *Markman* ruling is unnecessary on this language, as the meaning of this term is made clear through the description in the patent specifications as well as the context of the claims. (*Id.*). Plaintiffs argue that the Court should consider both the functional and physical definitions of the term "through" when making its determination as to the meaning of the claim language related to the mouthpiece and earpiece extending outward through the front wall. (Instrument No. 91, at 6-14).

Next, the Plaintiffs and Defendants are in disagreement about the construction of the phrase, "said dial tone actuating switch electrically connected to said phone line and said electronic circuit board," located in claims 1 and 6 of the '828 patent. Defendants argue that the term "and" in the claim language is used in the conjunctive sense, and therefore, the term should be construed to mean that "the activating switch is directly connected to *both* the phone line and the electronic circuit board." (Instrument No. 82, at 9) (emphasis in original). On the other hand, Plaintiffs aver that Defendants' construction of this term requires two direct connections-which Plaintiffs maintain is inconsistent with and not supported in either the claims or the specifications of the '828 patent. (Instrument No. 91, at 14-15). For the construction of this term, Defendants relied solely on the arguments made in their brief, and did not put forth additional arguments during the *Markman* hearing.

The last significant term in dispute in claims 1 and 6 of the '828 patent is "said earpiece and said mouthpiece presenting an external relief surface for positioning said ear and a mouth of said user." Plaintiffs' argue that in construing this term, the Court must take into account the alternative embodiment conceived of in the '828 patent, and conclude that the term "relief" means not only the Defendants' proposed construction, "raised" or "projected," but also, "distinction or prominence resulting from contrast." (Instrument No. 91, at 17-18). Plaintiffs attempt to bolster their argument by further arguing that the inventor of the inmate telephone confirmed that the term "relief," as used in the '828 patent means "distinction or prominence resulting from contrast." (*Id.*, at 18). Plaintiffs state that their construction naturally includes "both raised-surface earpiece and mouthpiece configurations, recessed-surface earpiece and mouthpiece configurations and flush-surface earpiece and mouthpiece configurations." (*Id.*, at 19). Similar to the Plaintiffs' argument, Defendants believe that the construction of this term is dependent upon the term "external relief surface." (Instrument No. 82, at 11). Defendants, however, argue that the Court should adopt the ordinary and customary meaning of the term "relief," "raised" or "projected," given the

figures and words in the patent that describe the inmate telephone. (Id.). Further, Defendants believe this interpretation of the term results in the claim term being construed to mean, "the earpiece and the mouthpiece present a raised surface that is external to the phone for positioning the ear and a mouth of the user." (Id., at 13).

Lastly, Plaintiffs and Defendants disagree about the construction of the term "annular seal." Based on the ordinary and customary meaning of annular, Defendants believe that the term should be construed to mean "a ring-like structure that provides a seal." (Instrument No. 82, at 13). On the other hand, Plaintiffs believe that the word "structure" is unnecessary, and should therefore be construed to mean "a circular seal." (Instrument No. 91, at 20).

The following table summarizes the proposed claim constructions by both the Plaintiffs' and the Defendants'. The contested claims are indicated in parentheses.

DISPUTED TERM	PATENT NO. (claims that include the disputed term)	PLAINTIFFS' PROPOSED CONSTRUCTION	DEFENDANTS' PROPOSED CONSTRUCTION
"handset"	'169 patent (claims 1 and 12)	"earpiece and mouthpiece and equivalents"	"a handle with an earpiece at one end and a mouthpiece at the opposite end"
"earpiece ... and mouthpiece ... permanently extend out through the front wall"	'169 patent (claims 1 and 12)	"said mouthpiece and said earpiece extending outward from said housing 'to a conclusion or accomplishment;' 'among or between; in the midst of said aural apertures"	"both the earpiece and mouthpiece pass through apertures in the front wall such that they project out from the front wall"
"said mouthpiece and said earpiece extending outward from said housing through said aural apertures"	'828 patent (claims 1 and 6)		
"said dial tone actuating switch electronically connected to said phone line and said electronic circuit board"	'828 patent (claims 1 and 6)	"the dial tone actuating switch is electrically connected to said phone line and said electronic circuit board, such that electricity can pass among these elements"	"the dial tone actuating switch must be electrically connected to both the phone line and the electronic circuit board"
"said earpiece and said mouthpiece presenting an external relief surface for positioning said ear and a mouth of said user"	'828 patent (claims 1 and 6)	"distinction or prominence resulting from contrast"	"the earpiece and the mouthpiece present a raised surface on the outside of the phone for positioning the ear and a mouth of the user"
"annular seal"	'169 patent (claims 3 and 13)	"circular seal"	"a ring-like structure that provides a seal"

II.

Whoever without authority makes, uses, or sells any patented invention within the United States during the term of the patent therefore, infringes the patent. 35 U.S.C. s. 271(a). The determination of whether a claim of a patent has been infringed is a two-step process. First, the Court must determine the meaning and scope of the patent claims asserted to be infringed. *See* Bell Atl. Network Servs., Inc. v. Covad Comms. Group, Inc., 262 F.3d 1258, 1267 (Fed.Cir.2001); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995), *aff'd*, 116 S.Ct. 1384 (1996). This step is commonly known as claim construction or interpretation. Second, the court must compare the claims alleged to be infringed to the accused device. *See* Bell Atlantic, 262 F.3d at 1267; *Markman*, 52 F.3d at 976.

Claim interpretation is a matter of law involving the review of patent specifications, prosecution history, language of the patent claims, and, if necessary, extrinsic evidence. *See* Texas Instruments v. U.S. Int'l Trade Comm'n, 988 F.2d 1165, 1171 (Fed.Cir.1993). The court must decide and explicate its findings regarding claim construction on the record. *See* Genentech, Inc. v. Wellcome Foundation Ltd., 29 F.3d 1555 (Fed.Cir.1994).

"[A]s a general rule, all terms in a patent claim are to be given their plain, ordinary and accustomed meaning to one of ordinary skill in the relevant art." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed.Cir.2001). *See also* *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299 (Fed.Cir.1999) ("[W]ords in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning."). In addition, unless required to do otherwise, a court should give a claim term "the full range of its ordinary meaning as understood by an artisan of ordinary skill." *Rexnord*, 274 F.3d at 1342 (citing *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed.Cir.1999)).

In construing patent claims, the Court looks to the intrinsic evidence of claim meaning—the claims, the specification of the patent, and the prosecution history of the patent. *See* *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582-83 (Fed.Cir.1996). If the intrinsic evidence is clear, "it is improper to rely on extrinsic evidence in construing the patent claims." *Id.* at 1583. In fact, when the meaning of a disputed claim term is clear from the intrinsic evidence, *i.e.*, the intrinsic evidence is unambiguous, then that meaning and no other must prevail; it is improper for the court to rely on extrinsic evidence to alter or supersede that meaning. *See* *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 706 (Fed.Cir.1997).

It is well established that "the language of the claim defines the scope of the protected invention." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619 (Fed.Cir.1995). The Court first must look at the claim language and ascribe the plain and ordinary meaning to the phrase. *See* *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 955 (Fed.Cir.2000). The Federal Circuit has indicated that the claim language itself defines the scope of the claim, and a construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves. *See* *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed.Cir.1997), *overruled on other grounds by* *Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448, 1456 (Fed.Cir.1998). "A court must therefore 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., Inc.*, 175 F.3d at 989.

Although the focus should be on the ordinary meaning, the specification and prosecution history cannot be ignored. *See Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1277 (Fed.Cir.1995) (stating that claim terms are given their ordinary meaning unless the specification, prosecution history, and other claims indicate a contrary intent). A patent specification is the written description of the patented invention that "describe[s] the manner and process of making and using" the patented invention. *Autogiro Co. of America v. United States*, 384 F.2d 391, 397-98 (Ct.Cl.1967). "The descriptive part of the specification aids in ascertaining the scope and meaning of the claims inasmuch as the words of the claims must be based on the description. The specification is, thus, the primary basis for construing the claims." *Standard Oil Co. v. Am. Cynamid Co.*, 774 F.2d 448, 452 (Fed.Cir.1985). *See also* *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed.Cir.1998)("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.").

The prosecution history consists of the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent. *Autogiro*, 384 F.2d at 399. Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent. *See Lemelson v. Gen. Mills, Inc.*, 968 F.2d 1202, 1206 (Fed.Cir.1992). However, because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes. *See Inverness Med. Switz. GmbH v. Awarner Lambart Co.*, 309 F.3d 1373, 1380-82 (Fed.Cir.2002).

Use of the specification and the prosecution history, however, must be balanced with the principle that it is impossible to read a particular embodiment into the claim. *See Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87 (Fed.Cir.1998). In other words, while claims should be read in view of the specification, it is improper to limit the scope of a claim to the preferred embodiment or specific examples disclosed in the specification. *See Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1303 (Fed.Cir.1997). The Federal Circuit has consistently found that a patent is not restricted to the examples but is defined by the words of the claims. *See Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 987 (Fed.Cir.1988).

What is important is what the elements of the claim require, not what they "do not cover." *See, e.g., NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed.Cir.2002). Claims are not to be interpreted in view of the accused infringing device. *See Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1141 (Fed.Cir.1997). Courts have routinely rejected an accused infringer's attempt to show that his device is outside the scope of the claims by asserting a distinction that is not specifically claimed. *See, e.g., Shamrock Techs., Inc. v. Med. Sterilization, Inc.*, 903 F.2d 789, 793 (Fed.Cir.1990).

The court may also rely on extrinsic evidence to interpret the meaning of a claim. In *Markman v. Westview Instruments*, the Federal Circuit discussed the principles governing claim interpretation, including the role of the specification, prosecution history, and "extrinsic evidence." 52 F.3d at 979-80. It emphasized that extrinsic evidence serves a limited purpose; it facilitates a judge's understanding of the meaning of patent claim language. *Id.* The court explained that:

Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. This evidence may be helpful to explain

scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history. Extrinsic evidence may demonstrate the state of the prior art at the time of the invention. It is useful to show what was then old, to distinguish what was new, and to aid the court in the construction of the patent.

Id. at 980 (internal citations and quotations omitted). "The court may, in its discretion, receive extrinsic evidence in order 'to aid the court in coming to a correct conclusion' as to the 'true meaning of the language employed' in the patent." *Id.* (quoting *Seymour v. Osborne*, 78 U.S. (11 Wall.) 516, 546 (1871) (reviewing a decree in equity)).

The Federal Circuit recently clarified the role of extrinsic evidence in claim construction. In *Phillips v. AWH Corp.*, 415 F.3d 1303, 2005 U.S.App. LEXIS 13954 (Fed Cir. July 12, 2005), the Federal Circuit recognized that it has "viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms." 415 F.3d 1303, 2005 U.S.App. LEXIS 13954 at *40. The court explained:

First, extrinsic evidence by definition is not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning. Second, while claims are construed as they would be understood by a hypothetical person of skill in the art, extrinsic publications may not be written by or for skilled artisans and therefore may not reflect the understanding of a skilled artisan in the field of the patent. Third, extrinsic evidence consisting of expert reports and testimony is generated at the time of and for the purpose of litigation and thus can suffer from bias that is not present in intrinsic evidence.... Finally, undue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the indisputable public records consisting of the claims, the specification and the prosecution history, thereby undermining the public notice function of patents.

415 F.3d 1303, *Id.* at *40-41 (internal citations and quotations omitted).

Thus, the *Phillips* court concluded, "[i]n sum, extrinsic evidence may be useful to the court, but it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence." 415 F.3d 1303, *Id.* at *41-42. The *Phillips* court did not completely invalidate the use of extrinsic evidence "because extrinsic evidence can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean." 415 F.3d 1303, *Id.* at 42. However, the court recognized that "the specification is 'the single best guide to the meaning of a disputed term,' and ... the specification 'acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.'" 415 F.3d 1303, *Id.* at *47-48 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996); *see also* *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1300 (Fed.Cir.2004) ("Even when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents.")).

III.

A.

Disputed Term	Patent No.	Plaintiffs' Construction:	Defendants' Construction:
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"Handset"	'169 (claims land 12)	"earpiece and mouthpiece equivalents"	"a handle with an earpiece at one end and a mouthpiece at the opposite end"
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The term "handset" appears in both claims 1 and 12 of the '169 patent. Parties concede that although the term "handset" is used throughout the 21 claims of the '169 patent, claims 1 and 12 are independent claims upon which claims 2-10 and 13-21 depend. (Instrument No. 88, at 10). Thus, both parties' claim term analysis is presented within the context of claims 1 and 12.

Plaintiffs aver that the '169 patent specifications "discloses and contemplates the mounting of the earpiece and mouthpiece as separate." (*Id.*, at 14). Plaintiffs argue that the "preferred embodiment of the invention is to mount a handset so that it cannot be held by the human hand." (*Id.*, at 9). Thus, Plaintiffs propose that the '169 patent "redefines" the conventional telephone handset in that the handset becomes simply the earpiece and mouthpiece, less a handle. (*Id.*). Plaintiffs' proposed redefinition of the handset stems from the "inmate phone's" function as a hands-free telephone. (*Id.*). Plaintiffs contend that this hands-free function of the phone "necessarily includes embodiments where the only potentially accessible elements, the earpiece and mouthpiece, can be mounted to the housing separately from the handset handle." (*Id.*). Further Plaintiffs argue that "[t]he earpiece and mouthpiece ... do not require a handle for use within the invention, and in actuality the handle itself is rendered non-functional." (*Id.*, at 10; *see also* Exhibit A).

On the contrary, Defendants argue that the elimination of the word "handle" from the definition of handset is improper given the claim language. (Instrument No. 89, at 1). Both claims 1 and 12 in the '169 patent define a telephone handset "as being a *handle* with an earpiece at one end and a mouthpiece at an opposite end." (*Id.*, Exhibit 1, at 5-6 (claims 1 and 12)). Defendants offer in furtherance of this contention the drawings in the '169 patent, which include a conventional telephone handset consisting of a handle, an earpiece, and a mouthpiece. (*Id.*, Exhibit 1, at figure 3). Claim construction requires the Court to first look to the claims within the patent to discern the meaning of a disputed term. *Phillips*, 415 F.3d at 1312-13.

Plaintiffs, in an effort to bolster their argument, claim that based on means-plus-function claim interpretation, this Court is not required to adopt Defendants' limitation-the inclusion of the word "handle." (Instrument No. 88, at 11-14). Means-plus-function claim format is applicable "to purely functional limitations that do not provide the structure that performs the recited function." *Phillips*, 2005 U.S.App. LEXIS 13954, at (citing *Watts v. XL Sys. Inc.*, 232 F.3d 877, 880-81 (Fed.Cir.2000)); *see also* 35 U.S.C. s. 112, para. 6 (stating that "[a]n element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts ..."). In determining a claim based on means-plus-function analysis, structures presented in the specifications as well as equivalent structures not disclosed in the specifications ought to be considered. (*Id.*). The construction of a means-plus-function limitation requires the court "first to identify the claimed function and then to determine the structure in the specification that corresponds to that function." *Frank's Casing Crew v. Weatherford Int'l Inc.*, 389 F.3d 1370, 1376 (Fed.Cir.2004).

The claim language in the '169 patent states "means for permanently mounting the telephone handset vertically within the front wall of the housing." (Instrument No. 88, Exhibit A, at 5-6). Plaintiffs contend that the use of the word "means" renders 35 U.S.C. s. 112, para. 6 applicable, and "the Court must look to the corresponding structure disclosed in the specification, as well as equivalents, to interpret claims 1 and 12, and in defining the term 'handset.'" (*Id.*, at 12). Defendants on the other hand, argue that the term "handset" is not governed by a means-plus-function analysis because they allege that the term "handset is not the structure that corresponds to the means for permanently mounting." (Instrument No. 89, at 7).

Defendants believe the bracket assembly is the only element of the invention that corresponds to the "means for permanently mounting." (*Id.*, at Exhibit 1, Figure 3). Therefore, because Defendants' construction of the claim term "means for permanently mounting" does not include the "handset," they believe that a means-plus-function analysis is unnecessary. (*Id.*, at 8). The Court agrees with Defendants' assessment, and concludes that means-plus-function analysis is improper given the fact that the means by which the phone is mounted relates to the bracket assembly.

Lastly, Plaintiffs cite to the prosecution history of the '169 and '828 patents to support their interpretation of the term "handset." (Instrument No. 88, at 18). Here, Plaintiffs highlight the fact that they were required to file a terminal disclaimer as a part of the '828 patent because "an obvious-type double patenting rejection" was issued by the Patent Examiner "because all the present claimed features of the telephone, such as the housing, its various apertures, the keys, the volume control, the mouthpiece and the earpiece were all substantially claimed in the ['169] patent ..." (*Id.*, Exhibit C, at 2-3).

The fundamental difference between the '169 and the '828 patents is that the telephone in the '828 patent does not include a handle. (Instrument No. 89, at 6, Figure 3). Therefore, in the drawings and specifications of the '828 patent, the earpiece and mouthpiece elements of the telephone are located in the housing unit as separate from a handle. (Instrument No. 88, Exhibit B, at Sheet 2). Thus, Plaintiffs believe that the '828 patent's use of the earpiece and mouthpiece as separate elements can be imputed as a contemplated use of the same elements within the '169 patent. (*Id.*, at 19). Defendants point out that the '828 patent application was rejected because the claims included the term "handset," although no handset was shown in the drawings submitted along with the application. (Instrument No. 89, at 6). Subsequently, Plaintiff replaced the term "handset" in the '828 patent with the phrase "mouthpiece and earpiece." (*Id.*). Further, Defendants note that "[n]o argument was made that the mouthpiece and earpiece ... in the '828 patent was actually a 'handset' ". (*Id.*, at 6) (citing Exhibit 3, at 59). In fact, Plaintiffs distinguished the handset in the '169 patent from the earpiece and mouthpiece in the '828 patent by stating that:

The present application varies from the ['169 Patent] primarily in the structure of the earpiece/mouthpiece. In the ['169 Patent], the earpiece and mouthpiece were integral in a standard telephone handset. In the present application, the earpiece and mouthpiece are not integral into a single standard handset.

(Instrument No. 89, at 6) (citing Exhibit 2, at 59-60).

The Court first looks to the claims for the meaning of a disputed claim term. Phillips, 415 F.3d at 1312-13. Because the claim language specifically states that a "handset" is a handle with an earpiece at one end and a mouthpiece at an opposite end, claims 1 and 12 of the '169 patent should be construed as such. The patent specifications, claims, and drawings—all intrinsic evidence—state and show that a "handset" consists of three elements: (1) a handle; (2) a mouthpiece; (3) an earpiece. This Court does not adopt Plaintiffs' proposed means-plus-function analysis because the phrase "means for permanently mounting" refers to the bracket assembly shown in the patent, and not the "handset" itself. Even more telling is the prosecution history of the '169 patent. Plaintiffs correctly state that the '828 patent was rejected for obvious-type double patenting. More specifically, however, the '828 patent prosecution history shows that Plaintiffs made an argument that the mouthpiece and earpiece were in fact a "handset." Ultimately, Plaintiffs simply replaced the term "handset" in the '828 patent with the phrase "earpiece and mouthpiece," conceding that no "handset" existed in the '828 patent. Accordingly, the Court finds that the proper construction for the term "handset" is "***a handle with an earpiece at one end and a mouthpiece at the opposite end.***"

B.

Disputed Term	Patent No.	Plaintiffs' Construction:	Defendants' Construction:
"earpiece ... and mouthpiece ... permanently extend out through the front wall"	'169 patent (claims 1 and 12)	"said mouthpiece and said earpiece extending outward from said housing 'to a conclusion or accomplishment;' 'among or between; in the midst of said aural apertures"	"both the earpiece and mouthpiece pass through apertures in the front wall such that they project out from the front wall"
"said mouthpiece and said earpiece extending outward from said housing through said aural apertures"	'828 patent (claims 1 and 6)		

Defendants note in their Joint Claim Construction Brief that because these terms are readily understood from the context of the claims, a *Markman* ruling on this term is not needed. (Instrument No. 82, at 6). Defendants state that because the Plaintiff believes this term requires interpretation from the Court, they offer a proposed construction. (*Id.*). Claims 1 and 12 of the '169 patent and Claims 1 and 6 of the '828 both include language regarding the extension of the earpiece and mouthpiece through the front wall of the housing. (Instrument No. 88, Exhibits A, B). Defendants argue that the plain language of the claims "indicates that the earpiece and mouthpiece must pass through the apertures in the front of the housing and at least a portion of the earpiece and the mouthpiece must project out from the front wall of the phone." (Instrument No. 82, at 6). Defendants point to the patent specifications to note that,

... the improvement comprises a facility for permanently mounting the telephone handset vertically within the front wall of the housing, so that the earpiece positioned at the top and mouthpiece positioned at the bottom will permanently extend out through the front wall of the housing to be used by inmates hands free.

(Instrument No. 88, Exhibit A, at 2-3). The '828 patent includes similar language. The patent states,

[a]ural output and input to inmate phone is provided by earpiece and mouthpiece, both being mounted to the interior of the housing front wall and extending outward from housing front wall through aural apertures

(*Id.*, Exhibit B, at 2). Therefore, Defendants believe that the drawings coupled with the patent specifications leads to the conclusion that the earpiece and mouthpiece must project out from the front wall housing. (Instrument No. 82, at 8). Moreover, Defendants draw from the prosecution history to support their contention. "In response to a rejection over the prior art, applicant argued that his invention 'requires the user to place his ear next to the earpiece.' " (*Id.*) (citing Exhibit 4, at 60 where Plaintiffs contrasted this to the prior art where the earpiece and mouthpiece were internal to the housing).

Plaintiff brings to the Court's attention alternative embodiment language in the patent specifications of the '828 patent. This language supports the contention that the '828 patent "includes both raised-surface earpiece and mouthpiece configurations, recessed-surface earpiece and mouthpiece configurations and flush-surface earpiece and mouthpiece configurations." (Instrument No. 91, at 19).

In an alternative embodiment, earpiece 28 and mouthpiece 30 are mounted within the inmate phone 10,

preferably to front wall inner surface 21, such that no portion of earpiece 28 or mouthpiece 30 extend through housing front wall 20. In this embodiment, aural communication to earpiece 28 and mouthpiece 30 is afforded through a sound transparent section of housing front wall 20, such as a plurality of small holes (not shown). This sound transparent section provides protection to earpiece 28 and mouthpiece 30, while allowing sound to pass through.

(Instrument No. 88, Exhibit B, at 3:11-14).

The Court first looks to the claims for the meaning of a disputed claim term. Phillips, 415 F.3d at 1312-13. The claims in both the '828 patent and the '169 patent support Defendants' construction that the earpiece and the mouthpiece in both inventions physically extend out through the aural apertures. (Instrument No. 88, Exhibits A, B). The alternative embodiment described in the '828 patent specification cannot be incorporated into the claim language when the claim language does not include the embodiment. Johnston Assoc. v. R.E. Service Co., 285 F.3d 1046 (Fed.Cir.2002). Upon a review of the '169 and '828 patents and the arguments of the parties, the Court finds that the term "said mouthpiece and said earpiece extending outward from said housing through said aural apertures" means "***both the earpiece and mouthpiece pass through apertures in the front wall such that they project out from the front wall.***"

C.

Disputed Term	Patent No.	Plaintiffs' Construction:	Defendants' Construction:
"said dial tone actuating switch electronically connected to said phone line and said electronic circuit board"	'828 patent (claims 1 and 6)	"the dial tone actuating switch is electrically connected to said phone line and said electronic circuit board, such that electricity can pass among these elements"	"the dial tone actuating switch must be electrically connected to both the phone line and the electronic circuit board"

The term "said dial tone actuating switch electronically connected to said phone line and said electronic circuit board" appears in claims 1 and 6 of the '828 patent. (Instrument 88, Exhibit B). Defendants point out that the patent specification language says that the "[d]ial tone actuating switch 36 is electrically connected between phone line 58 *and* electronic circuit board 19." (*Id.*, Exhibit B, at 3) (emphasis added). Further, Defendants assert that the use of the word "and" "is in the conjunctive and means that both conditions must occur." (Instrument No. 82, at 9). *Mars, Inc. v. H.J. Heinz Co., L.P.*, 371 F.3d 1369, 1376 (Fed.Cir.2004) (holding that the term mixture of lipid *and* solid ingredients requires that both elements be present). The parties seem to agree that the dial tone actuating switch is electronically connected to the phone line and the electronic circuit board. They disagree, however, as to whether the dial tone switch is connected to two separate, direct electrical connections or whether the dial tone switch is connected such that electricity can flow among the phone line and electronic circuit board. (Instrument No. 91, at 15-16). Plaintiffs argue that its invention uses a standard, non-patented, dial tone actuating switch component. (*Id.*, at 15). Moreover, Plaintiffs state that "[t]here is no indication that the patent disclosed anything but standard electrical phone connections as it pertains to these elements of the phone, whereby electricity passes between said connections." (*Id.*, at 16). While Plaintiffs rely on the drawings in the '828 patent, their embodiment is not clear from the figures. Plaintiffs contend, however, that Defendants' "interpretation improperly limits the electrical connection to a configuration where the dial tone actuating switch is electrically connected to the phone line in one connection and the circuit board in a separate connection." (*Id.*). The Court notes that Defendants elected not to argue this term at the *Markman* hearing, and instead relied solely on their claim

construction brief.

From the patent and the specifications it appears necessary for the dial tone actuating switch to connect to both the phone line and electronic circuit board whereby electricity passes through these elements. Accordingly, the Court finds that the proper construction for the phrase is "*said dial tone actuating switch electronically connected to both the said phone line and said electronic circuit board, such that electricity can pass among these elements.*"

D.

Disputed Term	Patent No.	Plaintiffs' Construction:	Defendants' Construction:
"said earpiece and said mouthpiece presenting an external relief surface for positioning said ear and a mouth of said user"	'828 patent (claims 1 and 6)	" distinction or prominence resulting from contrast"	"the earpiece and the mouthpiece present a raised surface on the outside of the phone for positioning the ear and a mouth of the user"

The phrase "said earpiece and said mouthpiece presenting an external relief surface for positioning said ear and a mouth of said user" appears in claims 1 and 6 of the '828 patent. (Instrument No. 88, Exhibit B). The parties are in dispute about the construction of the claim term "external relief surface." Defendants propose using the ordinary and customary meaning of "relief" to define the term. (Instrument No. 82, at 11). The term as defined by the Webster's Dictionary means "the projection of a figure or a part from the ground or plane on which it is formed, as in sculpture or similar work." WEBSTER'S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH LANGUAGE 1212 (1996). From this definition, Defendants infer that "relief" means "raised" or "projected." (Instrument No. 82, at 11). Thus, Defendants believe that the ordinary and customary meaning of "external relief surface" is a "raised or projected surface that is external to." (Id.). Defendants rely on this definition, derived from Webster's Dictionary, and the drawings offered as part of the '828 patent to support their argument, as the terms "relief" and "external relief surface" appear only in the claims of the patent. (Id.). Defendants do, however, cite to the description of the earpiece and mouthpiece as further evidence that the elements "are raised relative to the outside surface of the phone." (Id.).

Aural output and input to inmate phone 10 is provided respectively by earpiece 28 and mouthpiece 30, both being mounted to the interior of housing front wall 20 and *extending outward* from housing front wall 20 through aural apertures 38.

...

In the preferred embodiment, inmate phone 10 is mounted on building wall 14 at a height such that earpiece 28 is approximately level with the ear of an average height adult user.... The user then places his ear next to *extended* earpiece 28....

(Instrument No. 88, Exhibit B, 2-4). Plaintiffs' position is that the term "relief," as used in the '828 patent, means "distinction or prominence resulting from contrast." (Instrument No. 91, at 17). In Plaintiff's opinion, this includes "both raised-surface earpiece and mouthpiece configurations and flush-surface earpiece and mouthpiece configurations, so long as the phone user can identify and access the earpiece and mouthpiece

elements while using the phone." (Id.). Plaintiffs attack Defendants' proposed construction by saying that they chose to use one limited definition of "relief," and as a result, Defendants' proposed construction does not adequately describe the invention within the context of the '828 patent. (Id.). While the Defendants pointed out specifications in the '828 patent to support their position that the patent contemplated only earpiece and mouthpiece elements which extended outward from the housing front wall, Plaintiff brings to the Court's attention alternative embodiment language in the patent specifications. This language supports the contention that the '828 patent "includes both raised-surface earpiece and mouthpiece configurations, recessed-surface earpiece and mouthpiece configurations and flush-surface earpiece and mouthpiece configurations." (Id., at 19).

In an alternative embodiment, earpiece 28 and mouthpiece 30 are mounted within the inmate phone 10, preferably to front wall inner surface 21, such that no portion of earpiece 28 or mouthpiece 30 extend through housing front wall 20. In this embodiment, aural communication to earpiece 28 and mouthpiece 30 is afforded through a sound transparent section of housing front wall 20, such as a plurality of small holes (not shown). This sound transparent section provides protection to earpiece 28 and mouthpiece 30, while allowing sound to pass through.

(Instrument No. 88, Exhibit B, at 3:11-14).

The specifications of the '828 patent not only specifically provide for a preferred embodiment that includes raised-surface earpiece and mouthpiece elements, but also an alternative embodiment where the earpiece and mouthpiece are mounted within the invention, with no portion of either of the elements extending through the front wall housing. (Instrument No. 88, Exhibit B, at 3). The Court notes, however, that this alternative embodiment is not provided for in the claim language of the '828 patent.

The Court first looks to the claims for the meaning of a disputed claim term. Phillips, 415 F.3d at 1312-13. The claims in the '828 patent support Defendants' construction that the earpiece and the mouthpiece in the telephone physically extend out through the aural apertures. (Instrument No. 88, Exhibits A, B). As noted by both parties, the patent specification expressly mentions an alternative embodiment whereby the earpiece and the mouthpiece are mounted within the invention. While it is obvious that Plaintiffs foresaw this alternative embodiment, they declined to claim the alternative inmate phone. The failure to claim the alternative embodiment is fatal, and precludes Plaintiffs from now arguing that the alternative should be considered in the Court's determination of the proper construction of the term "external relief surface." Maxwell v. J. Baker, Inc., 86 F.3d 1098, 39 USPQ2d 1001 (Fed.Cir.1996). The alternative embodiment described in the '828 patent specifications cannot be incorporated into the claim language when the claim language does not expressly include or provide for the alternative embodiment. Johnston Assoc., 285 F.3d 1046 (holding that patent which claimed only use of aluminum substrate, was not infringed under doctrine of equivalents by products using steel substrate, because use of steel was disclosed but not claimed in the patent). Accordingly, the Court finds that the proper construction for the phrase is "*the earpiece and the mouthpiece present a raised surface on the outside of the phone for positioning said ear and mouth of said user.*"

E.

Disputed Term	Patent No.	Plaintiffs' Construction:	Defendants' Construction:
"annular	'169 patent (claims 3	"circular seal"	"a ring-like structure that

seal" and 13)
'828 patent (claim 1)

provides a seal"

The term "annular seal" appears in claims 3 and 13 of the '169 patent and claim 1 of the '828 patent. (Instrument No. 88, Exhibits A, B). Defendants rely on the ordinary and customary meaning of annular, which is "having the form of a ring." WEBSTER'S ENCYCLOPEDIA UNABRIDGED DICTIONARY OF THE ENGLISH Language 60 (1996). They combine this definition with "seal" to create a proposed construction of the term, "a ring-like structure that provides a seal." (Instrument No. 82, at 13). Further, Defendants point to figure 3 of both the '169 and '828 patents to show that "the annular seal 42 is in the shape of a ring and forms a seal to prevent gas, air, and other materials from entering the interior of the phone." (Id., at 14). Plaintiffs, however, argue that Defendants' proposed construction, including the limitation "structure," is improper. (Instrument No. 91, at 20). Plaintiffs contend that because "[n]o such limitation is contained within the patents, [] no such limitation should be read into the patents. (Id.). Plaintiffs believe that a structure is not "necessary to provide a seal within the patents." (Id.). Defendants relied solely on their brief for this term, and elected not to provide the Court with additional arguments during the *Markman* hearing.

There is no need to define the term with an additional limitation stating that an "annular seal" is "a ring-like structure that provides a seal." If the term "annular seal" were defined in such a way it would render the explicit limitations of the claims as mere surplusage. *See Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed.Cir.1993) (noting that a proposed construction would render the disputed claim language mere surplusage because "courts can neither broaden nor narrow claims to give the patentee something different than what he has set forth") (quoting *Autogiro Cp. of Am. v. United States*, 384 F.2d 391, 396 (Ct.Cl.1967)). Accordingly, the Court finds that the proper construction for the term "annular seal" is "*ring-like seal*."

IV.

Accordingly, IT IS HEREBY ORDERED that the disputed terms shall have the following claim constructions:

DISPUTED TERM	PATENT NUMBER	CLAIM CONSTRUCTION
"handset"	'169	"a handle with an earpiece at one end and a mouthpiece at the opposite end"
"earpiece ... and mouthpiece ... permanently extend out through the front wall"	'169	
"said mouthpiece and said earpiece extending outward from said housing through said aural apertures"	'828	"both the earpiece and mouthpiece pass through apertures in the front wall such that they project out from the front wall"
"said dial tone actuating switch electronically connected to said phone line and said electronic circuit board"	'828	"said dial tone actuating switch electronically connected to both the said phone line and said electronic circuit board, such that electricity can pass among these elements."
"said earpiece and said mouthpiece presenting an external relief surface for	'828	"the earpiece and the mouthpiece present a raised surface on the outside of the phone for positioning said

positioning said ear and a mouth of said user"		ear and mouth of said user"
"annular seal"	'169, '828	"ring-like seal"

The Clerk shall enter this Order and provide a copy to all parties.

S.D.Tex.,2006.

TIP Systems, LLC v. Phillips & Brooks/Gladwin

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