United States District Court,
E.D. Virginia, Richmond Division.

TELECOMMUNICATION SYSTEMS, INC,
Plaintiff.
v.
MOBILE 365, INC,
Defendant.

Civil Action No. 3:06CV485

Dec. 22, 2006.

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ORDER

JAMES R. SPENCER**, Chief Judge.**

THIS MATTER comes before the Court for the construction of claim terms in United States Patent Number 6,985,748. The Court, having considered the evidence and arguments submitted by the parties, hereby construes the claim terms as discussed below.

I.

A. Principles of Claim Construction

A finding of patent infringement involves a two-step analysis. Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995). First, the court must interpret the asserted patent claim. *Id*. Second, the trier of fact must compare the properly construed claim to the allegedly infringing product. *Id*. The construction of a patent claim is a legal matter exclusively for the court. *Id*. at 978.

The starting point for determining the proper construction of a claim is a review of the intrinsic evidence. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). The court must first look to the

words of the claim itself. *Id*. Technical terms should be interpreted as having the meaning that "it would be given by persons experienced in the field of invention, unless it is apparent from the patent and the prosecution history that the inventor used the term with a different meaning." Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F.3d 1575, 1578 (Fed.Cir.1996). All other claim terms are given their ordinary and customary 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, i.e., as of the effective filing date of the patent application." Phillips v. AWH Corp., 415 F.3d 1303,1313 (Fed.Cir.2005). Importantly, "a claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent." Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed.Cir.2001). Moreover, the preamble to a claim is "limiting where it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claims." Advanced Medical Optics, Inc. v. Alcon Inc., 361 F.Supp.2d 370, 378 (D.Del.2005) (internal quotations omitted).

The second source of intrinsic evidence to which the court must look to construe a claim is the specification. Vitronics Corp., 90 F.3d at 1582. "The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention." Markman, 52 F.3d at 979. It is the dictionary of the patent claim, explaining the invention and defining the terms of the claim. *Id*. The patentee "is free to be his own lexicographer," and therefore any specialized meaning of terms must be fully disclosed in the specification. *Id*. at 980. "Usually, [the specification] is dispositive; it is the single best guide to the meaning of a disputed term." Vitronics Corp., 90 F.3d at 1582.

The third, and final, source of intrinsic evidence which the court may consider is the patent's prosecution history. *Id*. The prosecution history of a patent contains "the complete record of all proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims." *Id*. The prosecution history may not be used to "enlarge, diminish, or vary the limitations in the claims." Markman, 52 F.3d at 980 (internal quotations omitted). However, the prosecution history is effective in guiding the court's construction of claims, since "[c]laims may not be construed one way to obtain their allowance and in a different way against accused infringers." Southwall Tech. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed.Cir.1995).

If consideration of intrinsic evidence resolves any ambiguity in the claim terms, then further inquiry is unnecessary. Vitronics Corp., 90 F.3d at 1583. However, the court may consider extrinsic evidence as an aid to understanding scientific principles, technical terms, terms of art in the patent and prosecution history, and the state of prior art at the time of the invention. Markman, 52 F.3d at 980. Extrinsic evidence consists of material outside of the patent and prosecution history, including dictionaries, treatises, prior art not cited during prosecution of the patent, and expert testimony. *Id*. Ultimately, however, a court may not rely on extrinsic evidence to alter the meaning of the claim, as defined by the claim language, specification and prosecution history. Vitronics Corp., 90 F.3d at 1584.

B. Construction of "Means/Step-Plus-Function" Claims Pursuant to 35 U.S.C. s. 112 **para. 6**

Some of the claims of the patent-in-suit contain elements written in means-plus-function format. 35 U.S.C. s. 112 para. 6, which permits an invention to be claimed in "means-plus-function" or "step-plus-function" format, provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material or acts in support thereof, and such claim shall be

construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The question of whether a particular limitation is governed by s. 112 para. 6 is a matter of law for the court. Lighting World, Inc. v. Birchwood Lighting, Inc., 382 F.3d 1354, 1358 (Fed.Cir.2004). "A claim limitation that actually uses the word 'means' invokes a rebuttable presumption that s. 112 para. 6 applies. By contrast, a claim term that does not use 'means' will trigger the rebuttable presumption that s. 112 para. 6 does not apply." CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1369 (Fed.Cir.2002). "[T]he presumption flowing from the absence of the term 'means' is a strong one that is not readily overcome." Lighting World, 382 F.3d at 1358. A patentee may generically define a structure for performing a particular function through the use of a means expression, provided that the specified structures corresponding to the means are disclosed in the patent specification. Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co., 520 U.S. 17, 28 (1997).

If a claim term is governed by s. 112 para. 6, the court must first define the particular function claimed. Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1376 (Fed.Cir.2001). Then, the court must identify "the corresponding structure, material, or acts described in the specification. It is not until the structure corresponding to the claimed function in a means-plus-function limitation is identified and considered that the scope of coverage of the limitation can be measured." *Id*. (internal quotations omitted). "Whether or not the specification adequately sets forth structure corresponding to the claimed function necessitates consideration of that disclosure from the viewpoint of one skilled in the art." *Id*. "If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112." In re Donaldson Co., 16 F.3d 1189, 1195 (Fed.Cir.1994).

A court's determination that a claim containing a means-plus-function limitation lacks a disclosure of structure in the patent specification that performs the claimed function necessarily means that the court finds the claim in question indefinite, and thus invalid. Budde, 250 F.3d at 1376. It is well settled that claims of a patent are afforded a statutory presumption of validity, and that overcoming that presumption of validity requires that any facts supporting a holding of invalidity must be proved by clear and convincing evidence. *Id*. Accordingly, "a challenge to a claim containing a means-plus-function limitation as lacking structural support requires a finding, by clear and convincing evidence, that the specification lacks disclosure of structure sufficient to be understood by one skilled in the art as being adequate to perform the recited function." *Id*. at 1376-77.

II.

In accordance with the principles discussed above, the Court has construed the claim terms according to their plain and ordinary meaning, as supported by the specification and prosecution history. Accordingly, the Court hereby construes the claim terms as follows:

A. Construction of Disputed Claim Terms

1. *Inter-carrier Messaging Module:* A structure (or software) that allows communication of messages between two or more carriers (phone networks such as Sprint, Verizon, Cingular, etc.).
2. *Routing Syntax, Syntax Associated with Said Carrier Providing Service to Said Phone Number, and Said Added Syntax Associated with Said Carrier Providing Service to Said Phone Number:* Information which when attached to or inserted within a telephone number, enables a message to be routed.

3. *Message Distribution Center:* A computer system acting as a clearinghouse for the distribution of message transactions between carrier networks.

4. *Digital Packet and Digital Message Packet:* A unit of information transmitted from one device to another on a network.

5. *Addressed with Only a Phone Number, Addressed to a Phone Number Only, and Phone Number Only Addressed:* Wherein the only address information of the digital packet (or digital message packet) is a phone number.

6. *Database Associating Subscriber Phone Numbers with Servicing Carriers:* A database that associates or links a subscriber phone number with the carrier that provides service to that phone number.

7. *Database Associating Carriers with Routing Syntax:* A database that associates or links a carrier providing service to a subscriber phone number with the "routing syntax" necessary to route a message to that carrier.

8. *Add Routing Syntax Determined from Said Lookup to Said Phone Number:* No construction necessary.

9. *Newly Addressed to Said Phone Number with a Syntax Associated with Said Carrier Providing Service to Said Phone Number:* Newly addressed to the phone number with a syntax associated with the carrier who provides service to that phone number.

10. *Formulating a New Digital Message Packet Including a Body of Said Initial Digital Message Packet:* Formulating a new digital message packet which includes a body of a prior digital message packet.

11. *Means for Receiving an Initial Digital Message Packet Addressed to a Phone Number Only:*

Function: Receiving an initial digital message packet addressed to a phone number only.

Structure: Message Distribution Center (MDC) software that accepts message from outside source (Column 9).

12. *Means for Formulating a New Digital Message Packet Including a Body of Said Initial Digital Message Packet and Newly Addressed to Said Phone Number with a Syntax Associated with Said Carrier Providing Service to Said Phone Number:*

Function: Formulating a new digital message packet including a body of said initial digital message packet and newly addressed to said phone number with a syntax associated with said carrier providing service to said phone number.

Structure: Carrier routing table 120 used by messaging module 100 to automatically add appropriate syntax (Column 10).

13. *Means for Routing Said New Digital Message Packet:*

Function: Routing said new digital message packet.

Structure: Message Distribution Center (MDC) routing message (Column 12).

B. Undisputed Claim Term Constructions Adopted by the Court

1. *STMP Protocol:* Simple Mail Transport Protocol.
2. *Means for Associating a Carrier Providing Service to Said Phone Number:*

Function: Associating a carrier providing service to said phone number.

Structure: MIN/Carrier database 110, as shown in Figs. 3 and 4, and described at col. 9, line 63 through col. 10, line 13.

Let the Clerk send a copy of this Order to all Counsel of record.

It is SO ORDERED.

E.D.Va.,2006.
Telecommunication Systems, Inc. v. Mobile 365, Inc.

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