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

TIVO INC,
Plaintiff.
v.
ECHOSTAR COMMUNICATIONS CORP., et al,
Defendants.

No. 2:04-CV-1-DF

March 24, 2006.

Alexander Chester Giza, Andrei Iancu, Adam S. Hoffman, Christine W.S. Byrd, Morgan Chu, Perry M. Goldberg, Richard E. Lyon, Irell & Manella LLP, Los Angeles, CA, Samuel Franklin Baxter, McKool Smith, Marshall, TX, Ben Yorks, Brian Jones, Irell & Manella, Newport Beach, CA, Michelle Armond, Knobbe Martens Olson & Bear LLP, R. Scott Feldmann, Randall I. Erickson, Steven P. Rice, Van V. Nguyen, Crowell & Moring, Irvine, CA, Garret Wesley Chambers, McKool Smith, Dallas, TX, for Plaintiff.

Alison M. Tucher, Jason A. Crotty, Rachel Krevans, Harold J. McElhinny, Kristina Paszek, Morrison & Foerster LLP, Robert M. Harkins, Jr., Howrey LLP, San Francisco, CA, Karl J. Kramer, Emily A. Evans, Morrison & Foerster, Palo Alto, CA, Damon Michael Young, John Michael Pickett, Young Pickett & Lee, Texarkana, TX, Scott F. Llewellyn, Morrison & Foerster, Denver, CO, for Defendants.

SUPPLEMENTAL CLAIM CONSTRUCTION ORDER

DAVID FOLSOM**, District Judge.**

Before the Court are the following briefs concerning claim construction of claims 5 and 36 of U.S. Patent No. 6,233,389 ("'389): TiVo's Brief on Claim Construction of Claims 5 and 36, Dkt. No. 550; EchoStar's Opening Claim Construction Brief Regarding Claims 5 and 36, Dkt. No. 549; TiVo's Reply Brief on Claim Construction of Claims 5 and 36, Dkt. No. 568; and EchoStar's Responsive Claim Construction Brief Regarding Claims 5 and 36. Having considered these and all other relevant briefs as well as the applicable law, the Court finds that claims 5 and 36 should be construed as set forth herein. FN1

FN1. As the parties are well aware, this is the Court's third order regarding claim construction of the '389 patent. See Dkt. Nos. 185 and 520. The Court here construes claims 5 and 36 consistent with the legal principles set forth in its prior orders. Additional information on the technology at issue is set forth in the Court's prior orders.

I. CLAIM LANGUAGE

This order considers what, if any, construction is necessary for claims 5 and 36 of the '389 patent. Claims 5 and 36 depend from claims 1 and 32, respectively. Each of these claims is set forth below:

1. A process for the simultaneous storage and play back of multimedia data, comprising the steps of:

accepting television (TV) broadcast signals, wherein said TV signals are based on a multitude of standards, including, but not limited to, National Television Standards Committee (NTSC) broadcast, PAL broadcast, satellite transmission, DSS, DBS, or ATSC;

tuning said TV signals to a specific program;

providing at least one Input Section, wherein said Input Section converts said specific program to an Moving Pictures Experts Group (MPEG) formatted stream for internal transfer and manipulation;

providing a Media Switch, wherein said Media Switch parses said MPEG stream, said MPEG stream is separated into its video and audio components;

storing said video and audio components on a storage device;

providing at least one Output Section, wherein said Output Section extracts said video and audio components from said storage device;

wherein said Output Section assembles said video and audio components into an MPEG stream;

wherein said Output Section sends said MPEG stream to a decoder;

wherein said decoder converts said MPEG stream into TV output signals;

wherein said decoder delivers said TV output signals to a TV receiver; and

accepting control commands from a user, wherein said control commands are sent through the system and affect the flow of said MPEG stream.

5. The process of claim 1, wherein the storing and extracting of said video and audio components from said storage device are performed simultaneously.

32. An apparatus for the simultaneous storage and play back of multimedia data, comprising:

a module for accepting television (TV) broadcast signals, wherein said TV signals are based on a multitude of standards, including, but not limited to, National Television Standards Committee (NTSC) broadcast, PAL broadcast, satellite transmission, DSS, DBS, or ATSC;

a module for tuning said TV signals to a specific program;

at least one Input Section, wherein said Input Section converts said specific program to an Moving Pictures Experts Group (MPEG) formatted stream for internal transfer and manipulation;

a Media Switch, wherein said Media Switch parses said MPEG stream, said MPEG stream is separated into its video and audio components;

a module for storing said video and audio components on a storage device;

at least one Output Section, wherein said Output Section extracts said video and audio components from said storage device;

wherein said Output Section assembles said video and audio components into an MPEG stream;

wherein said Output Section sends said MPEG stream to a decoder;

wherein said decoder converts said MPEG stream into TV output signals;

wherein said decoder delivers said TV output signals to a TV receiver; and

accepting control commands from a user, wherein said control commands are sent through the system and affect the flow of said MPEG stream.

36. The apparatus of claim 32, wherein the storing and extracting of said video and audio components from said storage device are performed simultaneously.

II. DISCUSSION

A. "Video and Audio Components"

a. The Parties' Positions

EchoStar argues that the phrase "video and audio components" should be given its plain, literal meaning. Dkt. No. 549 at 1. According to EchoStar, this limitation is met whether or not the "video and audio components" are from the same television show. Dkt. No. 549 at 3. EchoStar argues TiVo's position on the term conflicts with the plain meaning as TiVo will argue that claims 5 and 36 are limited to "simultaneous storage and extraction of portions of the *same television show*." Dkt. No. 549 at 3, emphasis supplied, referring to statements made by TiVo's counsel on March 16, 2006. According to EchoStar, nothing in the patent supports TiVo's alleged position. Dkt. No. 549 at 3-4, citing patent. EchoStar then proposes that the Court construe the phrase "video and audio components" "to have its plain meaning, which would be satisfied by 'video and audio components' of any content, including content from different television shows." Dkt. No. 549 at 4.

In its response, TiVo argues that EchoStar's proposed construction renders the dependant claims broader than their corresponding independent claims. Dkt. No. 568 at 2. TiVo argues that:

Consistent with [sic] Court's prior ruling on the preamble, claims 1 and 32 are limited to storing and extracting one specific program. EchoStar's construction of claims 5 and 36 erroneously expands the scope of related independent claims 1 and 32 to optionally allow for storing and extracting different television shows.

Dkt. No. 568 at 2. TiVo then argues that the claim language "clearly connects the video and audio components with one 'specific program.' " Dkt. No. 568 at 2, citing patent. Lastly, TiVo argues that EchoStar's proposed construction is "obviously incorrect" because it eliminates the key concept of "manipulating live TV." Dkt. No. 568 at 4.

In its response, EchoStar casts TiVo's argument as requiring "tuning said TV signals to a specific television show, and 'said video and audio components' must then be limited to 'video and audio components' from that specific television show." Dkt. No. 567 at 1. EchoStar argues that TiVo's position ignores and contradicts the Court's prior rulings on this limitation. Dkt. No. 567 at 1-2. According to EchoStar, the Court did not construe the claims to require that all of the processing steps recited in the claim are limited to the content of one television show. Dkt. No. 567. FN2 EchoStar argues that the Court's previous construction of the term "specific program" as "specified frequency range" is erroneous. EchoStar further argues that "TiVo offers no rational to support its proposal that the words of claims 5 and 36 require 'video and audio components' to be from the same television show. Dkt. No. 567 at 3. EchoStar argues that the question squarely before the court is "whether or not the extracting and storing must be the audio and visual components of a single television show." Dkt. No. 567 at 4. EchoStar then requests that "said video and audio components" be construed to mean "any 'video and audio components' that are captured and processed in the system after 'tuning to a specified frequency range.' " Dkt. No. 567 at 4.

FN2. EchoStar, for the first time in its response brief, informs the Court that it believes the Courts prior construction is erroneous and "welcome[s] the Court's revisiting of its original, erroneous claim construction." Dkt. No. 567 at 2-3, n. 1.

a. Claim Construction

The Court previously found that the terms "storing said video and audio components on a storage device" and "extracts said video and audio components from said storage device" did not require construction. Dkt. No. 185 at 18-20. The Court also construed "specific program" to mean "specified frequency range." Dkt. No. 185 at 14. These rulings need not change here.

Having considered the parties' recent briefing, however, some clarification is in order. Contrary to TiVo's position in its response brief, this Court did not previously construe claims 1 and 32 as "limited to storing and extracting *one specific program*." Dkt. No. 568 at 2, emphasis added. Tellingly, TiVo provides no citation to an order in support of this position as the Court has not so ruled.

An examination of the claim language reveals that claim 1 claims a process wherein the invention tunes to a "specified frequency range" which is then converted into an MPEG formatted stream and then parsed into "video and audio components." These "video and audio components" are the same referred to throughout the remainder of the claim as " *said* video and audio components." Claim 1, emphasis added. These components are stored and can be extracted. As the Court found in its March 13, 2006 Order addressing the preamble, claim 1 does not require that the components be stored and extracted simultaneously, though the claim does not foreclose simultaneous storage and extraction. Dkt. No. 520 at 13-14. Claim 5 further limits claim 1 in that claim 5 requires that "said video and audio components" be stored and extracted "simultaneously." In claim 5 the "said video and audio components" being stored are the same "said video and audio components" being extracted.

Thus, a plain reading of the claim language demonstrates that the "video and audio components" described in claim 1 at Col. 12:50 provide the antecedent basis for " *said* video and audio components" referenced throughout the remainder of claim 1 and in the claims depending from claim 1. Accordingly, no additional construction of the term is necessary for claim 5 as no construction of the term "video and audio components" is required. The same analysis holds true for claims 32 and 36.

B. "Simultaneously"

a. The Parties' Positions

In its opening brief, TiVo takes the position that no additional claim construction is required for claims 5 or 36. Dkt. No. 550 at 1-2. The only phrase in these two claims that has not previously been considered by the Court, according to TiVo, is "performed simultaneously." Dkt. No. 550 at 1. Although TiVo takes the position that "simultaneously" does not require construction, it proposes the construction of "at the same time." Dkt. No. 550 at 1.

TiVo argues that, if "simultaneously" is construed, the plain meaning of the term should be used as the patent uses the term in accordance with its plain meaning. Dkt. No. 550 at 2-3, citing the patent and dictionary definitions. The plain meaning is "at the same time" which, in a footnote, TiVo argues does "not mean at the same exact infinitesimal instance." Dkt. No. 550 at 3, n. 2 citing Linear Techn. Corp. v. Impala Linear Corp., 379 F.3d 1311, 1324 (Fed.Cir.2004). TiVo argues that EchoStar agrees, citing a letter wherein EchoStar allegedly proposes the construction of "simultaneously in effect." Dkt. No. 550 at 3, n. 2 citing 3/15/06 letter from K. Kramer to A. Icancu.

Addressing the term "simultaneously" in the context of an invalidity argument, EchoStar's posits that the term is not ambiguous as "[t]he operations of storing and extracting from the hard disk are either 'simultaneous' or they are not." Dkt. No. 549 at 2. FN3

FN3. In its opening claim construction brief, EchoStar first challenges the validity of claims 5 and 36 as inoperative, not enabled, and, with regard to claim 36, indefinite. Dkt. No. 549 at 1-2. As the Court is here considering the construction of these claims, and the claims are amenable to construction, these arguments will not here be decided. The Court will entertain such challenges if set forth in a Rule 50 motion at the appropriate time.

TiVo, in its response brief, argues that:

Nowhere in the patent does it state that the invention requires that the same exact component must be stored and extracted at the same exact instant. The patent teaches that storage and extraction of video and audio from the same specific program must be simultaneous so that the system can operate on live TV.

Dkt. No. 568 at 4. Further, TiVo argues that a construction of "simultaneously" that would require video and audio components to be stored at "the same precise instant" would read out the preferred embodiments. Dkt. No. 568 at 5. Instead, TiVo argues, "simultaneously" "simply means 'at the same time,' and not the exact same instant". Dkt. No. 568 at 5.

EchoStar, in its response brief, takes the position that the claims require that extracting and storing be

performed simultaneously. Dkt. No. 567 at 4. EchoStar distinguishes *Linear Technologies*. Dkt. No. 567 at 3. EchoStar argues that the question squarely before the Court is "whether or not the extracting and storing must be done 'simultaneously.' "

b. Claim Construction

The parties agree that the plain meaning of the term "simultaneously" is "at the same time." Yet, the parties disagree as to what the "plain meaning" means. TiVo essentially argues "at the same time" means "at the same time but not at the same exact infinitesimal instance or exact same instant" while EchoStar essentially argues that "at the same time" means "at exactly the same time."

As drafted, the specification and claims 5 and 36 require storage and extraction be "performed simultaneously." FN4 A review of the patent as a whole does not indicate that the patentee intended to act as his own lexicographer and specially define "simultaneously." It appears the only explicit reference to 'simultaneous performance' in the patent is at Col. 3:66-4:2: "[The Media Switch] then performs two operations if the user is watching real time TV: the stream is sent to the Output Section and it is written simultaneously to the hard disk or storage device." The preferred embodiment indicates that "performed simultaneously" means the operations are performed at the same time. The principles of claim construction dictate that a claim construction that would cause a preferred embodiment to fall outside of the scope of the patent claims is strongly disfavored and that claims should be read in the context of the patent as a whole. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583-84 (Fed.Cir.1996); Phillips v. AWH Corp., 415 F.3d 1303, 1316 (Fed.Cir.2005). Consistent with these principles, with the claims, and with the patent as a whole, the Court therefore construes "**simultaneously**" as "**operations are performed at the same time.**"

FN4. The language in claims 1 and 32 and claims 5 and 36 is largely the same except that claims 1 and 5 claim a process and claims 32 and 36 claim an apparatus. Unless otherwise noted, all analysis of claims 1 and 5 is applicable to claims 32 and 36.

III. CONCLUSION

For the foregoing reasons, the Court enters this supplemental claim construction order.

E.D.Tex.,2006.
TiVo Inc. v. Echostar Communications Corp.