

No. 23-

IN THE
Supreme Court of the United States

JOE A. SALAZAR,

Petitioner,

v.

AT&T MOBILITY LLC, SPRINT UNITED
MANAGEMENT COMPANY, T-MOBILE USA, INC.,
CELLCO PARTNERSHIP INC., DBA VERIZON
WIRELESS, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

The Constitution empowers Congress to incentivize innovation by granting inventors limited monopolies in exchange for the public disclosure of their inventions. U.S. Const. Art. I, § 8, Cl. 8. A patent—and the accompanying right to exclude others from making, using, offering for sale, or selling the disclosed invention—is a form of private property. 35 U.S.C. § 154(a)(1). The Takings Clause of the Fifth Amendment protects against uncompensated governmental takings of private property. U.S. Const. amend. V.

Where the Federal Circuit Panel’s construction of petitioner’s patent claim was unforeseeable and unjustifiable under the circuit’s prior decisions, disrupting petitioner’s legitimate investment-backed expectations and rendering his and similarly situated patent owners’ patents worthless, does the Panel’s precedential opinion constitute a judicial taking of property in violation of the Fifth Amendment’s Takings Clause?

STATEMENT OF RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

- *Salazar v. AT&T Mobility LLC, et al.*, No. 21-2320 (Fed. Cir.), judgment entered on April 5, 2023, and petition for rehearing *en banc* denied on June 8, 2023;
- *Salazar v. AT&T Mobility LLC, et al.*, No. 21-2376 (Fed. Cir.), judgment entered on April 5, 2023; and
- *Salazar v. AT&T Mobility LLC, et al.*, No. 2:20-cv-00004-JRG (E.D. Tex.), judgment entered on August 17, 2021.

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PETITION FOR A WRIT OF CERTIORARI

Joe A. Salazar (“petitioner”) respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The Federal Circuit’s opinion (Pet’r’s App. 1a–17a) is reported at 64 F.4th 1311. The district court’s claim construction memorandum opinion and order (Pet’r’s App. 18a–97a) is unreported.

JURISDICTION

The Federal Circuit entered its judgment on April 5, 2023, (Pet’r’s App. 1a–17a), and denied rehearing on June 8, 2023, (Pet’r’s App. 97a–98a). This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS

Article I, Section 8, Clause 8 of the United States Constitution (the “Intellectual Property Clause”) provides:

[The Congress shall have Power . . .] To promote the Progress of Science and useful Arts, by securing for limited

Times to . . . Inventors the exclusive
Right to their respective . . . Discoveries.

U.S. Const. Art. I, § 8, Cl. 8.

The Due Process Clause and the Takings Clause of
the Fifth Amendment of the United States
Constitution provides:

No person shall . . . be deprived of life,
liberty, or property without due process
of law; nor shall private property be
taken for public use, without just
compensation.

U.S. Const. amend. V.

35 U.S.C. § 154(a)(1) provides:

Every patent shall contain a short title of
the invention and a grant to the
patentee, his heirs or assigns, of the right
to exclude others from making, using,
offering for sale, or selling the invention
throughout the United States or
importing the invention into the United
States

35 U.S.C. §154(a)(1).

35 U.S.C. § 261 provides:

Subject to the provisions of this title, patents shall have the attributes of personal property.

35 U.S.C. § 261.

STATEMENT OF THE CASE

This case presents the exceptionally important question whether a judicial decision that construes patent claims in a manner that unjustifiably excludes the disclosed “present invention” as described in the patent is an unconstitutional taking of the patent owner’s property rights. Here, the Federal Circuit Panel misapplied well-settled rules of claim construction, resulting in a drastic, unforeseeable narrowing of petitioner’s patent claims, such that petitioner’s “present invention” as described in the patent falls outside the scope of the patent’s protection. This unjustifiable deprivation of petitioner’s patent rights is a judicial taking, rendering petitioner’s and similarly situated inventors’ patents worthless. Absent this Court’s intervention, petitioner has no remedy.

A. Background

U.S. Patent No. 5,802,467 (“the ’467 Patent”) was filed on September 28, 1995, and issued on September

1, 1998. The '467 Patent discloses and claims a communications, command, control and sensing system integrated with a unique set of high-tech features and functionalities of high-end smart phones of the 2013 time period. These features include: a display device, replaceable icons associated with desired functionalities, efficient space management of parameter sets and command codes, bi-directional IR (infrared frequency) and RF (radio frequency) communications capabilities, touch sensitive device creating signals, sound/voice activation and commands (sending and receiving voice commands), sensors for measuring physical phenomena, and sound and data coupling to receive sound as data signals, among others. The Salazar invention incorporates remote-controlled technology into a device such as a telephone, and the two-way IR transceiver allows the device to communicate and control other devices such as a television or thermostat.

A key aspect of the Salazar invention is the integration and operation of these high-tech features through the use of a plurality of microprocessors. The '467 Patent's teaching that the system be implemented through multiple microprocessors is consistent and prolific. Notably, the '467 Patent's specification describes the "present invention" as "a wireless and wired communications, command, control and sensing system" where "both the handset and the base station contain a touch screen or similar

touch sensitive device that when touched in at least one specific outlined area, provide the **means for externally interacting with their respective microprocessors.**’467 Patent col. 2 l. 66–col. 3 l. 14 (emphasis added). The ’467 Patent further describes the handset and base station of the present invention as both having “microprocessors to control all their internal operations.” ’467 Patent col. 3 l. 15–19.

B. Procedural History

1. On June 18, 2019, Salazar sued AT&T Mobility LLC; Sprint United Management Company; T-Mobile USA, Inc.; and Cellco Partnership d/b/a Verizon Wireless, Inc. (collectively, “respondents”) in the United States District Court for the Eastern District of Texas, alleging, pursuant to 35 U.S.C. § 271, that they directly infringed, contributorily infringed, and induced others to infringe at least claim 1 of the ’467 Patent by offering for sale and selling their smartphone products, including the HTC One M7, HTC One M8, and HTC One M9 (collectively, the “Accused Smartphones”).

During the pendency of the case, the parties briefed various claim construction issues, and the district court held a *Markman* hearing on July 24, 2020. One of the disputed claim terms was “a microprocessor for generating . . ., said microprocessor creating . . ., a plurality of parameter sets retrieved by said microprocessor . . ., said microprocessor

generating” This claim term, which is applicable to each of the asserted claims of the ’467 Patent, was the subject of Salazar’s appeal to the Federal Circuit Court of Appeals.

The crux of the dispute was whether the claims require a single microprocessor that is capable of performing all the recited “generating,” “creating,” “retrieving,” and “generating” functions. Citing Federal Circuit and district court precedent, Salazar argued that they do not. Because the claim-at-issue is an open-ended “comprising” claim involving the indefinite “a microprocessor,” the well-established general rule of claim construction found in *Baldwin Graphic Systems, Inc. v. Siebert, Inc.*, 512 F.3d 1338 (Fed. Cir. 2008), and its progeny dictates that: (1) the general construction rule of “a” meaning “one or more” applies, such that the recited “a microprocessor” means “one or more microprocessors,” and (2) the subsequent use of the definite article “said” to refer back to the same claim term reinvokes that non-singular meaning. Further, none of the extremely limited exceptions to this general rule applies, as there is nothing in the prosecution history, specification, or claim language that evinces a clear intent to limit “a microprocessor” to “one microprocessor” or necessitates a departure from the rule. Thus, any one of the one or more microprocessors can be capable of performing any one of the recited functions in the claim term, and any individual one of the microprocessors (or all the

microprocessors) need not be capable of performing all of the recited functions.

Respondents argued that although the phrase “a microprocessor” could mean “one or more” microprocessors, the same microprocessor must be configured to perform the microprocessor functions attributed to every subsequent recitation of “said microprocessor”—i.e., “generating,” “creating,” “retrieving,” and “generating.” Respondents did not argue that their construction was grounded in the ’467 Patent’s prosecution history or limitations in the specification. Following the hearing and supplemental briefing by the parties, the district court agreed with respondents, construing the term as “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving and generating functions.”

A six-day jury trial was held on August 2, 2021. At trial, respondents consistently and emphatically argued that the Accused Smartphones did not infringe the asserted claims of the ’467 Patent because they did not contain a single microprocessor capable of performing all the recited functions. This argument was a centerpiece of respondents’ case and was raised in their opening statement, during cross-examination of petitioner’s technical expert, in the testimony of respondents’ technical expert, and in respondent’s closing argument—where counsel for respondents explicitly acknowledged that the “microprocessor”

claim language was key to the question of infringement.

At the close of trial, the jury returned a verdict of noninfringement as to all of the asserted claims, while also affirming the validity of the '467 Patent. The district court entered final judgment on August 17, 2021.

2. On September 17, 2021, Salazar filed a notice of appeal to the Federal Circuit, which had jurisdiction over Salazar's appeal under 28 U.S.C. § 1295(a)(1). Salazar filed his opening brief on November 15, 2021, and argued that the district court's erroneous claim construction prejudiced Salazar, likely affecting the outcome of the trial and therefore constituting reversible error. Respondents filed a response brief on February 24, 2022, which included arguments that the district court erred in holding that the asserted claims were not anticipated. Oral argument was held on November 7, 2022.

On April 5, 2023, the Federal Circuit Panel issued an opinion affirming the district court's claim construction. In its opinion, the panel held that "the claim language 'a microprocessor,' read in the context of the full claim . . . should be construed to require at least one microprocessor capable of performing the recited functions." Pet'r's App. 13a–14a. The panel explained that "it does not suffice to have multiple microprocessors, each able to perform just one of the

recited functions; the claim language requires at least one microprocessor capable of performing each of the recited functions.” Pet’r’s App. 14a.

Under this construction the district court and the panel required that a single microprocessor be capable of performing all the recited functions. Doing so, the panel rejected Salazar’s position (and analogous precedent) that any one of the group of “one or more microprocessors” could carry out each of the recited functions so long as that group of “one or more microprocessors” collectively was capable of carrying out all of the recited functions, i.e., a single microprocessor did not need to be capable of performing all the recited functions. Under this construction, Salazar was deprived of the scope of his invention as set out consistently throughout his patent and particularly as described as the “present invention.”

With respect to respondents’ anticipation argument, the Panel affirmed the jury decision in favor of Salazar, holding that “AT&T clearly disavowed any intention to move for judgment as a matter of law regarding anticipation” and “accordingly, even under the most liberal construction of the requirements of Rule 50(a), AT&T has nevertheless waived its anticipation argument.” Pet’r’s App. 17a.

On May 5, 2023, Salazar timely filed a Petition for rehearing *en banc*. The Federal Circuit denied Salazar’s petition on June 8, 2023.

REASONS FOR GRANTING THE PETITION

The Panel’s unduly narrow construction of petitioner’s claimed invention, which requires a single microprocessor to perform each of the recited functions, dramatically departs from well-settled precedent of the Federal Circuit which consistently construes the language used in petitioner’s claim to allow for any one of the “one or more” microprocessors to perform each of the claimed functions. The Panel’s ruling was unforeseeable and unjustifiable by reference to the circuit’s prior decisions, disrupting petitioner’s legitimate investment-backed expectations. The unfair, unexpected claim construction—at odds with settled law—constitutes a judicial taking in violation of the Fifth Amendment.

The Constitution empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries.” U.S. Const. Art. I, § 8, Cl. 8. To effect this purpose, Congress has enacted patent laws granting inventors limited monopolies in exchange for disclosure of their inventions. These disclosures spur innovation by collectively forming a vast body of public knowledge that allows others to make and use the disclosed

inventions. This Court stated more than a century ago that “[t]he object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated . . . by the application of artificial rules of interpretation.” *Topliff v. Topliff*, 145 U.S. 156, 171 (1892). Yet the Panel, through the arbitrary misapplication of the circuit’s rules of interpretation, has construed patent claims in a manner that excludes the disclosed invention as described in the patent, thus stripping petitioner of his patent rights and reneging on the government’s bargain.

The Panel’s precedential decision undermines the critical public purposes of patent law, and, if left unchecked, will have devastating impacts on innovation and the economy. Innovation-driven industries account for more than forty percent of all U.S. domestic economic activity, and those industries rely on robust, reliable intellectual property protection. Kathi Vidal, Under Sec’y of Commerce for Intellectual Prop. & Director, U.S. Patent & Trademark Office, Remarks at AIPLA Spring Meeting (May 10, 2023), <https://www.uspto.gov/about-us/news-updates/remarks-uspto-director-kathi-vidal-aipla-spring-meeting>. At a minimum, inventors and investors must have confidence that a patent will “confer[] upon the patentee an exclusive property in the patented invention.” *Horne v. Dep’t of Agric.*, 576 U.S. 351, 359 (2015) (quoting *James v. Campbell*, 104 U.S. 356, 358 (1882)). But the Panel’s decision

inexplicably deprives petitioner and those similarly situated of their property by misinterpreting patent claims such that the invention described in the patent itself is not protected by the patent.

Petitioner's use of the indefinite article "a" preceding the word "microprocessor" in his claim language of independent claim 1 of the '467 Patent carries with it by weight of settled precedent in the Federal Circuit the meaning of "one or more" microprocessors capable of performing each of the recited functions. *Baldwin Graphic Sys., Inc.*, 512 F.3d at 1342; *see also* Joseph E. Root, 1 Rules of Patent Drafting § 3.03 (2023) ("In the quest for achieving maximum breadth with minimal words, the traditional method of achieving coverage of both the singular and plural elements in a patent claim consists of simply using the singular indefinite article, 'a' or 'an.'"); Edward D. Manzo, Patent Claim Construction in the Federal Circuit § 7:2 (2023) ("The general rule applicable where "comprising" is the transition term is that [the] indefinite article ['a' or 'an'] means . . . one item or more."). Moreover, his subsequent use of the term "said" in his claim language referring back to the "a microprocessor" similarly carries with it by settled precedent in the circuit the meaning of "one or more" microprocessors capable of performing the recited functions; it simply reinvoles the plural, non-singular meaning and does not change the import of the indefinite article "a" previously used to describe the "one or more"

microprocessor(s) at issue. *Baldwin Graphic Sys., Inc.*, 512 F.3d at 1343; *see also Lite-Netics, LLC v. Nu Tsai Cap. LLC*, 60 F.4th 1335, 1346 (Fed. Cir. 2023).

Baldwin's “one or more” construction of the indefinite article “a” when used in a patent claim is a “bedrock rule of patent law,” *Creative Internet Advert. Corp. v. Yahoo!, Inc.*, 476 F. App'x 724, 735 (Fed. Cir. 2011) (Clevenger, J., dissenting in part), with very limited and well-known exceptions, i.e., only where the language of the claims themselves, the specification, or the prosecution history necessitate a departure from this bedrock rule, *Baldwin*, 512 F.3d at 1342–43; *accord Convolve, Inc. v. Compaq Computer Corp.*, 812 F.3d 1313, 1321 (Fed. Cir. 2016) (“Absent a clear intent in the claims themselves, the specification, or the prosecution history, we interpret ‘a processor’ to mean ‘one or more processors.’”). The claim language exception to *Baldwin's* bedrock general rule (that “a” means “one or more”) *must* be derived from language other than a claim's subsequent use of the words “said” or “the” to describe an element of the invention. *Lite-Netics, LLC*, 60 F.4th at 1346; *Baldwin Graphic Sys., Inc.*, 512 F.3d at 1343.

In a patent, the use of the term “present invention” is strong evidence that the elements contained therein apply to the invention as a whole. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001); *IP Innovation, L.L.C. v.*

Ecollege.com, 156 F. App'x 317, 322 (Fed. Cir. 2005). The Federal Circuit has consistently construed claims in a way that they align with the specific features of the embodiment labeled as the “present invention.” See *nCube Corp. v. Seachange Int'l*, 436 F.3d 1317, 1329 (Fed. Cir. 2006) (Dyk, J., dissenting) (stating that the use of the term “present invention” is strong evidence that the use applies to the invention as a whole); *Gaus v. Conair Corp.*, 363 F.3d 1284, 1289–90 (Fed. Cir. 2004) (identifying the phrase, “according to the invention,” and the phrase, “the object of the invention,” and limiting the claims to the features disclosed by these phrases). Moreover, “the characterization of [a limitation] as part of the ‘present invention’ is strong evidence that the claims should not be read to encompass the opposite structure.” *nCube Corp.*, 436 F.3d at 1329 (Dyk, J., dissenting); see also *Pacing Techs., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021, 1025 (Fed. Cir. 2015) (stating that when a patentee “describes the features of the ‘present invention’ as a whole,” he alerts the reader that “this description limits the scope of the invention”).

Similarly, embodiments representing the character of the invention should not be excluded from a claim construction. See *Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361, 1369–70 (Fed. Cir. 2003) (construing claim to include limitation because “**very character of the invention**” required that the limitation be part of every embodiment) (emphasis

added); *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1311 (Fed. Cir. 2014) (reversing the district court’s grant of summary judgment of noninfringement based on a claim construction that excluded an embodiment because “there [were] no statements during prosecution or in the specification that indicate[d] the patentee’s intent to limit his claim”).

Consistent with the precedent on interpreting claims and the importance of the disclosure of the “present invention” in the patent, petitioner had a reasonable expectation that his patent claims would be interpreted to include one or more microprocessors, any one of which could perform any of the recited functionality. The “present invention” of the ’467 Patent describes multiple microprocessors working in concert to implement the disclosed functionalities of petitioner’s invention. Indeed, the present invention is described as including components that both “have microprocessors to control all their internal operations.” ’467 Patent col. 3 l. 15–16. For example, the ’467 Patent states: “**In accordance with the present invention**, a wireless and wired communications, command, control and sensing system, in the form of a remote handset or base station, or both, is provided. . . . Both the handset and the base station contain a touch screen or similar touch sensitive device that when touched in at least one specific outlined area, provide the **means for externally interacting with their respective**

microprocessors.” ’467 Patent col. 2 l. 66–col. 3 l. 14 (emphasis added); “The handset and the base station **microprocessors** are configured to actuate internal circuits, make calculations, process data, generate and verify privacy codes for telephone communications, generate sound and/or data signals, control signal processing, control the reception and transmission of radio and/or infra-red frequency signals and activate access to public or private telephone networks.” ’467 Patent col. 3 l. 15–19.

Moreover, the embodiments of the ’467 Patent repeatedly describe the invention as including multiple microprocessors. The specification explains that “**The microprocessors** further provide . . . **The microprocessors** and associated software logically inter-relate data to generate information and general purpose command and control signals . . . **The microprocessors** further generate signals . . .” ’467 Patent col. 3 l. 9–31. In another embodiment, the specification describes data signals being coupled to microprocessors for processing and output: “Sensors embodied in the communications, command, control and sensing system detect physical phenomena differentials and convert these differentials into data signals. These data signals are coupled to **microprocessors** for further processing..” ’467 Patent col. 4 l. 18–22. These descriptions are consistent and without exception. *See, e.g.*, ’467 Patent col. 3 l. 15–31, col. 3 l. 44, col. 4 l. 57–60 (“received data is processed by the **respective**

microprocessor for display and/or automatic updates to command and control signals sent back to the external ...”), col. 5 l. 46–51 (“A ninth implementation comprises a sensor... which senses temperature, pressure or some other externally measurable human body condition which is then converted and processed by the **respective microprocessor...**”).

The concept of multiple microprocessors working collectively to carry out the functions of petitioner’s invention is the essence of his entire invention disclosed in his patent. The district court and Federal Circuit’s construction requiring that a single microprocessor be capable of performing all the recited functions renders the ’467 Patent virtually devoid of value; anyone may appropriate Salazar’s invention by simply adding additional microprocessors to achieve the recited functions.

Despite this admitted bedrock rule of patent law for claim construction and the invention disclosed in petitioner’s patent, the Panel read petitioner’s claim language describing “a” (non-singular) microprocessor performing certain functions as being changed by the claim language’s subsequent use of the word “said” to describe the microprocessors at issue, and concluded from the subsequent use of the word “said”—when read in context of the full claim—that the claim now required that *at least one* microprocessor be capable of performing *each of* the claimed functions, i.e., the

“generating,” “creating,” “retrieving,” and “generating” functions. In doing so, the Panel dramatically departed from the circuit’s well-settled precedent that the subsequent use of the word “said” by the claim language *does not* change the “one or more” meaning of the claim’s antecedent use of the indefinite article “a” to define an element of the invention, here “microprocessor.”

This unduly constricted reading of petitioner’s claim by the Panel not only runs counter to settled law but also rewrites petitioner’s claim language encompassing “one or more” microprocessors which would perform each of the claimed functions to now require that *a single microprocessor* perform each and every function of the claim, rendering the “or more” of the “one or more” language meaningless. It excludes the embodiments of the ’467 Patent which consistently describe petitioner’s invention as including *multiple* microprocessors to carry on its functions, the very heart of the invention itself, as disclosed in the patent.

Finally, the Panel’s unjustified narrowing of *Baldwin’s* “one or more” rule erodes the rights of patent owners like petitioner, constricting their patent claims without justification for doing so in the prosecution history, specification, or claim language. It will also remove embodiments of claimed inventions—sometimes years after the patent has issued—rendering many of these patents worthless

and leaving inventors like petitioner with no remedy for the loss of their inventions.

The Panel’s onerous claim construction was unforeseeable and unjustifiable by reference to the Federal Circuit’s prior decisions, including *Baldwin* and its progeny, disrupting petitioner’s legitimate investment-backed expectations. Its unfair, unexpected reading of petitioner’s patent claim—dramatically at odds with prior well-settled law of the Federal Circuit—constitutes a judicial taking of petitioner’s property in violation of the Fifth Amendment.

A. Petitioner’s Patent Rights are Private Property Within the Intendment of the Fifth Amendment’s Takings Clause.

The Takings Clause of the Fifth Amendment provides that “private property [shall not] be taken for public use, without just compensation.” U.S. Const. amend. V. Property rights are created by law. As a general matter, state law creates property rights, but in the case of patents, federal law defines the nature of the right. Authorized by the Constitution “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive right to their . . . Discoveries,” U.S. Const. Art. I, § 8, cl. 8, Congress enacted patent laws rewarding inventors with a limited monopoly, *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S.

898, 901 (2014). In this regard, 35 U.S.C. § 261 provides in pertinent part that “patents shall have the attributes of personal property”

In addition, the Court’s decisional law has consistently acknowledged that a patent for an invention “is as much property as a patent for land.” *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92, 96 (1876). In *James v. Campbell*, 104 U.S. 356, 358 (1882), it recognized that a patent confers upon a patentee like petitioner an *exclusive* property in the patented invention which cannot be used—even by the government—without the patentee’s consent or without just compensation being paid. *Id.*; *see also* 35 U.S.C. § 154(a)(1); *Carl Schenck, A.G. v. Norton Corp.*, 713 F.2d 782, 786 n.3 (Fed. Cir. 1983) (the patentee’s right to exclude others is “the very definition of ‘property’”); Adam Mossoff, *Patents as Constitutional Private Property: The Historical Protection of Patents Under the Takings Clause*, 87 B.U. L. Rev. 689, 700–11 (2007) (discussing that the “nineteenth-century jurisprudence was quite clear: patents are private property rights secured under the Constitution” and their taking or use without compensation even by the government was unconstitutionally unjust).

Subsequent decisions of the Court have reaffirmed the proposition that patents are property for purposes of the Takings Clause. *See Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373–75, 1379 (2018) (patents convey “a public

franchise” to the patentee which is property subject to the Takings Clause); *Horne*, 576 U.S. at 359–60 (2015) (patents are private property which cannot be taken by the government without just compensation); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002) (patentee’s monopoly under the patent laws “is a property right” whose dimensions should be clear); *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 641–43 (1999) (patents are a species of property included within the concept of “property” of which no person may be deprived without due process of law); *Ruckelshaus v. Monsanto*, 467 U.S. 986, 1003–04 (1984) (trade secrets are secured as “private property” under the Takings Clause, citing Blackstone and Locke for the proposition that “property” subsumes all things that arise from “labour and invention”).

B. The Panel’s Unfair, Unexpected Claim Construction Renders Petitioner’s Patent Worthless and Constitutes a Judicial Taking in Violation of the Fifth Amendment.

In order to constitute a taking forbidden by the Fifth Amendment, this Court has identified three factors which have “particular significance” in the analysis: (1) the economic impact of the regulation on the claimant; (2) the extent to which the regulation has interfered with distinct investment-backed expectations; and (3) the character of the

governmental action. *Connolly v. Pension Benefit Guar. Corp.*, 475 U.S. 211, 224–25 (1986) (quoting *Penn Cent. Transp. Co. v. New York City*, 438 U.S. 104, 124 (1978)); see also *Horne*, 576 U.S. at 360.

Petitioner’s showing below satisfied all three factors. In pursuing his patent claims, he justifiably relied upon a coherent body of law developed by the Federal Circuit both before *Baldwin*, see *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000) (citing cases), and after *Baldwin*, see, e.g., *01 Communique Lab., Inc. v. LogMeIn*, 687 F.3d 1292, 1297 (Fed. Cir. 2012), that the use of the indefinite article “a” preceding the word “microprocessor” carries with it the meaning of “one or more” microprocessors; and the subsequent use of the definite articles “the” or “said” simply reinvokes that non-singular meaning.

The Federal Circuit charges inventors like petitioner with knowledge of the law. *Novo Nordisk Pharm., Inc. v. Bio-Tech. Gen. Corp.*, 424 F.3d 1347, 1361 (Fed. Cir. 2005) (citing *Brasseler, U.S.A. I., L.P. v. Stryker Sales Corp.*, 267 F.3d 1370, 1385 (Fed. Cir. 2001) (“[I]nventors represented by counsel are presumed to know the law.”)). When petitioner filed the ’467 Patent in **1995**, the “one or more” construction of the indefinite article “a” when used in a patent claim was already well established. See *N. Am. Vaccine, Inc. v. Am. Cyanamid Co.*, 7 F.3d 1571, 1575–76 (Fed. Cir. **1993**) (citing Robert C. Faber, Landis on Mechanics of Patent Claim Drafting 531 (3d ed. **1990**)).

(“In a claim, the indefinite article A or AN connotes ‘one or more.’”); *see also* Root, *supra*, at § 3.03 (2023) (citing John H. Landis, *Mechanics of Patent Claim Drafting* (1970)). Prior to petitioner bringing this litigation, the Federal Circuit in *Baldwin* “strongly restated” this traditional rule. Root, *supra*, at § 3.03 (“The fact that [the *Baldwin*] court referred to this principle as ‘best described as a rule, rather than merely a presumption or even a convention,’ underlines the fact that *the Federal Circuit expects this principle to be applied as a matter of course.*” (emphasis added)).

Petitioner’s ’467 Patent describes “a” (i.e., a non-singular) microprocessor performing certain functions, a key aspect of which is the integration and use of *a plurality* of microprocessors. Petitioner thus had the legitimate expectation that his claim would be construed by the Panel consistent with *Baldwin*’s well-settled, bedrock precedent so that it would encompass the use of multiple microprocessors in performing the claimed functions. Its construction to require instead that a single microprocessor perform each and every function of the claim—founded as it was on the Panel’s overt and unexpected abnegation of *Baldwin* and its progeny—rendered his patent worthless, directly interfering with his distinct investment-backed expectations. The negative economic impact on petitioner is self-evident and the character of the government action in the form of the Panel’s erroneous claim construction at odds with its

well-settled precedent is direct and immediate. A judicial taking of petitioner's property in violation of the Fifth Amendment has therefore been made out, warranting reversal of the Panel's ruling and a remand of the matter to the district court for the resolution of petitioner's infringement claims.

That the Panel's unfair, unexpected claim construction at odds with its well-settled precedent constitutes a judicial taking of petitioner's property has been anticipated by several decisions of this Court. In *Hughes v. Washington*, 389 U.S. 290 (1967), the Washington Supreme Court, ignoring a 1946 state decision to the contrary, held that the state—not the landowner—owns certain accretions of land deposited on uplands. *Id.* at 291–92. A majority of the Court determined that ownership was a federal issue and reversed. *Id.* In a concurring opinion, Justice Stewart made the point that while a state's highest court will have the final word on state law, “to the extent that [its] judicial decision “constitutes *a sudden change* in state law, unpredictable in terms of the relevant precedents, no such deference would be appropriate.” *Id.* at 296 (Stewart, J., concurring) (emphasis added).

Justice Stewart concluded that state court judges could not defeat the constitutional prohibition against the taking of property by the simple expedient of asserting retroactively that the property it has taken “never existed at all.” *Id.* at 297 (Stewart, J., concurring). The Due Process Clause forbids such

confiscation “no less through its courts than through its legislature, and no less when a taking is unintended than when it is deliberate.” *Id.* at 298 (Stewart, J., concurring) (emphasis added).

In *Pruneyard Shopping Center v. Robins*, 447 U.S. 74 (1980), the Court responded to a shopping center owner’s claim of a taking after the California Supreme Court, overturning its own well-settled precedent, ruled that it could not regulate citizens’ expressive activity there. *Id.* at 78–80. Justice Rehnquist agreed that “there has literally been a ‘taking’ of that right [to exclude others] to the extent that the California Supreme Court has interpreted the State Constitution to entitle its citizens to exercise free expression and petition rights on shopping center property.” *Id.* at 82.

Similarly, in *Stop the Beach Renourishment, Inc. v. Florida Department of Environmental Protection*, 560 U.S. 702 (2010), Justice Scalia, writing for a plurality of the Court, acknowledged that a judicial taking occurs when “governmental actors,” i.e., the Florida Supreme Court, “recharacterize as public property what was previously private property.” *Id.* at 713. He concluded that a judicial taking is committed when a court “declares that what once was an established right of private property no longer exists.” *Id.* at 715.

Thus, the sum and substance of this Court’s jurisprudence on judicial takings is that where a court, contradicting well-settled precedent, unfairly

and unexpectedly decides that a person's property is no longer his but instead belongs to the public, it constitutes a judicial taking which can only be remedied by a reversal of that unconstitutional judgment. *Id.* at 723; *Hughes*, 389 U.S. at 298; *See also Zoltek Corp. v. United States*, 442 F.3d 1345, 1376–77 (Fed. Cir. 2006) (Plager, J., dissenting) (acknowledging the “constitutional remedy” under the Fifth Amendment for inverse condemnation arising from the taking of patent rights by government action).

This issue of predictability and reasonable reliance on well-settled precedent to justify relief in the takings context aligns with the Court's decisional law addressing due process generally. This Court has held that where a federal appellate court interprets a state statute or practice in a way that was “unforeseen” or “indefensible by reference to the law which had been expressed prior to the conduct in issue” in order to deny a litigant a hearing on the substantive right affected, it violates due process. *See Bush v. Gore*, 531 U.S. 98, 115 (2000) (Rehnquist, J., concurring); *see also United States v. Lanier*, 520 U.S. 259, 266 (1997) (due process bars courts from applying a novel construction of a criminal statute to conduct that neither the statute nor any prior judicial decision had fairly disclosed to be within its scope); *NAACP v. Ala. ex rel. Patterson*, 357 U.S. 449, 457–58 (1958) (state court's unexpected resort to new procedural rules to

deny relief to alleged contemnors violates due process).

By recharacterizing petitioner's patent claims to exclude his disclosed invention, the Panel's ruling constitutes a judicial taking of his property in violation of the Fifth Amendment. This Court should reverse the judgment below and remand the matter to the district court for the resolution of petitioner's infringement claims.

C. This Case Presents an Ideal Opportunity for the Court to Rectify the Unconstitutional Judicial Taking of Patent Rights.

The related issues of reasonable reliance, inadequate forewarning, and unfair surprise in judicial decisions—all of which can converge to cause a judicial taking of property without due process—are particularly important in the context of patent law. As Justice Kennedy wrote in *Festo Corp.*, patent laws strike a “delicate” balance “between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights.” 535 U.S. at 731; see also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989).

However, this delicate balance is put at risk when the Federal Circuit—which has jurisdiction over nearly all patent appeals in the United States—makes changes without warning, adopting new rules for claim construction and blindsiding inventors like petitioner who have justifiably relied on *Baldwin’s* “one or more” rule when drafting the patent claims for his disclosed invention. As Justice Kennedy cautioned:

[f]undamental alterations in [patent rules] risk destroying the legitimate expectations of inventors in their property. . . . “To change so substantially the rules of the game now could very well subvert the various balances the [Patent and Trademark Office] sought to strike when issuing the numerous patents

Festo Corp., 535 U.S. at 739 (quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 32 n.6 (1997)).

Such is the case here. Petitioner justifiably relied on the “one or more” bedrock rule in describing his invention. The Panel’s unfair, unjustifiable, and unforeseeable abnegation of that rule has now rendered petitioner’s patent worthless. The Panel’s claim construction so substantially changed the rules of the game as to subvert not only the legitimate investment-backed expectations of petitioner but also

the delicate balance between inventors who rely on the law and the public domain. And this erroneous claim construction constitutes grounds for granting a partial new trial on infringement. *Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1022 (Fed. Cir. 2020) (“It is well established that when an incorrect jury instruction—such as an incorrect claim construction—removes from the jury a basis on which the jury could reasonably have reached a different verdict, the verdict should not stand.”).

This case provides a valuable opportunity for the Court to remedy the Panel’s unconstitutional judicial taking and protect the constitutional objective of patent law. Petitioner appropriately argued in his petition for rehearing *en banc* that, should the Federal Circuit’s decision stand, it would constitute an unconstitutional taking. Further, because of the exclusive federal jurisdiction over patent law issues, this case does not raise any of the federalism issues often inherent in takings claims. *See, e.g., Stop the Beach Renourishment, Inc.*, 560 U.S. at 742 (Breyer, J., concurring) (expressing concerns regarding federalism issues).

It is exceptionally important for the Court to protect patent owners who are otherwise left without recourse when a Federal Circuit panel dramatically and unjustifiably departs from well-settled precedent. Patent owners must have confidence that the patent claims covering their invention will be construed in

accordance with well-settled principles of claim interpretation and in a manner that includes the disclosure of the “present invention” and embodiments of the patent, barring any specific limiting language in the specification or prosecution history. This fundamental patent law principle is crucial to a robust and efficient patent system.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted, the judgment of the Federal Circuit should be vacated, and the matter should be remanded to the district court for the Eastern District of Texas, Marshall Division, instructing the district court to conduct a partial new trial on infringement with a constitutionally sound construction of petitioner’s patent claims.

Respectfully submitted,

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September 6, 2023

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**APPENDIX A — OPINION OF THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT,
FILED APRIL 5, 2023**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2021-2320, 2021-2376

JOE A. SALAZAR,

Plaintiff-Appellant,

v.

AT&T MOBILITY LLC, SPRINT UNITED
MANAGEMENT COMPANY, T-MOBILE USA, INC.,
CELLCO PARTNERSHIP INC., DBA VERIZON
WIRELESS, INC.,

Defendants-Cross-Appellants,

HTC CORPORATION, HTC AMERICA, INC.,

Defendants.

Appeals from the United States District Court for
the Eastern District of Texas in No. 2:20-cv-00004-JRG,
Chief Judge J. Rodney Gilstrap.

Decided: April 5, 2023

Before STOLL, SCHALL, and STARK, *Circuit Judges.*

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STOLL, *Circuit Judge*.

Joe Salazar appeals the United States District Court for the Eastern District of Texas’s judgment of noninfringement, challenging the court’s claim construction. Mr. Salazar contends that the court erroneously construed “a microprocessor” to mean one microprocessor, contrary to this court’s precedent. AT&T Mobility LLC, Sprint United Management Company, T-Mobile USA, Inc., and Cellco Partnership Inc., dba Verizon Wireless, Inc. (collectively, “AT&T”) cross-appeal the district court’s ruling that Mr. Salazar’s claims were not precluded based on prior litigation and challenge the judgment that the asserted claims are not invalid as anticipated. Because we agree with the district court’s claim construction, we affirm the judgment of noninfringement. Having affirmed the judgment of noninfringement, we do not reach AT&T’s preclusion arguments. Finally, we hold that AT&T waived its challenge to the jury’s verdict on anticipation by failing to move for judgment as a matter of law under Rule 50 of the Federal Rules of Civil Procedure.

BACKGROUND

Mr. Salazar owns U.S. Patent No. 5,802,467. The ’467 patent describes technology for wireless and wired communications, including command, control, and sensing for two-way communication of sound, voice, and data “with any appliance and/or apparatus capable of transmitting and/or receiving compatible sound, voice and data signals.” ’467 patent col. 1 ll. 8-13. The ’467 patent expired on September 28, 2015.

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Independent claim 1, one of several claims that contain the terms at issue, recites:

1. A communications, command, control and sensing system for communicating with a plurality of external devices comprising:

a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols, for transmission to said external devices wherein each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices;

a memory device coupled to said microprocessor configured to store a plurality of parameter sets retrieved by said microprocessor so as to recreate a desired command code set, such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets;

a user interface coupled to said microprocessor for sending a plurality of signals corresponding to user selections to said microprocessor and displaying a plurality of menu selections available for the user's choice, said microprocessor generating a communication protocol in response to said user selections; and

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an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols.

Id. at col. 25 l. 57-col. 26 l. 17 (emphasis added).

In 2016, Mr. Salazar sued HTC Corp., alleging HTC Corp. infringed the '467 patent by selling certain HTC One phones that allegedly embodied the asserted claims. *See* Compl., *Salazar v. HTC Corp.*, No. 2:16-cv-01096, 2016 WL 11577368 (E.D. Tex. Oct. 5, 2016) (“*Salazar I*”). HTC Corp. raised two defenses: (1) that it did not commit any infringing acts in the United States; and (2) in any event, the accused phones did not infringe. *See Salazar I* Trial Tr. 21:21-22:2. A jury ultimately returned a verdict finding HTC Corp. did not infringe the '467 patent. The jury did not decide whether the '467 patent was valid, however, instead leaving that portion of the verdict form blank. J.A. 2201.

In 2019, Mr. Salazar sued AT&T, again asserting the '467 patent against the same products he challenged in *Salazar I*. HTC Corp. and HTC America, Inc. (collectively “HTC”) intervened, requesting a declaratory judgment that the accused products did not infringe. The district court severed HTC’s claims and stayed that portion of the case.

At claim construction, the parties disputed limitations present in multiple asserted claims, which required: “a

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microprocessor for generating . . . , said microprocessor creating . . . , a plurality of parameter sets retrieved by said microprocessor . . . , [and] said microprocessor generating” The district court characterized the dispute between the parties as coming down to “whether the claims require one microprocessor that is capable of performing the recited ‘generating,’ ‘creating,’ ‘retrieving,’ and ‘generating’ functions.” *Salazar v. AT&T Mobility LLC*, No. 2:20-cv-00004, 2020 U.S. Dist. LEXIS 171135, 2020 WL 5608640, at *17 (E.D. Tex. Sept. 18, 2020) (*Claim Construction Op.*). The district court answered this question in the affirmative and construed the term to mean “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving, and generating functions.” 2020 U.S. Dist. LEXIS 171135, [WL] at *19. Relying in part on our decisions in *Convolve, Inc. v. Compaq Computer Corp.*, 812 F.3d 1313 (Fed. Cir. 2016), and *In re Varma*, 816 F.3d 1352 (Fed. Cir. 2016), the district court explained that the claim term provided certain functions that the “said microprocessor” must be “necessarily configured to perform as well as the structural relationship between ‘said microprocessor’ and other structural elements.” *Claim Construction Op.*, 2020 U.S. Dist. LEXIS 171135, 2020 WL 5608640, at *19. Thus, the district court reasoned, “at least one microprocessor must satisfy all the functional (and relational) limitations recited for ‘said microprocessor.’” 2020 U.S. Dist. LEXIS 171135, [WL] at *18.

Prior to trial, AT&T moved for summary judgment, arguing that Mr. Salazar’s claims were barred under claim preclusion and the Supreme Court’s decision in *Kessler v.*

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Eldred, 206 U.S. 285, 27 S. Ct. 611, 51 L. Ed. 1065, 1907 Dec. Comm’r Pat. 696 (1907), which prevents harassment of customers of an adjudged noninfringer in specific circumstances. The district court denied that motion.

At trial, AT&T’s technical expert opined that the asserted claims were anticipated by Goldstein, a prior art reference that was not considered by the U.S. Patent Office during prosecution. J.A. 1256-92 (Trial Tr. 91:18-127:7). At the conclusion of trial, AT&T moved for judgment as a matter of law under Federal Rule of Civil Procedure 50 regarding “infringement, damages, and preclusion,” but not regarding invalidity. J.A. 1572 (Trial Tr. 198:16-19). The district court confirmed with AT&T’s counsel that it was not moving for judgment as a matter of law regarding anticipation. *Id.* (Trial Tr. 198:20-22). The jury thereafter returned its verdict, finding that the accused products did not infringe the ’467 patent and that the patent was not invalid. J.A. 397-98. The district court entered final judgment reflecting the jury’s verdict.

Mr. Salazar and AT&T both appeal. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We start by addressing Mr. Salazar’s challenge to the district court’s claim construction. We then turn to AT&T’s cross- appeal, in which it argues that the district court erred both by (1) denying AT&T’s motion for summary judgment that Mr. Salazar’s claims were barred by collateral estoppel and the *Kessler* doctrine and (2) finding that claims 1-7, 27-30, and 34 were not anticipated.

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On appeal, Mr. Salazar argues that he is entitled to a new jury trial because the court erred in construing “a” microprocessor and “said” microprocessor. Appellant’s Br. 39. According to Mr. Salazar, the court should have interpreted the claim terms to require one or more microprocessors, any one of which may be capable of performing each of the “generating,” “creating,” and “retrieving” functions recited in the claims. *Id.* at 11-12, 32-33. Put another way, in Mr. Salazar’s view, a correct claim construction would encompass one microprocessor capable of performing one claimed function and another microprocessor capable of performing a different claimed function, even if no one microprocessor could perform all of the recited functions. Mr. Salazar maintains that the district court erred by interpreting “a” microprocessor as a single microprocessor that is capable of performing all of the later recited “generating,” “creating,” and “retrieving” functions. *Id.* at 31.

We review a district court’s claim construction de novo where, as here, it is decided only on the intrinsic evidence. *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331, 135 S. Ct. 831, 190 L. Ed. 2d 719 (2015). We begin, as we must, with the claim language itself. *Immunex Corp. v. Sanofi-Aventis U.S. LLC*, 977 F.3d 1212, 1218 (Fed. Cir. 2020). The words of a claim are generally given their ordinary meaning, which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc).

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At issue in this appeal is the proper construction of the articles “a” and “said.” We have explained that the indefinite article “a” means “‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” *Convolve*, 812 F.3d at 1321 (quoting *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000)). “An exception to the general rule that ‘a’ . . . means more than one only arises where the language of the claims themselves, the specification, or the prosecution history necessitate a departure from the rule.” *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342-43 (Fed. Cir. 2008). We have also explained that “[t]he use of the term ‘said’ indicates that this portion of the claim limitation is a reference back to the previously claimed” term. *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283, 1291 (Fed. Cir. 2015); see *Baldwin*, 512 F.3d at 1343 (the claim term “said” is an “anaphoric phrase[], referring to the initial antecedent phrase”). “The subsequent use of [the] definite article[] . . . ‘said’ in a claim to refer back to the same claim term does not change the general plural rule, but simply reinvokes that non-singular meaning.” *Baldwin*, 512 F.3d at 1342.

In *Baldwin*, for example, we considered a patent describing systems for cleaning the cylinder of a printing press using cleaning fabric.¹ *Id.* at 1340. There, the claim

1. The claim at issue in *Baldwin* recited in relevant part:

A pre-packaged, pre-soaked cleaning system for use to clean the cylinder of printing machines comprising in combination:

(1) a pre-soaked fabric roll saturated to equilibrium with cleaning solvent disposed around a core, *said*

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recited “a pre-soaked fabric roll” and subsequently recited “said fabric roll.” *Id.* We held that “a pre-soaked fabric roll” meant “one or more” pre-soaked fabric rolls, and that the subsequent “said fabric roll” maintained that non-singular meaning. *Id.* at 1342-43. But we did not hold in *Baldwin* that using an indefinite article somehow displaces the antecedent basis rule, as to require “said fabric roll” to refer to something other than the same earlier referenced “pre-soaked fabric roll.” *See id.* at 1343 (stating that the Manual of Patent Examining Procedure “describes the need, in most cases, for claim terms to have proper antecedent bases”). In other words, in *Baldwin*, the “said fabric roll” was the same “one or more” pre-soaked fabric rolls that were referred to earlier in the claim.

We considered a similar claim construction dispute in *Harari v. Lee*, 656 F.3d 1331 (Fed. Cir. 2011), a case involving rewritable memory chips. There, the parties disputed the terms “a bit line” and “said bit line.”² The

fabric roll having a sealed sleeve which can be opened or removed from *said fabric roll* for use of *said fabric roll*, . . . and said system including

(2) means for locating *said fabric roll* adjacent to and operatively associated with a cylinder to be cleaned.

512 F.3d at 1340 (emphasis added).

2. The claim at issue in *Harari* recited in relevant part:

A method of treating at least one erased EEPROM cell, comprising:

[(1)] accessing a number of control gates and accessing a *bit line*, thereby activating a number of memory cells, . . . ; [and]

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relevant claim recited a method comprising accessing a number of control gates and “a bit line” to activate a number of cells. *Id.* at 1341. Noting that “*Baldwin* . . . does not set a hard and fast rule that ‘a’ always means one or more than one,” we determined that “[t]he plain language of the claim clearly indicates that only a single bit line is used when accessing a number of cells.” *Id.* We thus concluded that “the correct and only reasonable construction of the claim terms ‘a bit line’ and ‘said bit line’ . . . requires that a single bit line activates multiple memory cells.” *Id.* at 1342. Stated otherwise, “said bit line” later in the claim must be the same, singular bit line as “a bit line” earlier in the claim.

We followed similar reasoning in *Convolve*, which involved a claim element introduced with the indefinite article “a” and further defined by certain recited characteristics. 812 F.3d at 1321. Specifically, we interpreted “[u]ser interface for . . . working with *a processor* . . . comprising” in claims 1, 3, and 5 to require “a single processor” having all of the subsequently recited characteristics. *Id.* (emphasis added). In reaching this conclusion, we considered the subsequent references to the initial processor:

Specifically, claim 1 recites “a processor” in the preamble before recitation of “comprising,” and the claim body uses the definite article “the” to

[(2)] subsequent to accessing *said bit line*, sensing the presence of at least one activated cell from said number of memory cells . . .

Harari, 626 F.3d at 1340 (emphasis added).

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refer to the “processor.” This reference to “the processor,” referring back to the “a processor” recited in [the] preamble, supports a conclusion that the recited user interface is “operatively working with” the same processor to perform all of the recited steps. In other words, the claim language requires a processor associated with the user interface to issue the shaped commands of the claims. Given this claim language, which contrasts with the claims described above that allow for multiple processors, we conclude that claims 1, 3, and 5 require the user interface to work with a single processor in performing all of the claim steps.

Id. at 1321.

Claim 9, however, had no subsequent reference to “the” or “said” processor. Because that claim did not reference a single processor, we interpreted “a processor” to mean “one or more processors” in the context of that claim. *See id.*

Finally, in *Varma*, we considered claims directed to performing statistical analyses of investment data. 816 F.3d at 1355. There, the disputed claim limitation was “a statistical analysis request corresponding to two or more selected investments.” *Id.* at 1362. The Patent Trial and Appeal Board held that the limitation could be satisfied even if two statistical analysis requests were required to analyze the “two or more selected investments.” *Id.* We reversed the Board’s decision, explaining that:

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[T]he question is not whether there can be more than one request in a claim-covered system: there can. Rather, the question is whether “a” can serve to negate what is required by the language following “a”: a “request” (a singular term) that “correspond[s]” to “two or more selected investments.” It cannot. For a dog owner to have “a dog that rolls over and fetches sticks,” it does not suffice that he have two dogs, each able to perform just one of the tasks. In the present case, no matter how many requests there may be, no matter the variety of the requests the system may receive, the system must be adapted to receive a request that itself corresponds to at least two investments.

Id. at 1362-63.

Varma thus dealt with claim language that introduces a claim element using an indefinite article and further defines the element with subsequently recited functionality. While this structure may allow for more than a single instance of the claim element, it may nonetheless require that a single instance of the element be capable of performing all the recited functionality.

With this precedent in mind, we agree that the district court correctly construed the claim term Mr. Salazar challenges on appeal. Specifically, the district court properly interpreted “a microprocessor for generating . . . , said microprocessor creating . . . , a plurality of parameter sets retrieved by said microprocessor . . . ,

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said microprocessor generating . . .” to mean “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving, and generating functions.” *Claim Construction Op.*, 2020 U.S. Dist. LEXIS 171135, 2020 WL 5608640, at *19. We agree with the district court that while the claim term “a microprocessor” does not require there be only one microprocessor, the subsequent limitations referring back to “said microprocessor” require that at least one microprocessor be capable of performing each of the claimed functions. This approach is entirely consistent with our precedent.

Like the claim language in *Convolve* and *Varma*, the claim language here requires a singular element—“a microprocessor”—to be capable of performing all of the recited functionality. *See Convolve*, 812 F.3d at 1321 (requiring “a processor” and “the processor” in claims 1, 3, and 5 to “perform all of the recited steps”); *Varma*, 816 F.3d at 1362-63 (finding “a statistical analysis request corresponding to two or more selected investments” requires a single request to correspond to at least two investments where the subsequent language “makes it unmistakable that at least two investments must be the subject of each statistical analysis”). This conclusion is bolstered when we consider *Convolve*’s claim 9, which had no subsequent reference to “the” or “said” processor, and thus did not require a single processor. 812 F.3d at 1321. Here, the claim language “a microprocessor,” read in the context of the full claim, aligns more closely with *Convolve*’s claims 1, 3, and 5—which required “a processor” and “the processor” to perform the recited

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functionality—and, like those claims, should be construed to require at least one microprocessor capable of performing the recited functions.

Mr. Salazar would have us read the phrase “one or more” in the district court’s claim construction to mean “*any one of the one or more*” when referring to the later-recited functions. Appellant’s Br. 35. We decline to do so. Although Mr. Salazar insists that the phrase “said microprocessor” “simply reinvokes th[e] non-singular meaning,” *Id.* at 22 (quoting *Baldwin*, 512 F.3d at 1342), the claim’s use of “said” does not negate what is required by the language that follows “said”: a “microprocessor” that “generat[es],” “creat[es],” and “retriev[es].” As we stated in *Varma*, “[f]or a dog owner to have ‘a dog that rolls over and fetches sticks,’ it does not suffice that he have two dogs, each able to perform just one of the tasks.” 816 F.3d at 1363. Here, it does not suffice to have multiple microprocessors, each able to perform just one of the recited functions; the claim language requires at least one microprocessor capable of performing each of the recited functions.

Because we agree with the district court’s claim construction, we affirm its judgment of noninfringement.

II

We now turn to AT&T’s cross-appeal challenging (1) the district court’s ruling that Mr. Salazar’s claims were not barred by claim preclusion or the *Kessler* doctrine; and (2) the district court’s finding that the asserted claims were not invalid as anticipated.

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At oral argument, AT&T agreed that we need not reach its preclusion arguments if we affirm the district court's judgment of noninfringement. *See* Oral Arg. at 9:46-10:10, https://oralarguments.ca9c.uscourts.gov/default.aspx?fl=21-2320_11072022.mp3. As explained above, we affirm the district court's judgment and, accordingly, do not address this issue.

Finally, we turn to AT&T's anticipation argument. The jury found that the asserted claims were not anticipated, and the district court subsequently entered judgment consistent with that finding. On appeal, AT&T argues that “[i]t was reversible error for the district court to hold that asserted claims 1-7, 27-30, and 34[] are not anticipated” because AT&T “presented substantial, clear and convincing evidence” that the asserted claims are anticipated. Cross-Appellants' Br. 49-50. But AT&T failed to move for judgment as a matter of law under Federal Rule of Civil Procedure 50. Its failure to do so dooms this argument.

A party must make proper motions under Rule 50 in order to appeal an adverse verdict on grounds relating to the sufficiency of the evidence. *See Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1308 (Fed. Cir. 2011) (“Rule 50(a)(2) requires the moving party” to make its motion for judgment as a matter of law “to preserve the issue.”); *Feld Motor Sports, Inc. v. Traxxas, L.P.*, 861 F.3d 591, 596 (5th Cir. 2017) (“[T]his court has jurisdiction to hear an appeal of the district court's legal conclusions . . . , but only if it is sufficiently preserved in a Rule 50 motion.”). Here, AT&T did not move under Rule 50 regarding any validity ground, including anticipation. As a result, it never

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challenged the sufficiency of the evidence with respect to anticipation before the district court, and it has therefore waived its anticipation challenge on appeal.

Hoping to correct its error, AT&T requests we “liberally constru[e]” Rule 50(a) to require parties to move under that Rule only if “the court [or opposing] attorneys needed any more enlightenment about [the appellant’s] position on those issues.” Cross-Appellants’ Reply Br. 19-20 (quoting *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1380 (Fed. Cir. 2009)). But AT&T’s reliance on *Blackboard* is misplaced. In *Blackboard*, the defendant made “cursory” Rule 50(a) motions regarding anticipation and obviousness, and the district court acknowledged those motions. 574 F.3d at 1379. We held that “in light of the Fifth Circuit’s practice of liberally construing the rule,” the cursory motions and “the district judge’s prompt statement that he would take both motions under advisement, made clear that no more was necessary to serve the purposes of Rule 50(a).” *Id.* at 1379-80.

That was not the case here. In contrast to the defendant in *Blackboard*, AT&T explicitly expressed to the district court that it would not move under Rule 50(a) regarding anticipation:

THE COURT: Let me hear from Defendants.
What matters do Defendants seek relief on
under Rule 50(a)?

[COUNSEL FOR AT&T]: Your Honor, we
intend to seek relief on issues of infringement,
damages, and preclusion.

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THE COURT: Not on anticipation under Rule 102?

[COUNSEL FOR AT&T]: We are not moving under Rule 50(a) for anticipation.

J.A. 1572 (Trial Tr. 198:16-22). In other words, AT&T clearly disavowed any intention to move for judgment as a matter of law regarding anticipation. Accordingly, even under the most liberal construction of the requirements of Rule 50(a), AT&T has nevertheless waived its anticipation argument.

CONCLUSION

We have considered the parties' remaining arguments and find them unpersuasive. For the foregoing reasons, we affirm the judgment of noninfringement.

AFFIRMED

COSTS

No costs.

**APPENDIX B — OPINION OF THE UNITED
STATES DISTRICT COURT FOR THE EASTERN
DISTRICT OF TEXAS, MARSHALL DIVISION,
FILED SEPTEMBER 18, 2020**

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

CIVIL ACTION NO. 2:20-cv-00004-JRG

JOE ANDREW SALAZAR,

Plaintiff,

v.

AT&T MOBILITY LLC, SPRINT UNITED
MANAGEMENT COMPANY, T-MOBILE USA
INC., CELLCO PARTNERSHIP D/B/A VERIZON
WIRELESS, INC.,

Defendants,

HTC CORP. and HTC AMERICA, INC.,

Intervenors.

**CLAIM CONSTRUCTION MEMORANDUM
OPINION AND ORDER**

Before the Court is the opening claim construction
brief of Joe Andrew Salazar (“Plaintiff”) (Dkt. No. 97,

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filed on June 10, 2020),¹ the response of AT&T Mobility LLC; Sprint/United Management Company; T-Mobile USA, Inc.; Cellco Partnership d/b/a Verizon Wireless; HTC Corporation; and HTC America, Inc. (collectively “Defendants”) (Dkt. No. 102, filed on June 24, 2020), and Plaintiff’s reply (Dkt. No. 103, filed on July 1, 2020) and supplemental brief (Dkt. No. 112, filed on July 30, 2020). The Court held a hearing on the issues of claim construction and claim definiteness on July 24, 2020. Having considered the arguments and evidence presented by the parties at the hearing and in their briefing, the Court issues this Order.

[TABLES INTENTIONALLY OMITTED]

I. BACKGROUND

Plaintiff alleges infringement of U.S. Patent No. 5,802,467 (the “467 Patent”). The ’467 Patent is entitled Wireless and Wired Communications, Command, Control and Sensing System for Sound and/or Data Transmission and Reception. The application leading to the ’467 Patent was filed on September 28, 1995 and the patent issued on September 1, 1998. Plaintiff asserts Claims 1-7, 27-30, and 34. Dkt. No. 97 at 7.

The ’467 Patent was previously construed by the Court in Claim Construction Opinion and Order, *Joe Andrew*

1. Citations to the parties’ filings are to the filing’s number in the docket (Dkt. No.) and pin cites are to the page numbers assigned through ECF.

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Salazar v. HTC Corporation et al., No. 2:16-cv-01096-JRG, Dkt No. 108, 2017 U.S. Dist. LEXIS 183222 (E.D. Tex. Nov. 3, 2017) and Report and Recommendation, *Joe Andrew Salazar v. HTC Corporation et al.*, No. 2:16-cv-01096-JRG, Dkt No. 250, 2018 U.S. Dist. LEXIS 235016 (E.D. Tex. May 1, 2018). The claim construction order is referred to herein as the “*HTC CC Order*,” the Report and Recommendation as the “*HTC R&R*,” and the case as the “HTC Case.”

In general, the '467 Patent is directed to technology for “wireless and wired communications, command, control and sensing ... for the two way communication of sound, voice, and data with any appliance and/or apparatus capable of transmitting and/or receiving compatible sound, voice and data signals.” '467 Patent col.1 ll.8-13.

The abstract of the '467 Patent provides:

An interactive microprocessor based wireless communication device includes sound and data transceivers, signal detection and coupling devices, signal conversion device, voice recording, playback and storage device, voice activated device, display device, touch screen or similar device, sensors, frequency generation device, sound detection and reproduction devices and power source to concurrently perform generalized two way wireless communications, command, control and sensing functions utilizing radio and infra-red frequency communication links. A microprocessor

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receives signals from the touch screen and generates a digital data, command/or control signal for transmission to external devices such as home appliances and remote sensors. The microprocessor also responds to voice signal commands received via microphone and a voice processor. The microprocessor uses this signal to generate data, command/or control signals for transmission to external devices such as telephone, paging and intercom systems. Sound signals may be stored in a voice recorder and playback IC for subsequent message processing and coupling to a transceiver and/or a speaker. Telephone ringer signals are generated by the microprocessor and are coupled to a ringer for audio output. In response to certain commands, the wireless communication device establishes a communication link with external devices using radio frequency or infra-red frequency transmission and/or reception. Sensor signals are created by sensors that can detect physical differential changes and that can convert the changes into measurements. These signals are coupled to the microprocessor for further processing, display and/or transmission.

Claims 1 and 34, the asserted independent claims, recite as follows (the disputed terms are emphasized and the terms that Defendants contend render claims indefinite are underlined):

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1. A communications, command, control and sensing system for communicating with a plurality of external devices comprising:

a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols, for transmission to said external devices wherein each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices;

a memory device coupled to said microprocessor ***configured to store a plurality of parameter sets retrieved by said microprocessor so as to recreate a desired command code set, such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets***;

a user interface coupled to said microprocessor for sending a plurality of signals corresponding to user selections to said microprocessor and displaying a plurality of menu selections available for the user's choice,

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said microprocessor generating a communication protocol in response to said user selections; and

an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols.

34. A communications, command, control and sensing system for communicating with a plurality of external devices comprising:

a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols for transmission to said external devices wherein each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices;

a memory device coupled to said microprocessor configured to store a plurality of parameter sets retrieved by said microprocessor so as to recreate

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based on said parameter sets a desired set of pulse signals corresponding to logical “1’s” and “0’s” as specified by a command code set;

- a user interface coupled to said microprocessor for sending a plurality of signals corresponding to user selections to said microprocessor and displaying a plurality of menu selections available for the user’s choice, **said microprocessor generating a communication protocol in response to said user selections**; and

an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols.

II. LEGAL PRINCIPLES

A. Claim Construction

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Innova/Pure Water Inc. v. Safari Water Filtration Sys.*,

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Inc., 381 F.3d 1111, 1115 (Fed. Cir. 2004)). To determine the meaning of the claims, courts start by considering the intrinsic evidence. *Id.* at 1313; *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861 (Fed. Cir. 2004); *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001). The intrinsic evidence includes the claims themselves, the specification, and the prosecution history. *Phillips*, 415 F.3d at 1314; *C.R. Bard, Inc.*, 388 F.3d at 861. The general rule—subject to certain specific exceptions discussed *infra*—is that each claim term is construed according to its ordinary and accustomed meaning as understood by one of ordinary skill in the art at the time of the invention in the context of the patent. *Phillips*, 415 F.3d at 1312-13; *Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361, 1368 (Fed. Cir. 2003); *Azure Networks, LLC v. CSR PLC*, 771 F.3d 1336, 1347 (Fed. Cir. 2014) (“There is a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time.”) (vacated on other grounds).

“The claim construction inquiry . . . begins and ends in all cases with the actual words of the claim.” *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998). “[I]n all aspects of claim construction, ‘the name of the game is the claim.’” *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1298 (Fed. Cir. 2014) (quoting *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998)). First, a term’s context in the asserted claim can be instructive. *Phillips*, 415 F.3d at 1314. Other asserted or unasserted claims can also aid in determining the claim’s meaning, because claim terms are typically used

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consistently throughout the patent. *Id.* Differences among the claim terms can also assist in understanding a term's meaning. *Id.* For example, when a dependent claim adds a limitation to an independent claim, it is presumed that the independent claim does not include the limitation. *Id.* at 1314-15.

“[C]laims ‘must be read in view of the specification, of which they are a part.’” *Id.* (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc)). “[T]he 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.’” *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002). But, “[a]lthough the specification may aid the court in interpreting the meaning of disputed claim language, particular embodiments and examples appearing in the specification will not generally be read into the claims.” *Comark Communs, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998) (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988)); *see also Phillips*, 415 F.3d at 1323. “[I]t is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004).

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The prosecution history is another tool to supply the proper context for claim construction because, like the specification, the prosecution history provides evidence of how the U.S. Patent and Trademark Office (“PTO”) and the inventor understood the patent. *Phillips*, 415 F.3d at 1317. 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.” *Id.* at 1318; *see also Athletic Alternatives, Inc. v. Prince Mfg.*, 73 F.3d 1573, 1580 (Fed. Cir. 1996) (ambiguous prosecution history may be “unhelpful as an interpretive resource”).

Although extrinsic evidence can also be useful, it is “less significant than the intrinsic record in determining the legally operative meaning of claim language.” *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc.*, 388 F.3d at 862). Technical dictionaries and treatises may help a court understand the underlying technology and the manner in which one skilled in the art might use claim terms, but technical dictionaries and treatises may provide definitions that are too broad or may not be indicative of how the term is used in the patent. *Id.* at 1318. Similarly, expert testimony may aid a court in understanding the underlying technology and determining the particular meaning of a term in the pertinent field, but an expert’s conclusory, unsupported assertions as to a term’s definition are not helpful to a court. *Id.* Extrinsic evidence is “less reliable than the patent and its prosecution history in determining how to read claim terms.” *Id.* The Supreme Court has explained the role of extrinsic evidence in claim construction:

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In some cases, however, the district court will need to look beyond the patent's intrinsic evidence and to consult extrinsic evidence in order to understand, for example, the background science or the meaning of a term in the relevant art during the relevant time period. *See, e.g., Seymour v. Osborne*, 78 U.S. 516, 11 Wall. 516, 546, 20 L. Ed. 33 (1871) (a patent may be “so interspersed with technical terms and terms of art that the testimony of scientific witnesses is indispensable to a correct understanding of its meaning”). In cases where those subsidiary facts are in dispute, courts will need to make subsidiary factual findings about that extrinsic evidence. These are the “evidentiary underpinnings” of claim construction that we discussed in *Markman*, and this subsidiary factfinding must be reviewed for clear error on appeal.

Teva Pharms. USA, Inc. v. Sandoz, Inc., 574 U.S. 318, 331-32, 135 S. Ct. 831, 190 L. Ed. 2d 719 (2015).

B. Departing from the Ordinary Meaning of a Claim Term

There are “only two exceptions to [the] general rule” that claim terms are construed according to their plain and ordinary meaning: “1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of the claim

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term either in the specification or during prosecution.”² *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014) (quoting *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)); see also *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014) (“[T]he specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal.”). The standards for finding lexicography or disavowal are “exacting.” *GE Lighting Sols.*, 750 F.3d at 1309.

To act as his own lexicographer, the patentee must “clearly set forth a definition of the disputed claim term,” and “clearly express an intent to define the term.” *Id.* (quoting *Thorner*, 669 F.3d at 1365); see also *Renishaw*, 158 F.3d at 1249. The patentee’s lexicography must appear “with reasonable clarity, deliberateness, and precision.” *Renishaw*, 158 F.3d at 1249.

To disavow or disclaim the full scope of a claim term, the patentee’s statements in the specification or prosecution history must amount to a “clear and unmistakable” surrender. *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1329 (Fed. Cir. 2009); see also *Thorner*, 669 F.3d at 1366 (“The patentee may demonstrate intent to deviate from the ordinary and accustomed meaning of a claim term

2. Some cases have characterized other principles of claim construction as “exceptions” to the general rule, such as the statutory requirement that a means-plus-function term is construed to cover the corresponding structure disclosed in the specification. See, e.g., *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1367 (Fed. Cir. 2002).

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by including in the specification expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.”). “Where an applicant’s statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable.” *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013).

C. Definiteness Under 35 U.S.C. § 112, ¶ 2 (pre-AIA) / § 112(b) (AIA)

Patent claims must particularly point out and distinctly claim the subject matter regarded as the invention. 35 U.S.C. § 112, ¶ 2. A claim, when viewed in light of the intrinsic evidence, must “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910, 134 S. Ct. 2120, 189 L. Ed. 2d 37 (2014). If it does not, the claim fails § 112, ¶ 2 and is therefore invalid as indefinite. *Id.* at 901. Whether a claim is indefinite is determined from the perspective of one of ordinary skill in the art as of the time the application for the patent was filed. *Id.* at 911. As it is a challenge to the validity of a patent, the failure of any claim in suit to comply with § 112 must be shown by clear and convincing evidence. *BASF Corp. v. Johnson Matthey Inc.*, 875 F.3d 1360, 1365 (Fed. Cir. 2017). “[I]ndefiniteness is a question of law and in effect part of claim construction.” *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir. 2012).

When a term of degree is used in a claim, “the court must determine whether the patent provides some

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standard for measuring that degree.” *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1378 (Fed. Cir. 2015) (quotation marks omitted). Likewise, when a subjective term is used in a claim, “the court must determine whether the patent’s specification supplies some standard for measuring the scope of the [term].” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1351 (Fed. Cir. 2005). The standard “must provide objective boundaries for those of skill in the art.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014).

D. Previous Constructions of Disputed Terms**D-1. Prior court constructions are entitled to reasoned deference.**

The “importance of uniformity in the treatment of a given patent” suggests a level of deference to previous court constructions of disputed claim terms. *See Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008) (quoting *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 390, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996)); *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 329, 135 S. Ct. 831, 190 L. Ed. 2d 719 (2015) (noting that “prior cases . . . sometimes will serve as persuasive authority”). While the “doctrine of *stare decisis* does not compel one district court judge to follow the decision of another . . . previous claim constructions in cases involving the same patent are entitled to substantial weight.” *TQP Dev., LLC v. Intwit Inc.*, No. 2:12-CV-180-WCB, 2014 U.S. Dist. LEXIS 84057, at *21-22 (E.D. Tex. June 20, 2014) (Bryson, J.).

*Appendix B***D-2. In some instances, a party may be estopped from pursuing a claim construction different from a prior court construction under the equitable doctrine of issue preclusion.**

In some instances, previous court construction of a disputed term may trigger issue preclusion and bind a party to a previous construction. *Teva*, 574 U.S. at 329 (“prior cases will sometimes be binding because of issue preclusion”) (citing *Markman*, 517 U.S. at 391). “Issue preclusion generally refers to the effect of a prior judgment in foreclosing successive litigation of an issue of fact or law actually litigated and resolved in a valid court determination essential to the prior judgment, whether or not the issue arises on the same or a different claim [for relief].” *New Hampshire v. Maine*, 532 U.S. 742, 748-49, 121 S. Ct. 1808, 149 L. Ed. 2d 968 (2001). “Issue preclusion prohibits a party from seeking another determination of the litigated issue in the subsequent action.” *Soverain Software LLC v. Victoria’s Secret Direct Brand Mgmt., LLC*, 778 F.3d 1311, 1315 (Fed. Cir. 2015) (quoting *State Farm Mut. Auto. Ins. Co. v. Logisticare Sols., LLC*, 751 F.3d 684, 689 (5th Cir. 2014)). Issue preclusion applies only if four conditions are met:

First, the issue under consideration in a subsequent action must be identical to the issue litigated in a prior action. Second, the issue must have been fully and vigorously litigated in the prior action. Third, the issue must have been necessary to support the judgment in the prior case. Fourth, there must be no special

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circumstance that would render preclusion inappropriate or unfair.

State Farm, 751 F.3d at 689. Ultimately, issue preclusion is an “equitable doctrine” and the “discretion vested in trial courts to determine when it should be applied is broad.” *Nations v. Sun Oil Co.*, 705 F.2d 742, 744 (5th Cir. 1983) (citing *Parklane Hosiery Co., Inc. v. Shore*, 439 U.S. 322, 331, 99 S. Ct. 645, 58 L. Ed. 2d 552 (1979)).

III. AGREED CONSTRUCTIONS

The parties have agreed to constructions set forth in their Revised Joint Claim Construction Chart Pursuant to Patent Rule 4-5(d). Dkt. No. 108. Based on the parties’ agreement, the Court hereby adopts the agreed constructions for this case.

IV. CONSTRUCTION OF DISPUTED TERMS

- A. **“a plurality of signals” and “a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols”**

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Disputed Term³	Plaintiff's Proposed Construction	Defendants' Proposed Construction
<p>“a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols”</p> <ul style="list-style-type: none"> • '467 Patent Claim 1, 34 <p>“a plurality of control signals”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	<p>a microprocessor configured to generate a plurality of control signals used to operate said system and configured to create a plurality of [reprogrammable] communication protocols to the extent not covered by this Court's construction in the HTC Case, plain and ordinary meaning</p>	<p>a microprocessor configured to bring into existence two or more control signals used to operate said system and configured to bring into existence two or more [reprogrammable] communication protocols two or more signals</p>

Because the parties' arguments and proposed constructions with respect to these terms are related, the Court addresses the terms together.

3. For all term charts in this order, the claims in which the term is found are listed with the term but: (1) only the highest-level claim in each dependency chain is listed, and (2) only asserted claims identified in the parties' Revised Joint Claim Construction Chart Pursuant to Patent Rule 4-5(d) (Dkt. No. 108) are listed. Based on Plaintiff's statement in its opening claim construction brief, the

*Appendix B***The Parties' Positions**

Plaintiff submits: This term should be construed as the Court construed it in the HTC Case (citing *HTC CC Order* at 15-22). Specifically, it would be improper to construe “generating” control signals and “creating” protocols in the term to require the microprocessor bring the signals and protocols into existence. Indeed, the Court rejected such an interpretation in the HTC Case and there noted that “the creation of new ‘rules’ for communicating . . . would defeat the purpose of the invention—to facilitate communication with different third-party external devices” (quoting *HTC R&R* at 8-9). Finally, construing “plurality” as “two or more” improperly deviates from the ordinary and customary meaning of “plurality.” Dkt. No. 97 at 16-17, 20.

In addition to the claims themselves, Plaintiff cites the following intrinsic and extrinsic evidence to support its position: **Intrinsic evidence:** '467 Patent col.8 ll.22-30, col.8 ll.60-65, col.16 ll.40-45; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2, 10 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3, 11), February 17, 1998 Notice of Allowability at 2 (Plaintiff's Ex. C, Dkt. No. 97-4 at 3).

Defendants respond: The claim terms “create” and “generate” and variants mean to bring something into existence, thus the microprocessor term is directed to bringing signals and protocols into existence. Further, the plain and ordinary meaning of “plurality” is “two or more.” Dkt. No. 102 at 8-9, 13, 17-18.

Court understands that the asserted claims are Claims 1-7, 27-30 and 34. Dkt. No. 97 at 7. Of these, Claims 1 and 34 are independent and the others are dependent claims.

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In addition to the claims themselves, Defendants cite the following intrinsic and extrinsic evidence to support their position: **Intrinsic evidence:** '467 Patent col.7 ll.14-19. **Extrinsic evidence:** *Webster's New World College Dictionary* (3d ed. 1996), "create" and "generate" (Defendants' Ex. C, Dkt. No. 102-4 at 4-5).

Plaintiff replies: As described in the '467 Patent, the claimed invention is directed to facilitating communication with third-party devices, and the manufacturers of those devices determine the communication protocols and command sets for those devices. In other words, it is the manufacturer of those devices, not the recited microprocessor, that brings the protocols and command sets into existence. Further, "plurality" in the microprocessor term "is not a quantification but rather simply refer[s] to a variety/various (and is used interchangeably with these terms) control signals used to communicate with different third-party external devices." Dkt. No. 103 at 4-6.

Plaintiff cites further **intrinsic evidence** to support its position: '467 Patent col.7 ll.37-60, col.8 ll.52-54, col.11 ll.15-19, col.16 ll.42-46.

Analysis

There are two issues in dispute. The first issue is whether "generating" signals and "creating" protocols requires bringing the signals and protocols into existence. To the extent that Defendants contend that "generating" and "creating" in the term somehow precludes the use of signals and protocols that are previously defined, the Court rejects Defendants' "bring into existence"

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construction. The second issue is whether the “plurality” of signals and protocols necessarily refers to two or more signals and protocols. It does.

In the HTC Case, the Court directly addressed the issue of whether “generating” or “creating” in the claims requires bringing new protocols into existence and thereby excludes systems that utilize predefined third-party protocols. *HTC R&R* at 8-9. The Court there held as follows:

In describing the microprocessor, the specification notes one embodiment is “configured to utilize several communication protocols employed by various manufacturers or various models of the same brand.” ’467 Patent at 7:37-39. But nowhere does the specification teach the creation of new “rules” for communicating, which would defeat the purpose of the invention—to facilitate communication with different third-party external devices.

Id. The position that Defendants here advocate is the same as that rejected by the Court in the HTC Case. The Court reiterates the reasoning and ruling set forth in *HTC R&R* and rejects Defendants’ proposed construction regarding “create,” “generate,” and variants of those words.

The Court rejects Plaintiff’s position that “plurality of control signals” and “plurality of reprogrammable communication protocols” is satisfied by a single control signal or communication protocol, respectively. The Federal Circuit has instructed that “‘plurality’ when

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used in a claim, refers to two or more items, absent some indication to the contrary.” *Dayco Prods. v. Total Containment, Inc.*, 258 F.3d 1317, 1328 (Fed. Cir. 2001). In other words, the plain and ordinary meaning of plurality is “two or more.” The context in which “plurality” is used may indicate that the term is used other than according to this plain and ordinary meaning to “describe a universe ranging from one to some higher number, rather than requiring more than one item.” *See Versa Corp. v. Ag-Bag Int’l Ltd.*, 392 F.3d 1325, 1330 (Fed. Cir. 2004). Plaintiff has not established any context in the ’467 Patent that indicates “plurality” is meant to encompass the singular. The fact that “plurality” in the patent indicates a “variety” of control signals or protocols suggests just the opposite of Plaintiff’s position. Instead of indicating that “plurality” includes a singular signal or protocol, the patent teaches that plurality indicates a variety of signals or protocols, meaning several. For example, the patent provides:

One embodiment of handset 10, in accordance with the present invention, is ***configured to communicate with various devices such as TV sets***. VCR sets, CD players, and Cable boxes. The handset is further ***configured to utilize several communication protocols*** employed by various manufacturers or various models of the same brand. Typically, ***each manufacturer*** of one of these devices such as TV sets, VCR sets, CD players and Cable boxes, ***employs a specific communication protocol that includes a command code set for performing various functions*** to remotely control the device. ***Each command code set comprises a set of signals***,

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wherein each signal is utilized to perform an available function. For example, a TV set made by manufacturer A, may require a command code set that includes various signals to remotely control various available functions such as channel up, channel down, volume up, volume down, mute, and power “on” and “off”. This command code set may have a different set of signals than another command code set employed for a TV set made by manufacturer B. In the alternative, manufacturer A may employ different command code sets for its own various models of TV sets.

’467 Patent col.7 ll.34-54 (emphasis added). Ultimately, Plaintiff fails to identify any context that indicates “plurality” in the claims is used other than according to its plain and ordinary meaning of “two or more.”

Accordingly, the Court construes these terms as follows:

- “a plurality of signals” means “two or more signals”; and
- “a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols” means “a microprocessor configured to generate two or more control signals used to operate said system and configured to create two or more reprogrammable communication protocols.”

*Appendix B***B. The Selector Terms**

Disputed Term	Plaintiff's Proposed Construction	Defendants' Proposed Construction
<p data-bbox="435 726 685 1650">“a selector controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as desired, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals”</p> <ul data-bbox="435 1675 634 1747" style="list-style-type: none"> <li data-bbox="435 1675 634 1747">• '467 Patent Claim 2 	<p data-bbox="695 726 948 1650">a selector controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as selected by a user, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals</p>	<p data-bbox="959 726 1209 1692">a multiplexer/demultiplexer controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as desired, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals</p>

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Disputed Term	Plaintiff's Proposed Construction	Defendants' Proposed Construction
"selector" <ul style="list-style-type: none"> • '467 Patent Claim 2 	to the extent not covered by this Court's construction in the HTC Case, plain and ordinary meaning	a multiplexer/demultiplexer

Because the parties' arguments and proposed constructions with respect to these terms are related, the Court addresses the terms together.

The Parties' Positions

Plaintiff submits: These terms should be construed as the Court construed them in the HTC Case (citing *HTC CC Order* at 31-36). Specifically, it would be improper to construe "selector" as "multiplexer/demultiplexer," which terms do not appear in the '467 Patent. Dkt. No. 97 at 17-19.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent figs.1b, 3, 5, col.1 ll.50-52, col.20 ll.2-17, col.20 ll.41-56; '467 Patent File Wrapper October 31, 1997 Amendment at 5, 11, 13-14 (Plaintiff's Ex. B, Dkt. No. 97-3 at 6, 12, 14-15).

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Defendants respond: The “selector” of ’467 Patent is described as providing “full two way RF and IR communication links” and is depicted as including two-way connections to both RF (radio frequency) and IR (infrared) transceivers. As described, the selector routes received RF and IR signals from the appropriate transceiver to a common path, and routes RF and IR signals from a common path to the appropriate transceiver for transmission. Thus, the defining nature of the selector is that, when receiving, it selects between multiple inputs (both IR and RF) to route to a single output, and when transmitting, it selects between multiple outputs (both IR and RF) to route from a single input. This is a multiplexer/demultiplexer. Dkt. No. 102 at 9-11.

In addition to the claims themselves, Defendants cite the following **intrinsic evidence** to support their position: ’467 Patent fig.3, col.1 ll.50-52, col.20 ll.11-17, col.20 ll.40-46, col.20 ll.49-50, col.20 ll.60-63, col.23 ll.23-29, col.23 ll.32-38, col.23 ll.51-55, col.24 ll.25-28.

Plaintiff replies: Nothing identified by Defendants supports narrowing “selector” to a multiplexer/demultiplexer. Dkt. No. 103 at 6-7.

Analysis

The issue in dispute distills to whether the “selector” is, as a matter of claim construction, necessarily a multiplexer/demultiplexer. It is not.

The “selector” is not necessarily a “multiplexer/demultiplexer.” Defendants’ argument is essentially

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that the only “selector” embodiment in the ’467 Patent has two transceivers connected to a single common path through the selector and thus the selector is limited to this embodiment. Defendants’ have not, however, established that the claims are necessarily limited to such an arrangement. *See Phillips*, 415 F.3d at 1323 (“In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.”); *see also, Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1366 (Fed. Cir. 2012) (“It is likewise not enough that the only embodiments, or all of the embodiments, contain a particular limitation. We do not read limitations from the specification into claims; we do not redefine words. Only the patentee can do that.”). While it is plain from the claim language that the selector enables selection between RF and IR signals (“transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as desired”), the claims are silent on whether the RF and IR transceivers are coupled to a common path through the selector. Further, neither “multiplexer” nor “demultiplexer” are used anywhere in the patent. Thus, even if “multiplexer” and “demultiplexer” carry the meanings Defendants accord them (without evidence), injecting the terms into the construction is not supported.

Accordingly, the Court determines that “selector” has its plain and ordinary meaning without the need for further construction and construes the “a selector controlled by ...” term as follows:

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- “a selector controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as desired, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals” means “a selector controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as selected by a user, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals.”

C. “a communication protocol”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“a communication protocol” • ’467 Patent Claims 1, 34	plain and ordinary meaning	a defined set of rules and formats that allows devices to communicate with each other

*Appendix B***The Parties' Positions**

Plaintiff submits: This term should be construed as the Court construed it in the HTC Case (citing *HTC CC Order* at 42-46). Specifically, and as previously held by the Court, it would be improper inject a “set of rules” limitation into the construction. Dkt. No. 97 at 19-20.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent col.7 ll.14-25, col.7 ll.37-54; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2, 10 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3, 11).

Defendants respond: As described in the '467 Patent, communication protocols define the device-specific rules and formats for communication between devices. This comports with the customary meaning of the term in the art of telecommunications. Dkt. No. 102 at 11-13.

In addition to the claims themselves, Defendants cite the following intrinsic and extrinsic evidence to support their position: **Intrinsic evidence:** '467 Patent col.7 ll.14-21, col.7 ll.40-44. **Extrinsic evidence:** *Newton's Telecom Dictionary* at 1013-14 (30th ed. 2016), “protocol” (Defendants' Ex. A, Dkt. No. 102-2 at 4-5).

Plaintiff replies: As the Court stated in the HTC Case, the term “communication protocol” is sufficiently defined by the claim language” (quoting *HTC CC Order* at 46). Dkt. No. 103 at 7.

*Appendix B***Analysis**

The issue in dispute is whether the “communication protocol” of the claims is limited to “rules and formats” that enable communication. It is not.

The issue here is substantially similar to the issue addressed by the Court in the HTC Case. There, the Court refused to construe “communication protocols” as “sets of rules that allow for two or more devices to communicate wirelessly with one another using a command code set to produce an action in a remotely controlled external device” and held:

The Court is not persuaded by Defendant’s arguments given that nothing in the intrinsic record requires Defendant’s construction. ***For example, the term “rules” or “set of rules” is never mentioned in the intrinsic record, and the inclusion of such terms would add ambiguity and/or confusion to this term. Overall, the intrinsic record is consistent with the claims in defining the communication protocol in relation to the command code set.*** In effect, Defendant is trying to redefine the “command code set” term rather than defining the “communication protocol” term. Defendant’s attempt to separately define both “communication protocols” and “command code set” using similar language / limitations makes such limitations redundant and/or superfluous.

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Overall, the Court finds “communication protocol” is sufficiently defined by the claim language and, in particular, the “command code set” limitation. Nothing else is needed. *See U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997) (“Claim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement. It is not an obligatory exercise in redundancy.”); *see also O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008) (“[D]istrict courts are not (and should not be) required to construe every limitation present in a patent’s asserted claims.”) (*citing U.S. Surgical*, 103 F.3d at 1568).

HTC CC Order at 45-46 (emphasis added). The Court there noted that a “communication protocol” of the claims is defined by its “command code set.” *Id.* at 39 (“each independent claim specifies that ‘each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices’”). This nature of the protocol is repeated in the description of the invention. *See, e.g.*, ’467 Patent col.7 ll.40-44 (“Typically, each manufacturer of one of these devices such as TV sets, VCR sets, CD players and Cable boxes, employs a specific communication protocol that includes a command code set for performing various functions to remotely control the device.”); *see also, HTC CC Order* at 40 (quoting this passage).

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The Court is not persuaded that its holding or reasoning in the HTC Case is incorrect and should be supplanted by Defendants' current proposal. For example, Defendants propose "a defined set of rules and formats" but their extrinsic evidence states that a protocol is "a set of rules governing the format." *Newton's Telecom Dictionary* at 1013, Dkt. No. 102-2 at 5. How is a "set of rules and formats" different from a "set of rules governing the format"? The variance between Defendants' proposal and the extrinsic evidence proffered in support of that proposal exacerbates the "ambiguity and/or confusion" that the Court previously determined would result from injecting "rules" or "set of rules" into the construction. *HTC CC Order* at 45. For example, does the command code set itself set forth the "rules and formats" of the communication? If not, what else is required? Ultimately, the Court reiterates the reasoning and ruling set forth in the *HTC CC Order*: "communication protocol" is sufficiently defined by the claim language and, in particular, the 'command code set' limitation. Nothing else is needed." *Id.* at 46.

Accordingly, the Court determines that "communication protocol" has its plain and ordinary meaning without the need for further construction.

*Appendix B***D. “a plurality of reprogrammable communication protocols”**

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
<p>“a plurality of reprogrammable communication protocols”</p> <ul style="list-style-type: none"> • ’467 Patent Claims 1, 34 	<p>to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning</p>	<p>Indefinite. Protocols cannot be reprogrammable.</p> <p>Alternatively:</p> <ul style="list-style-type: none"> • two or more communication protocols whose rules and formats can be changed through programming

The Parties’ Positions

Plaintiff submits: In the HTC Case, the Court construed “a plurality of reprogrammable communication protocols” in the context of the “a microprocessor for generating ...” phrase, and gave the term its plain and ordinary meaning (citing *HTC CC Order* at 15-22). Here, Defendants have not provided any evidence that a communication protocol cannot be reprogrammable and therefore fail to establish by clear and convincing evidence that this term renders any claim indefinite. Further,

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Defendants' alternative construction is improperly narrow. Dkt. No. 97 at 27-28.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent col.8 ll.22-30, col.8 ll.60-65, col.16 ll.40-45; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3).

Defendants respond: A "communication protocol" is not a "program" and therefore is not reprogrammable. Specifically, Plaintiff represented to the PTAB in an IPR proceeding that "reprogrammable" in the '467 Patent refers to "a program that can be replaced with another." In the patent, however, a "communication protocol" is created by a program but is not itself a program. Thus, it cannot be reprogrammable. Dkt. No. 102 at 14-15.

In addition to the claims themselves, Defendants cite the following intrinsic and extrinsic evidence to support their position: **Intrinsic evidence:** '467 Patent col.7 ll.14-19; Patent Owner's Preliminary Response, *HTC Corp. et al. v. Joe Andrew Salazar*, IPR2018-00273 (P.T.A.B. Apr. 11, 2018), Paper No. 10 at 3 (Defendants' Ex. B, Dkt. No. 102-3 at 11). **Extrinsic evidence:** *Newton's Telecom Dictionary* at 1013-14 (30th ed. 2016), "protocol" (Defendants' Ex. A, Dkt. No. 102-2 at 4-5).

Plaintiff replies: As the Court previously determined in the HTC Case, the meaning of this term is plain to a person of ordinary skill in the art without construction. Further, "plurality" here, as in "plurality of control signals," "is not a quantification but rather a reference

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to a variety/various communication protocols.” Dkt. No. 103 at 7-8.

Analysis

There are two issues in dispute. The first issue is whether “reprogrammable communications protocol” renders the claims indefinite because a protocol is technologically not reprogrammable. It does not. The second issue is whether “plurality” necessarily refers to “two or more.” It does.

The Court rejects Defendants’ contention that Plaintiff’s IPR statement somehow renders any claim indefinite. For example, the ’467 Patent states that “each [device] manufacturer . . . employs a specific communication protocol that includes a command code set for performing various functions to remotely control the device. Each command code set comprises a set of signals, wherein each signal is utilized to perform an available function.” ’467 Patent col.7 ll.40-44. Thus, it can fairly be stated that a communication protocol includes a set of instructions for performing functions and Plaintiff broadly used “program” in the IPR proceeding to encompass such a set.

The Court also rejects the phrase “whose rules and formats can be changed through programming” in Defendants’ alternative construction. As set forth above, “rules and formats” is not a useful, or proper, construction of “communication protocol.” Further, Defendants’ “through programming” phrase presupposes that “program” and “communication protocol” are necessarily mutually exclusive terms, which presupposition the Court rejects.

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Finally, and as set forth in the discussion of the “a microprocessor for generating a plurality ...” term, “plurality” is used in the claims to denote “two or more.”

Accordingly, the Court holds that Defendants have not proven any claim indefinite for including the phrase “reprogrammable communications protocol” and construe the term as follows:

- “a plurality of reprogrammable communication protocols” means “two or more reprogrammable communication protocols.”

E. “such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets” • ’467 Patent Claim 1	to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning	indefinite

*Appendix B***The Parties' Positions**

Plaintiff submits: This term should be construed to have its plain and ordinary meaning as the Court construed it in the HTC Case (citing *HTC CC Order* at 22-30). The only indefiniteness position provided by Defendants appears to be that the term is part of a “memory device” limitation that is governed by 35 U.S.C. § 112, ¶ 6. This exact issue was addressed and rejected by the Court in the HTC Case. Dkt. No. 97 at 28-29.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent col.8 ll.22-30, col.8 ll.60-65, col.16 ll.40-45; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2, 10-12 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3, 11-13).

Defendants respond: The phrase “said parameters” lacks antecedent basis. Specifically, the claim recites “a plurality of parameter sets” and then “said parameters.” Thus, it is not clear if “said parameters” refers to the parameter sets at all, to the entirety of the sets, to one of the sets, or to just some of the parameters within the sets. Dkt. No. 102 at 16-17.

Plaintiff replies: As the Court recognized in the HTC Case, the '467 Patent uses “parameters” interchangeably with “parameter sets” (quoting *HTC CC Order* at 46-49). Thus, “said parameters” in the claims refers to the earlier-recited “parameter sets.” Dkt. No. 103 at 8-9.

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Plaintiff cites further **intrinsic evidence** to support its position: '467 Patent col.8 ll.22-30.

Analysis

The issue in dispute is whether the meaning of “said parameters” is reasonably certain in the context of the claims and the description of the invention. It is. It refers to the earlier-recited “parameter sets.”

Read in the proper context, it is reasonably certain that “said parameters” refers to the earlier recited “plurality of parameter sets.” The '467 Patent notes one issue of supporting communications with a variety of devices is the memory required to store the command sets for the various devices. *See, e.g.*, '467 Patent col.7 l.55 — col.8 l.17 (it “requires a substantially large memory to store all the command code sets with various sets of signals”). To address this issue, a control device “in accordance with the present invention employs an encoding technique to store the desired signals in a memory space.” *Id.* at col.8 ll.17-21. Specifically, the memory of the control device “in accordance with the present invention . . . is configured so as to **store a finite set of parameters** that may be used to recreate and generate signals corresponding to a desired **command code set. These parameters** take substantially less memory space than if the entire signal were to be stored.” *Id.* at col.8 ll.22-30 (emphasis added); *see also id.* at col.8 ll.36-54 (“each command code set is represented by parameters stored in an array . . . This arrangement leads to a substantial reduction in memory space required to store parameters corresponding to various command code

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sets.”). In other words, the patent teaches representing a command code set with a smaller parameter set. The benefit taught is not that some subset of the parameter set requires less memory than the entirety of the command code set but rather that the entirety of the parameter set requires less memory than the entirety of the command code set. This enables the system to generate any desired command-code-set signal from the parameter set while requiring less memory than storing the command code set itself.

The language used to describe the memory-saving aspect of the invention is paralleled in the claim at issue: “a memory device coupled to said microprocessor configured to **store a plurality of parameter sets** retrieved by said microprocessor so as to recreate a desired command code set, such that the memory space required to **store said parameters** is smaller than the memory space required to store said **command code sets**.” *Id.* at col.26 ll.1-6. In the context of the description of the invention, it is reasonably certain that “said parameters” in the claims, like the “parameters” in the description of the invention, refer to the parameter sets that allow recreation of the command code sets and require less memory than the command code sets.

Accordingly, the Court holds that Defendants have not proven any claim is indefinite for including “said parameters” and construes the term as follows:

- “such that the memory space required to store said parameters is smaller than the memory space

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required to store said command code sets” means “such that the memory space required to store said plurality of parameter sets is smaller than the memory space required to store said command code sets.”

F. “a desired command code set”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“a desired command code set” <ul style="list-style-type: none"> • ’467 Patent Claim 1 	to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning	a different command code set than the command code set that defines the signals that are employed to communicate with each one of said external devices alternatively, <ul style="list-style-type: none"> • indefinite for lacking antecedent basis

*Appendix B***The Parties' Positions**

Plaintiff submits: This term should be construed to have its plain and ordinary meaning as the Court construed it in the HTC Case (citing *HTC CC Order* at 22-30). Defendants' proposed construction is improperly limiting and their alternative argument that the term renders claims indefinite for lack of antecedent basis is not supported by the requisite evidence. Dkt. No. 97 at 29-30.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent col.8 ll.22-30, col.8 ll.60-65, col.16 ll.40-45; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2, 10-12 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3, 11-13).

Defendants respond: The term "a desired command code set" is necessarily different from the "a command code set that defines the signals that are employed to communicate with each one of said external devices" earlier recited in the claim for two reasons. First, the two command code sets are separately recited in the claim. Second, the claims recite "a desired command code set" rather than "the command code set," indicating that they are not the same command code set. "Absent that construction, . . . this term is indefinite for lacking antecedent basis." Dkt. No. 102 at 19-20.

Plaintiff replies: The only restriction on the "desired command code set" is that it is "recreated from the retrieved parameter sets." Dkt. No. 103 at 9.

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Plaintiff cites further **intrinsic evidence** to support its position: '467 Patent col.7 l.55 — col.8 l.65, col.16 ll.25-46.

Analysis

The issue in dispute is whether “a desired command code set” is necessarily different from the command code set earlier recited in the phrase “each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices.” It is not; and this does not render any claim indefinite.

Claim 1 provides significant context to inform the understanding of “a desired command code set.” Specifically, the claim provides:

a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols, for transmission to said external devices wherein ***each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices;***

a memory device coupled to said microprocessor configured to store a plurality of parameter sets retrieved by said microprocessor so as to ***recreate a desired command code set***, such that the memory space required to store said

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parameters is smaller than the memory space required to store **said command code sets**;

a user interface coupled to said microprocessor for sending a plurality of signals corresponding to user selections to said microprocessor and displaying a plurality of menu selections available for the user's choice, said microprocessor ***generating a communication protocol in response to said user selections***; and

an infra-red frequency transceiver coupled to said microprocessor for ***transmitting to said external devices and receiving from said external devices***, infra-red frequency signals in accordance with said communications protocols.

'467 Patent col.25 1.60 – col.26 1.18 (emphasis added). Plainly, there are a plurality of communication protocols and thus there are a plurality of “command code sets” that define the communication signals that are employed to communicate with each one of said external devices. While the communication-signal-defining command code sets are recited distinctly from “a desired command code set,” there is nothing in a plain reading of the claim language that precludes the desired set from being one of the communication-signal-defining command code sets. Indeed, and as discussed above, the '467 Patent teaches that the command sets are recreated from parameters to reduce the amount of required memory—it takes less memory to store the parameters used to recreate the command sets than to store the command sets. In this light, one would expect that the “desired command code set” that is recreated

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from the stored parameters may be one of the command code sets that defines the communication signals.

Accordingly, the Court holds that Defendants have failed to prove any claim is indefinite for including “a desired command code set” and further rejects Defendants’ proposed construction. The Court therefore determines that this term has its plain and ordinary meaning without the need for further construction.

G. “a microprocessor for generating ..., said microprocessor creating ..., a plurality of parameter sets retrieved by said microprocessor ..., said microprocessor generating ...”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“a microprocessor for generating ..., said microprocessor creating ..., a plurality of parameter sets retrieved by said microprocessor ..., said microprocessor generating ...” • ’467 Patent Claims 1, 34	to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning	one or more microprocessors, each of which must perform the generating, creating, retrieving, and generating functions

*Appendix B***The Parties' Positions**

Plaintiff submits: This term should be construed to have its plain and ordinary meaning, subject to the Court's previous constructions in the HTC Case (citing *HTC CC Order* at 15-30). Defendants' proposed construction is improperly limiting in that it requires that the microprocessor "must perform" the functions. As the Court explained in the HTC Case, the claims are directed to capability, and do not require actual performance of the functions. Dkt. No. 97 at 21-23.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent col.7 ll.37-39, col.8 ll.22-30, col.8 ll.60-65, col.16 ll.40-45; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3), February 17, 1998 Notice of Allowability at 2 (Plaintiff's Ex. C, Dkt. No. 97-4 at 3).

Defendants respond: The claims are directed to capability, and do not require actual performance, and the claims do not exclude systems of multiple microprocessors. The claims, however, require a (singular) microprocessor that is capable of performing all the recited microprocessor functions. In other words, the claims require that the same microprocessor that is capable of the recited "generating" is also capable of the later-recited "creating," "retrieving," and "generating." This does not encompass a system in which no single microprocessor is capable of performing all the recited functions, even if the system includes multiple microprocessors that in the aggregate

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are capable of performing all the recited functions. Dkt. No. 102 at 21-23.

Plaintiff replies: The claims are open-ended “comprising” claims and “a microprocessor” means “one or more microprocessors.” This means “that any one of the one or more microprocessors can be capable of performing any one of the recited functions in this claim term, and any individual one of the microprocessors (or all the microprocessors) need not be capable of performing all of the recited functions.” Dkt. No. 103 at 9-10.

Analysis

The issue in dispute distills to whether the claims require one microprocessor that is capable of performing the recited “generating,” “creating,” “retrieving,” and “generating” functions. They do. The plain reading of the claims is that the same microprocessor is capable of performing all the recited functions attributed to “said microprocessor.”

The claims provide significant context to inform the understanding of the “microprocessor” phrases. For example, Claim 1 provides:

1. A communications, command, control and sensing system for communicating with a plurality of external devices comprising:

a microprocessor for generating a plurality of control signals used to operate

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said system, ***said microprocessor creating*** a plurality of reprogrammable communication protocols, for transmission to said external devices wherein each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices;

a memory device coupled to said microprocessor configured to store a plurality of ***parameter sets retrieved by said microprocessor*** so as to recreate a desired command code set, such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets;

a user interface coupled to said microprocessor for ***sending*** a plurality of signals corresponding to user selections ***to said microprocessor*** and displaying a plurality of menu selections available for the user's choice, ***said microprocessor generating*** a communication protocol in response to said user selections; and

an ***infra-red frequency transceiver coupled to said microprocessor*** for transmitting

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to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols.

'467 Patent col.25 l.57 – col.26 l.18 (emphasis added). Thus, the claimed system includes “a microprocessor” having various structural characteristics defined by its functions and by its relationships to other structural limitations. Claim 34 is similar in this respect. Plaintiff contends that “a microprocessor” of the claims, because it means “one or more microprocessors,” encompasses a plurality of microprocessors that in the aggregate satisfy the functional (and presumably relational) limitations. For example, Plaintiff contends that Claim 1 encompasses a multi-microprocessor system in which no single microprocessor is configured “for generating” control signals, for “creating” reprogrammable communication protocols, for “retriev[ing]” parameter sets, and for “generating” a communication protocol in response to a user selection. Plaintiff’s argument also necessarily implies that no single microprocessor is “coupled to” a memory device, a user interface, and an infra-red frequency transceiver. Rather, Plaintiff contends that each recited microprocessor limitation may be satisfied by a different microprocessor.

The Court agrees with Defendants that under Federal Circuit precedent, at least one microprocessor must satisfy all the functional (and relational) limitations recited for “said microprocessor.” The parties dispute the import of two Federal Circuit opinions: *Convolve, Inc. v. Compaq*

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Computer Corp., 812 F.3d 1313 (Fed. Cir. 2016) and *In re Varma*, 816 F.3d 1352 (Fed. Cir. 2016). Both opinions involve interpretation of a claim element introduced with the indefinite article “a” and further defined by claim-recited characteristics of the element. Both opinions hold that claim language alone may require a singular element to have all recited characteristics. *Convolve* states that starting position of such an interpretation:

This court has repeatedly emphasized that an indefinite article “a” or “an” in patent parlance carries the meaning of “one or more” in open-ended claims containing the transitional phrase “comprising.” ... The exceptions to this rule are extremely limited: a patentee must evince a clear intent to limit “a” or “an” to “one.”

Convolve, 812 F.3d at 1321 (quotation and modification marks omitted). In the context of interpreting “a processor” defined simply by enumerated functions that it executes, *Convolve* found no intent to limit the claims (claim 9 and 15) to one processor performing all the functions. *Id.* In the context of interpreting “[u]ser interface for . . . working with a processor . . . comprising” in other claims (claims 1, 3, and 5), however, *Convolve* found an intent to limit “a processor” to a singular processor having all the claim-recited characteristics:

Here, unlike claims 9 and 15, the language and structure of claim 1 demonstrate a clear intent to tie the processor that “output[s] commands to the data storage device” to the “user interface.”

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Specifically, claim 1 recites “a processor” in the preamble before recitation of “comprising,” and the claim body uses the definite article “the” to refer to the “processor.” This reference to “the processor,” referring back to the “a processor” recited in preamble, supports a conclusion that the recited user interface is “operatively working with” the same processor to perform all of the recited steps. In other words, the claim language requires a processor associated with the user interface to issue the shaped commands of the claims. Given this claim language, which contrasts with the claims described above that allow for multiple processors, we conclude that claims 1, 3, and 5 require the user interface to work with a single processor in performing all of the claim steps.

Id. Varma, in the context of interpreting “a statistical analysis request corresponding to two or more selected investments,” similarly found that a single “statistical analysis request” must correspond to two or more selected investments:

But while “a” sometimes is non-restrictive as to number, permitting the presence of more than one of the objects following that indefinite article, context matters even as to whether the word has that meaning. . . . And here the question is not whether there can be more than one request in a claim-covered system: there can. Rather, the question is whether “a”

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can serve to negate what is required by the language following “a”: a “request” (a singular term) that “correspond[s]” to “two or more selected investments.” It cannot. For a dog owner to have “a dog that rolls over and fetches sticks,” it does not suffice that he have two dogs, each able to perform just one of the tasks. In the present case, no matter how many requests there may be, no matter the variety of the requests the system may receive, the system must be adapted to receive a request that itself corresponds to at least two investments.

Varma, 816 F.3d at 1362-63. Thus, while a claim element introduced by an indefinite article and further defined by claim-recited characteristics may not be limited to one instance of the element, the way in which the characteristics are recited may dictate that at least one instance of the element must have all the claim-recited characteristics.

In the claims at issue here, one “microprocessor” is set forth in the claims as including a variety of characteristics. The claim-recited characteristics are not just a simple listing of functions to be performed by “a microprocessor.” Rather, the characteristics are repeatedly introduced using “said microprocessor.” Those characteristics include the functions that “said microprocessor” is necessarily configured to perform as well as the structural relationship between “said microprocessor” and other structural elements. In this respect, the claims here are distinguishable from claims

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9 and 15 addressed in *Convolve* and are analogous to claims 1, 3, and 5 addressed in *Convolve* and the claim addressed in *Varma*. Notably, the repeated use of “said microprocessor” to enumerate the functional and relational characteristics of “a microprocessor” suggests that the same microprocessor that is “coupled to” various structural elements is the one that is configured to perform the various recited microprocessor functions. In other words, one microprocessor must have all the recited characteristics.

Accordingly, the Court construes this phrase as follows:

- “a microprocessor for generating ..., said microprocessor creating ..., a plurality of parameter sets retrieved by said microprocessor ..., said microprocessor generating ...” means “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving, and generating functions.”

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H. “said communications protocols” and “said microprocessor generating a communication protocol in response to said user selections”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“said microprocessor generating a communication protocol in response to said user selections” ⁴ • ’467 Patent Claims 1, 34	to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning	said microprocessor generating a communication protocol different from the reprogrammable communication protocols alternatively, • indefinite
“said communications protocols” • ’467 Patent Claims 1, 34	plain and ordinary meaning	indefinite

Because the parties’ arguments and proposed constructions with respect to these terms are related, the Court addresses the terms together.

4. The parties identify the term with the singular “selection,” the claims recite “selections.” Dkt. No. 108-1 at 53-56.

*Appendix B***The Parties' Positions**

Plaintiff submits: These terms should be construed to have their plain and ordinary meanings consistent with the Court's construction of "communication protocol" in the HTC Case (citing *HTC CC Order* at 42-46). Defendants' proposed construction of "said microprocessor generating a communication protocol in response to said user selections" is improperly limiting and Defendants have not provided the requisite evidence to establish that either term renders any claim indefinite. Dkt. No. 97 at 30-31.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent col.7 ll.14-25, col.7 ll.37-54; '467 Patent File Wrapper October 31, 1997 Amendment at 1-2, 10 (Plaintiff's Ex. B, Dkt. No. 97-3 at 2-3, 11).

Defendants respond: The term "a communication protocol" is necessarily different from the "a plurality of reprogrammable communication protocols" earlier recited in the claim for two reasons. First, the terms are separately recited in the claims. Second, the claims recite "a communication protocol," using the indefinite article "a" rather than the definite article "the," indicating that it is not referring to a previously recited "communication protocol." The term "said communications protocols" renders the claims indefinite as the claims recite multiple different communication protocols and it is not clear which one corresponds to "said communications protocols." Dkt. No. 102 at 23-24, 29-30.

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Plaintiff replies: The claims recite that the microprocessor has the capability to create a “plurality of reprogrammable communication protocols” for communication with external devices and the term “said microprocessor generating a communication protocol in response to said user selections” refers back to the earlier recited communication protocols. The term “said communications protocols” in the claims denotes that the generated protocol is for communication with external devices. Dkt. No. 103 at 11-12.

Analysis

There are two issues in dispute. The first issue is whether “a communication protocol” in the claims is necessarily different from a plurality of reprogrammable communication protocols recited earlier in the claims. It is not. The second issue is whether the meaning of “said communications protocols” is reasonably certain. It is; it refers to the plurality of reprogrammable communication protocols.

The communication protocol of “said microprocessor creating a plurality of reprogrammable communication protocols” is not necessarily different from the communication protocol of “said microprocessor generating a communication protocol in response to said user selections.” This issue is similar to the difference between the “desired command code set” and the communication-signal-defining command sets addressed above. Again, the claims provide significant context to inform the proper understanding. For example, Claim 1 provides:

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a microprocessor for generating a plurality of control signals used to operate said system, ***said microprocessor creating a plurality of reprogrammable communication protocols***, for transmission to said external devices wherein ***each communication protocol includes a command code set that defines the signals that are employed to communicate with each one of said external devices***;

a memory device coupled to said microprocessor configured to store a plurality of parameter sets retrieved by said microprocessor so as to recreate a desired command code set, such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets;

a user interface coupled to said microprocessor for sending a plurality of signals corresponding to user selections to said microprocessor and displaying a plurality of menu selections available for the user's choice, ***said microprocessor generating a communication protocol in response to said user selections***; and

an infra-red frequency transceiver coupled to said microprocessor for ***transmitting to said external devices and receiving from said external devices***, infra-red frequency signals ***in accordance with said communications protocols***.

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'467 Patent col.25 l.60 – col.26 l.18 (emphasis added). Plainly, there are a plurality of communication protocols that govern the communication with the external devices, each including a communication-signal-defining command set. While these reprogrammable communication protocols are recited distinctly from “a communication protocol” that is generated in response to user selections, there is nothing in a plain reading of the claim language that precludes the user-selected communication protocol from being one of the communication-governing communication protocols. Indeed, the '467 Patent describes selecting and activating protocols from among stored communication protocols. *See, e.g.*, '467 Patent col.19 ll.64-67 (“In response to touch sequences, modes of operation and communication protocols are selected as explained above in reference with FIG. 6.”), col.20 ll.7-11 (“Transmission and reception protocols are contained within microprocessor 30 and are activated based on the mode selection made via touch sensitive device 14. In this manner, handset 10 communicates with any number of external devices having compatible transceivers.”). Again, under a plain reading of the patent, one would expect that the communication protocol generated in response to the user selections may be one of the reprogrammable communication protocols that include the communication-signal-defining code sets.

The term “said communications protocols” in the claims refers back to the “reprogrammable communication protocols.” First, there is only one earlier recitation of the plural “communications protocols”; namely, the “plurality of reprogrammable communication protocols.” This commonality of protocol count suggests that the plural

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“communications protocols” refers to the “plurality of reprogrammable communication protocols.” Second, the reprogrammable communication protocols govern communication with external devices through their communication-signal-defining command code sets and the transmitting and receiving (communicating) of the claim is in accord with “said communications protocols.” This commonality of communication-governing function again suggests that the “said communications protocols” refers to the “plurality of reprogrammable communication protocols.” Ultimately, when read in context, the meaning of “said communication protocols” is reasonably certain.

Accordingly, the Court holds that Defendants have not proven any claim is indefinite for including “said microprocessor generating a communication protocol in response to said user selections” or “said communications protocols.” The Court further determines that “said microprocessor generating a communication protocol in response to said user selections” has its plain and ordinary meaning without the need for further construction and construes “said communications protocols” as follows:

- “said communications protocols” means “said plurality of reprogrammable communication protocols.”

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I. “an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols” ⁵ • ’467 Patent Claims 1, 34	to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning	for each of the two or more external devices, the infra-red frequency transceiver must be capable of both transmitting to that device and receiving from that device, in accordance with said communications protocols

5. The parties omit “infra-red frequency signals” from the term identified for construction. Dkt. No. 108-1 at 56–59.

*Appendix B***The Parties' Positions**

Plaintiff submits: Subject to the Court's constructions in the HTC Case, this term should be construed to have its plain and ordinary meaning (citing *HTC CC Order* at 31-36, 42-46). Indeed, the Court rejected Defendants' proposed construction in the HTC Case, there noting that "[t]he limitation only requires that the IR transceiver be capable of sending and receiving IR signals to the plurality of external devices—not that it be capable of transmitting and sending to each device within that plurality" (quoting *HTC R&R* at 6-7). Dkt. No. 97 at 23-24.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent figs.1b, 3, 5, col.1 ll.50-52, col.2 ll.17-20, col.7 ll.14-25, col.7 ll.37-54, col.20 ll.2-17, col.20 ll.41-56; '467 Patent File Wrapper October 31, 1997 Amendment at 5, 10-11, 13-14 (Plaintiff's Ex. B, Dkt. No. 97-3 at 6, 11-12, 14-15).

Defendants respond: The phrase "said external devices" refers to the earlier recited "plurality of external devices" thus the infra-red transceiver must be capable of transmitting to and receiving from each of the plurality of external devices. Dkt. No. 102 at 25.

Plaintiff replies: The Court should reject Defendants' proposed construction here as it did in the HTC Case. Dkt. No. 103 at 12.

*Appendix B***Analysis**

The issue in dispute distills to whether “said external devices” should be construed as “each external device of the plurality of external devices.” It should not.

This issue was addressed by the Court in the HTC Case. The Court is not persuaded by Defendants’ argument and evidence that the HTC Case ruling was incorrect. Specifically:

The asserted claims require an “infra-red frequency transceiver coupled to [said] microprocessor for transmitting to said external devices and receiving from said external devices.” . . .

Effectively, Defendant urges the Court to construe “said external devices” in the microprocessor limitation as “*each* external device of the plurality of external devices.” . . .

The limitation only requires that the IR transceiver be capable of sending and receiving IR signals to the plurality of external devices—not that it be capable of transmitting and sending to each device within that plurality. The specification supports this conclusion by noting “the signals can be transmitted *and/or* received . . . to any number of appliances and/or apparatus capable of receiving *and/or* transmitting compatible signals.” ’467 Patent at 2:17-20 (emphasis added).

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HTC R&R at 6-7. The Court reiterates the reasoning and ruling set forth in *HTC R&R* and rejects Defendants' proposed construction regarding the "infra-red transceiver ..." limitation.

Accordingly, the Court rejects Defendants' proposed construction and determines that this term has its plain and ordinary meaning without the need for further construction.

J. "a radio frequency transceiver ... in accordance with said communication protocols"

Disputed Term	Plaintiff's Proposed Construction	Defendants' Proposed Construction
"a radio frequency transceiver ... in accordance with said communication protocols" • '467 Patent Claim 2	to the extent not covered by this Court's construction in the HTC Case, plain and ordinary meaning	the radio frequency transceiver must transmit and receive signals in accordance with the same protocols as used by the infra-red frequency transceiver of claim 1

*Appendix B***The Parties' Positions**

Plaintiff submits: Subject to the Court's constructions in the HTC Case, this term should be construed to have its plain and ordinary meaning (citing *HTC CC Order* at 31-36, 42-46). Indeed, the Court rejected Defendants' proposed construction in the HTC Case, there noting that "it's nonsensical to require the RF transceiver to communicate using IR communications protocols, or to require the IR transceiver to communicate using RF protocols" (quoting *HTC R&R* at 7-8). Dkt. No. 97 at 24-25.

In addition to the claims themselves, Plaintiff cites the following **intrinsic evidence** to support its position: '467 Patent figs.1b, 3, 5, col.1 ll.50-52, col.2 ll.17-20, col.7 ll.14-25, col.7 ll.37-54, col.20 ll.2-17, col.20 ll.41-56; '467 Patent File Wrapper October 31, 1997 Amendment at 5, 10-11, 13-14 (Plaintiff's Ex. B, Dkt. No. 97-3 at 6, 11-12, 14-15).

Defendants respond: Claim 1 refers to infra-red communications "in accordance with said communication protocols" and Claim 2, which depends from Claim 1, refers to radio frequency communications "in accordance with said communication protocols." Since "said communication protocols" necessarily means the same thing in both claims, the infra-red transceiver and the radio-frequency transceiver necessarily use the same protocols. Dkt. No. 102 at 26.

Plaintiff replies: The Court should reject Defendants' proposed construction here as it did in the HTC Case. Dkt. No. 103 at 12.

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Plaintiff cites further **intrinsic evidence** to support its position: '467 Patent col.3 ll.61-62.

Analysis

The issue in dispute distills to whether the RF transceiver necessarily communicates with RF external devices using the same protocol used by the IR transceiver for communicating with IR external devices. It does not.

Claim 2, which depends from Claim 1, provides significant context to properly understand this term. Specifically, it provides:

1. A communications. command, control and sensing system for communicating with a plurality of external devices comprising:

a microprocessor for generating a plurality of control signals used to operate said system. said microprocessor creating ***a plurality of reprogrammable communication protocols, . . .***

an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices. infra-red frequency signals ***in accordance with said communications protocols.***

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2. The communication, command, control and sensing system of claim 1 further comprising:

radio frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said devices radio frequency signals at variable frequencies within a predetermined frequency range and ***in accordance with said communication protocols . . .***

'467 Patent col.25 l.56 – col.26 l.26. For the same reasons that “said communications protocols” in Claim 1 refers to the “plurality of reprogrammable communication protocols” (set forth above), “said communications protocols” in Claim 2 refers to the “plurality of reprogrammable communication protocols.” While this means that both the IR and RF communications are in accord with the “plurality of reprogrammable communication protocols” it does not mean that the RF transceiver necessarily uses the same (IR) protocol used by the IR transceiver (or vice versa). Indeed, this issue, packaged in a different form, was addressed by the Court in the HTC Case. The Court is not persuaded by Defendants’ argument and evidence that the HTC Case ruling was incorrect. Specifically:

Each asserted claim requires the IR transceiver to transmit and receive “in accordance with [earlier-recited] communications protocols.” . . .

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The point of the invention is to enable communication with many different types of external devices, which between them may implement different IR and/or RF communication protocols. Considering the claim language in that context, it's nonsensical to require the RF transceiver to communicate using IR communications protocols, or to require the IR transceiver to communicate using RF protocols.

HTC R&R at 7-8. Further, the IR and RF transceivers are not necessarily both used for sending to and receiving from each external device. *See, e.g.*, '467 Patent col.2 ll.17-20 ("the signals can be transmitted and/or received . . . to any number of appliances and/or apparatus capable of receiving and/or transmitting compatible signals"), col.4 ll.61-63 ("External appliance and/or apparatus functions are controlled in response to a radio or infra-red command and control signal generated and transmitted by the wireless communications, command, control and sensing system."), col.5 ll.14-15 ("These communication links [between the communications, command, control and sensing system and external appliances and/or apparatuses] are two way radio and/or infra-red links."), col.5 ll.15-27 (listing examples). In other words, the patent teaches: (1) communicating with an external device with IR only or RF only and, as set forth above, (2) different devices may have different protocols. Thus, communication with one device may be through an IR protocol and with a different device through a RF protocol different from the IR protocol. Ultimately, the Court reiterates the

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reasoning and ruling set forth in *HTC R&R* and rejects Defendants' proposed construction requiring the RF transceiver to use the same protocol as the IR transceiver.

Accordingly, the Court rejects Defendants' proposed construction and determines that this term has its plain and ordinary meaning without the need for further construction.

K. "a sound and data coupling device adapted to receive sound as data signals"

Disputed Term	Plaintiff's Proposed Construction	Defendants' Proposed Construction
"a sound and data coupling device adapted to receive sound as data signals" • '467 Patent Claim 7	to the extent not covered by this Court's construction in the HTC Case, plain and ordinary meaning	a device adapted to receive sound as data signals, excluding voice

The Parties' Positions

Plaintiff submits: The meaning of this term is plain to one of ordinary skill in the art and there is no reason to stray from that plain and ordinary meaning. Dkt. No. 97 at 25-26.

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Defendants respond: The device of Claim 7 is narrower than the device of Claim 6, from which Claim 7 depends, in that the “device in claim 7 cannot receive sound commands. It is limited to receiving sound as data signals only.” Claim 6 recites a device capable of receiving sound commands: “a sound activated device coupled to said microprocessor . . . used to recognize sound signals including sound commands.” The term at issue (i.e., the device of Claim 7) is narrower, it refers only to “sound as data signals.” Since voice and data are distinguished from each other in the ’467 Patent, the device of Claim 7 is adapted only to receive sound as data signals while the device of Claim 6 may receive both voice and data signals. Dkt. No. 102 at 27-28.

In addition to the claims themselves, Defendants cite the following **intrinsic evidence** to support their position: ’467 Patent, at [57] Abstract, col.17 ll.41-44, col.17 ll.56-60, col.21 ll.37-40, col.21 ll.43-58.

Plaintiff replies: Defendants’ proposed construction is improperly narrow. Dkt. No. 103 at 13.

Analysis

The issue in dispute appears to be whether the “sound and data coupling device adapted to receive sound as data signals” is adapted solely for the function of receiving sound as data signals, to the exclusion of any other capability, such as receiving voice. It is not.

A plain reading of the claims does not support Defendants’ proposed construction. Specifically, Claims 6 and 7 of the ’467 Patent provide:

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6. The communications, command, control and sensing system of claim 1, further comprising ***a sound activated device coupled to said microprocessor, said sound activated device used to recognize sound signals including sound commands*** corresponding to executable logical commands, said sound activated device generating signals in response to recognized sound signals for further processing by said microprocessor.

7. The communications command, control and sensing system of claim 6, further comprising ***a sound and data coupling device adapted to receive sound as data signals.***

'467 Patent col.26 ll.51-61 (emphasis added). Defendants argue that the device of Claim 6 is capable of receiving both voice (sound commands) and sound as data and because Claim 7 is necessarily narrower than Claim 6 under the doctrine of claim differentiation, the device of Claim 7 necessarily receives only sound as data. Defendants' application of claim differentiation is unfounded. Even if the "sound activated device" of Claim 6 were necessarily the same as the "sound and data coupling device" of Claim 7—which is not supported by a plain reading of the claims or by any argument or evidence—the device of Claim 7 requires the ability to receive sound as data signals while the device of Claim 6 simply does not preclude such ability. Thus, the device of Claim 7 is narrower without precluding the ability to receive voice. Plainly, while the "sound and data coupling device" of Claim 7 is "adapted to receive

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sound as data signals” this does not preclude it from having other features, such as the ability to receive voice.⁶

Accordingly, the Court rejects Defendants’ proposed construction and determines that this term has its plain and ordinary meaning without the need for further construction.

L. “configured to”

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“configured to” <ul style="list-style-type: none"> • ’467 Patent Claims 1, 34⁷ 	to the extent not covered by this Court’s construction in the HTC Case, plain and ordinary meaning	a particularized arrangement of the memory device for a specific purpose

6. The Court notes that “voice” and “data” are not necessarily mutually exclusive as the terms are used in the ’467 Patent. For example, the patent teaches “microphones couple external sound signal, including voice signals, to a sound and data_coupler,” and “[s]ound, voice, and/or data signals [are] inputted via a microphone.” ’467 Patent col.3 ll.32-34, col.3 ll.41-42. Thus, while “sound,” “voice,” and “data,” are frequently separately enumerated in the patent, the enumerated categories are not necessarily mutually exclusive.

7. The parties identify the dispute as focused solely on “configured to” found in Claims 1 and 34 in the following phrase: “a memory device coupled to said microprocessor configured to store . . .” Dkt. No. 108-1 at 61-64

*Appendix B***The Parties' Positions**

Plaintiff submits: The Court should adopt the construction of this term from the HTC Case: “some particularized arrangement of the memory device for a specific purpose” (quoting *HTC R&R* at 6-7). Dkt. No. 97 at 26.

Defendants respond: The Court should adopt the construction of this term from the HTC Case, with a minor modification, changing “some” to “a” to “better conform to the surrounding claim language.” Dkt. No. 102 at 28-29.

Plaintiff replies: There is no reason to stray from the construction of this term provided in the HTC Case. Dkt. No. 103 at 13.

Analysis

The issue in dispute appears to be whether “some,” as found in the Court’s construction of this term in the HTC Case, should be replaced with “a.” At the hearing, the parties agreed that “some particularized arrangement of the memory device for a specific purpose” is the appropriate construction.

Accordingly, the Court construes “configured to” as it appears in the memory-device limitation of Claims 1 and 34, as follows:

- “configured to” means “some particularized arrangement of the memory device for a specific purpose.”

*Appendix B***M. “create,” “creating,” “generate,” “generating,”
“generated,” and “recreate”**

Disputed Term	Plaintiff’s Proposed Construction	Defendants’ Proposed Construction
“create” • ’467 Patent Claim 27	plain and ordinary meaning	bring into existence
“creating” • ’467 Patent Claims 1, 34	plain and ordinary meaning	bringing into existence
“generate” • ’467 Patent Claim 28 ⁸	plain and ordinary meaning	bring into existence
“generating” • ’467 Patent Claims 1, 3, 6, 34	plain and ordinary meaning	bringing into existence
“generated” • ’467 Patent Claims 2, 3	plain and ordinary meaning	brought into existence
“recreate” • ’467 Patent Claims 1, 34	plain and ordinary meaning	bring something back into existence

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Because the parties' arguments and proposed constructions with respect to these terms are related, the Court addresses the terms together.⁸

The Parties' Positions

Plaintiff submits: For the same reasons that “generating” and “creating” in the “microprocessor for generating a plurality of control signals . . .” term do not require bringing anything into existence, these terms do not require bringing anything into existence. Dkt. No. 97 at 16-17 & n.5.

Defendants respond: The claim terms “create” and “generate” and variants mean to bring something into existence, thus these terms are directed to bringing something into existence. Dkt. No. 102 at 17-19.

In addition to the claims themselves, Defendants cite the following intrinsic and extrinsic evidence to support their position: **Intrinsic evidence:** '467 Patent col.7 ll.14-19; Patent Owner's Preliminary Response, *HTC Corp. et al. v. Joe Andrew Salazar*, IPR2018-00273 (P.T.A.B. Apr. 11, 2018), Paper No. 10 at 3 (Defendants' Ex. B, Dkt. No. 102-3 at 11). **Extrinsic evidence:** *Webster's New World College Dictionary* (3d ed. 1995), “create,” “generate,” “recreate” (Defendants' Ex. C, Dkt. No. 102-4 at 4-6).

8. The term “generates” appears in Claim 4, which Plaintiff identified as an asserted claim, but “generates” was not in bold type in the parties' Revised Joint Claim Construction Chart Pursuant to Patent Rule 4-5(d). Dkt. No. 108-1 at 41.

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Plaintiff replies: For the reasons stated in the section on the “microprocessor for generating a plurality of control signals . . . ” term, the “create,” “generate,” and “recreate” terms should not be construed as bringing something into existence. Dkt. No. 103 at 4-6.

Analysis

The issues in dispute are the same as presented with respect to “generating” and “creating” in the “a microprocessor for generating a plurality of control signals . . . ” term. For the reasons stated above, the Court rejects Defendants’ proposed constructions and determines that these terms have their plain and ordinary meanings without the need for further construction.

V. CONCLUSION

The Court adopts the constructions set forth above, as summarized in the following table. The parties are **ORDERED** that they may not refer, directly or indirectly, to each other’s claim-construction positions in the presence of the jury. Likewise, the parties are **ORDERED** to refrain from mentioning any portion of this opinion, other than the actual definitions adopted by the Court, in the presence of the jury. Any reference to claim-construction proceedings is limited to informing the jury of the definitions adopted by the Court.

The parties are hereby **ORDERED** to file a Joint Notice within fourteen (14) days of the issuance of this Memorandum Opinion and Order indicating whether

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the case should be referred for mediation. If the Parties disagree about whether mediation is appropriate, the Parties should set forth a brief statement of their competing positions in the Joint Notice.

Section	Term	Construction
A	“a microprocessor for generating a plurality of control signals used to operate said system, said microprocessor creating a plurality of reprogrammable communication protocols” <ul style="list-style-type: none"> • '467 Patent Claim 1, 34 	a microprocessor configured to generate two or more control signals used to operate said system and configured to create two or more reprogrammable communication protocols
	“a plurality of control signals” <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	two or more signals

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Section	Term	Construction
B	<p>“a selector controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as desired, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals”</p> <ul style="list-style-type: none"> • '467 Patent Claim 2 	<p>a selector controlled by said microprocessor for enabling said radio frequency transceiver and said infra-red frequency transceiver to transmit a desired command code set generated by said microprocessor via either radio frequency signals and infra-red signals as selected by a user, and to receive a signal from any one of said external devices via either radio frequency signals and infra-red signals</p>
	<p>“selector”</p> <ul style="list-style-type: none"> • '467 Patent Claim 2 	<p>plain and ordinary meaning</p>
C	<p>“a communication protocol”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	<p>plain and ordinary meaning</p>

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Section	Term	Construction
D	<p>“a plurality of reprogrammable communication protocols”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	two or more reprogrammable communication protocols
E	<p>“such that the memory space required to store said parameters is smaller than the memory space required to store said command code sets”</p> <ul style="list-style-type: none"> • '467 Patent Claim 1 	such that the memory space required to store said plurality of parameter sets is smaller than the memory space required to store said command code sets
F	<p>“a desired command code set”</p> <ul style="list-style-type: none"> • '467 Patent Claim 1 	plain and ordinary meaning
G	<p>“a microprocessor for generating ..., said microprocessor creating ..., a plurality of parameter sets retrieved by said microprocessor ..., said microprocessor generating ...”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving, and generating functions

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Section	Term	Construction
H	<p>“said microprocessor generating a communication protocol in response to said user selections”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	plain and ordinary meaning
	<p>“said communications protocols”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	said plurality of reprogrammable communication protocols
I	<p>“an infra-red frequency transceiver coupled to said microprocessor for transmitting to said external devices and receiving from said external devices, infra-red frequency signals in accordance with said communications protocols”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	plain and ordinary meaning

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Section	Term	Construction
J	<p>“a radio frequency transceiver . . . in accordance with said communication protocols”</p> <ul style="list-style-type: none"> • '467 Patent Claim 2 	plain and ordinary meaning
K	<p>“a sound and data coupling device adapted to receive sound as data signals”</p> <ul style="list-style-type: none"> • '467 Patent Claim 7 	plain and ordinary meaning
L	<p>“configured to”</p> <ul style="list-style-type: none"> • '467 Patent Claims 1, 34 	some particularized arrangement of the memory device for a specific purpose

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Section	Term	Construction
M	“create” • ’467 Patent Claim 27	plain and ordinary meaning
	“creating” • ’467 Patent Claims 1, 34	plain and ordinary meaning
	“generate” • ’467 Patent Claim 28	plain and ordinary meaning
	“generating” • ’467 Patent Claims 1, 34	plain and ordinary meaning
	“generated” • ’467 Patent Claim 2	plain and ordinary meaning
	“recreate” • ’467 Patent Claims 1, 34	plain and ordinary meaning

So ORDERED and SIGNED this 18th day of September, 2020.

/s/ Rodney Gilstrap
 RODNEY GILSTRAP
 UNITED STATES
 DISTRICT JUDGE

**APPENDIX C — DENIAL OF REHEARING OF
THE UNITED STATES COURT OF APPEALS FOR
THE FEDERAL CIRCUIT, FILED JUNE 8, 2023**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2021-2320, 2021-2376

JOE A. SALAZAR,

Plaintiff-Appellant,

v.

AT&T MOBILITY LLC, SPRINT UNITED
MANAGEMENT COMPANY, T-MOBILE USA, INC.,
CELLCO PARTNERSHIP INC., DBA VERIZON
WIRELESS, INC.,

Defendants-Cross-Appellants,

HTC CORPORATION, HTC AMERICA, INC.,

Defendants.

Appeals from the United States District Court for
the Eastern District of Texas in No. 2:20-cv-00004-JRG,
Chief Judge J. Rodney Gilstrap.

ON PETITION FOR REHEARING EN BANC

Appendix C

Before MOORE, *Chief Judge*, NEWMAN, LOURIE, SCHALL¹, DYK, PROST, REYNA, TARANTO, CHEN, HUGHES, STOLL, CUNNINGHAM, and STARK, *Circuit Judges*.

PER CURIAM.

ORDER

Joe A. Salazar filed a petition for rehearing en banc. The petition was first referred as a petition to the panel that heard the appeal, and thereafter the petition was referred to the circuit judges who are in regular active ser-vice.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue June 15, 2023.

FOR THE COURT

June 8, 2023
Date

/s/ Jarrett B. Perlow
Jarrett B. Perlow
Acting Clerk of Court

1. Circuit Judge Schall participated only in the decision on the petition for panel rehearing.