

United States District Court,  
E.D. Texas, Marshall Division.

**RING PLUS, INC,**  
Plaintiff.

v.

**CINGULAR WIRELESS, LLC, Cingular Wireless II, LLC, Cingular Wireless Corp., and AT & T  
Wireless Services, Inc,**  
Defendants.

Civil Action No. 2:06-CV-159-DF

**July 9, 2007.**

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Larry Dean Carlson, Barton Earl Showalter, David Osborn Taylor, Douglas Mark Kubehl, Baker Botts, Dallas, TX, Diane Devasto, Michael Edwin Jones, Potter Minton, PC, Tyler, TX, for Defendants.

### ***CLAIM CONSTRUCTION ORDER***

**DAVID FOLSOM, District Judge.**

Before the Court is the Opening Claim Construction Brief filed by Plaintiff Ring Plus. Dkt. No. 63. Also before the Court is Defendants' Responsive Claim Construction Brief and Plaintiff's Reply Claim Construction Brief. Dkt. Nos. 78 & 87. The Court held a hearing on June 21, 2007. After considering the patents, arguments of counsel, and all other relevant pleadings and papers, the Court finds that the claims of the patents-in-suit should be construed as set forth herein.

#### **I. BACKGROUND**

Plaintiff brought suit alleging infringement of United States Patent No. 7,006,608 (the "'608 Patent"), which relates to telecommunications. *See* Complaint, Dkt. No. 1.

Defendants deny infringement, asserts the affirmative defenses of invalidity, estoppel, and failure to provide marking and notice. Answer, Dkt. No. 13 at 3-5. Defendants counterclaim for declaratory judgments of non-infringement and invalidity. Dkt. No. 13 at 5-6.

#### **II. LEGAL PRINCIPLES OF CLAIM CONSTRUCTION**

A determination of patent infringement involves two steps. First, the patent claims are construed, and,

second, the claims are compared to the allegedly infringing device. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1455 (Fed.Cir.1998) (en banc).

The legal principles of claim construction were recently reexamined by the Federal Circuit in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005) (en banc). Reversing a summary judgment of non-infringement, an en banc panel specifically identified the question before it as: "the extent to which [the court] should resort to and rely on a patent's specification in seeking to ascertain the proper scope of its claims." *Id.* at 1312. Addressing this question, the Federal Circuit specifically focused on the confusion that had amassed from its recent decisions on the weight afforded dictionaries and related extrinsic evidence as compared to intrinsic evidence. Ultimately, the court found that the specification, "informed, as needed, by the prosecution history," is the "best source for understanding a technical term." *Id.* at 1315 (quoting *Multiform Dessicants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed.Cir.1998)). However, the court was mindful of its decision and quick to point out that *Phillips* is not the swan song of extrinsic evidence, stating:

[W]e recognized that there is no magic formula or catechism for conducting claim construction. Nor is the court barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence.

*Phillips*, 415 F.3d at 1324 (citations omitted). Consequently, this Court's reading of *Phillips* is that the Federal Circuit has returned to the state of the law prior to its decision in *Texas Digital Sys. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed.Cir.2002), allotting far greater deference to the intrinsic record than to extrinsic evidence. "[E]xtrinsic evidence cannot be used to vary the meaning of the claims as understood based on a reading of the intrinsic record." *Phillips*, 415 F.3d at 1319.

Additionally, the Federal Circuit in *Phillips* expressly reaffirmed the principles of claim construction as set forth in *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed.Cir.1996), and *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111 (Fed.Cir.2004). Thus, the law of claim construction remains intact. Claim construction is a legal question for the courts. *Markman*, 52 F.3d at 979. The claims of a patent define that which "the patentee is entitled the right to exclude." *Innova*, 381 F.3d at 1115. The claims are "generally given their ordinary and customary meaning" as understood by "a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Vitronics*, 90 F.3d at 1582; *Phillips*, 415 F.3d 1313. However, the Federal Circuit stressed the importance of recognizing that the person of ordinary skill in the art "is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips*, 415 F.3d at 1313.

Advancing the emphasis on the intrinsic evidence, the *Phillips* decision explains how each source, the claims, the specification as a whole, and the prosecution history, should be used by courts in determining how a skilled artisan would understand the disputed claim term. *See, generally, id.* at 1314-17. The court noted that the claims themselves can provide substantial guidance, particularly through claim differentiation. Using an example taken from the claim language at issue in *Phillips*, the Federal Circuit observed that "the claim in this case refers to 'steel baffles,' which strongly implies that the term 'baffles' does not inherently mean objects made of steel." *Id.* at 1314. Thus, the "context in which a term is used in the asserted claim can often illuminate the meaning of the same term in other claims." *Id.* Likewise, other claims of the

asserted patent can be enlightening, for example, "the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Id.* at 1315 (citing *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed.Cir.2004)).

Still, the claims "must be read in view of the specification, of which they are part." *Markman*, 52 F.3d at 978. In *Phillips*, the Federal Circuit reiterated the importance of the specification, noting that "the specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" *Phillips*, 415 F.3d at 1315 (quoting *Vitronics*, 90 F.3d at 1582). To emphasize this position, the court cited extensive case law, as well as "the statutory directive that the inventor provide a 'full' and 'exact' description of the claimed invention." *Id.* at 1316 (citing *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed.Cir.2003)); *see also* 35 U.S.C. s. 112, para. 1. Consistent with these principles, the court reaffirmed that an inventor's own lexicography and any express disavowal of claim scope is dispositive. *Id.* at 1316. Concluding this point, the court noted the consistency with this approach and the issuance of a patent from the Patent and Trademark Office and found that "[i]t is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Id.* at 1317.

Additionally, the *Phillips* decision provides a terse explanation of the prosecution history's utility in construing claim terms. The court simply reaffirmed that "the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.* (citing *Vitronics*, 90 F.3d at 1582-83). It is a significant source for evidencing how the patent office and the inventor understood the invention. *Id.*

Finally, the Federal Circuit curtailed the role of extrinsic evidence in construing claims. In pointing out the less reliable nature of extrinsic evidence, the court reasoned that such evidence (1) is by definition not part of the patent, (2) does not necessarily reflect the views or understanding of a person of ordinary skill in the relevant art, (3) is often produced specifically for litigation, (4) is far reaching to the extent that it may encompass several views, and (5) may distort the true meaning intended by the inventor. *See id.* at 1318. Consequently, the Federal Circuit expressly disclaimed the approach taken in *Texas Digital*. While noting the *Texas Digital* court's concern with regard to importing limitations from the written description, "one of the cardinal sins of patent law," the Federal Circuit found that "the methodology it adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history." *Id.* at 1320. Thus, the court renewed its emphasis on the specification's role in claim construction.

Many other principles of claim construction, though not addressed in *Phillips*, remain significant in guiding this Court's charge in claim construction. The Court is mindful that there is a "heavy presumption" in favor of construing claim language as it would be plainly understood by one of ordinary skill in the art. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed.Cir.1999); *cf. Altiris, Inc., v. Symantec Corp.*, 318 F.3d 1364, 1372 (Fed.Cir.2003) ("[S]imply because a phrase as a whole lacks a common meaning does not compel a court to abandon its quest for a common meaning and disregard the established meaning of the individual words.") The same terms in related patents are presumed to carry the same meaning. *See Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed.Cir.2003) ("We presume, unless otherwise compelled, that the same claim term in the same patent or related patents carries the same construed meaning.") "Consistent use" of a claim term throughout the specification and prosecution history provides "context" that may be highly probative of meaning and may counsel against "[b]roadening of the

ordinary meaning of a term in the absence of support in the intrinsic record indicating that such a broad meaning was intended ...." *Nystrom v. TREX Co.*, 424 F.3d 1136, 1143-46 (Fed.Cir.2005).

Claim construction is not meant to change the scope of the claims but only to clarify their meaning. *Embrex, Inc. v. Serv. Eng'g Corp.*, 216 F.3d 1343, 1347 (Fed.Cir.2000) ("In claim construction the words of the claims are construed independent of the accused product, in light of the specification, the prosecution history, and the prior art.... The construction of claims is simply a way of elaborating the normally terse claim language[ ] in order to understand and explain, but not to change, the scope of the claims.") (citations and internal quotations omitted). Regarding claim scope, the transitional term "comprising," when used in claims, is inclusive or open-ended and "does not exclude additional, unrecited elements or method steps." *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1235 (Fed.Cir.2005) (citations omitted). Claim constructions that would read out the preferred embodiment are rarely, if ever, correct. *Vitronics*, 90 F.3d at 1583-84.

The Court notes that a patent examiner's "Reasons for Allowance," where merely summarizing a claimed invention and not specifically noting that patentability is based on a particular feature, do not limit the scope of the claim. *See Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1375 (Fed.Cir.2003). Similarly, an examiner's unilateral statements in a "Notice of Allowance" do not result in the alteration of claim scope. *See id.*; *see also Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1346-47 (Fed.Cir.2005). "[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable." *Omega Eng'g*, 334 F.3d at 1326. The Federal Circuit has "declined to apply the doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous." *Id.* at 1324.

The doctrine of claim differentiation is often important in claim construction. *Phillips*, 415 F.3d at 1315 (citing *Liebel-Flarsheim*, 358 F.3d at 910). "Claim differentiation" refers to the presumption that an independent claim should not be construed as requiring a limitation added by a dependent claim. *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380 (Fed.Cir.2006). This is in part because "reading an additional limitation from a dependent claim into an independent claim would not only make that additional limitation superfluous, it might render the dependent claim invalid." *Id.*; *see also SRI Int'l. v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1122 (Fed.Cir.1985) ("It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement.") This doctrine is based in part on the presumption that each claim has a different scope. 35 U.S.C. s. 282; *Curtiss-Wright*, 438 F.3d at 1380. The difference in meaning and scope between claims is presumed to be significant to the extent that the absence of such difference in meaning and scope would make a claim superfluous. *Free Motion Fitness, Inc. v. Cybex Int'l*, 423 F.3d 1343, 1351 (Fed.Cir.2005). Although a validity analysis is not a regular component of claim construction, if possible claims should be construed to preserve their validity. *Phillips*, 415 F.3d at 1327; *see also Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed.Cir.1999).

Whether or not the preamble acts as a limitation is properly an issue of claim construction, and therefore a matter of law within the province of the court. *Markman*, 52 F.3d at 979; *see also Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 115 Fed. Appx. 84, 87 (Fed.Cir.2004, unpublished) ("Determining whether a preamble constitutes a limitation is a matter of claim construction ....") There is no presumption that the preamble either is or is not a claim limitation, and there is no litmus test to apply. *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d at 1257. A preamble is a limitation where it gives "meaning to the claim." *Id.* As the Federal Circuit has noted, this "may merely state the problem rather than lead one to the

answer." *Id.* To determine whether or not the preamble is a part of the claim, a review of the entire patent is necessary. *Id.* This is because a claim preamble has the import that the claim as a whole suggests for it. *Bell Commc'ns Research v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 620 (Fed.Cir.1995). General claim construction principles apply to the determination of whether or not a preamble is a limitation. *Id.* ("We construe claim preambles, like all other claim language, consistently with [claim construction] principles.")

As set forth in *Catalina Marketing International v. Coolsavings .com, Inc.*, the case law provides some guidelines for this determination. 289 F.3d 801, 808-09 (Fed.Cir.2002). The preamble may operate as a limitation where: a claim depends on a preamble phrase for an antecedent basis; the preamble is essential to understand limitations or terms in the claim; the preamble recites additional structure or steps underscored as important by the specification; or the patentee has clearly relied on the preamble during prosecution to distinguish the claimed invention from the prior art. *Id.* The preamble generally does not operate as a limitation where the preamble language merely extols benefits or features of the claimed invention or the preamble describes the purpose or use of an invention. *Id.* at 809. "[W]hen the limitations in the body of the claim rely upon and derive an antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed.Cir.2003).

### III. THE PATENTS-IN-SUIT

The '608 Patent, entitled "Software Algorithm and Method Enabling Message Presentation During a Telephone Ringing Signal Period," issued on February 28, 2006. The inventors listed are Karl Seelig and Anita Erickson, and the Abstract reads as follows:

A software based algorithm and associated method for generating and delivering to a caller or a recipient, or both, a message generated over a telephone link during a normal telephone ringing signal period. The software based algorithm and method is operable with hardware designed to accomplish this purpose, and is also effective for use with hard wire based telephone systems and cellular telephone systems. The algorithm and method operate on the basis of identifying a caller, introducing and playing a message and terminating the play of the message when a recipient answers a recipient telephone.

Plaintiff asserts Claims 1, 2, 3, 5, 9, and 10 of the '608 Patent, which read as follows:

1. A software based algorithm for operation of a telephone system in which a generated sound presentation can replace or overlay a ring-back signal normally heard in a caller's telephone until such time as a recipient of a telephone call answers the telephone call, said algorithm comprising the steps of:

- a) initiating those actions to identify the class of persons represented by the caller;
- b) introducing a sound presentation to be generated over the telephone which replaces a portion of or all of the ring-back signal;
- c) determining whether the telephone line of the recipient telephone is busy;
- d) terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy;

- e) initiating those actions to play the introduced message to the caller or the recipient or both; and
- f) terminating the playing of the sound presentation upon answering of the phone call by the recipient.

2. The software based algorithm of claim 1 further characterized in that the algorithm causes initiating those actions to identify the status of the telephone line between the caller and the recipient and terminating the telephone call if recipient telephone line is busy.

3. The software based algorithm of claim 2 further characterized in that the algorithm comprises initiating those actions to select and identify a sound presentation category which contains the message to be generated, before playing of the introduced message.

...

5. The software based algorithm of claim 1 further characterized in that the algorithm initiates those actions to generate and play the sound presentation during a portion of or the entire time that a ringing signal would normally be heard by the caller or the recipient or both.

...

9. A method of generating a sound presentation over a telecommunication link during a portion of or all of a normal ringing cycle period between the completion of a dialing process by a caller and the time when a telephone of the recipient is answered, said method comprising:

- a) initiating a telephone communication by terminating of the sound presentation when the intended recipient answers the telephone;
- b) selecting one or more sound presentations based on the identification of the class of persons represented by the caller before generating of that sound presentation; and
- c) generating the selected one or more sound presentations to be provided during a portion of or the entire time that a ringing signal would normally be generated at the telephone of the recipient and which generated sound presentation can be heard by the caller or the recipient or both;
- d) determining whether the telephone line of the recipient telephone is busy; and
- e) terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy.

10. The method of generating a sound presentation over a telecommunication link of claim 9 further characterized in that the method comprises identifying the class of persons represented by the caller before selecting the one or more sound presentations to be presented.

#### **IV. CLAIM CONSTRUCTION**

The parties request that the Court construe seven terms appearing in the ' 608 Patent. These terms are: (a) "class of persons represented by the caller;" (b) "sound presentation" or "message;" (c) "busy;" (d)

"terminating the telephone call;" (e) "generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy;" (f) "to play the introduced message to the caller or the recipient or both;" and (g) "generated sound presentation can be heard by the caller or the recipient or both." The parties also dispute whether certain steps in Claims 1 and 9 must be performed in a certain order.

Although originally disputed, Plaintiff has adopted Defendants' proposed construction of the term "ring-back signal" as "the audible effect which is normally heard by the caller while waiting for a recipient to answer." Joint Claim Construction Chart ("JCCC") filed 6/8/2007, Dkt. No. 98, Ex. A at 2; Dkt. No. 63 at 28. The parties have further agreed that "the caller" should be construed as "the person placing the current telephone call." JCCC at 1. Also, the parties originally disputed whether step (a) of Claim 1 ("Step 1(a)") ("initiating those actions ...") should be construed as a means-plus-function limitation in accordance with 35 U.S.C. s. 112, para. 6. Defendants have withdrawn their request for such construction. Dkt. No. 78 at 35. The absence of this term from the parties' most recent Joint Claim Construction Chart evidences the parties' agreement that this term does not require construction. Therefore, the Court does not construe it.

## **A. "class of persons represented by the caller"**

### **(1) The Parties' Positions**

The parties agree that the constituent term "the caller" should be construed as "the person placing the current telephone call." JCCC at 1 & 6. Plaintiff proposes this term means "a group of one or more people sharing a common characteristic with the caller." *Id.* Defendants propose this term means "a group of people sharing a common characteristic with the caller." *Id.*

Plaintiff argues that this term may refer to "one particular caller or a group of callers." Dkt. No. 63 at 26. Defendants respond that because the term refers to "persons," which is plural, the term must refer to a group of at least two persons. Dkt. No. 78 at 28-29. Plaintiff's reply adds no further argument. Dkt. No. 87 at 9.

### **(2) Construction**

Generally, a claim element recited in the plural requires two or more of that element. *See, e.g., Leggett & Platt, Inc. v. Hickory Springs Mfg. Co.*, 285 F.3d 1353, 1357-1358 (Fed.Cir.2002) (finding that "the claim recites 'support wires' in the plural, thus requiring more than one welded 'support wire'"). The Court thus searches for any teaching to the contrary in the specification.

The specification does not contain the word "class" outside the claims. *See* '608 Patent. However, in describing Figure 3, the specification teaches that "[a]n identification of the caller is determined at step 62, and when that identification is determined to be a proper identification, a database 64 is actuated at step 66." '608 Patent at 12:54-56. Then, "[a]fter a group of ... messages have been located, one or more particular messages are selected at step 70, based on factors such as the *type of caller*, perhaps the demographics of the *type of caller*, or other information which may be available." *Id.* at 12:61-65 (emphasis added). This "type of caller" language resembles the language in the term "class of persons represented by the caller," particularly where the specification does not define the constituent term "class." The use of the word "caller" in the singular also suggests that a "type" of caller could include a single caller. *Id.* In turn, a "class" of callers could similarly consist of only one caller. The present case is therefore distinguishable from *Leggett* because a person of ordinary skill in the art would understand that the constituent term "class," which is singular, refers to the "type" of caller.

At the claim construction hearing, Defendants suggested that non-asserted Claims 26 and 31 are directed to individual callers while Claims 1 and 9 deal with groups of two or more callers. *See id.* at 21:22-24 & 22:9-14. It is true that a person of ordinary skill in the art is deemed to read a term in the context of the entire patent. Phillips, 415 F.3d at 1313. However, Claims 26 and 31 also differ in that they claim communication between a caller and a "provider or provider-recipient," as well as "billing the recipient for the purchase of a product or service based on the presentation of the message." '608 Patent at 21:9-29 & 21:45-22:14. Because Claims 26 and 31 recite substantially different matter, a person of ordinary skill in the art would not conclude that Claims 26 and 31 were directed toward identifying a single caller while Claims 1 and 9 were directed toward identifying a class of two or more.

The specification teaches: "A memory will be provided for the retention of the various messages, and moreover, data can be associated with those messages, such that when a particular caller initiates a telephone call, a message can be selected for that particular *caller, or group of callers ....*" '608 Patent at 14:41-46 (emphasis added). This teaching suggests that a group consists of more than one caller. The Court therefore declines to use the term "group" to refer to "one or more," as proposed by Plaintiff.

The Court construes the term "class of persons represented by the caller" to mean "one or more persons sharing a common characteristic with the caller."

## **B. "sound presentation" or "message"**

This term appears in Claims 1 and 9.

### **(1) The Parties' Positions**

The parties agree that "sound presentation" and "message" should be construed identically. JCCC at 1 & 5. Plaintiff proposes this term means a "an audible effect that may be a jingle, a voice message, or a tune, possibly with lyrics." *Id.* Defendants propose this term means "the point or points conveyed in an audible advertisement or promotion." *Id.* Defendants also argue "[t]he claims are invalid for addition of new matter under Ring Plus' construction." *Id.* at 1.-2.

Plaintiff submits that in the prosecution history, the patentees substituted the word "sound presentation" for "message" and explained that the claims should not be limited to "straight-forward voice messages." Dkt. No. 63 at 13. Plaintiff also invokes the doctrine of claim differentiation as to Claim 17, which reads as follows:

17. The method of generating a sound presentation over a telecommunication link of claim 16 *further characterized in that the sound presentation is an advertising or promotional message* which is generated during a portion of the entire period in which a ringing signal would normally be heard at the telephone of the recipient.

'608 Patent at 20:4-9 (emphasis added). Plaintiff also notes that "claims 18-25 recite a 'method of presenting an advertising or promotional sound presentation,' " and Plaintiff argues that limiting the term "sound presentation" to advertising or promotional material would render this claim language superfluous. Dkt. No. 63 at 14. Plaintiff also argues that Defendants' proposed construction contradicts language in the specification that the invention relates to "other messages" besides promotional or advertising messages. *Id.* at 15 (quoting '608 Patent at 1:20-30 & 4:12-16).



Defendants respond that "sound presentation" must be construed the same as "message" because no new matter may be introduced into the patent after it is filed. Dkt. No. 78 at 29-30 (citing 35 U.S.C. s. 132). Defendants submit that the patentees substituted the term "sound presentation" for "message" just before allowance of the claims. *Id.* Defendants argue that the Court must construe the term "message" first and then construe "sound presentation" identically. *Id.* at 30. Defendants cite dictionary definitions purportedly showing that a "message" has a "point or points conveyed" and "an underlying theme or idea." *Id.* at 31 (quoting *American Heritage College Dictionary* (3d ed.1997), Dkt. No. 78 at Ex. 12 & *Merriam-Webster's Collegiate Dictionary* (10th ed.2001), Dkt. No. 78 at Ex. 13). Defendants also direct the Court to a provisional patent application from which the '608 Patent claimed priority, which Defendants submit "strictly limits the 'message' to 'advertisements or promotions.'" *Id.* at 31-32 (citing Provisional Patent App. No. 60/301,760, Dkt. No. 78 at Ex. 14). As to claim differentiation, Defendants argue that the phrase "advertising or promotional" is not the only limitation added by the dependent claims. *Id.* at 33. Defendants also submit that Claims 18-25 do not depend from Claim 9. *Id.*

Plaintiff replies that the application resulting in the '608 Patent was a continuation-in-part, so the claims may be supported by disclosures in the continuation-in-part specification. Dkt. No. 87 at 9-10. Plaintiff also reiterates its claim differentiation argument. *Id.* at 10.

## **(2) Construction**

The parties agree that the terms "sounds presentation" and "message" should be construed identically. The Court therefore deems the specification's teachings as to "message" relevant as to "sound presentation," and *vice versa*.

As to the provisional application, "[f]or the non-provisional utility application to be afforded the priority date of the provisional application, the two applications must share at least one common inventor and the written description of the provisional must adequately support the claims of the non-provisional application ...." *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed.Cir.2002). Title 35 U.S.C. s. 132 provides that "[n]o amendment shall introduce new matter into the disclosure of the invention," but the application leading to the '608 Patent was a new application rather than an amendment to the provisional application. Defendants present no authority for limiting the scope of a patent, during claim construction, to the disclosure in a provisional application where the priority date of the patent has not yet been disputed. *See* Dkt. No. 78 at 29-33 (citing *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec.*, 264 F.3d 1111, 1118 (Fed.Cir.2001) & *Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1326-27 (Fed.Cir.2000)). If anything, Defendant's argument bears upon invalidity, which should not usually be considered during claim construction. *Cf.* *Phillips*, 415 F.3d at 1327 ("[W]e have certainly not endorsed a regime in which validity analysis is a regular component of claim construction.") Thus, the Court should not limit itself to the disclosure contained in the provisional application.

Plaintiff's claim differentiation argument fails because Claim 17 contain more limitations than simply that the sound presentation is "an advertising or promotional message." '608 Patent at 20:4-9. In particular, Claim 16, from which Claim 17 depends, recites "generating a billing to the caller," which is a limitation not present in Claim 1 or Claim 9. *Id.* at 20:1; *see id.* at 18:23-43 & 19:10-32.

On the other hand, the specification teaches that the invention is directed to "allow for the generation and presentation of promotional or advertising messages, *or other messages* ...." '608 Patent at 1:26-28

(emphasis added); *see also* '608 Patent at 4:12-14 ("It is also an object of the present invention to provide ... advertising or promotional messages, or other messages, over a telephone communication system ....") A person of ordinary skill in the art, who must read claim terms in the context of the patent as a whole, would therefore understand that the "messages" are not necessarily "promotional or advertising messages." *See Phillips*, 415 F.3d at 1313.

This teaching also minimizes the import of Defendants' argument that the patentees inappropriately amended the application leading to the '608 Patent to change the term "message" to "sound presentation." The term "message" was present in the provisional application and the original application leading to the '608 Patent. *See Provisional Patent App. No. 60/301,760, Dkt. No. 78 at Ex. 14 & Application, Dkt. No. 78, Ex. 3.* Because the teaching as to "other messages" discussed above supports a claim scope beyond "promotional or advertising message," Defendants have not shown that such a construction would necessarily lead to a finding of invalidity. As a result, the Court need not apply the doctrine that courts should construe claims, where possible, to uphold their validity. *See Phillips*, 415 F.3d at 1327.

A "message" or "sound presentation" is something that a "caller may hear." '608 Patent at 8:50. Because something must be audible for it to be heard, the specification teaches that a "message" or "sound presentation" must be audible. Both parties present the word "audible" in their proposed constructions. JCCC at 1 & 5. The specification provides no further guidance on what is heard, aside from that it may be "promotional" in nature, so the Court turns to extrinsic evidence. A "message" is an "oral, written, recorded, or electronic communication sent from one person, group, etc., to another." *Oxford English Dictionary* (2d ed.1989). This definition demonstrates that a "message" is a "communication." The term "communication" will be more helpful to the jury than the more ambiguous term "effect" proposed by Plaintiff. As to Plaintiff's proposed language that the communication "may be a jingle, a voice message, or a tune, possibly with lyrics," the risk that the jury will limit the construction to those examples outweighs the potential benefit of explicitly including them.

The Court therefore construes the terms "sounds presentation" and "message" to mean "an audible communication."

### **C. "busy"**

This term appears in Claims 1 and 9.

#### **(1) The Parties' Positions**

Plaintiff proposes this term means "no transmission path is available." JCCC at 2 & 6. Defendants propose this term "includes any situation where the recipient's telephone is in use or off hook." *Id.* Plaintiff's opening brief agreed that the term "busy" should "include the concept of 'off hook.'" Dkt. No. 63 at 15.

Plaintiff argues that its proposed construction comports with the specification's disclosure of "first checking to see if the phone is off the hook, and if so, checking to see if call waiting is available." *Id.* at 16 (citing '608 Patent at Fig. 4 & 14:8-30). Plaintiff also cites a dictionary that defines a "busy signal" as "an audible or visual signal that indicates that no transmission path ... is available." *Id.* (quoting *Telecommunications: Glossary of Telecommunication Terms* (1997), Dkt. No. 63, Ex. 4 at B-20). Plaintiff proposes that "a telephone will not always be busy when it is 'in use' or 'off hook.'" *Id.* at 17.

Defendants respond that Plaintiff improperly seeks to change the agreed portion of its construction as to this

term to "remove the phrase 'in use' and to substitute the phrase 'no transmission path is available.'" Dkt. No. 78 at 14. Defendants argue that the Court should adopt the "ordinary meaning" of the term "busy." *Id.* Defendants submit that although "off hook" is the term traditionally used to describe busy telephones, wireless or cellular telephones do not have a hook, so "in use" is a more appropriate term. *Id.* at 14-15.

Plaintiff replies that the specification distinguishes between "off hook" and "busy." Dkt. No. 87 at 2. Plaintiff argues that the discussion of "call waiting" in the specification teaches that a telephone is not "busy" if call waiting is available because the invention will still "allow for the playing of the sound presentation even if the recipient's telephone line is 'in use' or 'off hook.'" *Id.* at 3. Plaintiff submits that Defendants seek to exclude this preferred embodiment. *Id.*

## (2) Construction

As a preliminary matter, the Court acknowledges an apparent clerical error in Figure 4 of the '608 Patent. The specification teaches that contrary to Figure 4, the determination of whether call waiting is available should occur if the recipient's telephone is "off hook," not if it is "on hook." See '608 Patent at 14:21-23. The "Is Phone on Hook?" in Block 104 of Figure 4 should therefore read "Is Phone Off Hook?" FN1 A person of ordinary skill in the art would readily ascertain this error and correct it. Defendants have not shown that this error justifies a finding that the patentees did not properly disclose call waiting. The specification's disclosure is adequate. *Id.*

FN1. Alternatively, the "Yes" and "No" appearing adjacent to block 104 could be interchanged.

The parties dispute centers on whether "busy" means that a caller receives a "busy signal" or means that the recipient's telephone is "off hook" or "in use."

Initially, the specification teaches that "[i]f the recipient's ... phone is on hook, a message generation can then be initiated [but][i]f the phone is off hook, for one reason or another, then the method will terminate." '608 Patent at 6:63-66. However, the specification goes on to describe that "even if the [recipient's] phone [is] off hook ... if call waiting is available, then the system can allow for holding for the recipient to answer ...." *Id.* at 14:21-26. A person of ordinary skill in the art would understand that if call waiting is available, then the "the message can be started for presentation" even though the recipient's telephone is "off hook." *Id.* at 14:28-30. The term "busy" should be construed to include this situation. *See Vitronics*, 90 F.3d at 1583-84; *see also Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1581 (Fed.Cir.1996) ("[I]t is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way.")

The claims do not describe the situation in which network congestion, or some other network failure, renders the caller unable to reach the recipient. During the technical tutorial in this matter, Defendants cited a dictionary definition of "busy" teaching:

There are slow busies and fast busies. Slow busies are when the phone at the other end is busy or off-hook. They happen 60 times a minute. Fast busies (120 times a minute) occur when the network is congested with too many calls. Your distant party may or may not be busy, but you'll never know because you never got that far.

*Netwon's Telecom Dictionary* (16th ed.2000). This definition suggests that the "fast busy" network congestion precedes, and is wholly separate from, the determination of whether the recipient's telephone is "busy." Although Claim 1 and Claim 9 refer not simply to the recipient telephone but rather to "the telephone line of the recipient telephone," the claims nonetheless fail to resolve the situation where the caller "never [gets] that far." '608 Patent at 18:33-34 & 19:27-28; *id.* The remaining claims and the specification provide no guidance on this situation. Terminating the telephone call if the network is congested is therefore not a limitation of Claims 1 and 9, and the construction of the term "busy" should reflect this.

The prosecution history cited by Defendants does not limit the scope of the term "busy." Defendants quote the following language: "The claims further call for the message generating means causing no message to be generated where the second telephone is off-hook, i.e. when the second telephone is busy." Dkt. No. 78 at 15 (quoting Ex. A, Ex. 6 at 15).FN2 While this statement defines "off-hook" as a "busy" condition, this statement does not define the scope of the term "busy." This statement in the prosecution history is therefore not a "clear and unmistakable" waiver of claim scope. *Omega Eng'g*, 334 F.3d at 1326.

FN2. Defendants cite the page number of the original document, to wit, page 14. The Court cites the page number of the electronic file, as docketed.

Defendants also rely on *Biovail Corp. v. Andrx Pharmaceuticals, Inc.*, 239 F.3d 1297 (Fed.Cir.2001), and *Kumar v. Ovonic Battery Co., Inc.*, 351 F.3d 1364, 1368 (Fed.Cir.2003), for the proposition that a prior art patent cited by a later patent is intrinsic evidence. The '608 Patent cites as prior art United States Patent No. 5,321,740 ("Gregorek"). Defendants contend that because Gregorek defines "busy" as "in use," and because Gregorek is cited by the '608 Patent, the '608 Patent therefore uses "busy" to mean "in use." Dkt. No. 78 at 16. Gregorek does refer to "busy, i.e. the telephone ... is in use." Gregorek at 3:20-21. Nonetheless, the specification of the patent being construed should take priority over prior art cited in the patent. *See Phillips*, 415 F.3d at 1316 ("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.") The Court in *Kumar* did not find otherwise:

[I]n *Arthur A. Collins, Inc. v. Northern Telecom Ltd.*, 216 F.3d 1042 (Fed.Cir.2000), we rejected the district court's claim construction, which "declined to consider the teachings of [prior art referenced in the patent] to ascertain the meaning" of the claim term "time-space-time (TST) switch." *Id.* at 1044. Instead, we interpreted the term based on its usage in the prior art that was cited in the patent, explaining that "[w]hen prior art that sheds light on the meaning of a term is cited by the patentee, it can have particular value as a guide to the proper construction of the term, because it may indicate not only the meaning of the term to persons skilled in the art, but also that the patentee intended to adopt that meaning." *Id.* at 1045.

*Kumar*, 351 F.3d at 1368. The Court finds that "shed[ing] light on the meaning of a term" should not include construing a term contrary to a clearly manifested intent in the specification of the patent-in-suit. *Id.* Finally, *Biovail* does not apply to Gregorek because *Biovail* only addressed the effect of the prosecution history from parent applications. *See* 239 F.3d at 1301. As discussed above, the specification of the '608 Patent discloses that the invention does not terminate the sound presentation if call waiting is available. Gregorek therefore does not require that "busy" be construed to cover all "in use" situations.

The Court construes the term "busy" to mean "in use and no call waiting is available."

## **D. "terminating the telephone call"**

This term appears in Claims 1 and 9.

### **(1) The Parties' Positions**

Plaintiff proposes this term means "ending attempts to communicate between the caller and the recipient." JCCC at 2 & 6-7. As to Claim 1, Defendants propose this term means "ending communications between the caller and the telephone system." *Id.* at 2. As to Claim 9, Defendants propose this term means "ending communications between the caller and the telecommunications link." *Id.* at 6-7.

Plaintiff argues that a telephone call may be terminated before the recipient answers the call. Dkt. No. 63 at 25. Defendants argue that the patentees used the term "telephone call" to "describe an actual communication that takes place between network elements." Dkt. No. 78 at 27. Plaintiff replies by reiterating its characterization of the telephone call as "an attempt to communicate" rather than an actual communication. Dkt. No. 87 at 8.

The parties underlying dispute concerns the meaning of the constituent term "telephone call." Plaintiff argues that a telephone call is an attempt to reach an intended recipient. Defendants argue that a telephone call exists both before the recipient answers and while the caller and the recipient are engaged in conversation, i.e. the call starts as soon as a caller "places a call," in common parlance. Defendants argued at the hearing on this matter that Plaintiff's construction would produce the purportedly absurd result that as soon as the recipient picks up the telephone, the "telephone call" ceases.

### **(2) Construction**

The preamble of Claim 1 recites "[a] software based algorithm for operation of a telephone system" while the preamble of Claim 9 recites "[a] method of generating a sound presentation over a telecommunication link." '608 Patent at 18:23-24 & 19:10-11. This difference in preamble language accounts for Defendants' proposal of different constructions for the same term in different claims. The Court nonetheless endeavors to construe the term "terminating the telephone call" consistently throughout the entire patent. *Omega Eng'g*, 334 F.3d at 1334 ("We presume, unless otherwise compelled, that the same claim term in the same patent or related patents carries the same construed meaning.")

The specification teaches that "[i]n a normal telephone communication, a caller initiates a telephone call to a recipient, and that recipient typically answers the telephone call." '608 Patent at 4:58-60. Thus, a "telephone call" is made by the aptly-named "caller." *Id.* Further, "terminating the telephone call," as recited in Claims 1 and 9, refers to an action that may occur before the "answering of the [tele]phone call by the recipient." '608 Patent at 18:43. Because a telephone call may be terminated before being answered, a telephone call exists before the caller begins conversing with the recipient.

Claim 9 teaches a distinction between "telephone call" and "telephone communication." *See* '608 Patent at 19:10-32. Step 9(e) teaches that the method "terminat[es] the telephone call and generat[es] no sound presentation if the telephone line is busy...." *Id.* at 19:29-30. Step 9(a), on the other hand, refers to "initiating a telephone communication by terminating the sound presentation when the intended recipient answers the telephone ." *Id.* at 19:15-17. Claim 9 thereby teaches that a "telephone call" is an attempt to communicate while a "telephone communication" does not occur until the recipient answers. *See also id.* at 4:58-61 ("In a

normal telephone communication, a caller initiates a telephone call to a recipient, and that recipient typically answers the telephone call. Thus, and in that respect, the telephone communication is a two-way communication.") However, this distinction does not affect the construction of "terminating the telephone call" because the parties proposed constructions are not necessarily inconsistent.

To the extent Defendants perceive the "telephone call" as a communication between the caller and telephone network elements, "terminating the telephone call" ends those communications. To the extent Plaintiff perceives the "telephone call" as attempts to communicate with the intended recipient, "terminating the telephone call" ends those attempts. In essence, the "attempts to communicate" proposed by Plaintiff are included in the "communications" proposed by Defendants. A proper construction should therefore include both proposed constructions.

The Court therefore construes the term "terminating the telephone call" to mean "ending the caller's attempts to communicate with the recipient by ending the caller's communication with the telephone system or telecommunications link."

#### **E. "generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy"**

This term appears in Claims 1 and 9.

##### **(1) The Parties' Positions**

Plaintiff proposes this term means "generating no sound presentation if the telephone line of the recipient telephone is busy and allowing for a sound presentation if the telephone line of the recipient telephone is not busy." JCCC at 3 & 7. Defendants propose this term means "the sound presentation is allowed to be generated only if the telephone line of the recipient telephone is not busy." *Id.*

Defendants originally proposed that this term means "the sound presentation is generated only if the telephone line of the recipient telephone is not busy." Dkt. No. 63 at 18. Plaintiff proposed that the Court should simply clarify that "the telephone line" refers to "the telephone line of the recipient telephone." Dkt. No. 63 at 19. Plaintiff argued that Defendants proposed construction excluded significant claim language, namely "allowing." *Id.* at 19-20. Defendants responded by including "allowing" in their currently proposed construction. Dkt. No. 78 at 22. Defendants argue that their proposed construction simplifies the claim language "to make it more palatable for a lay juror" because "[a] telephone line is busy, or it is not busy." *Id.* at 21-22. Plaintiff replies by reiterating the claim's distinct use of "generating" and "allowing." Dkt. No. 87 at 4-5. Plaintiff also cites similar language in the prosecution history. *Id.* at 4 (discussing Dkt. No. 78, Ex. 2 at 20:9-21).

##### **(2) Construction**

The relevant claim language is instructive:

1. A software based algorithm for operation of a telephone system in which a generated sound presentation can replace or overlay a ring-back signal normally heard in a caller's telephone until such time as a recipient of a telephone call answers the telephone call, said algorithm comprising the steps of:

...

c) determining whether the *telephone line of the recipient telephone* is busy;

d) terminating the telephone call and generating no sound presentation if the *telephone line* is busy and allowing for a sound presentation if the *telephone line* is not busy;

...

9. A method of generating a sound presentation over a telecommunication link during a portion of or all of a normal ringing cycle period between the completion of a dialing process by a caller and the time when a telephone of the recipient is answered, said method comprising:

...

d) determining whether the *telephone line of the recipient telephone* is busy; and

e) terminating the telephone call and generating no sound presentation if the *telephone line* is busy and allowing for a sound presentation if the *telephone line* is not busy.

'608 Patent at 18:23-41 & 19:27-32 (emphasis added). Step 1(c) and Step 1(d), as well as Step 9(d) and Step 9(e), teach that the "telephone line" in the disputed term refers to the "telephone line of the recipient telephone." Plaintiff's proposed construction appropriately clarifies this. Defendants' proposed construction unnecessarily rewrites an otherwise clear claim and does not render it sufficiently "more palatable for a lay juror" to justify departing from the plain language of the claim. Dkt. No. 78 at 21-22. The Court therefore adopts Plaintiff's proposed construction.

The Court construes the term "generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy" to mean "generating no sound presentation if the telephone line of the recipient telephone is busy and allowing for a sound presentation if the telephone line of the recipient telephone is not busy."

## **F. "to play the introduced message to the caller or the recipient or both"**

This term appears in Claim 1.

### **(1) The Parties' Positions**

Plaintiff proposes this term means "to the caller, to the recipient, or to both the caller and the recipient." JCCC at 3. Defendants propose this term means "the method is capable of playing the sound presentation to the caller, or the recipient, or both." *Id.*

Plaintiff argues that Defendants "unnecessarily include[ ] 'capable of playing the sound presentation' without justification." Dkt. No. 63 at 20. Defendants respond that their construction "appropriately focuses attention on the capabilities of the claimed algorithm and method, rather than on any particular caller's subjective ability to hear the sound presentation." Dkt. No. 78 at 34. Defendants also appear to interject that "the message *must* be played to the *caller*." *Id.* at 35. At the hearing on this matter, Defendants argued that the antecedent basis of "the telephone" in Step 1(b) is "the caller's telephone" recited in the preamble:

1. A software based algorithm for operation of a telephone system in which a generated sound presentation can replace or overlay a ring-back signal normally heard in *a caller's telephone* until such time as a recipient of a telephone call answers the telephone call, said algorithm comprising the steps of:

...

b) introducing a *sound presentation to be generated over the telephone* which replaces a portion of or all of the ring-back signal;

...

e) initiating those actions *to play the introduced message to the caller or the recipient or both*; ....

'608 Patent at 18:23-41 (emphasis added). Also at the hearing, Defendants submitted that the proper term for construction is "*to play the introduced message to the caller or the recipient or both* ." In reply, Plaintiff emphasizes the "disjunctive use of 'or' " in the language of the claim. Dkt. No. 87 at 11.

## **(2) Construction**

Defendants propose that the dispute embraces the language "to play the introduced message" that precedes "to the caller or the recipient or both." In the interest of resolving the entire dispute, the Court shall construe the term "to play the introduced message to the caller or the recipient or both." The addition of Defendants' language to the term to be construed has no significant impact on the Court's construction because the parties dispute centers on who may hear the "introduced message."

The meaning of "the telephone" in Step 1(b) informs the meaning of the term under construction because it is the "sound presentation to be generated over the telephone" that is "play[ed]" in Step 1(e). *See* '608 Patent at 18:31-43. The Court must therefore address the potential for ambiguity as to "the telephone" in Step 1(b).

"[W]hen the limitations in the body of the claim rely upon and derive an antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." Eaton, 323 F.3d at 1339. Generally, a term refers to an antecedent by repeating the antecedent identically except for preceding it with the word "said" instead of "a" or "the." *See, e.g.,* Energizer Holdings, Inc. v. Int'l Trade Comm'n, 435 F.3d 1366, 1370 (Fed.Cir.2006) (discussing "lack of explicit antecedent basis for 'said zinc anode.' ") Where a term lacks an "explicit antecedent basis," the Court must determine whether the term has a "reasonably ascertainable meaning[, which] must be decided in context." *Id.* In this case, if "a caller's telephone" in the preamble were intended as an antecedent basis, a person of ordinary skill in the art would expect Step 1(b) to recite "introducing a sound presentation to be generated over *said caller's* telephone," or perhaps "*said* telephone," or at least "the *caller's* telephone." In the absence of such language, a fair reading suggests that "a caller's telephone" in the preamble is *not* the antecedent basis for "the telephone" in Step 1(b).

The preamble may also operate as a limitation where: the preamble is essential to understand limitations or terms in the claim; the preamble recites additional structure or steps underscored as important by the specification; or the patentee has clearly relied on the preamble during prosecution to distinguish the claimed invention from the prior art. Catalina Marketing, 289 F.3d at 808-09. Defendants have not shown that the patentees relied upon the preamble during prosecution to distinguish the claimed invention from the



prior art. The preamble states that "a sound presentation *can* replace or overlay a ring-back signal normally heard in a caller's telephone." *Id.* at 18:23-26 (emphasis added). As to understanding limitations or terms in the claim, a person of ordinary skill in the art would understand the word "can" to be permissive rather than mandatory, so this language should not be construed as a limitation. Similarly, this "can" language does not recite additional structure or steps. Instead, this language merely describes the "use or purpose" of the invention. *Catalina Marketing*, 289 F.3d at 809. The preamble therefore does not limit the scope of "play[ing] the introduced message to the caller or the recipient or both." '608 Patent at 18:40-41.

As to any remaining ambiguity concerning "the telephone" in Step 1(b), the Court should construe a term, where possible, to uphold validity. *Phillips*, 415 F.3d at 1327 ("While we have acknowledged the maxim that claims should be construed to preserve their validity, we have not applied that principle broadly, and we have certainly not endorsed a regime in which validity analysis is a regular component of claim construction"); *see also* *Energizer Holdings*, 435 F.3d at 1370. A person of ordinary skill in the art would understand from the "context of the particular claim in which the disputed term appears, [as well as] the context of the entire patent" that "the telephone" in Step 1(b) could refer to the caller's telephone or the recipient's telephone. *Phillips*, 415 F.3d at 1313. The recipient's telephone might not have a ring-back signal that may be replaced. However, the claim does not preclude the sound presentation from being generated for both the caller and the recipient, even though the sound presentation only functions so as to "replace[ ] a portion of or all of the ring-back signal" on the caller's telephone. '608 Patent at 18:31-33. The specification explains that the message can be presented "to either the caller or the recipient, or both." *Id.* at 14:29-30. This description evidences the patentees' intent to play the message to the caller, to the recipient, or to both the caller and the recipient.

The Court construes the term "to play the introduced message to the caller or the recipient or both" to mean "to play the introduced message to the caller, to the recipient, or to both the caller and the recipient."

### **G. "generated sound presentation can be heard by the caller or the recipient or both"**

This term appears in Claim 9.

#### **(1) The Parties' Positions**

Plaintiff proposes this term means that the "generated sound presentation can be heard by the caller, by the recipient, or by both the caller and the recipient." JCCC at 6. Defendants propose this term means "the method is capable of playing the sound presentation to the caller, or the recipient, or both." *Id.*

Plaintiff argues that the Court should simply clarify the meaning of "both" and otherwise follow the language of the claim. Dkt. No. 63 at 22. Plaintiff emphasizes that "the term at issue specifically refers to the act of 'hearing,' and not the act of 'playing' as included in Defendants' construction." *Id.* The parties consolidate their response and reply arguments with the term "to the caller or the recipient or both." Dkt. Nos. 78 at 34-35 & 87 at 10-11; *see s. IV.F, supra.*

#### **(2) Construction**

The Court incorporates its discussion in s. IV.F, *supra*. However, Claim 9 is not susceptible to Defendants' preamble argument. *See id.* Also, nothing in Claim 9 limits who must be able to hear the sound presentations. The plain language of the claim refers to being "heard" and not to "playing." '608 Patent at 19:25-26. The Court finds no basis for altering the understandable "can be heard" language with the

"capable of playing" language proposed by Defendants. The Court therefore construes the term "generated sound presentation can be heard by the caller or the recipient or both" to mean that the "generated sound presentation can be heard by the caller, by the recipient, or by both the caller and the recipient."

## **H. Whether the Steps in Claims 1 and 9 Must be Performed in a Certain Order**

### **(1) The Parties' Positions**

Plaintiff argues that "the claim steps may be performed in any order." Dkt. No. 63 at 27. Defendants respond that the following restrictions apply:

- > Step 1(c) must be performed before Step 1(d)
- > Step 1(c) must be performed before Step 1(e)
- > Step 1(e) must be performed before Step 1(f)
- > Step 9(c) must be performed before Step 9(a)
- > Step 9(d) must be performed before Step 9(e)
- > Step 9(d) must be performed before Step 9(a)

Dkt. No. 78 at 24. Defendants uniformly argue that "logic and grammar" require all of these proposed limitations. *Id.* at 24-26. Plaintiff primarily relies upon the general rule that "unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one." Dkt. No. 63 at 27 (citing *Interactive Gift Express, Inc. v. Compuserve, Inc.*, 256 F.3d 1323, 1342 (Fed.Cir.2001)); *see also* Dkt. No. 87 at 7-8. Plaintiff makes a specific argument as to Figure 4 and the specification's description thereof, which the Court addresses herein. *See s. IV.H(2)(a)(i).*

### **(2) Construction**

Ordinarily, the steps of a claim may be performed in any order:

Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one. *See Loral Fairchild Corp. v. Sony Corp.*, 181 F.3d 1313, 1322, 50 USPQ2d 1865, 1870 (Fed.Cir.1999) (stating that "not every process claim is limited to the performance of its steps in the order written"). However, such a result can ensue when the method steps implicitly require that they be performed in the order written.

*Interactive Gift*, 256 F.3d at 1342. In *Altiris Inc. v. Symantec Corp.*, the Federal Circuit found that steps could be performed in any order so long as "nothing in the intrinsic evidence" compels otherwise. 318 F.3d 1363, 1370 (Fed.Cir.2003); *see also Kemin Foods, L.C. v. Pigmentos Vegetales del Centro S.A. de C.V.*, 301 F.Supp.2d 970, 993 (S.D.Iowa 2004) (finding steps interchangeable where there was "no discernible or important difference in the reaction or the end result") & *Elantech Devices Corp. v. Synaptics, Inc.*, 2007 WL 1056782, at (N.D.Cal. Apr.6, 2007) (finding no order "imposed upon the steps" where there was no "modifying adjective present in one step of the method that refers to an action taken in a previous step").

On the other hand, the Federal Circuit found in *Mantech Environmental Corp. v. Hudson Environmental Services, Inc.* that the steps of a method claim had to be performed in the recited order. 152 F.3d 1368 (Fed.Cir.1998). The method claim at issue in *Mantech* recited as follows:

1. A method for remediating a hydrocarbon-contaminated region of a subterranean body of groundwater to destroy or reduce the initial concentration levels of hydrocarbon contaminants, comprising the steps of:

(a) providing a plurality of mutually spaced wells intersecting said groundwater region;

(b) providing a treating flow of acetic acid from one or more of said wells into said groundwater region, to establish acidic conditions therein;

(c) introducing a turbulent flow of an aqueous solution of ferrous ion into said groundwater region, for mixing with said acidified groundwater, thereby providing a catalyst for disassociation of hydrogen peroxide; and

(d) providing a treating flow of hydrogen peroxide solution from one or more of said wells into said groundwater region, said hydrogen peroxide undergoing a Fenton-like reaction in the presence of said acidic conditions and said ferrous ion to generate hydroxyl free radicals for oxidizing said contaminants.

*Mantech*, 152 F.3d at 1376. The Federal Circuit reasoned as follows:

Step (a) provides the wells. No monitoring or injecting of the groundwater can occur until wells are provided; hence, step (a) must be performed first. Step (b) introduces acetic acid, via the wells provided in step (a), into the groundwater of the contaminated region. Hence, in order to accomplish step (b), the wells of step (a) must already have been provided. Step (c) introduces an aqueous solution of ferrous ion into said groundwater region for mixing with "*said acidified groundwater*" (emphasis added). In order for the aqueous solution to mix with the acidified groundwater, the acid must have already mixed with the groundwater to form acidified groundwater. Hence step (b) necessarily comes before step (c). Step (d) introduces a treating flow of hydrogen peroxide solution into the groundwater. The hydrogen peroxide solution undergoes a Fenton-like reaction "in the presence of said acidic conditions and said ferrous ion." Because the acidic conditions and the ferrous ion must be present before the hydrogen peroxide can undergo the Fenton-like reaction, step (d) must come after both steps (b) and (c). We hold, therefore, that the sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise.

152 F.3d at 1375-76. The Court applies these principles to the steps recited in Claim 1 and Claim 9.

**(a) Claim 1**

**(i) Step 1(c) Before Step 1(d)**

Defendants argue that Step 1(c) must be performed before Step 1(d). These steps read as follows:

c) determining whether the telephone line of the recipient telephone is busy;

d) terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy ....

'608 Patent at 18:34-39. Step 1(d) terminates the call if the recipient's telephone is busy and allows a sound presentation if the recipient's telephone is not busy. '608 Patent at 18:36-39. For the algorithm to make this choice, the algorithm must know whether the recipient's telephone is busy. The algorithm must therefore determine whether the recipient's telephone is busy *before* attempting to make the choice recited in Step 1(d). The claim recites this necessary determination in Step 1(c). *Id.* at 18:34-35. Because this "sequential nature of the claim steps is apparent from the plain meaning of the claim language and nothing in the written description suggests otherwise," Step 1(c) must be performed before Step 1(d). *Mantech*, 152 F.3d at 1376.

Plaintiff submits that Figure 4 of the '608 Patent discloses an embodiment that "starts a sound presentation before determining if the [recipient's] telephone line is busy." Dkt. No. 87 at 6. Specifically, Plaintiff argues that "step 114, starting the message or sound presentation, is performed before step 120." *Id.* at 7. However, block 114 in Figure 4 reads "Start Message *Process*," not the actual message. '608 Patent at Fig. 4 (emphasis added). Plaintiff relies on the following language in the specification:

[I]f call waiting is available, then the system can allow for holding for the recipient to answer at step 112. At that point, the message process is started at step 114. Thus, it can be observed that either at step 106 or at step 112, the message can be started for presentation to either the caller or the recipient, or both.

*Id.* at 14:25-30. However, this language is at odds with the description that immediately follows. Step 114 takes place before the "search for a message will take place at step 124." *Id.* at 14:36. A person of ordinary skill in the art would understand that a message could not be played to the caller before a message has even been selected. The specification thus teaches that the message process, not the playing of the message itself, can be started at step 114. Further, a review of Figure 4 as a whole reveals that the playing of the sound presentation allowed in Step 1(d) does not occur until "134 Play Message to Caller," which appears well downstream of "120 Identify Telephone Line Status." '608 Patent at Fig. 4. Because "step 114" cited by Plaintiff is not the "allowing for a sound presentation" recited in Step 1(d), the specification does not teach contrary to requiring Step 1(c) to be performed before Step 1(d).

Further, the prosecution history includes an amendment to Claim 1 after the examiner's rejection for anticipation by *Gregorek*. The patentees added Step 1(c) and Step 1(d) and explained that "if the [recipient's] line is not free, the phone call ends. Such is not the case with *Gregorek* ...." June 28, 2002 Amendment, Dkt. No. 78, Ex. 2 at 21. The patentees further clarified that they

amended [the Claims] to recite that the algorithm determines whether the telephone line of the recipient is busy [and] will *thereupon* terminate the call and generate no message if the telephone line is busy, but will allow for presentation of a message if the telephone line is not busy.

*Id.* (emphasis added). The patentees thereby made a "clear and unmistakable" statement that the "determining" in Step 1(c) must be performed before Step 1(d). *Omega Eng'g*, 334 F.3d at 1326.

The Court finds that Step 1(c) must be performed before Step 1(d).

**(ii) Step 1(c) Before Step 1(e)**

Defendants argue that Step 1(c) must be performed before Step 1(e). The relevant steps recite as follows:

1. A software based algorithm for operation of a telephone system in which a generated sound presentation can replace or overlay a ring-back signal normally heard in a caller's telephone until such time as a recipient of a telephone call answers the telephone call, said algorithm comprising the steps of:

...

c) determining whether the telephone line of the recipient telephone is busy;

...

e) initiating those actions to play the introduced message to the caller or the recipient or both; ....

'608 Patent at 18:22-41.

Step 1(d) teaches that the invention does not generate a sound presentation if the recipient's telephone is busy:

d) terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy ....

*Id.* at 18:36-39. A person of ordinary skill in the art would understand that a message cannot be "play[ed]" in Step 1(e) before it is first "allow[ed]" by Step 1(d). *See Mantech*, 152 F.3d at 1375-76. Step 1(d) must therefore be performed before Step 1(e). As discussed in s. IV.H(2)(a)(i), *supra*, Step 1(c) must be performed before Step 1(d). In turn, Step 1(c) must be performed before Step 1(e).

The Court finds that Step 1(c) must be performed before Step 1(e).

***(iii) Step 1(e) Before Step 1(f)***

Defendants argue that Step 1(e) must be performed before step 1(f). These steps read as follows:

e) initiating those actions to play the introduced message to the caller or the recipient or both; and

f) terminating the playing of the sound presentation upon answering of the phone call by the recipient.

'608 Patent at 18:40-43. Step 1(e) recites "initiating" and Step 1(f) recites "terminating." *Id.* at 18:30-44. Although Step 1(e) refers to "the introduced message" and step 1(f) refers to "the sound presentation," the parties have agreed that "message" and "sound presentation" should be construed identically. JCCC at 1-2. A person of ordinary skill in the art would understand that the thing "initiat[ed]" in Step 1(e) is the same thing "terminat[ed]" in Step 1(f). This resembles the circumstance in *Mantech* where "[n]o monitoring or injecting of the groundwater can occur until wells are provided." 152 F.3d at 1375. That which is terminated must first have been initiated. *Cf. id.*

The Court finds that Step 1(e) must be performed before Step 1(f).

***(b) Claim 9***

***(i) Step 9(c) before Step 9(a)***

Defendants argue that Step 9(c) must be performed before Step 9(a). The relevant steps of Claim 9 are as follows:

A method of generating a sound presentation over a telecommunication link during a portion of or all of a normal ringing cycle period between the completion of a dialing process by a caller and the time when a telephone of the recipient is answered, said method comprising:

a) initiating a telephone communication by terminating of the sound presentation when the intended recipient answers the telephone;

...

c) generating the selected one or more sound presentations to be provided during a portion of or the entire time that a ringing signal would normally be generated at the telephone of the recipient and which generated sound presentation can be heard by the caller or the recipient or both; ....

'608 Patent at 19:10-26. Step 9(a) recites "terminating ... the sound presentation." '608 Patent at 19:15-16. Step 9(c) recites the "generating" necessary to bring the sound presentation into existence. *Id.* at 19:21-26. Something must exist before it may be terminated. *Cf. s. IV.H(2)(a)(iii), supra.*

The Court finds that Step 9(c) must be performed before Step 9(a)

***(ii) Step 9(d) Before Step 9(e)***

Defendants argue that Step 9(d) must be performed before Step 9(e). These steps read as follows:

d) determining whether the telephone line of the recipient telephone is busy; and

e) terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy.

'608 Patent at 19:27-32. For the same reasons that Step 1(c) must be performed before Step 1(d), *see s. IV.H.(2)(a)(i), supra*, the Court finds that Step 9(d) must be performed before Step 9(e).

***(iii) Step 9(d) Before Step 9(a)***

Defendants propose that the "determining" in Step 9(d) must be performed before the "terminating" in Step 9(a). These steps read as follows:

a) initiating a telephone communication by terminating of the sound presentation when the intended recipient answers the telephone;

...

d) determining whether the telephone line of the recipient telephone is busy ....

'608 Patent at 19:15-32.

The relationship between Step 9(a) and Step 9(e) is probative. Step 9(e) teaches that if a recipient's telephone is not busy, a sound presentation is allowed. *See s. IV.H(2)(b)(ii), supra*. If Step 9(a) were performed before Step 9(e), then the termination of the sound presentation would occur before it was first "allow[ed]." *Id.* at 19:30. Such a construction would be illogical and is therefore disfavored. *See Mantech, 152 F.3d at 1375*. Instead, that which is terminated must first be allowed. *Cf. Mantech, 152 F.3d at 1375* (finding that "[n]o monitoring or injecting of the groundwater can occur until wells are provided"). Step 9(e) must therefore be performed before Step 9(a). Because Step 9(d) must be performed before Step 9(e), *see s. IV.H(2)(b) (ii), supra*, Step 9(d) must in turn be performed before Step 9(a).

The Court finds that Step 9(d) must be performed before Step 9(a).

## V. CONCLUSION

Accordingly, the Court hereby **ORDERS** the disputed claim terms construed consistent herewith.

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