United States District Court,
C.D. California.

BROADCOM CORP,
v.
QUALCOMM INC.

No. SACV 05-467JVS(RNBX)

March 11, 2009.

Andra Barmash Greene, Irell & Manella, Newport Beach, CA, Anne M. McLaughlin, Clark W. Petschek, Cynthia D. Vreeland, Dominic E. Massa, Donald R. Steinberg, James Lampert, John J. Regan, Joseph J. Mueller, Lauren B. Fletcher, Lubov Greenwood, Richard O'Neill, William F. Lee, Wilmer Cutler Pickering Hale and Dorr LLP, Boston, MA, Anthony H. Kahng, C. Colin Rushing, Danielle Y. Conley, James L. Quarles, III, Thomas Parker Olson, Wilmer Cutler Pickering Hale and Dorr, Washington, DC, Victor F. Souto, Wilmer Cutler Pickering Hale and Dorr, New York, NY, Jennifer H. Lee, Stanford Law School, Stanford, CA, Juliana Mirabilio, Maria K. Vento, Mark D. Selwyn, Nathan L. Walker, Wilmer Cutler Pickering Hale and Dorr LLP, Palo Alto, CA, Layn R. Phillips, Michael G. Ermer, Irell and Manella, Newport Beach, CA, Peter J. McAndrews, Ronald H. Spuhler, McAndrews, Held and Malloy, Chicago, IL, for Broadcom Corp.

Andrei Harasymiak, Darin P. McAtee, David Greenwald, James G. Hein, Jr., John E. Lazar, Keith R. Hummel, Nicholas W. Sage, Peter T. Barbur, Radu Lelutiu, Richard J. Stark, Roger G. Brooks, Teena-Ann V. Sankoorikal, Cravath Swaine & Moore LLP, Christopher A. Hughes, Howard Wizenfeld, James T. Bailey, Cadwalader, Wickersham & Taft LLP, Jeffrey Friesen, Zukerman, Gore & Brandeis LLP, Richard S. Taffet, Bingham McCutchen, New York, NY, Bert C. Reiser, Cecilia H. Gonzalez, Howrey LLP, Stephen B. Kinnaird, Sidley Austin LLP, Washington, DC, Brent Kevin Yamashita, DLA Piper US, Christopher Lee Kelley, James F. Valentine, Howrey LLP, Patrick T. Weston, Bingham McCutchen, Timothy S. Teter, Cooley Godward Kronish LLP, East Palo Alto, CA, Erin Paige Penning, John Allcock, Richard T. Mulloy, Sean Christy Cunningham, DLA Piper US LLP, John S. Kyle, Cooley Godward Kronish, Steven M. Strauss, Procopio Cory Hargreaves & Savitch, San Diego, CA, Frank P. Cote, Gregory S. Cordrey, Howrey LLP, Irvine, CA, William K. West, Jr., Howrey LLP, Washington, DC, Jason Anthony Yurasek, Bingham McCutchen San Francisco, CA, for Qualcomm Inc.

Heath A. Brooks, Wilmer Cutler Pickering Hale and Dorr LLP, Washington, DC, Evan R. Chesler, Cravath Swaine & Moore LLP, New York, NY, Martha K. Gooding, Howrey LLP, Irvine, CA, for Broadcom Corp./Qualcomm Inc.

Proceedings: (IN CHAMBERS) ***Order*** **re** ***Claim Construction*** **for the '051** ***Patent***

JAMES V. SELNA**, District Judge.**

Karla J. Tunis, Deputy Clerk.

Pursuant to the Court's November 25, 2008 instructions and a joint stipulation filed February 3, 2009, plaintiff Broadcom Corporation ("Broadcom") and defendant Qualcomm Incorporated ("Qualcomm") have submitted proposed claim constructions regarding claims 24 and 33, as well as claims 43-45, of U.S. Patent No. 5,425,051 ("the '051 patent"). The relevant claim language is construed by the Court as set forth in Section III below.

I. ***Background***

On May 18, 2005, Broadcom commenced this action against Qualcomm asserting claims for infringement of five patents, including the '051 patent. (Docket No. 1.) Broadcom initially asserted claims 1, 5, 24 and 26-28 of the '051 patent.

On September 11 and October 4, 2006, the Court issued orders regarding claim construction matters, which addressed, *inter alia,* certain terms of the '051 patent. (Docket Nos. 167, 208.) The case relating to the '051 patent was then stayed pending reexamination. Following the Patent and Trademark Office's ("PTO's") rejection of all claims subject to review in reexamination, Broadcom cancelled claims 1 and 5, but added 28 new claims, each of which depends from claim 24.

In light of this change, there are two new claim constructions at issue.

II. ***Legal Standard***

Claim construction is a legal question for the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 390, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996); Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454 (Fed.Cir.1998) (en banc). To construe a claim, the Court may consider the claim, the specifications, and the prosecution file history. Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed.Cir.2005) (en banc).

The Court begins its construction of a patent claim with the words of the claim itself, which "are generally given their ordinary and customary meaning," *i.e.,* "the meaning that the term would have to a person of ordinary skill in the art in question ... as of the [patent's] effective filing date." Id. at 1312-13.

The Court looks to the patent specifications when construing "the meaning of a claim term as it is used by the inventor in the context of the entirety of his invention." Comark Commc'ns v. Harris Corp., 156 F.3d 1182, 1187 (Fed.Cir.1998). In *Phillips,* the Federal Circuit emphasized 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." 415 F.3d at 1315 (internal quotations and citations omitted).

The prosecution history, like the specifications, provides evidence of how the Patent Officer and the inventor understood the patent. Id. at 1317. 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.* (citations omitted). The prosecution history, however, is important because it can demonstrate "whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.* (citations omitted).

"In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be

readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." *Id*. at 1314 (citation omitted). In these cases, "general purpose dictionaries may be helpful." *Id*. But the claim terms are not presumed to have the meaning that a person of ordinary skill in the relevant art would ordinarily attribute to them if (1) the patentee acts as his own lexicographer, or (2) the claim term is too vague for an accurate meaning to be ascertained from the language used. Novartis Pharms. Corp. v. Abbott Labs., 375 F.3d 1328, 1334 (Fed.Cir.2004). All that is required for a patentee to act as his own lexicographer is that a different meaning is set out in the specification in a manner sufficient to provide notice of the meaning to a person of ordinary skill in the art. In re Paulsen, 30 F.3d 1475, 1480 (Fed.Cir.1994). Overall, extrinsic evidence is "less significant than the intrinsic record in determining the legally operative meaning of the claim language." *Id*. at 1317 (internal quotations and citations omitted).

With these principles in mind, the Court turns to the terms at issue here.

III. *Discussion*

A. *The* '051 Patent

The '051 patent describes a system that adjusts the parameters of a network to address the wide range of operating conditions that effect the network, such as fading. ('05 patent, Abstract.)

B. *Disputed Terms*

1. "*source encoding to be used in maintaining RF communication*"

Disputed Term	Broadcom's Construction	Qualcomm's Construction	The Court's Construction
"source encoding to be used in maintaining RF communication"	No construction required	"source encoding to be used in maintaining RF communication for narrowband applications"	No construction required

Qualcomm contends that the Court ought to construe "source encoding to be used in maintaining RF communication" to mean "source encoding to be used in maintaining RF communication for narrowband applications." (Qualcomm Br. at 2, 5.) According to Qualcomm, because Broadcom acted as its own lexicographer by defining "source encoding" in the specification differently from its ordinary meaning, the scope of claim 24 cannot extend to non-narrowband applications, which are nowhere discussed in the specification as being applicable to source encoding.

The Court agrees that Broadcom acted as its own lexicographer. Previously, the Court adopted Broadcom's construction of "source encoding" as "method of modulation." (Docket No. 167, at 56.) Broadcom's own claim construction expert conceded that this construction is "somewhat different [from the way that term is] used ... conventionally in the art." (Cox Dep., at 93:13-16.) Broadcom therefore acted as its own lexicographer for the term "source encoding." In re Paulsen, 30 F.3d at 1480.

However, the Court does not agree with Qualcomm that claim 24 is limited to narrowband applications by virtue of this lexicography. Qualcomm's proposed construction is largely based on a single citation to Federal Circuit precedent, as well as on a single instance in which the specification discusses "source encoding" in terms of narrowband applications. Neither is persuasive.

Qualcomm's reliance on Irdeto Access, Inc. v. Echostar Satellite Corp., 383 F.3d 1295 (Fed.Cir.2004), is misplaced. This case does not stand for the broad proposition that, where the specification uses a claim term inconsistent with its ordinary meaning, courts must "construe a claim term only as broadly as provided for by the patent itself." Id. at 1300. Rather, the Federal Circuit in *Irdeto* held that a claim term was limited to the specification's implicit definition both because the patentee had admitted that the term had no accepted meaning in the art, and because the patentee had relied on the specification to overcome the patent examiner's indefiniteness objection. *Id*. at 1302-03. Distinguishing cases in which the "heavy presumption" in favor of ordinary meaning prevailed, the Federal Circuit stressed:

[None of these cases] involved a situation where the applicant admitted that certain claim terms lacked any agreed upon meaning in the art ... and unequivocally directed the patent examiner, as well as the public, to the specification as the complete source of meaning for the disputed terms by stating that those terms "are very adequately described in the specification and therefore there is a complete foundation for the use of those terms in the claims." Patentee's clear intent to rely on the four corners of his patent to define fully the terms at issue thus takes this case out of the "heavy presumption" regime of our cases.

Id. In this case, Qualcomm points to no analogous language in the prosecution history to evidence Broadcom's intent to rely on the four corners of his patent.

Further, Qualcomm's attempt to limit "source encoding" to narrowband applications, by implication based on the specification, is unavailing. Qualcomm largely relies on a single instance in which the specification discusses "source encoding" in terms of narrowband applications. (18:57-58.) In *Irdeto,* by contrast, the implicit definition was based on the consistent use of the claim term "group" to refer to a "subset of all subscribers." 383 F.3d at 1301. Here, the specification does not consistently use the term "source encoding" to refer exclusively to narrowband applications. FN1 Instead, the Court agrees with Broadcom that the use of "source encoding" for narrowband applications is simply a preferred embodiment.

The discussion of "Source Encoding Parameters (For Narrowband Applications)," at columns 18 through 20 of the patent, contains examples from a narrowband context, but nothing that would rule out or be inconsistent with a wideband application. Moreover, the benefits of improvement to system throughput are especially true of both narrowband and wideband. (19:29-33.) The fact that the patentee included an extended discussion of the narrowband context does not so limit the patent.

The Court also notes that the full phrase to be constructed here, "source encoding to be used in maintaining RF communication," need not be limited to narrowband applications. Instead, the Court agrees with Broadcom that this phrase has an ordinary meaning that needs no further construction. Notably, Qualcomm itself repeats this phrase in its proposed construction. This construction therefore cannot overcome the "heavy presumption" in favor of ordinary meaning and against claim construction. Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed.Cir.2002). That Broadcom has acted as its own lexicographer for the term "source encoding" does not detract from the ordinary meaning of the phrase, as a whole.

Moreover, claim differentiation also weighs against Qualcomm's proposed construction. "[D]ependent claims are presumed to be of narrower scope than the independent claims from which they depend." AK Steel Corp. v. Sollac & Ugine, 344 F.3d 1234, 1242 (Fed.Cir.2003). Because claim 41, which depends from claim 24, is limited to narrowband applications, claim differentiation suggests that claim 24 is not so limited. The Court finds unpersuasive Qualcomm's attempt to distinguish these claims based on the whether

"both *or* either of the mobile or the base station are operable to communicate with each other over a *narrowband* RF communication channel." (Qualcomm Br. at 9, second emphasis supplied.) Specification of which device is communicating does not explain why claim 41 needed to limit the communication to narrowband if claim 24 must be so read.

Finally, the Court notes that the correct construction is the one that "stays true to the claim language and most naturally aligns with the patent's description of the invention." Renishaw PLC v. Marposs Societa' per Azioni 158 F.3d 1243, 1250 (Fed.Cir.1998). Because the phrase modifies "RF data communication system" (23:15-24:6), and because "RF data communication system" is elsewhere described as using wideband communication systems (21:46-56, 22:29-41), in addition to narrowband applications, Broadcom's construction more naturally aligns with the overall description of the '051 patent. There is also evidence in the prosecution history that Qualcomm's proposed construction is inconsistent with its invalidity contentions in this action. (Broadcom Br. at 8-9, Ex. D.)

Accordingly, the Court finds that no construction is required for the phrase "source encoding to be used in maintaining RF communication."

2. " *operating parameters* "

Disputed Term	Broadcom's Construction	Qualcomm's Construction	The Court's Construction
"operating parameters"	"parameters that define the behavior of the RF data communication"	"four characteristics of the RF communication channel-(1) size of data segments to be transmitted, (2) length or frequency of the spreading code used for direct-sequence spread spectrum communications, (3) hopping rates, coding and interleaving for frequency-hopping spread spectrum communications, (3) hopping rates, coding and interleaving for frequency-hopping spread spectrum communication, and (4) type of RF source encoding used"	"parameters that define the behavior of the RF data communication"

Qualcomm contends that the Court ought to construe "operating parameters" as limited to "four characteristics of the RF communication channel-(1) size of data segments to be transmitted, (2) length or frequency of the spreading code used for direct-sequence spread spectrum communications, (3) hopping rates, coding and interleaving for frequency-hopping spread spectrum communication, and (4) type of RF source encoding used." (Qualcomm Br. at 2, 10.) According to Qualcomm, because the '051 patent refers to "operating parameters" as one of four-and only four-characteristics (11:17-36, 54-64), the construction of this term should reflect this limitation. Qualcomm cites Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc., 262 F.3d 1258, 1271 (Fed.Cir.2001), for this proposition.

But Qualcomm's citation to *Bell Atlantic* does not accurately recite the Federal Circuit's opinion. Qualcomm would have the Court believe that, under Bell *Atlantic,* "when a patentee uses a claim term throughout the entire patent specification, in a manner consistent with only a single meaning, he has defined that term by implication." *Id*. (internal quotations and citations omitted). But this quote must be read in context. At issue in *Bell Atlantic* was construction of the claim term "plurality of different modes" in the context of a patent for digital data transmission methods. Three modes of transmission were disclosed in the specification. The question was whether "plurality" was broader than these three modes. The court examined the use of the

words "mode" and "rate" in the specification and concluded that the word "mode" was used consistently and that, within that context, there were "only three possible" kinds of modes. *Id*. at 1272.

In sum, *Bell Atlantic* is not a case in which the Federal Circuit simply looked at the embodiments in the specification, found consistent use of a claim term, and narrowed the claim term to the specified embodiments. Rather, in addition to consistent use, the Court found that the language showed that the three disclosed embodiments were the only possible embodiments. *Id*. at 1272-73. The Court found that the specification limited the claim not because of merely consistent use of a claim term, but because no broader scope was possible. The specification thus "clearly set forth" the intent of the patentee to limit the scope of the claim term. Here, by contrast, Qualcomm does not argue that this Court should limit the claims to the preferred embodiment because no other embodiments are possible. Nor does Qualcomm assert anything beyond the "single meaning" contention to clearly set forth a narrowing redefinition of "operating parameters." Rather, Qualcomm relies on consistent use of a term in the specification alone, which, under Federal Circuit law, is not a sufficient basis for limiting claim language.

Broadcom's proposed construction is to construe "operating parameters" as "parameters that define the behavior of the RF data communication." (Broadcom Br. at 9.) The Court finds this definition appropriate. The '051 patent clearly sets forth that the limitations Qualcomm proposes to import into the term "operating parameters" are merely examples of such, not an exhaustive list. ('051 patent, Abstract (" *Examples of such parameters include:* the length and frequency of the spreading code in direct-sequence spread spectrum communications; the hop frame length, coding, and interleaving in frequency-hopping spread spectrum communications; the method of source encoding used; and the data packet size in a network using data segmentation.") (emphasis supplied).) The "Summary of the Invention" further identifies the illustrative nature of the four operating parameters. (2:30-36.) Further, Broadcom's proposed construction would include preferred embodiments disclosed in the specification and prosecution history, whereas Qualcomm's would exclude them. The abandoned application of Ronald L. Mahany, U.S. Ser. No. 07/485,313 ("the '313 application"), incorporated by reference into the '051 patent, provides several additional examples of "operating parameters" that define the operation of the "RF data communication system." (Broadcom Br. at 10-11; *see* ' 313 application, at 27, 31, 45; '051 Reexamination Certificate, at 2:63-67.) This weighs in favor of Broadcom's proposed construction and against Qualcomm's. *See* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (1996) ("Such an interpretation [excluding a patent's preferred embodiment] is rarely, if ever, correct and would require highly persuasive evidentiary support...."). The Court agrees that Broadcom's construction better accounts for all preferred embodiments, and more naturally aligns with the overall description of the '051 patent. Renishaw, 158 F.3d at 1250.

Accordingly, the Court construes "operating parameters" as "parameters that define the behavior of the RF data communication."

IV. *Conclusion*

As set forth above, the Court finds that no construction is required for "source encoding to be used in maintaining RF communication" in claims 24 and 33. The Court construes "operating parameters" in claims 43-45 as "parameters that define the behavior of the RF data communication."

FN1. Qualcomm asserts that the relevant section of the specification references constraints traditionally associated with narrowband communications. (Qualcomm Br. at 7.) But the Court finds these references too tenuous to show that Broadcom intended to limit "source encoding" to narrowband applications.

C.D.Cal.,2009.
Broadcom Corp. v. Qualcomm Inc.

Produced by Sans Paper, LLC.