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

Morris REESE,
Plaintiff.
v.
AT & T, INC., Southwestern Bell Telephone, L.P., Verizon Communications Inc., GTE Southwest, Inc,
Defendant.

Civil Action No. 2:07cv219-DF

Sept. 24, 2008.

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CLAIM CONSTRUCTION ORDER

DAVID FOLSOM**, District Judge.**

I. BACKGROUND

Before this Court is Plaintiff Morris Reese's ("Reese") Opening Claim Construction Brief regarding U.S. Patent No. 6,868,150 ("the '150 Patent"). Dkt. No. 71. FN1 Also before the Court are Defendants Southwestern Bell Telephone, L.P. and GTE Southwest, Inc.'s ("Defendants") joint response, Reese's reply, and Southwestern Bell Telephone's sur-reply. Dkt. Nos. 72, 74 & 78. The Court held a hearing on July 31, 2008. Dkt. No. 92. After considering the patent, arguments of counsel, and all other relevant pleadings and papers, the Court finds that the claims of the patent-in-suit should be construed as set forth herein.

FN1. All page numbers from the parties' submissions are hereinafter cited as paginated on the docket (PACER).

II. LEGAL PRINCIPLES OF CLAIM CONSTRUCTION

A determination of patent infringement involves two steps. First, the patent claims are construed, and,

second, the claims are compared to the allegedly infringing device. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1455 (Fed.Cir.1998) (en banc). The legal principles of claim construction were recently reexamined by the Federal Circuit in Phillips v. AWH Corp., 415 F.3d 1303 (Fed.Cir.2005) (en banc). The Federal Circuit in *Phillips* expressly reaffirmed the principles of claim construction as set forth in Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed.Cir.1996), and Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc., 381 F.3d 1111 (Fed.Cir.2004). Thus, the law of claim construction remains intact. Claim construction is a legal question for the courts. Markman, 52 F.3d at 979.

The Court, in accordance with the doctrines of claim construction which it has outlined in the past, construes the claims of the patents in suit below. *See Pioneer v. Samsung,* Civ. No. 2:07-cv-170, Dkt. No. 94 at 2-8 (E.D. Tex. filed Mar. 10, 2008) (claim construction order).

III. THE PATENTS-IN-SUIT

The '150 Patent issued on March 15, 2005 and is related through a series of continuation applications to an application filed April 25, 1991 which itself was a continuation-in-part application of an application filed on January 3, 1990 FN2. ' 150 Patent at Cover. U.S. Patent No. 6,427,009 is the immediate parent patent of the ' 150 Patent and was the subject of a prior claim construction order by this Court. *Reese v. Samsung Telecom. Am. L.P., et. al.,* Case No. 2:05-cv-00415-DF, Dkt. No. 169.

FN2. Application No. 07/460,481.

The Abstract of the '150 Patent reads as follows:

An apparatus and method are disclosed for accessing telephone or cellular originating central office equipment to control the disclosure of a calling party directory telephone number or, if applicable or available, directory telephone number and name to a called party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID), which discloses the calling party directory telephone number or directory telephone number and name to the called party, by performing a desired one of a plurality of automatic and/or manual operations. Method is disclosed for connecting to a called station idle or busy telephone line with ringing signals or a call-waiting tone signal and then transmitting the calling party directory telephone number or, if applicable or available, directory telephone number and name to the called station during a silent interval between the ringing signals or after the call-waiting tone signal responsively to receiving the calling party directory telephone number flagged as public from originating central office equipment of the calling party indicating that the directory telephone number or the directory telephone number and name are to be disclosed at the called station.

The Court provides the following summary of the '150 Patent without prejudice to or implication upon the parties' positions. Figure 1 and the associated text of the '150 Patent describe the operations at a calling party's phone and the communication with the originating central office to control the disclosure of a calling party's DN. '150 Patent at Fig. 1, col. 4, ll. 39-44; col. 5, ll. 3-67. Figures 2 and 2B and the associated text relate to communications between the terminating central office and the called party. '150 Patent at Figs. 2 & 2A, col. 4, ll. 45-57; col. 6, ll. 1-41. Figure 2B and the associated text relate to a called party returning a missed incoming call. '150 Patent at Fig. 2B; Id. at col. 4, ll. 58-62 & col. 6, ll. 42-54. Figure 3 and the

associated text relate to a simplified diagram of the principal components of a telephone connected "to originating or terminating central office equipment for performing the various operations of the inventions." '150 Patent at col. 4, ll. 63-67, Fig. 3, col. 6 l. 55-col. 7, l. 60. A principal dispute between the parties is whether the claims should be limited to a calling party utilizing an apparatus such as shown in Figure 3 or whether the claims are merely directed toward the communication process at the terminating central office end of the telephone call. Reese has asserted independent claims 1, 7, 13, 18, 23, 25, 32 and 36. Dkt. No. 71 at 5. These claims read as follows:

1. A method for sending to a called station of a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party a directory telephone number (DN) of a third party calling a telephone number of the first party, comprising the steps of:

(a) receiving at a terminating central office of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party DN flagged as public from an originating central office of the third party indicating that said DN of the third party is to be disclosed at the called station of the first part;

(b) said terminating central office sending a call waiting (CW) tone signal to the first pay; and

(C) said terminating central office then transmitting said DN of the third party to the called station of the first party during a silent interval after said CW tone signal.

7. A method for sending to a called station of a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party a directory telephone number and name (DN) of a third party calling a telephone number of the first party, comprising the steps of:

(a) receiving at a terminating central office of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party DN flagged as public from an originating central office of the third party indicating that said DN of the third party is to be disclosed at the called station of the first party;

(b) said terminating central office sending a call waiting (CW) tone signal to the first party; and

(C) said terminating central office then transmitting said DN of the third party to the called station of the first party during a silent interval following said CW tone signal.

13. A method for sending to a called station of a first party who is engaged in a conversation with a second party via a local switching office (LSO) a directory telephone number (DN) of a third party calling a telephone number of the first party, comprising the steps of:

(a) after receiving at said LSO said DN of the third party marked as public from an originating central office of the third party, indicating that said DN of the third party is to be disclosed at the called station of the first party, sending a call waiting tone signal to the first party;

(b) said LSO then transmitting to the called station of the first party said DN of the third party during a

silent interval after the call waiting tone signal cycle; and

(C) receiving by an apparatus at the called station of the first party during the silent interval after the call waiting tone signal cycle said DN of the third party from said LSO and displaying said received DN of the third party on a display of the apparatus.

18. A method for transmitting to a called station of a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party a directory telephone number (DN) of a third party calling a telephone number of the first party, comprising the steps of:

(a) receiving at a terminating central office (TCO) of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party DN flagged as public from an originating central office of the third party;

(b) said TCO sending a call waiting tone signal to the first party; and

(C) said TCO then transmitting the third party DN to the called station of the fist party.

23. A method for indicating to a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party an incoming call from a third party calling a telephone number of the first party comprising the steps of:

(a) receiving at a terminating central office (TCO) of the fist party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party directory telephone number (DN) flagged as private from an originating central office of the third party, indicating that said DN of the third party is not to be disclosed at the first party called station; and

(b) said TCO then sending a call waiting (CW) tone signal to the first party, said CW tone signal indicates to the first party the incoming call from the third party.

25. A method for transmitting to a called station of a first party who subscribes to a Custom Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party a directory telephone number (DN) of a third party calling a telephone number of the first party, comprising the steps of:

(a) receiving at a terminating central office (TCO) of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party the third party DN flagged as public from an originating central office of the third party, indicating that said DN is to be disclosed at the called station of the first party;

(b) said TCO sending a call waiting tone signal to the first party; and

(C) said TCO then transmitting said DN of the third party to the called station of the first party.

32. A method for sending a call waiting (CW) tone signal only to a first party who subscribes to a Custom

Local Area Signaling System (CLASS) service including Caller Identification (Caller ID) and who is engaged in a telephone conversation with a second party, comprising the steps of:

(a) receiving at a terminating central office (TCO) of the first party who subscribes to said CLASS service including said Caller ID and who is engaged in the telephone conversation with the second party a calling third party directory telephone number (DN) flagged as private from an originating central office of the calling third party indicating that said received DN of the calling third party is not to be disclosed at the first party called station; and

(b) said TCO then sending said CW tone to the first party.

36. A method of providing to a first party who is already engaged in a conversation with a second party identifying information related to a third party who wishes to converse with the first party, comprising the steps of:

(a) after receiving at a local switching office (LSO) serving the first party said identifying information marked as public from an originating central office of the third party, indicating that said identifying information related to the third party is to be disclosed at the first party called station, sending a call waiting tone signal to the first party;

(b) said LSO then transmitting to said called station of the first party said identifying information related to the third party; and

(C) receiving by an apparatus at said called station of the first party said identifying information related to the third party from said LSO and displaying said received identifying information related to the third party on a display on the apparatus.

IV. CLAIM CONSTRUCTION

A. Agreed Terms

The parties agreed during the briefing to construe "call waiting (CW) tone signal" to be "an audible notification sent via the voice channel to a called station already engaged in a call and indicating an incoming call." Dkt. No. 72 at 28-29; Dkt. No. 71 at 19.

The construction of the term "DN" was also agreed to by the parties at the claim construction hearing. Dkt. No. 92 at 5-6. With regard to claims 1, 13, 18, 23, 25 and 32, the agreed construction is "a telephone number associated with a calling party. The DN is received from an originating central office." *Id*. With regard to claim 7, the agreed construction is "a telephone number and name associated with a calling party. The DN is received from an originating central office." *Id*.

The construction of the terms "originating central office" and "terminating central office" were also agreed to at the claim construction hearing. Dkt. No. 92 at 50-51. In particular, the Defendants' asserted construction was agreed to with the removal of the word "closest." *Id*. The agreed construction for "originating central office" is "the telephone switching office that is directly connected to the person (third party) who is making the call-waiting call." *Id*. The agreed construction for "terminating central office" is "the telephone switching office that is directly connected to the person (first party) who is receiving the call-waiting call." *Id.; See also* Dkt. No. 80, Joint Claim Construction Chart ("JCCC") at 2-3.

Subsequent to the hearing, Reese filed a letter with the Court with regard to the "originating central office" and "terminating central office" agreement. Dkt. No. 85, Ex. A. Reese seeks to clarify that "directly connected" should not imply any specific type of connection such as hard-wiring, wireless or the like. Dkt. No. 85 at 2. Reese further noted that in a previous litigation involving the parent patent of the '150 Patent, this Court stated that "the specification thus demonstrates that an originating central office is a central office associated with a calling party and a terminating central office is a central office associated with a called party" and that "the preferred embodiment cannot be imported into the claims to limit claim scope, especially where the claims and written description specifically refer to a "cellular mobile telephone." Id. *citing Reese v. Samsung Telecom. Am. L.P ., et. al.,* No. 2:05-cv-00415-DF, Dkt. No. 169 at 19. The Defendants object to Reese's assertions and state that Reese is attempting to reopen the claim construction. Dkt. No. 87, Ex. A at 2. The Defendants assert that the Plaintiff has represented to the Court that the present case relates to landline telephone systems and cites to a quote from Reese's tutorial which states that "this litigation is focused on companies that provide telephone services over a landline telephone network." *Id.* at 2-4.

It is the Court's understanding that the present case relates to landline phone systems. Further, neither party has provided any briefing as to whether or not the claims of the '150 Patent should or should not apply to other types of systems. As such, the question of landline verse wireless mobile systems is not before this Court and need not be determined at this time. Further, at the claim construction hearing neither party indicated to the Court that the agreed construction would implicate a certain type of connection such as landline or mobile. Rather, it appeared that the parties were attempting to make a good faith effort to resolve the issues as presently pending before this Court. If the issue of landline systems versus mobile systems is properly and timely raised to this Court at a later date, the Court will address the dispute at that time. Thus, the Court's acceptance of the agreed constructions for "originating central office" and "terminating central office" at this time is not meant to provide any indication as to whether such construction implies a specific type of connection.

B. Disputed terms

1. "apparatus"

This term appears in asserted independent claims 13 and 36.

(1) The Parties' Positions

Reese contends that the term "apparatus" does not require construction. JCCC at 8 & 12. The Defendants assert that the term should be construed as "a device that is programmable and must include a number generator, a display unit, a memory unit, an autodialer unit, a recall button, a display button, a block button, a keypad, and a microprocessor." Id.

Reese asserts that the claim is drafted as a generic device and that the Defendants are improperly incorporating limitations from the preferred embodiment of Figure 3. Dkt No. 74 at 7. Reese further asserts that there is no support in the specification or file history for incorporation of all the elements of the preferred embodiment. *Id.* At the claim construction hearing, Reese argued that the claims in general were method claims which focused on the activities on the receiving end of a phone call such as the receiving at the final local switching office, the transmission at that local switching office and the receiving at the called location. Dkt. No. 92 at 31-32, 35 & 40-41. Reese argued that the claims merely recite "an apparatus at a

called station" and that the Defendants inclusion of all elements of the preferred embodiment, including apparatus details relevant to initiation of a phone call by a calling apparatus, is unsupported. *Id*. At the hearing, Reese acknowledged agreement with a construction in which apparatus means "telephone set." *Id*. at 31-32.

The Defendants assert that the elements contained in the Defendants' construction are the characteristics described for the apparatus in the specification. Dkt. No. 72 at 10-11 *citing* '150 Patent, Fig. 3 and col. 1, ll. 16-36, col. 2, ll. 29-65, col. 3, l. 13-col. 4, l. 32, col. 4, ll. 63-67, col. 3, ll. 3-67, col. 6, ll. 17-30, col. 6, l. 55-col. 7, l. 32. The Defendants also assert that the apparatus of Figure 3 is the only apparatus disclosed in the patent and that the intrinsic record requires a construction that conforms to what was disclosed. Id. at 10-13. The Defendants emphasize the following passage in the '150 Patent:

FIG. 3 shows a simplified diagram of the principal components of an apparatus (telephone set or other receiving and sending devices) connected via telephone lines and a RJ11 jack to originating or terminating central office equipment for performing the various operations of the inventions.

'150 Patent at 4:63-67. The Defendants then note that Figure 3 contains the various elements of the Defendants' construction. Dkt. No. 72 at 12. At the claim construction hearing, the Defendants also cited a number of passages which describe the activities at the calling party phone regarding the display and block buttons in the context of language such as "in one operation of this invention," "in another operation of this invention," and "in still yet another operation." Dkt. No. 92 at 27 *discussing* '150 Patent at 3:24-28, 3:65-66 & 4:22-24. The Defendants emphasized that *Honeywell Intern., Inc. v. ITT Industries, Inc*. illustrates that it is appropriate to adopt a construction that matches the preferred embodiment where a written description consistently refers to a single embodiment and also characterizes the embodiment as "the invention." *Id*. at 27-29 *discussing* Honeywell Intern., Inc. v. ITT Industries, Inc., 452 F.3d 1312, 1318 (Fed.Cir.2006); *See also* Dkt. No. 72 at 11.

(2) Construction

The Court finds it constructive to start with an analysis of the claims themselves. The claims themselves are directed toward the activities occurring at the receiving end of a phone call. Thus, claims 13 and 36 begin with a "method for sending to a called station" and the three method steps relate to "receiving at the LSO" (local switching office), "said LSO then transmitting to the called station" and "receiving by an apparatus at the [said] called station." '150 Patent at Claims 13 & 36. The other asserted independent claims have similar limitations, such as for example, those relating to receiving at a terminating central office, the terminating central office sending a signal, and the terminating central office transmitting to the called station. '150 Patent at Claims 1, 7, 18, 23, 25 & 32. Thus, it is clear that the claims are directed toward the activities at the called station end of the communication process. In addition, the claim limitation in question is presented in the context of the "apparatus at the [said] called station." JCCC at 8 & 12. At least some of the features sought to be added by the Defendants (such as the display and block button feature) generally relate to the placing of a call. '150 Patent at col. 5, ll. 1-43.

The Court recognizes that the structure described with reference to Figure 3 is the sole embodiment that is described for placing calls and flagging such calls as private or public. However, the specification also describes activities which occur on the receiving end of the communication process. For example, Figures 2 and 2A focus on the terminating central office end of the communication process. '150 Patent, Fig. 2 & 2A. Likewise such activities are described in the abstract and several portions of the specification. *See* ' 150

Patent at col. 1 ll. 35-45, col. 2, ll. 66-3:12, col. 3, ll. 52-57, col. 6, ll. 1-16, col. 6, ll. 30-41 & col. 7, ll. 45-60. Moreover, it is noted that the specification repeatedly refers to different aspects of the invention indicating that the disclosure is not limited to only one particular feature of the disclosure. For example, regarding the concepts of the steps of claims at issue, the disclosure states "this invention also relates to ..." and "still yet another technical advance...." '150 Patent at col. 1 ll. 35-36 & col. 2, ll. 66. Likewise, with regard to the references asserted by the Defendants regarding the Figure 3 structure being "the invention," the specification presents these as "one operation," or "another operation" or "still another operation" of the invention. '150 Patent at col. 3, ll. 24-28, col. 3, ll. 56-66 & col. 4, ll. 22-24. Combined with the references cited above regarding the terminating end activities being described as "this invention also relates to" and "yet another technical advance," the specification when read as a whole does not limit all aspects of the described techniques to require an inclusion of a calling apparatus such as shown in Figure 3. Rather, the specification appears to indicate that different aspects of the invention are presented. In this regard, the present specification is differentiated from the situation described in *Honeywell*. *See* Honeywell Intern., Inc. v. ITT Industries, Inc., 452 F.3d 1312. Moreover, in *Honeywell,* the specification recited limitations primarily directly applicable to the construction of the fuel injection system component referenced in the claims. *Id*. at 1315. Thus, the *Honeywell* court found that the component was limited to a fuel filter, the only disclosed embodiment. *Id*. at 1317-1318. The situation before this Court is different in that the claims themselves are not primarily directed toward limitations regarding the "apparatus" but rather more often directed toward the communication steps at the terminating end of the call (LSO receiving, LSO transmitting and receiving at the called station).FN3

FN3. It should also be noted that the specification in *Honeywell* referred to the fuel filter as "this invention" or the present invention." Honeywell Intern., Inc. v. ITT Industries, Inc., 452 F.3d at 1318. Here, as discussed above, the Figure 3 structure is described as "one operation," "another operation," "in still another operation." *See* '150 Patent, col. 3, l. 24 to col. 4, l. 33.

Finally, the Court notes that the specification itself utilizes the general term "apparatus" in a manner indicating a more generic meaning. When referencing Figure 3, the specification itself states "... an apparatus (telephone set or other receiving and sending devices)...." '150 Patent at Col. 4, ll. 64-65. Likewise the specification begins with: "[t]his invention relates to an apparatus, such as a pushbutton telephone or other receiving and sending equipment, ..." '150 Patent at Col. 1, ll.16-17.

Based upon the claims and the specification as a whole, the Court construes "apparatus" to mean "telephone or other receiving and sending equipment."

2. Flagged or Marked as Public or Private

There are several terms related to flagging or marking as public or private that the parties agree should be construed consistently. The terms in question are "DN flagged as public" (claims 1, 7, 18 and 25), "DN marked as public" (claim 13); "identifying information marked as public" (claim 36), and "DN flagged as private" (claims 23 and 32).

(1) The Parties' Positions

Reese asserts that "DN flagged as public" and "DN marked as public" should be construed as "a DN linked to an indication that the DN is to be disclosed at a called station." JCCC at 2, 5 & 7. Reese asserts that "identifying information marked as public" means "identifying information linked to an indication that the

information is to be disclosed at a called station." Id. at 11. Finally Reese asserts that "DN flagged as private" means "a DN linked to an indication that the DN is not to be disclosed at a called station." Id. at 9. The Defendants assert that that "DN flagged as public," "DN marked as public" and "identifying information marked as public" should be construed as "for each dialed call, the person (third party), who is making the call-waiting call, depresses a display button on his telephone set so that the "DN" will be sent to the person (first party) who is receiving the call-waiting call." Id. at 2, 5, 7 & 11. The Defendants assert that "DN flagged as private" means "for each dialed call, the person (third party), who is making the call-waiting call, depresses a block button on his telephone set so that the "DN" will not be sent to the person (first party) who is receiving the call-waiting call." Id. at 9.

Both parties repeat some of the arguments made in relation to the term "apparatus." Reese further states that the claims themselves provide indication of the proper construction. Dkt. No. 71 at 19. In particular, Reese asserts that the claims are drafted toward what happens after a call is flagged as opposed to how a call is flagged. *Id*. at 19-20. Reese supports this position by pointing to the surrounding claim language, such as claim 1 which states "the third party DN flagged as public from an originating central office of the third party indicating that said DN of the third party is to be disclosed at the called station." *Id*.

The Defendants maintain that the only method of flagging disclosed in the patent is performed through the use of a button on the telephone. Dkt. No. 72 at 16-17. The Defendants further assert that the prosecution history makes clear that "the novel feature of [the] invention was sending the identifying information in response to a publicly flagged call." *Id*. at 17 *citing Id*., Ex. H at 6-7 (March 13, 1996 Amendment), Ex. G at 8 (December 7, 1995 Amendment) & Ex. I at 5 (April 17, 1997 Amendment).

In response to the Defendants' prosecution history argument, Reese asserts that that the prosecution history statements referenced by the Defendants refer to what happens after a flagged DN is received and do not require steps regarding how flagging occurs or the use of buttons on a telephone. Dkt. No. 74 at 12. At the claim construction hearing, Reese also pointed out that flagging a call was known in the prior art as pointed out in the background of the invention. Dkt. No. 92 at 40-41.

(2) Construction

As discussed above with regard to the term "apparatus," the claims in general do not relate to the particular equipment utilized by the calling party and the specification provides sections that point out that one aspect of the disclosure focuses on the terminating central office end of the communication process. Much of the rationale for the Court's construction with regard to "apparatus" equally applies to the flagged/marked dispute. With regard to the particular claim language surrounding the terms in question, the Court notes that in claim 1 the "DN flagged as public" is "from an originating central office." '150 Patent at Claim 1. This language appears to focus on activity independent of the caller's particular phone. Similar language is found with regard to the disputed language in the other claims. As to the prosecution history statements, the Defendants do not point to statements that relate to the particular language which the Defendants seek to add___i.e., depressing a button on the telephone set. Rather, as pointed out by Reese, the prosecution history cited by Defendants more properly relate to what happens at the receiving end when a call that has been flagged Is received. *See* Dkt. No. 74 at 9; *See also* Dkt. No. 72 at Exs. G, H & I. Thus, the Court finds no disavowal in the prosecution history to limit the claims to flagging by depressing a button. Finally, the Court notes that the specification explicitly states that flagging techniques that do not involve depressing a particular button on a telephone to accomplish flagging were known in the art. '150 Patent at col. 1, ll. 48-2:5. In the totality, the claims, specification and prosecution history do not limit that flagged/marked

language to the particular caller equipment as sought by the Defendants.

Thus, the Court construes "DN flagged as public" and "DN marked as public" to mean "a DN linked to an indication that the DN is to be disclosed at a called station." The Court construes "identifying information marked as public" to mean "identifying information linked to an indication that the information is to be disclosed at a called station." Finally, the Court construes "DN flagged as private" to mean "a DN linked to an indication that the DN is not to be disclosed at a called station."

3. Sending a Call Waiting (CW) Tone Signal

This term is appears in asserted claims 1, 7, 13, 18, 23, 25, 32 and 36.

(1) The Parties' Positions

Reese asserts that the term does not need construction. JCCC at 3, 5, 10 & 11. The Defendants assert that the term means "transmitting a call waiting (CW) tone signal only if another person (third party) who is making the call waiting call, depresses the display or block button on the telephone set." Id. As mentioned above, the parties agreed during the briefing to construe "call waiting (CW) tone signal" to be "an audible notification sent via the voice channel to a called station already engaged in a call and indicating an incoming call." Dkt. No. 72 at 28-29; Dkt. No. 71 at 19.

Reese reiterates that the claims do not relate to the caller's equipment but rather relate to the receiving end of the communication process. Dkt. No. 71 at 26; Dkt. No. 92 at 42-43. Reese notes that the parties have agreed to the meaning of "call waiting tone signal" and the word "sending" is the only remaining word needing construction. *Id*. Reese asserts that "sending" is easily understood and needs no construction. Dkt. No. 71 at 25-26.

The Defendants assert that the specification describes a multi-step process for sending a call waiting signal. Dkt. No. 72 at 24-25. More particularly, the Defendants cite to the Abstract to assert that for a call waiting signal to be sent, the call must be flagged. *Id*. at 24. To accomplish flagging, the Defendants assert that display or block buttons must be utilized. *Id*. at 24-25. The Defendants cite to their flagged/marked arguments described above to then support the inclusion of the display and block buttons in the construction for sending a call waiting (CW) tone signal. *Id*. at 24. Reese counters that a call waiting tone will be sent regardless of whether flagging occurs. Dkt. No. 74 at 12.

(2) Construction

The Defendants' construction relies upon a construction for "flagging" that the Court has rejected above. Thus the Court rejects the Defendants' construction of "sending a call waiting (CW) tone signal" for the reasons explained. The Court notes that the only term in debate is "sending." The Court does not find the term in need of construction as it would be understandable to a jury. The Defendants have not provided support for any other construction of the term and the Court notes that with regard to another disputed term, "transmitting said DN," the Defendants own asserted construction begins with "sending" without further definition of "sending" itself.

Other than the agreed construction of "a call waiting (CW) tone signal," the Court finds that no further construction of "sending a call waiting (CW) tone signal" is required.FN4

FN4. Having rejected Defendants' proposed construction and resolved the parties' dispute regarding the scope of this term, the Court notes that this holding is consistent with *O2 Micro*. *See* O2 Micro Intern., Ltd. v. Beyond Innovation Technology Co., Ltd., 521 F.3d 1351, 1362 (Fed.Cir.2008) ("[D]istrict courts are not (and should not be) required to construe every limitation present in a patent's asserted claims.").

4 & 5. "transmitting said DN" and "silent Interval"

The term "transmitting said DN" appears in asserted claims 1, 7, 13 and 25. The term "transmitting the third party DN" appears in claim 18. The term "silent interval" appears in asserted claims 1, 7 and 13.

(1) The Parties' Positions

Reese asserts that "transmitting said DN" and "transmitting the third party DN" do not need construction. JCCC at 3-4, 6 & 7-8. The Defendants assert that the terms should be construed as "sending the 'DN', as a signal with a frequency between 20 and 22 kHz, but only if the 'DN' has been 'flagged as public.' " *Id*.

Reese asserts that the term "silent interval" should be construed as "the period of time between ringing signals or following transmission of the call waiting tone signal." JCCC at 3-4, 6 & 7-8. The Defendants assert that the term should be construed as "the time, either between the ringing signals or following the 'call-waiting (CW) tone signal', during which 'DN' information is sent at a frequency between 20 and 22 kHz." *Id*.

The arguments of the parties for both transmitting the DN and silent interval are generally the same and focus primarily on whether or not the prosecution history mandates a frequency range for the DN transmission. *See* Dkt. No. 71 at 20-22 & 26; Dkt. No. 72 at 18-23; Dkt. No. 74 at 5-8; Dkt. No. 78 at 1-3. The parties also dispute the necessity of including in the transmitting terms the language relating to the DN being flagged as public. Dkt. No. 72 at 21-22; Dkt. No. 74 at 10.

The Defendants assert that the patentee made a clear statement during the prosecution of one of the earlier filed priority applications:

Thus, throughout the Specification, any reference to a silent interval following the Call Waiting tone is the period of time that CN data flows as 20-22 kHz signals.

Dkt. No. 72 at 18-19 *citing* Ex. K at 12 (Amendment dated November 14, 1994 filed in priority Application No. 08/093,603) ("Nov. 14, 1994 Amendment"). The Defendants assert that this statement provides a clear and unambiguous characterization of the invention that should be used to construe the disputed terms. *Id*. at 20.

The Defendants further assert that the events leading up to this statement, provided below, further supports the inclusion of the frequency range in the construction. Dkt. No. 72 at 19. During prosecution of the priority application a rejection was issued as to how information could be sent to a busy station. *Id*., Ex. L at 4-5. (Office Action dated Sept. 22, 1994 filed in priority Application No. 08/093,603). The Applicant responded with a proposed response and amendment that stated "transmitting and receiving FSK signals (e.g. 20KHZ mark, 22 KHS space) via an analog line to a busy station is well established in the art." Dkt. No. 72, Ex. M at 8 (Proposed Amendment dated Oct. 2, 1994 filed in priority application no. 08/093,603) ("Oct. 2, 1994 Proposed Amendment"). Also included in the proposed response and amendment was a

statement from an expert, Ralph Dodds, which stated:

The mark and space frequencies of the FSK signal are to be above 4000 Hz. Use of 20 & 22 KHz is assumed for this new art. Any frequency above 4000 Hz will not be easily heard in the local apparatus head-set and 20-22 KHz is beyond normal hearing.

Thus throughout most of the following discussions we refer to a "silent interval" following the Call Waiting tone as the period of time that CN data flows as 20/22 KHz signals. A 64 character word/message can be transmitted within one second using 20/22 kHz carrier and 40 cycles to establish a mark or space, these factors are well within established practice of the 1980's.

Dkt. No. 72, Ex. N at 10 (Statement by R. Dodds submitted with Proposed Amendment dated Oct. 2, 1994 filed in priority application no. 08/093,603) ("Oct. 2, 1994 Statement"). After a subsequent Examiner Interview, the final amendment was submitted with the language cited above. *See* Dkt. No. 72, Ex. K at 12 (Nov. 14, 1994 Amendment). The Defendants assert that the record shows that when Reese was faced with being unable to persuade the examiner to allow the claims based on more general comments, Reese made a clear and unqualified narrowing statement. Dkt. No. 72 at 20. The Defendants also pointed out at the claim construction hearing that the specification states that transmission of the DN occurs during a silent interval. Dkt. No. 92 at 16-17 *discussing* '150 Patent at 1:36-40; 7:44-51.

Reese counters that "transmitting" does not require construction and that the prosecution history does not support the construction proposed by the Defendants. Dkt. No. 74 at 10. Reese asserts that the remark in question related to Reese's argument that the disclosure does not contain new matter and that the use of conventional equipment to send and receive signals was disclosed. *Id*. at 9-10. Reese asserts that that when taken as a whole the Amendment does not limit transmission to a specific frequency but describes known signaling techniques to overcome the Examiner's new matter objection. *Id*. at 10. Reese asserts that the statements were made to indicate that the transmissions in question could be implemented without modifying existing equipment. *Id*. Reese further asserts that looking at the entire Amendment shows that 20 to 22 KHz frequencies were merely exemplary. *Id*. at 9-10. Reese points to earlier statements in the Amendment where it was stated "for example, 20/22KHz." *Id*. at 9 *quoting* Dkt. No. 72, Ex. K at 9 (Nov. 14, 1994 Amendment). Reese also points to a section after the statement cited by the Defendants in which it states "Caller ID is mixed with Call Waiting and 20-22KHz or other frequencies above 4000 Hz are used to provide silent or near silent transmission of CN data." *Id*. *quoting* Dkt. No. 72, Ex. K at 13. Finally, Reese points to another subsequent portion of the Amendment which states:

The signaling in the system of the invention could be of a wider scope than any of the above, i.e., DTMF at 10-30KHz instead of the 300-1000 Hz range in common use. The description of a chosen scheme is only to show an example of an implementation to accomplish the method of the invention, and is not intended to limit the invention in any way.

Id.

Defendant Southwestern Bell contends in its surreply that "because the statements Plaintiff quotes are directed solely to the adequacy of the disclosure, rather than to the terms appearing in the claims, they do not render ambiguous Reese's clear definition of the claim terms 'silent interval' and 'transmitting the DN' in the same prosecution history document." Dkt. No. 78 at 2. Defendant Southwestern Bell further states with regard to the passage of issue that "this one sentence is an unambiguous admission of meaning of silent

interval (and transmitting the DN)." *Id.*

With regard to the end portion of the Defendants' construction which states "but only if the 'DN' has been 'flagged as public,' " Reese asserts that such portion is redundant with the actual claim language. Dkt. No. 74 at 9. In particular, Reese asserts that each of the claims in question already includes a limitation that the DN be flagged or marked as public. *Id.* The Defendants assert that as disclosed in the '150 Patent, the DN is only transmitted when it has been flagged as public. Dkt. No. 72 at 21. In particular, the Defendants point to Figure 1 to state that the disclosure requires activation of either the block or display button and thus the call may proceed only when one of those buttons is activated. *Id.*

With regard to silent interval, Reese asserts that the silent interval is the time period between the ringing signals or the period following the call waiting tone signal as defined consistently throughout the specification. Dkt. No. 71 at 20 *citing* '150 Patent at col. 3, ll. 57-58, col. 6, ll. 12-13, col. 7, ll. 50-51. Further, Reese asserts that a "silent interval" was known in the art and points to the reference in the '150 Patent that characterizes prior art U.S. Patent No. 4,582,956 as displaying "service information during a silent interval." Id. discussing '150 Patent at col. 2, ll. 15-16. At the claim construction hearing, Reese agreed that the parties' definitions are essentially the same except for the frequency based limitation and "if the Defendants' definition stopped after call waiting tone signal there and before the 'during which the DN,' we would be happy with that definition because it's the same." Dkt. No. 92 at 20-21.

(2) Construction

The Court finds that the Defendants point to the sentence of primary dispute without reading that sentence in the full context the Amendment in question. The Defendants attempt to distinguish the other portions of the Amendment cited by Reese (portions both before and after the disputed sentence) as being related to the adequacy of the disclosure. The Court however finds that the passages cited by the Defendants are a continuation of the same general argument being asserted by Reese. The entire context of the prosecution history statements must be evaluated to determine if a clear and unambiguous disclaimer has been made. *See* Seachange Int'l, Inc. v. C-COR, Inc., 413 F.3d 1361, 1372 (Fed.Cir.2005) ("[In determining] whether the patentee disclaimed or disavowed subject matter ... we examine the entire prosecution history, which includes amendments to claims and all arguments to overcome and distinguish references."). Moreover, immediately before the disputed sentence the November 14, 1994 Amendment reads:

Existing Caller ID art teaches the general scheme of retrieving the CN stored in digital format and generating a serial transmission of said CN by FSK technology during an interval following a ringing signal. The current art transmits FSK data within the Voice Band (1200-2400 Hz). The art teaches the use of the full 10 Hz-100 KHz bandpass of the local customer line, the voice channel.

Following the transmission of a standard Call Waiting alert signal, which is heard by the called party only (as is current standard), the CN data is then forwarded by an FSK message transmitted on some frequencies above the Voice Band but within the Voice Channel. The mark and space frequencies of the FSK signal are to be above 4000 Hz. Use of 20 and 22 KHz is assumed for this new art. Any frequency above 4000 Hz will not be easily heard in the local apparatus headset and 20-22 KHz is beyond normal human hearing.

Dkt. No. 72, Ex. K at 12 (Nov. 14, 1994 Amendment). The Amendment earlier defines voice band "to mean the existing band of from 300-3300Hz." *Id.* at 10. When the Amendment is viewed in its entirety, the 20-22 KHz limitation is more properly viewed as one example. The same amendment makes clear the use of

frequencies above 4000 Hz FN5 and the use of other ranges such as 10-30 KHz FN6. Furthermore, Mr. Dodd's October 2, 1994 Statement also provides as follows:

FN5. "... Caller ID is mixed with Call Waiting and 20-22 KHz or other frequencies above 4000 Hz are used to provide silent or near silent transmission of CN data." Dkt. No. 72, Ex. K at 13.

FN6. "The signaling in the system of the invention could be of a wider scope than any of the above, i.e., DTMF at 10-30 KHz instead of the 300-1000 Hz range in common use." *Id*.

TWO MAJOR CONCEPTS-MIXING CALLER ID WITH CALL WAITING AND THE USE OF 20/22 KHz or other frequencies above 4000 Hz to provide silent or near silent transmission of the CN data. Dkt. No. 72, Ex. M at 10. In the context of the entire Amendment the Court does not find a clear disclaimer limiting transmission of frequencies to 20-22 KHz.

However, the Court finds that the Amendment does provide guidance as to the meaning of these terms. As provided above, the Amendment includes the statement that "the CN data is then forwarded by an FSK message transmitted on some frequencies above the Voice Band but within the Voice Channel. The mark and space frequencies of the FSK signal are to be above 4000 Hz." Dkt. No. 72, Ex. K at 12. Further, the passage includes "any frequency above 4000 Hz will not be easily heard in the local apparatus headset." *Id*. Similarly, the Amendment states "other frequencies above 4000 Hz are used to provide silent or near silent transmission of CN data." *Id*. at 13. These passages also conform to Mr. Dodds' October 2, 1994 Statement. *See* Dkt. No. 72, Ex. M at 10. In the context of the overall prosecution history, it is clear that Reese did construe the transmission during the silent interval to be at frequencies above 4000 Hz. All of the examples provided in the Amendment are above 4000 Hz. Moreover, 4000 Hz was cited as being the frequency above which signals "will not be easily heard." In the context of the Amendment as a whole the Court construes the terms to include frequencies above 4000 Hz.

The Court notes that Claims 18 and 25 do not include the term "silent interval." *See* '150 Patent, Claims 18 & 25. For those claims, the term "silent interval" is provided in claims 21 and 28, which are dependent on claims 18 and 25. Id. at Claims 21 & 28. Reese does not make the argument that any frequency limitation should only be applied to claims 1, 7, and 13. However, even if Reese had argued that the scope of the term "transmitting the third party/said DN" in the independent claims 18 and 25 should be broader than the dependent claims that state "transmits the third party DN/said DN of the third party is transmitted ... during a ... silent interval" pursuant to the doctrine of claim differentiation, the Court finds that the doctrine should not apply in this case. *See* Philips v. AWH Corp., 415 F.3d at 1315; Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 910 (Fed.Cir.2004) ("the presence of a dependent claim that adds a particular limitation raises a presumption that the limitation in question is not found in the independent claim."). "[T]he presumption created by the doctrine of claim differentiation is 'not a hard and fast rule and will be overcome by a contrary construction dictated by the written description or prosecution history." Regents of University of Cal. v. Dakocytomation Cal., Inc., 517 F.3d 1364, 1375 (Fed.Cir.2008) *quoting* Seachange Int'l, Inc. v. C-COR, Inc., 413 F.3d at 1369. "[T]he doctrine of claim differentiation can not broaden claims beyond their correct scope, determined in light of the specification and the prosecution history and any relevant extrinsic evidence.... [C]laims that are written in different words may ultimately cover substantially the same subject matter." Seachange Int'l, Inc. v. C-COR, Inc., 413 F.3d at 1369 *quoting* Multiform Desiccants, Inc. v. Medzam, Ltd. ., 133 F.3d 1473, 1480 (Fed.Cir.1998). In the present case, the specification and the prosecution history clearly indicate that the DN is only transmitted during the silent interval. *See* '150 Patent

at 1:36-40 ("This invention also relates to a method for sending a directory telephone number ... during a silent interval ...."); *Id*. at col. 2, l. 66 to col. 3, l. 3 & col. 3, ll. 56-58 & col. 6, ll. 11-17; Dkt. No. 72, Ex. K at 11-12; *Id*., Ex. M at 10. Thus, the Court construes the term "transmitting said DN" and "transmitting the third party DM" consistently throughout claims 1, 7, 13, 18, and 25.

With regard to the end portion of the Defendants' construction of "transmitting," the Court finds that the earlier portions of each claim already indicates that the DN is "flagged as public." Even the Defendants acknowledge that the "this is clear from the claims themselves." Dkt. No. 72 at 21. As the claim language is already clear on this point, the Court does not find a need to restate this language to the jury in the "transmitting" construction.

As for the term "silent interval," the parties agree to the first portion of the Defendants' construction for "silent interval," as stated above. For the reasons explained above, the Court construes the latter portion to conform to the construction of the transmitting terms.

The Court construes "transmitting said DN" and "transmitting the third party DN" as "sending the 'DN', as a signal with a frequency above 4000 Hz." The Court construes "silent interval" as "the time, either between the ringing signals or following the 'call-waiting (CW) tone signal', during which 'DN' information is sent at a frequency above 4000 Hz."

V. CONCLUSION

Accordingly, the Court hereby **ORDERS** the claim terms construed in accordance herewith.

E.D.Tex.,2008.
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