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

RING PLUS, INC,
Plaintiff.
v.
CINGULAR WIRELESS, LLC, et al,
Defendants.

Civil Action No. 5:08-CV-42-DF

June 4, 2008.

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

ORDER

DAVID FOLSOM**, District Judge.**

Before the Court is Plaintiff Ring Plus Inc.'s Motion for Further Claim Construction. Dkt. No. 219. Also before the Court are Defendants' response, Plaintiff's reply, and Defendants' sur-reply. Dkt. Nos. 235, 240 & 243. The Court held a hearing on April 22, 2008. Dkt. No. 246. After considering the arguments of counsel and all relevant papers and pleadings, the Court finds that Plaintiff's motion should be **DENIED.**

I. BACKGROUND

Plaintiff brings suit alleging infringement of United States Patent No. 7,006,608 (the "'608 Patent" or the "Patent-In-Suit"), which relates to telecommunications. *See* Complaint, Dkt. No. 1. Defendants deny infringement, assert the affirmative defenses of invalidity, estoppel, and failure to provide marking and notice. Answer, Dkt. No. 13 at 3-5. Defendants counterclaim for declaratory judgments of non-infringement and invalidity. *Id*. at 5-6.

On December 24, 2007 Defendants filed a motion for summary judgment of noninfringement of the '608 Patent and Plaintiff filed its motion for summary judgment of infringement on the same day. Dkt. No. 192 & 193. After the cross summary judgment motions on the issue of infringement were fully briefed, Plaintiff brought this motion for further claim construction. Dkt. No. 219.

II. PARTIES' POSITIONS

Plaintiff claims that based on the summary judgment motions, it is apparent that "the order of element 1(b) compared to 1(c) and 1(d)" should be construed. Dkt. No. 219. The Claim Construction Order on July 9, 2007 provided that Step 1(c) must be performed before Step 1(d), Step 1(c) must be performed before Step 1(e), and Step 1(e) must be performed before Step 1(f). *Id*. at 2. Plaintiff claims that element 1(b) (generating a sound presentation) may come before Steps 1(c) and (d) (determination of busy status). *Id*. at 3. Plaintiff argues that both today's telecommunication systems and the claims of the '608 Patent perform multi-tasking which "renders a lineal prescription for an order of claim steps tenuous." Id. at 4-5.

Defendants respond that Plaintiff's motion is untimely and baseless. Dkt. No. 235 at 1. Defendants claim that since the Court's Claim Construction Order held that Steps 1(d) (allowing for sound presentation) and 1(e) (initiating those actions to pay the introduced message) can only occur after Step 1(c) (determining whether phone line is busy), no sound can be generated until it is known that the line is not busy. *Id*. at 2-3. Defendants argue that this point is supported by the patent specification and prosecution history. *Id*. at 3-4. Defendants note that the claim language of Step 1(b) specifies that the sound presentation is "to be generated." *Id*. at 4-5. Defendants also argue that even if Step 1(b) is where the sound presentation is actually generated, the Court has already held that the algorithm cannot "initiat[e] those actions to play" (Step 1(e)) until after the algorithm has "allow[ed] for a sound presentation" (Step 1(d)) and that the algorithm cannot allow for a sound presentation (Step 1(d)) until after it has determined whether the line is busy (Step 1(c)). *Id*. at 5. Defendants further argue that the technical feasibility of multitasking is irrelevant and the relevant issue is knowing whether the line is busy before generating a sound presentation. *Id*. at 6.

Plaintiff replies that it is not requesting a change in the Court's Claim Construction Order, but preventing Defendant's manipulation of the Order. Dkt. No. 240. Plaintiff claims that in the Court's Order, no determination was made regarding the order of Step 9(c) with regard to Steps 9(d) and 9(e) or regarding the order of Step 1(b) with regard to other steps. *Id*. at 2. Plaintiff argues that the claims say that Step 1(b) may come before Steps 1(c) and 1(d) and 9(c) (generating a sound presentation) may come before steps 9(d) and 9(e). *Id*. at 4. Plaintiff also argues that "allowing" in Step 9(e) means "allowing to continue" rather than "allowing to begin." *Id*. at 4-5. Plaintiff further argues that the patent specification demonstrates that a sound presentation may be generated before the telephone line status is determined. *Id*. at 5.

In its sur-reply, Defendants argue that the Court has already ruled that a sound presentation is allowed only after it is determined that the line is not busy and thus has held that "allowing for" means "allowing to begin." Dkt. No. 243 at 1-3. Defendants cite to portions of the briefing and order that discuss this issue. *Id*. at 3-4. Defendants argue that although the Court did not consider the order to Step 9(c) relative to Step 9(d) due to a typographical error, the Court's ruling with respect to Steps 1(c) and 1(e) applies equally to the identical language in Claim 9. *Id*. at 4-5. Defendants also argue that the intrinsic evidence supports the Court's construction and does not render Step 1(b) or Claim 15 superfluous. *Id*. at 5-7.

III. DISCUSSION

1) The Order of Claim Step 1(b) Relative to Steps 1(c) and 1(d)

The Court's Claim Construction Order dated July 9, 2007 construed that Claim Step 1(c) ("determining whether the telephone line of the recipient telephone is busy") must be performed before Step 1(d) ("terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy ...") and Claim Step 1(c) must be performed before 1(e) ("initiating those actions to play the introduced message to the caller or the recipient or both"). Dkt. No. 123.

Although the construction of the order of claim step 1(b) ("introducing a sound presentation to be generated over the telephone which replaces a portion of or all of the ring-back signal") compared to 1(c) and 1(d) was not requested by the parties and was not construed by the Court, it is evident in the Court's construction of the order of the Step 1(c) relative to Step 1(d) and Step 1(c) relative to 1(e), that the Court intended that the "generation of a sound presentation" would be performed *after* the determination of the recipient telephone's status (emphasis added). *See* Dkt. No. 123 at 38 ("A person of ordinary skill in the art would understand that a message cannot be "play[ed]" in Step 1(e) before it is first "allow[ed]" by Step 1(d)."). Plaintiff raised the argument that a sound presentation may be generated before determining whether the recipient's telephone line is busy in its claim construction briefing. Dkt. No. 87 at 6-7. This argument based on Figure 4 of the '608 Patent was rejected. Dkt. No. 123 at 36 ("this language is at odds with the description that immediately follows.").

The specifications and prosecution history of the '608 Patent also supports the position that a sound presentation is generated only after determination of the recipient telephone's status. *See* Dkt. No. 123 at 37 quoting Dkt. No. 78, Ex. 2 at 21 FN1; Dkt. No. 235 at 3 citing Dkt. No. 192, Ex. 3 at 6:61-64 FN2; Dkt. No. 192, Ex. 3 at Fig. 2 ("check if line is free" before "play message), *Id*. at 12:32-37 ("if the line is free at step 46 ... a message will be played at step 50"), Fig. 4 (determine "is phone on hook (104)" or "is call waiting available (108)" before "play message to caller (134)"), 14:17-27 ("... the algorithm of the invention will allow for determination as to whether or not the phone was on hook at step 104 ... At that point, the message process is started at step 114 ... A selected message in that category is then actually played to a caller at step 134"), Fig. 5 (determine "on hook (182)" before "introduction (194)"), 16:31-43 ("The algorithm for the subscriber station operation then determines at step 182 if the recipient's telephone was on hook or off hook.... At that point, the message generation will start ..."); Dkt. No. 192, Ex. 7 at 20 FN3; Dkt. No. 243 at 5 *citing* Dkt. No. 192, Ex. 7 at 19 FN4. The Court agrees with the Defendants that the technical feasibility of multi-tasking is irrelevant to the issue at hand. *See* Dkt. No. 235 at 6 *citing* Storage Tech. Corp. v. Cisco Sys., Inc., 329 F.3d 823, 832 (Fed.Cir.2003) (extrinsic evidence should only be considered after ambiguity remains after consulting the intrinsic evidence).

FN1. In their June 28, 2002 Amendment, the patentees added Steps 1(c) and 1(d) and provided that they "amended to recite that the algorithm determines whether the telephone line of the recipient is busy [and] will thereupon terminate the call and generate no message if the telephone line is busy, but will allow for presentation of a message if the telephone line is not busy."

FN2. The summary of the invention in the '608 Patent provides: "The aforesaid software based algorithm generally recognizes whether a recipient's or recipient provider's phone is on hook [i.e., not busy]. If the recipient's or provider-recipient's phone is on hook, a message generation can then be initiated."

FN3. In their November 30, 2004 Amendment, patentees stated that "[f]rom Figure 2 it can be seen that if the line is free, the process continues until the message is generated. However, if the line is not free, the phone call ends. Such is not the case with Gregorek and the other references of record."

FN4. In their November 30, 2004 Amendment, patentees also stated that "applicant's system only generates that message when the phone line between the caller and the recipient is not busy."

Defendants argue that the language of claim step 1(b) provides that the sound presentation is "to be generated" and thus "only refers to the retrieval of a stored sound presentation from a database and the introduction of that sound presentation into memory of a processor, so that the sound presentation can later be generated/played." Dkt. No. 235 at 5. The Court finds that whether "retrieval of a stored sound presentation" is performed before the determination of the telephone line status-i.e. Steps 1(c) and 1(d)-is not an issue before the Court, and thus finds it unnecessary to construe the order of Step 1(b), if Defendants are correct in placing an emphasis on the term "to be generated." However, assuming that Plaintiff is correct in construing that Step 1(b) is where the sound presentation is generated, the Court finds that Step 1(b) must be performed after Steps 1(c) and 1(d) pursuant to the Court's previous construction that a sound presentation may be played only after the presentation is allowed under Step 1(d). *See* Dkt. No. 123 at 37-38.

2) The Order of Claim Step 9(c) Relative to Steps 9(d) and 9(e)

In its reply brief, Plaintiff argues that Defendants are "seek[ing] to bootstrap the Court's dicta on 1(d)/1(e) to argue that Step 9(c) must come after Steps 9(d) and 9(e)." Dkt. No. 240 at 2. The Court's July 6, 2007 Claim Construction Order construed that Step 9(c) ("generating the selected one or more sound presentations to be provided ...") should be performed before Step 9(a) ("initiating a telephone communication by terminating the sound presentation when the intended recipient answers the telephone"), Step 9(d) ("determining whether the telephone line of the recipient telephone is busy") should be performed before 9(e) ("terminating the telephone call and generating no sound presentation if the telephone line is busy and allowing for a sound presentation if the telephone line is not busy ..."), and Step 9(d) must be performed before Step 9(a). Dkt. No. 123 at 39-40.

The Court, however, did not construe the order of Claim step 9(c) relative to Steps 9(d) and 9(e).FN5 Nonetheless, the Court finds that the holding regarding the relative order of Claim Steps 1(c) and 1(e) is applicable to the order of Claim Steps 9(c) and 9(d). The parties have fully briefed the issue of the order of Claim Steps 9(c) and 9(d). *See* Dkt. No. 78 at 20-21; Dkt. No. 87 at 5-6. Notably, Plaintiff argued that the preferred embodiment in Figure 4, discussed supra, excludes "Defendants' erroneous construction of Step 1(c) before Step 1(e), Step 9(d) before Step 9(e), and 9(d) before 9(c)," implying that the construction of the order to the claim steps in Claim 1 should be equally applicable to Claim 9. *See* Dkt. No. 87 at 5-6.

FN5. It appears that, as Defendants state in their sur-reply, a typographical error in both the joint claim construction chart and Defendants' responsive claim construction brief caused this oversight. *See* Dkt. No. 98, Ex. A at 5; Dkt. No. 78 at 19.

As to the construction of the term "allowing" in Steps 1(d) and 9(e), the Court's Claim Construction Order makes it clear that the term in both claims should be construed as "allowed to begin" rather than "allowed to continue." *See* Dkt. No. 123 at 38 ("A person of ordinary skill in the art would understand that a message cannot be 'play[ed]' in Step 1(e) before it is first 'allow[ed]' by Step 1(d)"). Although Plaintiff argues that the construction of "allowing" in Step 9(e) as "allowing to begin" would render Claim 15 superfluous, the Court agrees with the Defendant that Claim 9 and Claim 15 deal with different concepts-Claim 15 covers "identifying the status of the *telephone line between the caller and the recipient* before generation of the sound presentation" while Claim 9(d) covers "determining whether the *telephone line of the recipient*

telephone is busy." (emphasis added). Dkt. No. 193 at 20. Whereas network congestion, or some other network failure may affect the status of the "telephone line between the caller and the recipient" in Claim 15, it is not a limitation of Claims 1 and 9, which only cover the "telephone line of the recipient telephone" that is a part of the "telephone line between the caller and the recipient." *See* Dkt. No. 123 at 21; Dkt. No. 243 at 6-7.

In sum, the Court finds that, although not explicitly construed in the July 9, 2007 Claim Construction Order, the Court considered and decided the issues presented in this Motion in its July 9, 2007 Claim Construction Order. *See* Dkt. No. 123. The Court hereby clarifies that in accordance with its holding that a sound presentation may not be allowed until determination of the status of the recipient's telephone line and that a message may not be played until the presentation is allowed-i.e., Step 1(c) must be performed before Step 1(d) and Step 1(c) must be performed before Step 1(e)-Step 1(b) must be performed after Steps 1(c) and 1(d) and Step 9(c) must be performed after Steps 9(d) and 9(e).

V. CONCLUSION

For all of these reasons, Plaintiff's Motion for Further Claim Construction (Dkt. No. 219) should be **DENIED.**

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