United States District Court,
N.D. California.

FOUNDRY NETWORKS, INC,
Plaintiff.
v.
NORTEL NETWORKS, INC., et al,
Defendants.
And Related Counterclaims and Third Party Complain,
And Related Counterclaims and Third Party Complaint.

No. C 02-04909 CRB

Nov. 18, 2003.

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CLAIM CONSTRUCTION ORDER

CHARLES R. BREYER**, District Judge.**

This patent infringement lawsuit involves the telecommunications industry. Plaintiff Foundry Networks, Inc. ("Foundry") provides high-performance enterprise and service provider switching, routing and Web traffic management solutions for, among others, internet service providers, e-commerce sites, and universities. Defendants Nortel Networks Inc. and Nortel Networks Ltd. ("Nortel") similarly provide networking and communication services and infrastructure to service providers and enterprises around the world.

In October 2002, Foundry sued Nortel for infringement of the '864 patent. Foundry subsequently amended its complaint to include claims for a declaration that Foundry does not infringe certain Nortel patents. Nortel counterclaimed and alleged that Foundry had infringed five of Nortel's patents. The Court advised the parties that the initial claim construction hearing would be limited to two patents and five terms. The parties chose to seek construction of five terms of one of Nortel's patents, the '397, and five terms of Foundry's

patent, the '864. The Court held the claim construction hearing on November 6, 2003.

I. LEGAL STANDARD FOR CONSTRUCTION OF A PATENT CLAIM

Patent infringement analysis involves two steps: the proper construction of the asserted claim and a determination as to whether the accused method or product infringes the asserted claim as properly construed. *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370 (1996). The interpretation of patent claims is a matter of law determined exclusively by the court. *See* id. at 979.

"In interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). In examining the intrinsic evidence, the court should first review the words of the claims themselves to define the scope of the invention. *See id*. As the Federal Circuit recently explained:

In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to particularly point[ ] out and distinctly claim[ ] the subject matter which the patentee regards as his invention.

The terms used in the claims bear a presumption that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art. Moreover, unless compelled otherwise, a court will give a claim term the full range of its ordinary meaning as understood by persons skilled in the relevant art.

Honeywell Int'l v. Int'l Trade Comm'n, 341 F.3d 1332, 1338 (Fed.Cir.2003) (internal quotations and citations omitted). Nonetheless, while "words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer" and alter the meaning of any words "as long as the special definition is clearly stated in the patent specification or file history." Vitronics, 90 F.3d at 1582.

After examining the patent's claims, the court should then also review the patent specification "to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Id*. The specification is a written description of the invention which is designed to be clear and complete enough so that a person of ordinary skill in the art could make and use the invention. "The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication." *Id*. The Federal Circuit teaches that "the specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term." *Id*. Drawings included in the patent application have the same effect on the interpretation of claim language as other portions of the specifications. *See* Autogiro Co. of America v. United States, 384 F.2d 391, 398 (Ct.Cl .1967).

The third type of intrinsic evidence that the Court may consider is the prosecution history of the patent, if it is in evidence. *See* Vitronics, 90 F.3d at 1582. The prosecution history contains the entire record of the prosecution of the patent claim before the patent office, including any representations about the scope of the claim or the meaning of certain terms made by the applicant.

Ordinarily, the intrinsic evidence alone will resolve any ambiguity in a disputed term. "In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper." Id. at 1583. By relying first on the patent claims, specification, and prosecution history, a court can protect a patentee's rights while at the same time enabling the public to rely on the public record of the patentee's claim. "In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention." *Id*. (citing Markman, 52 F.3d at 978-79).

In this case the parties rely primarily on the claim language and the specification.

DISCUSSION

I. The '397

This patent is entitled a "Method for Establishing a Master-Slave Relationship in Peer-To-Peer Network." The patent relates to computer networks, and, in particular, to establishing a "master-slave" relationship between devices on a peer-to-peer network (that is, the devices are peers, or equals) to avoid data collisions caused by multiple devices transmitting at the same time. The master-slave relationship between two equal devices is established by each device generating an "information," such as a random number, and then comparing each device's information to determine which will be the master and which the slave.

Once the master-slave relationship is established, the master sends control signals, such as a clock signal, to the slave. By forcing the slave to use the master's clock signal to time its data transmissions, higher transmission rates and reduced noise on the network is achieved.

The parties dispute the construction of five terms and/or phrases.

A. "Master"

Nortel argues that "master" means "a device that is chosen to be superior to another device for a particular aspect of the communication of control signals, clock signals or other data between them." Foundry proposes: "a device that provides control signals or other data to another device."

Foundry's construction most closely follows the claim language. For example, claim 1 describes designating one device, the master, to provide a clock signal to the slave. Neither claim 1, nor any of the other claims, make any reference to the master being "superior." Indeed, were the Court to adopt Nortel's construction the Court would have to conduct a second claim construction to construe the meaning of "superior."

Nortel's argument is based on a passage found at col. 1, lines 55-58 of the ' 397. The inventors, in describing the background to their invention, wrote:

Each device in a peer-to-peer network is a peer to the other devices in the network. Thus, no device is considered to be "superior" to any other device on the network. As such, a master-slave relationship between devices is not typically supported in a peer-to-peer network environment. It is therefore desirable to provide a system capable of establishing a master-slave relationship (when such need arises), at the physical layer, on a point-to-point link in a peer-to-peer network.

This passage does not suggest, let alone require, that the term "master" be construed to include the vague

term "superior." It means merely that in the context of the '397 the master is "superior" to the slave by sending control signals, clock signals, or other data to the slave.

Accordingly, "master" means "a device that provides control signals, clock signals, or other data to another device."

B. Slave

For the reasons stated above with respect to "master," "slave" means "a device that uses control signals, clock signals or other data provided by another device."

C. Clock Signal

Foundry argues that "clock signal" means "timing signal." Such a construction is consistent with the ordinary meaning of clock. The specification refers to a "clock signal" as a "timing signal." Col. 4, ll. 57-58 ("its timing signal (clock signal)").

Nortel proposes a more complicated construction: "a signal containing timing information used to provide a timing reference for the communication of data." As support for its construction it cites language in the specification describing a preferred embodiment, namely, Figure 5. The specification describes Figure 5 as showing the master using "this clock signal to transmit data ... to" the slave. While the specification shows that a "clock signal" can be used to transmit data, it does not limit "clock signal" to the communication of data. To so hold would ignore the ordinary meaning of "clock signal" and would improperly use a preferred embodiment to limit the scope of the claims. *See* Electro Med. Sys. SA v. Cooper Life Sciences, 34 F.3d 1048, 1054 (Fed.Cir.1994) ("although the specifications may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments.").

Accordingly, "clock signal" means "timing signal."

D. Returning the clock signal from the slave to the master

In light of the Court's construction of "clock signal" to mean "timing signal," there is no need for the Court to construe this phrase.

E. Generating a first information associated with a first device

Generating a second information associated with a second device

The plain and ordinary meaning of these phrases, in light of the specification, means "producing or selecting information associated with a first (second) device.

II. The '864

The '864 is a "System and Method for Providing Communication on a Wide Area Network." The invention permits a caller using a telephone to communicate with a caller using a telephone over the Internet. Such technology is generally referred to as "Voice-Over-IP." The inventors claim the '386 is an improvement over previous Voice-Over-IP technologies because it allows callers from outside lines to communicate with

those on inside lines and to use public branch exchange ("PBX") services such as call-forwarding and call-holding.

A. Nortel's claim of indefiniteness

Nortel contends that three of the terms of the '864 are legally indefinite pursuant to 35 U.S.C. section 112(2). If a court determines that a claim is not " 'amenable to construction,' " then the claim is invalid as indefinite under 35 U.S.C. s. 112, para. 2. *See* Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed.Cir.2001). "The definiteness requirement of s. 112, para. 2 'focuses on whether the claims, as interpreted in view of the written description, adequately perform their function of notifying the public of the [scope of the] patentee's right to exclude.' " Honeywell Int'l Inc. v. Intern. Trade Com'n, 341 F.3d 1332, 1338 (Fed.Cir.2003). "Because a claim is presumed valid, a claim is indefinite only if the "claim is insolubly ambiguous, and no narrowing construction can properly be adopted." *Id*.

Foundry argues that Nortel's indefiniteness argument is premature; since indefiniteness resulting in invalidity is an affirmative defense which Nortel must prove by clear and convincing evidence, the Court cannot find the '864 invalid for indefiniteness in the context of claim construction.

Foundry is correct that the Court cannot declare the '864 invalid since Nortel has not moved for summary judgment of invalidity. However, if Nortel believes certain claims are indefinite because they are not "amenable to construction," it is appropriate for Nortel to at least raise the issue in the context of claim construction. The Court must determine whether the claims are definite enough to be construed. Of course, even if the Court construes the terms, Nortel is not precluded from later arguing that the construction is so vague as to render the claim fatally indefinite.

B. Disputed claims

1. Communication platform

Claim 1 recites "a first communication platform coupled to a first network and a second network, said first communication platform providing private branch exchange services in response to a request received from said first network." Col. 18, ll. 22-25.

Both parties agree that "communication platform" means "a general purpose computer system that operates under program control." Nortel contends, however, that the definition should include a further description from the preferred embodiment, namely, "and having, among other things, a motherboard coupled to a hard drive and having add-in card slots, a CPU, system bus, and internal memory." Col. 4, ll. 7-12. Nortel, citing Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532 n. 7 (Fed.Cir.1987), argues that the '864 describes only one embodiment of "communication platform" and therefore the term "communication platform" must be limited to that embodiment. Nortel, however, has never rebutted Foundry's assertion that the '864 describes a second embodiment. *See* Col. 17, ll. 52-57. Moreover, the facts of Perkin-Elmer Corp. are too dissimilar from this case to persuade the Court to abandon the long-standing rule against using preferred embodiments to limit the scope of a claim. *See* Electro Med. Sys. SA, 34 F.3d at 1054; Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1205 (Fed.Cir.2002).

Nortel also asks that the construction of communication platform include the following sentence: "A communication platform is a device that is integrated with a voice communication module so that telephone calls received from a telephone network can be switched and transmitted to another communication

platform." This additional definition is unnecessary: the claims themselves recite the requirement set forth in this sentence.

Accordingly, "communication platform" means "a general purpose computer system that operates under program control."

Nortel also argues that "communication platform" is indefinite because the third element of claim 1 requires a communication platform within a communication platform. The third element of claim 1 recites in relevant part:

Wherein said first communication platform and said second communication platform each include a voice communication module ***and a communication platform*** for managing said voice communication module so as to provide said private branch exchange services.

Col. 18, ll. 31-34. This sentence appears to require the first communication platform (the general purpose computer system) to include a second communication platform (in bold and italics). As Nortel points out, the specification makes no mention of a communication platform (general purpose computer system) that includes within it an additional general purpose computer system. Thus, contends Nortel, the term is indefinite. While Nortel argues that this ambiguity renders the term "communication platform" fatally indefinite, what it is really saying is that the recited limitation is indefinite. "Communication platform" as used throughout the '864 in itself is not indefinite; it means a general purpose computer system under program control.

In any event, when claim 1 is read in context and in light of the specification, it is apparent that the third element of claim 1describes a communication platform which consists of a communication platform and a voice communication module. This element does not require a general purpose computer system under program control within a general purpose computer system under program control.

2. private branch exchange ("PBX") services

The "Computer Glossary" defines "private bank exchange" as:

An in-house telephone switching system that interconnects telephone extensions to each other, as well as to the outside telephone network. It may include functions such as least cost routing for outside calls, call forwarding, conference calling and call accounting.

The specification describes "PBX features" as *including* call holding, call transfer, call forwarding and call conferencing. Col. 8, ll. 47-50. The patent abstract describes "PBX features" as "call-holding, transferring, forwarding, conferencing, and the like ."

Foundry argues for the definition found in the abstract. Nortel agrees that PBX services include forwarding, holding, transfer and conferencing, but contends that it does not include any additional features; in other words, anything not identified in the specification is not included within the definition of "PBX services." Nothing in the claims or the specification, however, suggests the inventor intended to limit his invention to systems which provide only those limited features. In fact, Nortel's proposed construction would exclude dependent claim 14 which claims private branch services which include "providing a voice status." Col. 19, ll. 18-19.

Accordingly, PBX services means "call-holding, transferring, forwarding, conferencing, and the like."

3. software designed to detect private branch service

Nortel argues that the Court should construe "software" in accordance with a preferred embodiment, namely, software "having API program modules that provide the ability to detect Inband format requests for PBX services." Col. 6, ll. 21-27. None of these very specific limitations appear in the language of the claims. Nortel's argument is based on the fact that the inventor added the "software designed to detect" language in an amendment to the patent application and generally referred the patent examiner to the above preferred embodiment (as well as other things) as "support" for his amendment. This prosecution history does not demonstrate that the inventor chose the specific and limited definition of software advocated by Nortel.

Accordingly, "software designed to detect private branch service" means "software designed to detect requests for PBX-like features, such as call holding, call transferring, call forwarding, call conferencing, and the like."

4. voice communication module

This phrase means a "module that enables a communication platform to provide voice-over-IP calls."

5. Responds to a telephone call received from said local telephone network from a caller by: receiving a telephone call

Claim 78 recites:

A method for providing telecommunication services on a switched communication backbone, the method comprising the steps of:

Providing a first communication platform having a telephone network interface and a voice communication module;

Networking said first communication platform to a local telephone network through said telephone network interface, and to the switched communication backbone through said voice communication module;

Wherein said first communication platform responds to a telephone call received from said local telephone network from a caller by:

Col. 24, ll. 4-16. The claim then goes on to list seven different steps the communication platform takes to respond to the telephone call: the first step is "receiving a telephone call." Col. 24, l. 18.

Nortel argues this first step is indefinite because it makes no sense. The Court disagrees. The first communication platform cannot respond to the call until it receives the call. If the claim is read as a whole it makes perfect sense; the first step in responding to the call is receiving the call in the first place. No construction of this phrase is necessary.

IT IS SO ORDERED.

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