

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

CERTAIN WIRELESS HEADSETS

Inv. No. 337-TA-943

ORDER NO. 17: INITIAL DETERMINATION GRANTING RESPONDENTS' MOTION FOR SUMMARY DETERMINATION THAT THE ASSERTED CLAIMS ARE INVALID BECAUSE THE CLAIM TERM "VIRTUALLY FREE FROM INTERFERENCE" IS INDEFINITE

(September 21, 2015)

I. INTRODUCTION

On August 10, 2015, Respondents Sony Corporation; Sony Corporation of America; Sony Electronics Inc.; BlueAnt Wireless Pty, Ltd.; BlueAnt Wireless, Inc.; Creative Technology Ltd.; Creative Labs, Inc.; and GN Netcom A/S (collectively, "Respondents") submitted a *Motion for Summary Determination* (Motion Docket No. 943-015) ("*Motion*") that asserted claim 8 of U.S. Patent No. 7,865,258 ("the '258 Patent") and asserted claims 1, 3-6, and 10 of U.S. Patent No. 8,131,391 ("the '391 Patent") (collectively, "the Asserted Claims") are invalid under 35 U.S.C. § 112, ¶ 2. Respondents simultaneously submitted a *Memorandum* and a proposed *Statement of Material Facts (SMF)* in support of their *Motion*.¹

On August 20, 2015, The Office of Unfair Import Investigations ("the Staff") submitted a *Response to Respondents' Motion (Staff Response)*, in which the Staff supported the *Motion*.² Also on August 20, 2015, Complainant One-E-Way, Inc. (One-E-Way or Complainant) filed an

¹ In all, Respondents' *Motion*, *Memorandum*, and *SMF* totaled approximately 29 pages of text, not including supporting exhibits.

² Approximately 17 pages of text.

Opposition to Respondents' August 10, 2015 *Motion*, which consisted of a Memorandum and Responses to Respondents' *SMF* (generally referred to as Complainant's *Opposition*), as well as supporting exhibits.³

On August 27, 2015, Respondents moved for leave to file a reply to Complainant's *Opposition* and simultaneously provided a brief *Reply*.⁴ On August 27, 2015, I issued Order No. 16 in which I: (1) granted Respondents' Motion for Leave; (2) permitted the Staff to reply if it desired; (3) and stated that no other responsive briefing to the motion for summary determination would be permitted.

II. RELEVANT BACKGROUND OF THE INVESTIGATION

The International Trade Commission instituted this investigation on January 13, 2015, based on a complaint filed on behalf of One-E-Way, Inc. 80 Fed. Reg. 1663 (Jan. 13, 2015). The complaint alleges violations of Section 337 in the importation into the United States, sale for importation, and sale within the United States after importation of certain wireless headsets by reason of infringement of the Asserted Claims of the Asserted Patents.⁵

A *Markman* hearing was scheduled for May 26-27, 2015. *See* Order No. 5, Appendix A (Feb. 9, 2015). Pursuant to the Joint Proposed Procedural Schedule filed March 3, 2015 (*see* Case Management Statements, Appendix 1), the parties exchanged: (i) on March 13, 2015, their lists of proposed terms for construction, as required by Ground Rule 8.1; and (ii) on March 27, 2015 and April 14, 2015, their preliminary constructions for those terms, as required by Ground

³ Approximately 73 pages of text (including a Motion for Oral Argument), not including supporting exhibits.

⁴ Approximately eight pages of text.

⁵ Complainant originally also asserted infringement of claims 3, 4, 10, and 11 of the '258 Patent and claim 2 of the '391 Patent, but subsequently filed motions to terminate the investigation with respect to these claims, which were granted by the ALJ. *See* Order No. 9 (May 4, 2015) and Order No. 15 (August 7, 2015).

Rule 8.2. After discussing the preliminary constructions in an effort to narrow their disputes over these claim terms, the parties filed: (i) on April 21, 2015, a Joint Claim Construction Chart; and (ii) on May 21, 2015, an Amended Joint Claim Construction Chart.

In preparation for the *Markman* hearing, (i) Complainant filed, on April 28, 2015, its Initial Claim Construction Brief (“CMIB”) (EDIS Document ID: 556018) including, *inter alia*, a supporting Declaration of Joseph C. McAlexander (“McAlexander Decl.”); (ii) Respondents also filed, on April 28, 2015, their Opening Claim Construction Brief (“RMIB”) (EDIS Document ID: 556123) including, *inter alia*, a supporting Declaration of Robert Akl (“Akl Decl.”); and (iii) the Staff filed, on May 5, 2015, its Initial Claim Construction Brief (“SMIB”) (EDIS Document ID: 556484).

On May 12, 2015, (i) Complainant filed its Reply Claim Construction Brief (“CMRB”) (EDIS Document ID: 556967), including, *inter alia*, a supporting Supplemental Declaration of Joseph C. McAlexander (“McAlexander Supp. Decl.”); (ii) Respondents filed their Reply Brief on Claim Construction (“RMRB”) (EDIS Document ID: 556979); and (iii) the Staff filed its Reply Claim Construction Brief (“SMRB”) (EDIS Document ID: 556969).

On May 26-27, 2015, I held a technology tutorial and *Markman* hearing. After the *Markman* hearing, and at the request of the undersigned, (i) Complainant and Respondents filed respectively, on June 3, 2015, a bullet-point summary of their claim construction arguments (“CBPS”) (EDIS Document ID: 558201) and “RBPS” (EDIS Document ID: 558209)); and (ii) the Staff filed, on June 5, 2015, a bullet-point summary of its claim construction arguments (“SBPS”) (EDIS Document ID: 558367).

On July 24, 2015, I issued Order No. 12, construing certain claim terms of the Asserted Patents and found the claim limitation “virtually free from interference” to be “indefinite because

one of ordinary skill in the art [of the Asserted Patents] would be unable to discern with reasonable certainty the limitation's metes and bounds." (See Order No. 12 at 28.)

III. SUMMARY OF DECISION

The facts underlying Respondents' *Motion* are not complicated. Rather, what is complicated is the morass Complainant created with its *Opposition*. Instead of responding to the substance of Order No. 12 and to Respondents' succinct *Memoranda* and *SMF*, Complainant based its *Opposition* upon irrelevant extrinsic evidence offered to manufacture a genuine issue of material fact where none existed. Moreover, Complainant seeks to usurp the construction responsibilities of the undersigned by having an expert construe claim language rather than testify about what is known to a person having ordinary skill in the art (PHOSITA).

It is important to emphasize that the question of indefiniteness under 35 U.S.C. § 112, ¶ 2 for the term "virtually free from interference," as it applies to the Asserted Claims, was thoroughly developed before (in the various briefs) and during the May 26-27, 2015 *Markman* Hearing in this investigation, as discussed at length in Order No. 12, at pages 1-2 and 19-28. To the best of my understanding, no party has raised any substantive matter that I did not consider when issuing Order No. 12 in which I found the term at issue indefinite. Moreover, the core of Complainant's *Opposition* remains the same, which is that the prosecution history of U.S. Patent No. 7,684,885 ("the '885 Patent") justifies its construction. I note that Order No. 12 dealt decisively with this issue as follows (footnote omitted):

According to Complainant, the "prosecution history evidence ... provides a meaningful benchmark standard for determining when a wireless audio transmission is 'virtually free from interference.'" (CMRB at 11-12.) Complainant does not rely on the prosecution history of the asserted patents, but the prosecution history of the parent '885 [sic] patent. Complainant must go back to the prosecution of the '885 [sic] patent and a single statement made by the applicant to find a guidepost one of ordinary skill in the art can allegedly follow to discern the scope of the limitation "virtually free from interference."

Specifically, during prosecution of the '885 patent, the applicant explained that "Lavalley does not teach, disclose or suggest such a relationship where *interference is virtually eliminated (e.g. where eavesdropping cannot occur)*. (CMIB, Ex. 18 ('885 Patent File History, June 16, 2009 Response) at p. 3 (emphasis added).) According to Complainant, this passage "reinforces that, to reproduce audio 'virtually free from interference from device transmitted signals operating in [a particular] spectrum,' a system must reproduce audio sufficiently free from interference from such signals that eavesdropping on those signals cannot occur." (See CMIB at 38-39.) I disagree.

The statement on which Complainant relies was given in response to the patent examiner's rejection of certain claims in the '885 [sic] patent that do not include the limitation in question "virtually free from interference," but rather the limitation "free from interference." (RMIB, Ex. 39 ('885 Patent File History, June 8, 2009 Response, Amended Claims) at 5-7.) Thus, when the applicant's statement from the prosecution history is read in the context for which it was given, I find it impossible to agree with Complainant that one of ordinary skill in art would conclude that the applicant was providing guidance as to the meaning and scope of a different limitation (*i.e.*, "virtually free from interference") from different claims.

35 U.S.C. § 112, ¶ 2 requires that the specification of a patent "conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Because claims delineate the patentee's right to exclude, the patent statute requires that the scope of the claims be sufficiently definite to inform the public of the bounds of the protected invention, *i.e.*, what subject matter is covered by the exclusive rights of the patent. Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims.

Halliburton Energy Services, Inc. v. M-I LLC, 514 F.3d 1244, 1249 (Fed. Cir. 2008). To accept Complainant's argument would be to require a level of clairvoyance by one of ordinary skill in the art that would undermine the public notice function of patents.

In any event, Complainant's argument leads to a claim construction that is untenable. Under Complainant's proposed construction the limitation "virtually free from interference" means "free from interference such that eavesdropping on device transmitted signals operating in the [portable wireless digital audio system / wireless headphone / wireless digital audio system / digital wireless audio receiver] spectrum cannot occur." If, however, "virtually free from interference" means *no eavesdropping*, as Complainant argues, then the limitation "free from interference" has no meaning because "no eavesdropping" already represents the maximum amount of eavesdropping that can be prevented.

Complainant argues that tying its proposed construction of “virtually free from interference” to “no eavesdropping” addresses the concern about the difference between “virtually free from interference” and “free from interference,” because avoiding eavesdropping indicates being “virtually free from interference,” not necessarily completely “free from interference.” I disagree. Complainant constructs this argument from whole cloth. There is no intrinsic evidence to suggest that the phrases “virtually free from interference” and “free from interference” are meant to be of differing scope, rather than differing degree. In fact, the parent ‘885 [sic] patent has claims that include the limitation “free from interference from ... device transmitted signals operating in the wireless digital audio system spectrum” demonstrating that the scope of the interference that the applicant was trying to eliminate (*i.e.*, “free from interference”) in the ‘885 [sic] patent or virtually eliminate (*i.e.*, “virtually free from interference”) in the asserted patents is the same—“device transmitted signals operating in the wireless digital audio system spectrum.” (*See* ‘885 [sic] Patent, claims 17, 19, 20.) Therefore, the difference between the limitations “free from interference” and “virtually free from interference” must be one of degree and not of scope as Complainant argues. Thus, I find Complainant’s argument not persuasive.

(*See* Order No. 12 at 25-28.)

While I acknowledge that Complainant argued extensively on this matter in its *Opposition*, I also note its arguments were succinctly disposed of by Respondents and the Staff in their filings. In addition, I note that Complainant attempted to support its arguments with extrinsic evidence consisting of improper legal analysis by experts rather than permissible testimony of how a PHOSITA would interpret the term “virtually free from interference” in the Asserted Claims. This is unhelpful and irrelevant, for as the Court of Appeals has stated, “[n]one of the experts identified a particular meaning in the art, and an expert’s subjective understanding of a patent term is irrelevant.” *General Protecht Group, Inc., v. Int’l Trade Comm’n*, 619 F.3d 1303,1310-1311 (Fed Cir. 2010).

Complainant’s overly long and largely irrelevant *Opposition* is off target. Complainant fails to comprehend that Respondents’ succinct findings of fact, which are effectively undisputed, constitute the relevant facts to the term at issue, not the subjective and thus irrelevant

meanderings of its expert concerning his interpretation of the intrinsic evidence (including the prosecution history) presented for the first time after the *Markman* hearing. Moreover, Complainant fails to comprehend, that even after *Teva* (i.e., *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015)), interpretation of intrinsic evidence remains a matter of law and is not a matter for experts.

Construing the term “virtually free from interference” and thus determining whether the term is indefinite in this investigation should be a logical exercise. First, there is no doubt the word “virtually” is one of degree. Second the term “virtually free from interference” is not defined or described in the specifications underlying the Asserted Claims (no metes and bounds or measurable standard). Third, the term coexists in the Asserted Claims with the term “free from interference.” Fourth, there is no objective and thus relevant testimony establishing the term has any meaning to a PHOSITA, unless I were to erroneously give credit to the improper interpretation of intrinsic evidence by Complainant’s expert, which is forbidden by applicable precedent. Fifth, there is no explanation applicable to the term in the history of the patent or any of the related patents. Thus, since the term “virtually free from interference” is: (1) not defined; (2) has no specific meaning to a PHOSITA; (3) cannot mean “free from interference”; and (4) requires metes and bounds --which are conspicuously missing, the language is indefinite.⁶

⁶ In addition to the analysis provided in the present Order, Order No. 12 is incorporated herein in its entirety.

IV. APPLICABLE LAW

A. Summary Determination

Commission Rule 210.18 provides that “[a]ny party may move ... for a summary determination in its favor upon all or any part of the issues to be determined in the investigation.” 19 C.F.R. § 210.18(a). Summary determination “shall be rendered if pleadings and any depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to summary determination as a matter of law.” 19 C.F.R. § 210.18(b).

In evaluating a motion for Summary Determination I must evaluate the evidence “in the light most favorable to the party opposing the motion. *See, e.g., Certain Personal Computers and Digital Display Devices*, Inv. No. 337-TA-606, Order No. 20 (Jan. 11, 2008) (“*Personal Computers*”). Nevertheless, the non-moving party “has the burden to submit more than averments in pleadings or allegations in legal memoranda. Mere denials or conclusory statements are insufficient.” *Certain Magnetic Response Injection Systems and Components Thereof*, Inv. No. 337-TA-434, Order No. 16 at 3 (Sept. 26, 2000) (citations omitted). This means the “[the non-moving party] must do more than simply show there is some metaphysical doubt as to the material facts” to avoid summary determination. *Electronic Devices*, Order No. 58 at 4, 13, 15 (quoting *Matsushita Elec. Indus. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986)); accord *Certain Electronic Devices with Image Processing Systems, Components Thereof, and Associated Software*, Inv. No. 337-TA-724, Order No. 29 at 3, 16-17 (Mar. 11, 2011) (non-reviewed) (“*Electronic Devices with Image Processing Systems*”).

B. Indefiniteness

35 U.S.C. § 112, ¶ 2, requires a patent to conclude with one or more claims particularly

pointing out and distinctly claiming the subject matter which the applicant regards as the invention. A patent claim fails to satisfy 35 U.S.C. § 112, ¶ 2's requirement, *i.e.*, it is invalid for indefiniteness, if its language, when read in light of the patent specification and the prosecution history, fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention. *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1379 (Fed. Cir. 2015) (*Nautilus*). See also *Dow Chemical Corp. v. Nova Chemicals Corp.*, --- F.3d ---, 2015 WL 5060947, *9-*10 (Fed. Cir. Aug. 28, 2015) (for the most recent application of *Nautilus*). General principles of claim construction apply in making this determination. See *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332 (Fed. Cir. 2010).

The other aspect of establishing indefiniteness is that Respondent must prove it because it is an affirmative defense. 35 U.S.C. § 282(b)(3)(A). Here, the Asserted Patents are presumed valid, and Respondents bear the burden of establishing indefiniteness. See 35 U.S.C. § 282(a) (2012). Further, like anytime invalidity is asserted, the party challenging validity must establish any facts showing indefiniteness by clear and convincing evidence. See *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. ---, 131 S. Ct. 2238, 2242 (2011); *Warsaw Orthopedic, Inc. v. NuVasive, Inc.*, 778 F.3d 1365, 1371 (Fed. Cir. 2015). "Clear and convincing evidence places in the fact finder 'an abiding conviction that the truth of [the] factual contentions are highly probable.'" *Procter & Gamble Co. v. Teva Pharm. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009).

C. Claim Construction

Claim construction is a matter of law. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). The claim language defines the scope of the claims. See *Catalina Marketing Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 807 (Fed. Cir. 2002). Proper construction of the claims is done from the perspective of a person

of ordinary skill in the field of the invention, who is deemed to read the words in the patent with an understanding of their meaning in the field, and to have knowledge of any special usage of the words in the field. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*).

When construing a claim, there are three sources of evidence that must be considered: (i) the patent claims, (ii) the patent specification, and (iii) the prosecution history. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Such intrinsic evidence is the most significant source of the legally operative meaning of the claim language in dispute. *See Bell Atl. Network Servs., Inc. v. Covad Commc'ns Grp., Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001).

Words in a patent claim are generally presumed to carry their ordinary meaning to one of ordinary skill in the art. *See CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). The same term must be construed consistently where it appears in claims of common ancestry. *See Epcon Gas Sys. v. Bauer Compressors*, 279 F.3d 1022, 1030 (Fed. Cir. 2002). Additionally, every claim term is presumed to have meaning, and any construction that renders a claim term superfluous is discouraged. *See Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004). Also, any differences among the claims can be useful in understanding the meaning of claim terms. *See Phillips*, 415 F.3d at 1314-15.

Claims are also to be read in view of the patent specification. *See Markman*, 52 F.3d at 979. The patent specification may act as a dictionary, explaining the invention and defining terms used in the claims. If a patentee acts as his or her own lexicographer, any special definition given to a word must be clear in the patent specification. *See Vitronics*, 90 F.3d at 1582-83. The claims, however, and not the written description part of the patent specification, delimit the right to exclude others from making, using, selling or importing the claimed

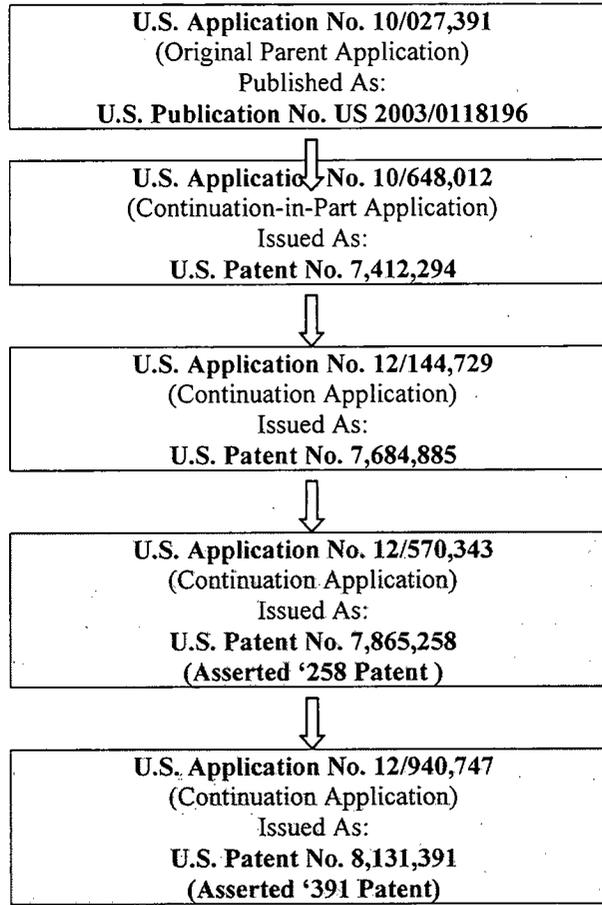
invention. *See Markman*, 52 F.3d at 979. Thus, it is not proper to import limitations from the patent specification into the claims. *See Varco, L.P. v. Pason Sys. Corp.*, 436 F.3d 1368, 1373 (Fed. Cir. 2006). A party wishing to use a statement appearing in the specification to confine or otherwise affect a patent's scope must, at the very least, point to a term (or terms) in the patent claim with which to draw in those statements. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1310 (Fed. Cir. 2005). In other words, there must be a textual reference in the language of the patent claim with which to associate a proffered claim construction. *See id.*

Finally, claims are to be read in view of the prosecution history, which “provides evidence of how the PTO and the inventor understood the patent.” *Phillips*, 415 F.3d at 1317. As such, the prosecution history “may inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Id.* A prosecution disclaimer only occurs if there has been a clear and deliberate disavowal. *See Purdue Pharma L.P. v. Endo Pharms., Inc.*, 438 F.3d 1123, 1136 (Fed. Cir. 2006).

In addition to the intrinsic evidence, extrinsic evidence may also be considered, if needed, to assist in determining the meaning of terms in patent claims and determining how a person of ordinary skill in the art would understand terms in patent claims. *See Phillips*, 415 F.3d at 1317. Also, expert testimony may be useful to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of technical aspects of the patent is consistent with that of a person of ordinary skill in the art, or to establish that a term in the patent has a particular meaning in the pertinent field. *See Phillips*, 415 F.3d at 1318. However, expert testimony that is at odds with the intrinsic evidence must be disregarded. *See Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353, 1361 (Fed. Cir. 2005).

V. OVERVIEW OF THE ASSERTED PATENTS

The Asserted Patents descend from a series of related patent applications, as shown below:



Memorandum, Ex. A ('258 Patent), cover page; Ex. B ('391 Patent), cover page.

As displayed on their face, the Asserted Patents are based on a *continuation application* claiming the benefit of U.S. Patent Application No. 12,144,729 ("the '729 Application"), which issued as U.S. Patent No. 7,684,885 ("the '885 Patent") and is itself a *continuation application* claiming the benefit of U.S. Patent Application No. 10/648,012 ("the '012 Application"), which issued as U.S. Patent No. 7,412,294 ("the '294 Patent") and is, in turn, a *continuation-in-part application* claiming the benefit of the original parent application -- U.S. Patent Application No.

10/027,391 (“the ‘391 Application”) -- abandoned and published as U.S. Patent Application Publication No. 2003/0118196 (“the ‘196 Publication”). See *Memorandum*, Ex. A (‘258 Patent), cover page; Ex. B (‘391 Patent), cover page. Thus, the claims, the specifications, and the prosecution histories of all of the above related patent applications are pertinent to the issue of claim construction in this investigation. See *Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed. Cir. 2003).

The Asserted Patents share the same specification, which generally disclose, *inter alia*, a digital audio transmitter operatively coupled to an audio source and a digital audio receiver operatively coupled to a headphone set, the audio transmitter and the audio receiver being configured for digital wireless communication. *Memorandum*, Ex. A (‘258 Patent), Abstract; Ex. B (‘391 Patent), Abstract. Additionally, the specification further discloses, *inter alia*, that the digital wireless communication involves the coded transmission of the audio signal, which provides for private listening without interference from other users of wireless devices occupying the same space. *Memorandum*, Ex. A (‘258 Patent), Figs. 1-3, “Summary of the Invention”; Ex. B (‘391 Patent), Figs. 1-3, “Summary of the Invention.”

VI. The Terms at Issue

The claim term “virtually free from interference” appears in all of the Asserted Claims of the Asserted Patents, including illustrative independent claim 1 of the ‘391 Patent and independent claim 8 of the ‘258 Patent, which are reproduced below, with the claim term (and the related claim phrase containing the claim term) highlighted.

1. A wireless digital audio headphone comprising:

a portable digital audio headphone receiver configured to receive a unique user code bit sequence and a original audio signal representation in the form of packets, said digital audio headphone receiver capable of mobile operation and

configured for direct digital wireless spread spectrum communication with a mobile digital audio transmitter;

a direct conversion module configured to capture packets and the correct bit sequence within the packets aided by lowering signal detection error through reduced intersymbol interference coding of said audio representation signal respective to said headphone receiver and said mobile digital audio transmitter, said packets embedded in the received spread spectrum signal, the captured packets corresponding to the unique user code bit sequence;

a digital demodulator configured for independent CDMA communication operation;

a decoder operative to decode reduced intersymbol interference coding of original audio signal representation;

a digital-to-analog converter (DAC) generating an audio output of said original audio signal representation; and

a module adapted to reproduce said generated audio output in response to the unique user code bit sequence being recognized, said audio having been wirelessly transmitted and reproduced *virtually free from interference from device transmitted signals operating in the wireless headphone spectrum.*

* * * * *

8. A portable wireless digital audio system for digital transmission of an original audio signal representation from a portable audio source to a digital audio headphone, said portable wireless digital audio system comprising:

a portable digital audio transmitter configured to couple to said portable audio source and transmitting a unique user code bit sequence with said original audio signal representation in packet format, said digital audio transmitter comprising:

an encoder operative to encode said original audio signal representation to reduce intersymbol interference; and

a digital modulator configured for independent code division multiple access (CDMA) communication operation; and said portable audio digital transmitter configured for direct digital wireless communication with said digital audio headphone, said digital audio headphone comprising:

a direct conversion module configured to capture packets embedded in the received spread spectrum signal, the captured packets corresponding to the unique user code bit sequence;

a digital demodulator configured for independent CDMA communication operation;

a decoder operative to decode the applied reduced intersymbol interference coding of said original audio signal representation;

a digital-to-analog converter (DAC) generating an audio output of said original audio signal representation; and

a module adapted to reproduce said generated audio output, said audio having been wirelessly transmitted from said portable audio source *virtually free from interference from device transmitted signals operating in the portable wireless digital audio system spectrum.*

Memorandum, Ex. B ('391 Patent), 4:49-5:12; Ex. A ('258 Patent), 5:60-6:35 (emphasis added).

The parties' positions on the meaning, if any, of the claim term "virtually free from interference" (and the related claim phrases containing the claim term), discussed in briefing before and presented in arguments at the *Markman* hearing, are as follows:

"virtually free from interference" ("virtually free from interference from device transmitted signals operating in the [portable wireless digital audio system / wireless headphone / wireless digital audio system / digital wireless audio receiver] spectrum")		
Complainant's Proposed Construction	Respondents' Position	Staff's Position
One-E-Way proposes that this term should be construed in the context of the larger claim phrases in which it appears in the asserted patent claims, which are addressed below. "free from interference such that eavesdropping on device transmitted signals operating in the [portable wireless digital audio system / wireless headphone / wireless digital audio system / digital wireless audio receiver] spectrum cannot occur"	Indefinite.	Absent any opinion(s) provided by one of ordinary skill in the art on the meaning of this claim term, specifically with regard to the words "virtually free," and therefore the scope of the invention, the Staff is of the view that this claim term is indefinite under 35 U.S.C. § 112.

VII. PARTY CONTENTIONS

A. Respondents' Motion and Contentions

Respondents begin the substantive arguments underlying the *Memorandum* supporting their *Motion* by asserting that because of the presence of the term “virtually free from interference,” which is indefinite, all of the Asserted Claims are invalid. (*Memorandum* at 6.) Respondents rely on the *Markman* Hearing of May 26-27, 2015, the extensive briefing before and after the hearing, the evidence, and argument that occurred in connection with that hearing. (*Id.*) Next, Respondents explain that, as a result of Order No. 12 finding the term “virtually free from interference” as indefinite, all of the Asserted Claims (which contain the term, *see SMF ¶5*) are invalid. (*Memorandum* at 6.)

1. The Word “Virtually”

Respondents contend the Asserted Claims are indefinite because they all include the phrase “*virtually* free from interference.”⁷ (*Id.*) As I found in Order No. 12 (at 23-24), the term “virtually free from interference” is meaningfully different from “free from interference,” and the word “virtually” must be given effect. *See, e.g., Merck & Co. v. Teva Pharm. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (“A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so.”); *Pause Tech., LLC v. TiVo Inc.*, 419 F.3d 1326, 1334 (Fed. Cir. 2005) (“In construing claims . . . we must give each claim term the respect that it is due.”).

Respondents assert even the patentee recognized this distinction. Noting that in the '885 patent, of which the Asserted Patents are continuations (*see SMF ¶¶ 2-3*), the inventor sought

⁷ Respondents also maintain the Asserted Claims are indefinite for additional reasons unrelated to the claim term “virtually free from interference” and Respondents have reserved the right to present evidence and arguments to that effect at any evidentiary hearing in this Investigation.

claims reciting “virtually free from interference,” claims reciting “free from interference” (without the “virtually” qualifier), and claims reciting *both* “free from interference,” and “virtually free from interference” (*i.e.*, within the same claim). (See *Memorandum* at 7 (citing *SMF* ¶¶ 8-11).) Specifically, Respondents point out that Claims 11, 12, and 16 of the ’885 patent respectively recite that:

the transmitted audio signal is reproduced, providing a user of said portable transmitter and said audio receiver with private audio reproduction of said audio signal provided by said audio source ***free from interference*** when operated in a shared space containing at least one other user of wireless devices utilizing code division multiple access (CDMA) communication and utilizing an independent portable transmitter and audio receiver [(Claim 11)];

the transmitted audio signal is reproduced, providing a user of said portable transmitter and said audio receiver with private audio reproduction of said audio signal provided by said audio source ***virtually free from interference*** when operated in a shared space containing at least one other user of wireless devices utilizing code division multiple access (CDMA) communication and utilizing an independent portable transmitter and audio receiver in a shared space [(Claim 12)]; and

the transmitted audio signal is reproduced, providing a user of said portable transmitter and said audio receiver with private audio reproduction of said audio signal ***virtually free from interference*** when operated in a shared space containing at least one other user of a wireless device utilizing an independent portable transmitter and audio receiver; and listening to said audio output ***free from interference*** from at least one other user of a wireless devices in a shared space [(Claim 16)].

(See *SMF* ¶¶ 9-11 (emphasis added).)

Based upon this choice of words, Respondents contend the two phrases must have different meanings. (*Memorandum* at 8.) Respondents also allege that the evidence makes it clear that the word “virtually” is a term that alters the degree, rather than the scope, of the term “free from interference.” (*Id.* (citing Order No. 12 at 27-28).) Therefore, Respondents offer that

the Asserted Claims permit *some degree* of interference but the amount of permitted interference is unclear. (*Id.*)

2. “Virtually Free From Interference” Has No Specific Meaning

Respondents claim it is undisputed that standing alone the phrase “virtually free from interference” does not have a specific meaning capable of informing a PHOSITA as to any particular level of interference or as to how much interference is permitted. (*Id.*) Respondents assert that even though Complainant’s expert submitted two declarations during the claim construction briefing, in neither declaration did he opine that the phrase “virtually free from interference” by itself has a specific meaning to one of ordinary skill in the art. (*Id.* (citing *SMF* ¶¶ 26-27).) In addition, Respondents assert that Mr. McAlexander’s opinion that “virtually free from interference” has a meaning within the context of the Asserted Patents is contradicted by the intrinsic evidence and is incorrect. (*Id.*)

Respondents assert that, when a term lacks a specific meaning, the Federal Circuit instructs that the patent’s intrinsic evidence must be looked at for guidance. (*Id.* (citing *Interval Licensing*, 766 F.3d at 1371).) Respondents allege it is fruitless in this case because the written description of the Asserted Patents fails to provide sufficient information for a person having ordinary skill in the art to determine how much interference is permitted by the term “virtually free from interference.” (*Id.*) Respondents assert that nowhere in the specification of the Asserted Patents does the phrase “virtually free from interference” appear, nor is there any discussion of what the phrase means within the prosecution histories of the Asserted Patents. (*Id.* (citing *SMF* ¶¶ 14-15).)

Respondents explain that rather than describing the claimed invention as being “virtually free from interference,” the specifications use absolute terms. For example, the Asserted Patents

state that the invention “allows private audio enjoyment *without interference* from other users of independent wireless digital transmitters and receivers sharing the same space;” “provides private listening *without interference* from other users or wireless devices;” and allows a user “to listen (privately) to high fidelity audio music . . . *without interference* from any other receiver headphone 50 user,” in contrast to certain prior art which does not permit “private listening *without interference* where multiple users occupying the same space are operating wireless transmission devices.” (*Id.* at 8-9 (citing *Memorandum*, Ex. B, ’391 Patent at Abstract, 1:35-44, 2:1-3, 3:32-36; Ex. A, ’258 Patent at Abstract, 1:31-40, 1:64-66, 3:28-32; *SMF* ¶ 16) (emphasis added).) According to Respondents, such absolute statements can provide no guidance as to the metes and bounds of the term “*virtually free from interference.*” (*Id.* (citing Order No. 12 at 24-25).)

Respondents allege that during the claim construction proceedings, Complainant argued the statements in the patents provided “abundant guidance” and that, based upon them, “one of ordinary skill in the art would understand that users of the invention do not hear each other’s transmissions.” (*Id.* at 9 (citing Order No. 12 at 25).) Respondents argue Complainant is wrong because:

First, as the Administrative Law Judge found, the specifications only connect “private” listening with *absolute* freedom from interference (’258 Patent at 1:64-67 (“The wireless digital audio music system *provides private listening without interference from other users or wireless devices* and without the use of conventional cable connections” (emphasis added)); Ex. D, Order No. 12 at 25. Nowhere do the Asserted Patents describe “private listening” with respect to levels of interference other than zero. *SMF* ¶ 17. Second, as discussed above, “*virtually free from interference*” and “*free from interference*” must have different meanings. Thus, private listening without interference cannot correspond to “*virtually free from interference*” without destroying the distinction between “*virtually free from interference*” and “*free from interference.*” Finally, even if “private listening” were equated with “*virtually free from interference,*” “private listening” and “private audio enjoyment” are subjective terms: what constitutes “private listening” may differ from one person to another. They cannot provide

the objective guidance necessary to define the scope of “virtually free from interference” because it would merely replace one subjective term with another. *See, e.g., Datamize*, 417 F.3d at 1530-51 (“The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention.”).

(*Id.* at 9-10 (emphasis in original).)

3. Complainant’s Proposed Construction and the Intrinsic Evidence.

Respondents first note that Complainant has proposed that “virtually free from interference from device transmitted signals” should be construed to mean “free from interference such that eavesdropping on device transmitted signals . . . cannot occur.” (*Id.* at 10 (citing Order No. 12 at 19).) Nevertheless, as Respondents points out, the specifications of the Asserted Patents fail to mention “eavesdropping.” (*Id.* (citing *SMF* ¶ 18).) Further, while the prosecution history of either Asserted Patent does not include the word “eavesdropping,” Respondents note that Complainant bases its proposed construction from a single remark in the prosecution history of the parent ’885 Patent, *i.e.*, where the applicant distinguished the prior-art Lavelle reference by stating, “Lavelle does not teach, disclose or suggest such a relationship where interference is virtually eliminated (e.g., where eavesdropping cannot occur).” (*Id.* (citing *SMF* ¶ 23).)

Respondents contend the ’885 patent history’s reference to eavesdropping is insufficient to support Complainant’s construction. Respondents explain as follows:

First, the claims being discussed in this statement in the file history of the ’885 Patent did not include the term “virtually free from interference.” Instead, they recited “free from interference,” without the “virtually” qualifier or any other term of degree. Ex. H, June 2009 Amendment at 1EWAY00005557-59 (claims 24-27); *SMF* ¶¶ 23-25. Thus, as the Administrative Law Judge found (Ex. D, Order No. 12 at 25-27), they provide no insight to a person of ordinary skill in the art as to what “virtually free from interference” means when recited as a claim limitation. Permitting such an isolated statement, addressing a different claim limitation in a different application, to redefine the claim language would undermine the notice function of the claims.

Furthermore, the statement relied on by One-E-Way is phrased as an example (“e.g., where eavesdropping cannot occur”). Even if this was assumed to be referring to an example of being “virtually free from interference,” it would not give one of ordinary skill in the art any reasonable certainty as to the full scope of the claim because, by being stated as an example, it inherently implies that there are other ways in which the “virtually free from interference” limitation may be satisfied. The Federal Circuit has refused to treat a single “e.g.” phrase as definitional even when it appears in the patent specification itself. *Interval Licensing*, 766 F.3d at 1373-74 (“[W]e decline to cull out a single ‘e.g.’ phrase from a lengthy written description to serve as the exclusive definition of a facially subjective claim term.”). Here, the example relied upon by One-E-Way is even further removed in that it is not an example from the specification of the Asserted Patents but rather an example from an argument made during prosecution of a different patent involving claim language that does not even include the term of degree in question.

(*Id.* at 10-11.) Respondents also dispute the applicability of cases previously cited by Complainant to support its use of the “no eavesdropping” example to define a term of degree.

(*Id.* at 11.) Respondents explain that *Sinorgchem* was not about whether a claim term was indefinite but instead, involved a situation where an express definition of the term at issue was provided in the patent specification, along with examples that met that express definition. (*Id.*)

Respondents assert: “The issue before the Federal Circuit was whether the examples should be included in the construction along with the express definition from the specification; not whether the examples themselves were sufficient to make the claim term definite. (*Id.* at 11-12 (citing *Sinorgchem Co. v. Int’l Trade Comm’n*, 511 F.3d 1132, 1137 (Fed. Cir. 2007)).) Next,

Respondents explain that while *DDR Holdings* involved an indefiniteness issue, “[it] did not involve a term of degree, and its reference to examples being sufficient to define terms of degree cited to *Enzo Biochem, Inc. v. Applera Corp.*, an earlier Federal Circuit decision.” (*Id.* at 12 (citing *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245, 1260 (Fed. Cir. 2014).) Explaining *Enzo Biochem*, Respondents noted the patent itself provided multiple examples of permissible “linkage groups” and criteria for testing and selecting additional groups, neither of which is

present in the Asserted Patents. (*Id.* (citing *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1331-34 (Fed. Cir. 2010).) Next, Respondents distinguish *Apple*, where “the patent specification itself provided guidance in the form of a figure and accompanying description, illustrating a block of text that was ‘substantially centered.’” (*Id.* (citing *Apple Inc. v. Samsung Elecs. Co.*, 786 F.3d 983, 1002-03 (Fed. Cir. 2015)).) According to Respondents, none of these cases supports the proposition that a term of degree in one patent can be made definite by a single example from an argument made during prosecution of a different patent regarding claim language that does not even include the term of degree in question. (*Id.*)

Respondents continue by explaining how Complainant’s reliance on the ’885 patent prosecution history argument about “eavesdropping” is further undermined because it fails to account for devices that transmit non-audio signals. (*Id.*) Respondents explain that the Asserted Claims recite “interference from device transmitted signals operating in the [claimed device’s] spectrum” meaning, interference from *any* device operating in the same range of frequencies as the claimed invention. (*Id.*) Respondents aver the Asserted Patents describe that the claimed invention may operate in the 2.4 GHz Industrial, Scientific and Medical (“ISM”) band, a band admittedly used by a host of devices, such as microwave ovens and Wi-Fi networks (whose transmissions may include webpages, textual documents, images, etc.), that transmit non-audio signals. (*Id.* at 12-13 (citing *SMF ¶¶ 20-21*)). According to Respondents, Complainant’s proposed claim construction ignores these devices and their *non-audio* transmissions, on which “eavesdropping” using a wireless *audio* receiver is impossible. Respondents also postulate that, the claim language in the ’885 Patent at issue when the applicant made the “eavesdropping” argument to the examiner had just been amended to recite “free from interference from multiple CDMA wireless digital audio system transmitters operating in the wireless digital audio system

spectrum,” (*Id.* at 13n.6 (citing *SMF* ¶¶ 24-25).) According to Respondents, the type of interference addressed by the amended claims was limited to interference from other *audio* transmitters and thus “eavesdropping” on those signals was at least possible. (*Id.*)

Respondents assert that their point on the source of interference is further apparent from a prior definition of interference that the inventor provided during prosecution. (*Id.*) As Respondents explain that during prosecution of the '294 Patent (the Asserted Patents being continuations thereof, *see SMF* ¶¶ 2-3), the inventor stated “[i]t is well known by those skilled in the art that radio frequency (RF) interference originates from a source (i.e., transmitter) external to an RF signal path and produces undesired artifacts in the RF signal.” (*Memorandum* at 13 (citing *SMF* ¶ 22).) Respondents explain these “undesired artifacts” are not limited to eavesdropping on another audio signal, but would instead also include interference from non-audio sources. (*Id.*) Otherwise, Respondents argue it would be inconsistent with this prior representation to limit the “interference” of “virtually free from interference” solely to audio signals that can be eavesdropped upon. (*Id.*)

Respondents also argue Complainant’s proposed construction of “virtually free from interference” is inconsistent with the differences in the way the Asserted Claims recite the “virtually free from interference.” (*Id.*) Referencing Order No. 12, Respondents note that certain of the Asserted Claims recite “said audio having been *wirelessly transmitted and reproduced virtually free from interference* from device transmitted signals . . .” while other claims recite “said audio having been *wirelessly transmitted* from a portable audio player *virtually free from interference* from device transmitted signals . . .” (*Id.* at 13-14 (citing *SMF* ¶¶ 6-7) (emphasis in original).) Respondents contend that because a claim term must be interpreted consistently across the claims of a patent, Complainant’s construction must be appropriate both

in claims reciting “wirelessly *transmitted*” virtually free from interference, and in claims reciting “wirelessly . . . reproduced virtually free from interference.” (*Id.* at 14 (citing *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1334 (Fed. Cir. 2003)).) However, Respondents contend the “no eavesdropping” of Complainant’s construction relates to whether the user of the claimed device overhears someone else’s audio. (*Id.*) The problem there, according to Respondents, is that the potential for overhearing someone else’s audio (*i.e.*, eavesdropping on it) only occurs in connection with reproduction, not transmission. (*Id.* (emphasis in original).) Respondents argue this means for claims reciting transmission “virtually free from interference,” that Complainant’s construction provides no guidance as to whether the limitation is met. (*Id.* (emphasis in original).)

Respondents close their argument under this section by asserting that Complainant’s proposed claim construction is inconsistent with the purpose of the claimed invention. (*Id.*) Specifically, Respondents allege that under Complainant’s construction, “the claim limitation would be met even when the interference is so severe that a user does not hear his or her intended audio—because it would still be ‘virtually free from interference’ so long as the user did not hear *someone else’s* audio.” (*Id.* (emphasis in original).)

4. Construction of Intrinsic Evidence is a Question of Law

Respondents observe that Complainant relies heavily on its expert’s interpretation of the intrinsic evidence to support its proposed construction. (*Id.*) Nevertheless, Respondents reiterate the intrinsic evidence contradicts Complainant’s construction and that Complainant cannot use its expert’s opinion to override the legal meaning of the intrinsic evidence, citing the following excerpt from *Teva*, to wit:

A party cannot transform into a factual matter the internal coherence and context assessment of the patent simply by having an expert offer an opinion on it. The internal coherence and context assessment of the patent, and whether it conveys claim meaning with reasonable certainty, are questions of law. The meaning one of skill in the art would attribute to the [disputed claim term] in light of its use in the claims, the disclosure in the specification, and the discussion of this term in the prosecution history is a question of law.

(*Id.* at 14-15 (citing *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1342 (Fed. Cir. 2015)).) Respondents note that in *Teva*, the Federal Circuit found the claim indefinite because it was undisputed that the term at issue had no specific meaning to one of ordinary skill in the art and the intrinsic evidence did not indicate which of three possible measurement methods was to be used). (*Id.* at 14-15.) Respondents also point out that the Supreme Court explained in *Teva*: “[t]hat is because ‘[e]xperts may be examined to explain terms of art, and the state of the art, at any given time,’ but they cannot be used to prove ‘the proper or legal construction of any instrument of writing.’” (*Id.* at 15 (quoting *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 841 (2015)) (citations omitted).) Respondents maintain there is no dispute that the term “virtually free from interference” does not have a specific meaning to one of ordinary skill in the art as to how much interference is permitted and thus it becomes a legal question of evaluating the intrinsic evidence, whereupon Complainant’s expert cannot proffer an opinion that can transform that legal analysis into an issue of fact. (*Id.*)

5. Conclusion

Respondents conclude there is no evidence of (and Complainant's expert failed to opine that) the term "virtually free from interference" is a term of art that would have a particular meaning to a person of ordinary skill (absent opinions about the intrinsic evidence). (*Id.*) Moreover, Respondents note there is also no evidence that the inventor acted as his own lexicographer to define "virtually free from interference" to have a special meaning. Finally, Respondents assert that One-E-Way's proposed construction is contradicted by the intrinsic evidence. Thus, for reasons set forth in Order No. 12 and in the discussion above, Respondents contend the term "virtually free from interference" fails to inform, with reasonable certainty, those skilled in the art about the scope of the invention and thus does not comply with 35 U.S.C. § 112, ¶ 2, which makes the Asserted Claims invalid. (*Id.*)

B. The Commission Investigative Staff's Contentions

The Staff agrees with Respondents that the claim term "virtually free from interference" is indefinite and, therefore, contends that summary determination should be granted. (*Staff Response* at 11.)

1. Level of Ordinary Skill in the Art

The Staff remarks that as discussed in Order No. 12 (but not in Respondents' *Motion*), the parties proposed different levels of ordinary skill in the art of the Asserted Patents. (*Id.* at 12 (citing Order No. 12 at 7-9).) The Staff notes Order No. 12 held that one of ordinary skill in the art of the Asserted Patents would have either (i) "a Bachelor of Science degree in electrical engineering or a related field, and around two years of experience in the design or implementation of wireless communications systems, or the equivalent," or (ii) "six years of experience in the design or implementation of wireless communications systems, or the

equivalent.” (*Id.*) The Staff contends that Respondents apparently applied this level of ordinary skill in the art in their *Motion* and offers that the *Motion* is clearly based on the findings in Order No. 12 for the claim term “virtually free from interference.” (*Id.*) The Staff also explained that the parties stipulated to this level of ordinary skill in the art. (*Id.*)

2. The Claim Language Does Not Provide Guidance As To The Metes And Bounds Of The Limitation “Virtually Free From Interference”

The Staff agrees with the Respondents and with Order No. 12 that the claim term “virtually free from interference” is meaningfully different from the claim term “free from interference,” because the word “virtually” must be given effect. (*Id.* (citing *Memorandum* at 6; Order No. 12 at 23).) As the Staff points out, every claim term is presumed to have meaning, and any construction that renders a claim term superfluous is discouraged. (*Id.* (citing *Innova/Pure Water*, 381 F.3d 1111 at 1119).)

The Staff asserts that the patentee understood there is a distinction between the terms. (*Id.* (citing Order No. 12 at 24).) The Staff reiterates that the Asserted Patents are continuations of the ‘885 Patent, which contains claims reciting: (i) the term “free from interference”; (ii) the term “virtually free from interference”; and (iii) both of these terms (“virtually free from interference” and “free from interference”). (*Id.* at 13 (citing *Memorandum*, Ex. C, the ‘885 patent at 6:41-49, 6:66-7:7, 7:63-8:6).) Accordingly, the Staff contends that the patentee deliberately drafted claims containing either one of these claim terms or both of these claim terms, and there is no evidence or even any argument by Complainant (or Complainant’s technical expert) that the patentee acted as his own lexicographer and redefined these claim terms to have the same meaning. (*Id.*)

The Staff observes that even though the claim language makes a clear distinction between the terms “virtually free from interference” and “free from interference,” it does not further explain or otherwise provide guidance as to the metes and bounds of “virtually free from interference.” (*Id.*) Agreeing with Respondents and with Order No. 12, the Staff contends the word “virtually” is a term of degree and further asserts the claim language does not further disclose the amount of interference permitted. (*Id.* (citing Order No. 12 at 27-28).) Further, considering the evidence available at the time of the *Motion*, the Staff asserts Complainant had not (and cannot) point to any claim language providing such disclosure. (*Id.*)

3. The Patent Specification Does Not Provide Guidance As To The Metes And Bounds Of The Limitation “Virtually Free From Interference”

Like the claim language, the Staff perceives that the patent specification also provides no guidance as to the metes and bounds of the limitation “virtually free from interference.” (*Id.*) Continuing, the Staff reports there is no disclosure, much less discussion, of the term “virtually free from interference” in the specification of the Asserted Patents. (*Id.*) Noting this was recognized by Respondents and in Order No. 12, the Staff states the specification discloses instead that: (i) “[t]he wireless digital audio system allows private audio enjoyment *without interference* from other users of wireless digital transmitters and receivers”; (ii) “[t]he wireless digital audio music system provides private listening *without interference* from other users of [f] wireless devices”; and (iii) “receiver headphone 50 user may be able to listen (privately) to high fidelity audio music . . . *without interference* from any other receiver headphone 50 user.” (*Id.* at 13-14 (citing *Memorandum*, Ex. A, ’258 Patent, Abstract, 1:64-66, 3:28-32; Ex. B, ’391 Patent, Abstract, 2:1-3, 3:32-36, and Order No. 12 at 25) (emphasis in original).) Regardless, the Staff contends there is no evidence or even any argument by Complainant (or Complainant’s technical

expert) indicating that the patentee acted as his own lexicographer and redefined the term “without interference” to have the same meaning as the term “virtually free from interference.” (*Id.* at 14.) Accordingly, the Staff asserts, any reliance on disclosures pertaining to “without interference” in the specification to discern the limits of the term “virtually free from interference” is misplaced. (*Id.* (citing Order No. 12 at 25).)

4. The Prosecution History Does Not Provide Guidance As To The Metes And Bounds Of The Limitation “Virtually Free From Interference”

The Staff also recognizes that just like the claim language and the patent specification, the prosecution history fails to provide guidance as to the metes and bounds of the limitation “virtually free from interference.” The Staff contends that because there is nothing in the prosecution histories of the Asserted Patents, the Complainant seized upon the following statement made by the applicant during prosecution of the ‘885 Patent: “Lavalle does not teach, disclose, or suggest such a relationship where *interference is virtually eliminated (e.g., where eavesdropping cannot occur)*.” (*Id.* (emphasis in original).) However, the Staff contends that Complainant’s reliance upon this statement to support its construction of “virtually free from interference” is wrong because the applicant’s explanation to the examiner related to the rejection of claims reciting “free from interference,” not claims reciting “virtually free from interference.” (*Id.* at 14-15 (citing Order No. 12 at 26).) Hence, the Staff concurs with the Respondents and Order No. 12 that the applicant’s statement made during prosecution of the ‘885 Patent provides guidance on the meaning of a different limitation from different claims, rather than the limitation “virtually free from interference” in the Asserted Claims of the Asserted Patents. (*Id.* at 15 (citing Order No. 12 at 26).)

Discussing the matter further, the Staff states that even assuming the applicant's use of the word "*virtually*" during prosecution of the '885 Patent showed a direct correspondence between "where the interference is virtually eliminated" and "virtually free from interference," as argued by Complainant and its technical expert, the applicant's use of the term "*e.g.*" shows applicant did not clearly and deliberately define "where the interference is virtually eliminated" to mean "where eavesdropping cannot occur," as asserted by Respondents. (*Id.*)

Following up, the Staff contends:

Even assuming further that the applicant clearly and deliberately defined the term "virtually free from interference" to mean "where eavesdropping cannot occur" through the allegedly corresponding statement of "where the interference is virtually eliminated," this proposed definition -- the absence of eavesdropping -- does not give meaning to claims reciting "free from interference." In other words, it is impossible to determine what condition beyond the absence of eavesdropping indicates a state of "free from interference" that is presumably different in degree than a state of "virtually free from interference." Thus, Complainant's proposed construction of "virtually free from interference" is untenable, as found by the ALJ. Order No. 12 at 27.

(*Id.*)

The Staff also concurs with Respondents and with Order No. 12 that Complainant's proposed construction of "virtually free from interference" is inconsistent with Asserted Claims of the Asserted Patents reciting, among other things, "audio having been wirelessly transmitted virtually free from interference," for the record contains nothing that teaches, explains, or discusses how the invention can transmit the audio free from interference such that eavesdropping cannot occur. (*Id.* at 15-16 (emphasis in original).) As stated by Respondents and in Order No. 12, Complainant's construction addresses the reproduction of audio, not the transmission of audio. (*Id.* at 16 (citing Order No. 12 at 28; *Memorandum* at 13-14).)

The Staff notes Complainant originally did not submit any expert declaration addressing the proper meaning of the term "virtually free from interference," because it apparently believed

that “the intrinsic evidence by itself is clear enough.” (*Id.* (citing *Markman* Hearing Tr. at 129:23-130:2).) The Staff then contends that even if Complainant were to submit or otherwise rely upon new extrinsic evidence in opposition to support its proposed construction, extrinsic evidence that conflicts with the intrinsic evidence must be disregarded. (*Id.* at 16n.2 (citing *Network Commerce*, 422 F.3d at 1361).) Summing up, the Staff avers the claims, the patent specification, and the prosecution history do not provide guidance as to the metes and bounds of the limitation “virtually free from interference,” and Complainant’s proposed construction is inconsistent with the intrinsic evidence. (*Id.* at 16.)

C. Complainant’s Contentions

1. The PTO never rejected “virtually free from interference” as indefinite

Complainant observes the Examiner never rejected “virtually free from interference” or “free from interference” as indefinite on any basis. (*Opposition* at 6.) Complainant claims the Examiner specifically reviewed Claim 17 of the ’885 application, which contained both the “virtually free from interference” and the “free from interference” limitations and issued 112 rejections on that claim, but not on the basis of those limitations. (*Id.* at 6-7.) Complainant alleges this means the Examiner “never indicated any difficulty understanding “virtually free from interference.”⁸ (*Id.* at 7.) Instead, Complainant alleges the Examiner demonstrated his understanding of “virtually free from interference” during prosecution of child application No. 13/356,949, where he rejected a claim containing the same limitation, to wit:

In section 3.b. Applicant generally discusses the differences between the interference correction of Altstatt and the claimed “virtually free from interference.” Examiner notes that simply tuning Altstatt to an unused

⁸ This paragraph is supported by no evidence, only speculation. Moreover, it was the subject of an immediate and convincing rebuttal by Respondents. (*Reply* at 1-2.) This comment is offered as an illustration of why some of Complainant’s *Opposition* was afforded so little weight.

frequency will allow reproduction that is “virtually free from interference.” Furthermore, the CDMA implementation of the combination requires a device be paired to a particular “code,” which is the entire basis of CDMA. *This code enables transmission and reception separate from other CDMA transmissions, i.e. “virtually free from interference.”*

(*Id.* (emphasis in original).)

According to Complainant, the Examiner’s own statements meant he understood that a system operates virtually free from interference when its transmissions are kept “separate from other CMDA transmissions.” (*Id.*) Complainant further argues, based upon Mr. McAlexander’s interpretation of the child patent application, that a PHOSITA understands that keeping transmissions “separate from other CDMA transmissions” is consistent with no eavesdropping. (*Id.*) Closing this section, Complainant argues that if “virtually free from interference” had meaning once, it cannot now be indefinite. (*Id.*)

2. Respondents’ Characterizations Of The Intrinsic Evidence Are Wrong

Complainant initiates its discussion under this heading by contending that which follows demonstrates that Respondents’ arguments are incompatible with the “intrinsic” and “extrinsic” evidence. (*Id.* at 8.)

a. Applicant’s “Not Virtually-Eliminated” Distinction Was Made With Regard to a Virtually Free From Interference Limitation

Complainant notes it is undisputed that the applicant, during prosecution of the ’885 patent, distinguished his inventions over the prior art by explaining that “Lavelle does not teach, disclose or suggest such a relationship where interference is virtually eliminated (*e.g.*, where eavesdropping cannot occur)” (*Id.*; *see also SMF* ¶ 5.) Complainant summarizes and characterizes Respondents’ argument that this reference does not refer to “virtually free from interference” (because Claims 24-27 only include the “free from interference” limitation) as

speculative, because Respondents allege “the not-virtually-eliminated distinction cannot bear on the meaning of VFFI [virtually free from interference] to one of ordinary skill.” (*Opposition* at 8.)

Complainant alleges “Respondents’ speculation” makes the applicant’s use of the word “virtually” inexplicable and “begs the question” as to why the applicant used “virtually” at all if it only referred to claims containing free from interference. (*Id.*) According to Complainant, the answer is that the applicant made his statement in the context of a claim containing the term virtually free from interference, which is Claim 17. (*Id.*)

Complainant contends the applicant clearly stated that the not-virtually-eliminated distinction was previously provided during a June 16, 2009 interview with the Examiner based upon the first sentence of the oft cited excerpt from the ’885 patents history, to wit:

As is agreed to by the Applicant and Examiner, most recently discussed during the teleconference with the Examiner on June 3, 2009, Lavelle does not teach, disclose, or suggest such a relationship where interference is virtually eliminated (e.g. where eavesdropping cannot occur) where multiple receivers and transmitters occupy the same environment.

(*Id.* at 8-9 (emphasis in original).) Based upon an opinion from Mr. McAlexander, Complainant alleges this means there is no doubt that, before the June 16, 2009 Response, the applicant believed he had reached agreement with the Examiner that Lavelle does not disclose “virtually” eliminating interference, and that the applicant offered this distinction during the June 3, 2009 interview. (*Id.* at 9.)

Citing the interview summary, Complainant claims “[t]he substance of the interview centered around the Final Rejection issued on May 29, 2009.” (*Id.*) That rejection, drafted five days before the interview, was memorialized in the Examiner’s May 29 Office Action, which rejected Claims 17, 19, 20 and 24-27. (*Id.*) And according to Complainant, a PHOSITA would

understand several points about that Office Action. (*Id.*) Complainant alleges these include: (1) the Examiner engaged in a detailed examination of Claim 17 spanning three pages; (2) Claim 17 included both “virtually free from interference” and “free from interference” limitations; (3) the Examiner based his rejection of Claims 24-27 upon his examination of Claim 17; (4) the Examiner rejected Claim 17 on the basis that Lavelle disclosed both “virtually free from interference” and “free from interference” and relied upon the same passage from Lavelle to argue that Lavelle disclosed both terms. (*Id.*)

Complainant argues this means that when the June 3, 2009 interview was conducted five days later, “the Examiner’s detailed rejection of Claim 17 stood as the foundation for the Examiner’s rejection of Claims 24-27.” (*Id.*) Complainant argues this means “the intrinsic evidence reflects that the applicant’s not-virtually-eliminated distinction was provided and agreed upon during an interview that addressed the Examiner’s rejections, which were founded on Claim 17 containing a VFFI [virtually free from interference] limitation.” (*Id.* at 9-10.)

Complainant also argues the applicant’s not-virtually-eliminated distinction had been discussed with the Examiner even before that interview and that other claims had been pending that included the “virtually free from interference” term and the Examiner had allowed them. (*Id.* at 10.) Accordingly, Complainant suggests the intrinsic record contradicts Respondents’ disparagement of Complainant’s construction as relying upon “a single remark” or “isolated statement.” (*Id.*) In addition, Complainant also alleges that Respondents’ attempt to diminish One-E-Way’s construction as based on the prosecution of a parent application carries no legal weight. (*Id.* at 10n.3 (citations omitted).)

Based upon Mr. McAlexander’s declaration, Complainant also asserts that the applicant’s use of “not virtually eliminated” to distinguish the “virtually free from interference” term also

distinguished the “free from interference” term from that same prior art. (*Id.* at 10.) According to Complainant, a PHOSITA understands that if a prior art reference does not teach being virtually free from interference, it necessarily does not teach being free from interference. And this means, that in distinguishing Lavelle as failing to teach Claim 17’s “virtually free from interference” term, the applicant also distinguished Lavelle as failing to teach the “free from interference” term in the same claim. (*Id.*) Complainant notes the interview summary shows that the Examiner agreed Lavelle does not disclose the “virtually free from interference” limitation. (*Id.*) This means, according to Complainant (and Mr. McAlexander), that a PHOSITA would understand that when the June 16, 2009 Response cited the Examiner’s prior agreement that Lavelle failed to disclose even virtually eliminating interference, the applicant also addressed the Examiner’s rejection that Lavelle discloses the “free from interference” limitations in Claims 24-27. (*Id.* at 10-11.)

Complainant alleges the full context of prosecution history makes clear what a PHOSITA would understand and this “neither requires clairvoyance nor undermines the public notice function of patents.” (*Id.* at 11.) Instead, Complainant alleges, with Mr. McAlexander’s support, the prosecution history demonstrates and explains what “Respondents’ attorney argument speculation cannot – why the applicant used the word ‘virtually’ when addressing Claims 24-27, which did not contain the word ‘virtually.’” (*Id.*) Complainant asserts the applicant deliberately used the term “virtually” because of the previous interview with the Examiner where they discussed Claims 24-27 within the context of the Examiners’ rejection of Claim 17, which contained the “virtually free from interference” limitation. (*Id.*)

Complainant closes its argument under this section by alleging that Respondents’ “attorney-argument speculation is refuted by the full context of the prosecution” and that all

inferences should be interpreted in Complainant's favor (as the non-moving party) in any event. (*Id.*) Therefore, Complainant argues that under no circumstances can Respondents' *Motion* be granted on the notion that one of ordinary skill would not be informed of the meaning of "virtually free from interference" because the word "virtually" is absent from Claims 24-27. (*Id.* at 12, 12n.4 (citing *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 348 F. Supp. 2d 713, 748 (N.D. W. Va. 2004) (speculation concerning prosecution history could not satisfy requirement to prove invalidity by clear and convincing evidence); *Fuji Photo Film Co. v. Jazz Photo Corp.*, 173 F. Supp. 2d 268, 276 (D.N.J. 2001)).)

b. The Teaching in the Specification about Private Listening is Consistent with One-E-Way's Construction of VFFI

i. The intrinsic evidence refutes Respondents' characterization of the specification

Complainant next addresses Respondents' assertion that the specification of the Asserted Patents is inconsistent with One-E-Way's construction of virtually free from interference, *i.e.*, the alleged failure of the Asserted Patents to describe private listening with levels of interference of other than zero. (*Id.* at 12.) Complainant claims this is incorrect because the specification refutes this argument, to wit:

Each receiver headphone **50** user may be able to *listen (privately)* to high fidelity audio music, using any of the audio devices listed previously, without the use of wires, and *without interference* from any other receiver headphone **50** user, even when operated within a shared space. The fuzzy logic detection technique **61** used in the receiver **50** could provide *greater user separation* through optimizing code division in the headphone receiver.

(*Id.* (citing *Memorandum*, Ex. B, '391 Patent at 3:32-39 (emphasis in original)).) According to Complainant, and again citing Mr. McAlexander, the first sentence in the passage above shows the specification teaches that users of the invention are able to listen to audio privately "without interference" from other devices in a shared space. (*Id.*) While Respondents cite this sentence to

support their contention that “without interference” cannot mean anything other than zero interference, Complainant contends the next sentence refers to a technique that “could provide greater user separation.” (*Id.* at 12-13.) According to Complainant, if “without interference” was taken to mean “absolute freedom from interference” or “zero interference” there would be no need for, or possibility of, providing “greater user separation” because user separation would already be maximized. (*Id.* at 13.) Complainant alleges that when the patent specification refers to private listening “without interference” from other devices, “it is irrefutably teaching that private listening is achieved at nonzero levels of interference, because greater user separation is still possible. (*Id.*)

Complainant also argues that the claims of the '885 quoted by the Respondents, confirm that private audio listening cannot require “zero” interference. (*Id.*) Complainant alleges: (1) Claim 16 recites “private audio” along with both “virtually free from interference” and “free from interference” limitations; (2) Claim 12 recites “private audio” along with a “virtually free from interference” limitation; (3) and Claim 11 recites “private audio” along with a “free from interference” limitation. (*Id.*) According to Complainant, this would make Claims 12 and 16, which recite private audio based on “virtually free from interference,” nonsensical if “private audio” required “zero” interference. In contrast, when “private audio” is properly understood to permit nonzero amounts of interference, all three claims of the '885 patent cited and quoted by the Respondents would make sense and would be consistent with One-E-Way’s construction of the “virtually free from interference” limitation. (*Id.*)

ii. A wireless system that achieves private listening is consistent with a wireless system where eavesdropping cannot occur

Complainant alleges the patent specification never uses the term “absolute freedom,” or either of those words, or any variation of those words or even the word the word “free.” (*Id.* at 13-14.) Complainant alleges that Respondents fabricated the “absolute freedom” contention. (*Id.* at 14.) Rather, Complainant alleges the patent specification literally explains that the invention “provides private listening without interference from other users or wireless devices” and a PHOSITA would understand that such private listening can be achieved even if the system is not completely free from interference from the wireless transmissions of other devices. (*Id.*, again citing Mr. McAlexander.) Continuing, Complainant asserts it is commonly known that the nearby presence of other wireless devices transmitting in the same frequency spectrum may cause some interference with wireless systems using CDMA, which does not preclude private listening. (*Id.*) Complainant contends that while private listening can be achieved by a system that operates completely free from other wireless interference, complete freedom from interference is not required to achieve private listening. Complainant further states that a PHOSITA understands that, because interference cannot be completely eliminated, wireless systems are designed to tolerate some degree of interference (*e.g.*, CDMA-based systems). (*Id.*)

Complainant’s premise is that a PHOSITA reading the specification’s teaching about private listening would understand it to mean that users of the invention will be able to listen to their audio transmissions privately and thus interference from other nearby transmissions does not preclude private listening. (*Id.*) Complainant further asserts that eavesdropping is prevented by One-E-Way’s CDMA-based wireless inventions, even if transmissions in the same frequency spectrum from other nearby wireless devices result in some transmission collisions. (*Id.* at 15.) Complainant contends that a PHOSITA understands that a system operating to avoid

eavesdropping may operate with some degree of interference. (*Id.*) Complainant also argues that extrinsic evidence demonstrates that a PHOSITA understands when a wireless system prevents eavesdropping and when it does not, which is consistent with the intrinsic evidence from the patent specification's "eavesdropping cannot occur" guidance. (*Id.*)

Complainant disputes that private listening is related to "free from interference" and argues that it is contradicted by the intrinsic evidence. (*Id.*) Complainant alleges that its expert's declaration is consistent with the intrinsic evidence and faults Respondents' position that the "private listening" guidance provided in the specification is tied only to zero interference. (*Id.*)

c. The Extrinsic Evidence Affirms the Intrinsic Guidance and Confirms the Well-Understood Interrelationship between Interference, Privacy and Eavesdropping.

I decline to summarize the arguments or factual allegations that Complainant made under this subheading starting at page 16 of its *Opposition*. I can detect no case law supporting these arguments or facts and I find specifically they are immaterial and irrelevant and thus they are incapable of having any probative value in establishing the meaning of "virtually free from interference" in the Asserted Patents. Moreover, I find that rather than support Complainant's position, some of the extrinsic evidence is at odds with their argument, *e.g.*, eavesdropping appears to have a relationship with signal interception and privacy, while interference appears to relate to signal clarity.

d. The Absence of Eavesdropping is Not "Subjective," and Provides Reasonable Certainty in the Context of Interference from Both Audio and Non-Audio Transmissions.

As with the preceding section, I decline to summarize the arguments or factual allegations that Complainant makes under this subheading starting at page 19 of its *Opposition*. They are not material to any of the issues before me in deciding this motion and accordingly, no

possible purpose would be served in summarizing them.

e. There Is No Dispute that “Virtually Free From Interference” and “Free From Interference” Have Different Meanings.

Consistent with its topic heading, Complainant concedes the two terms have different meanings. (*Id.* at 26.) Complainant argues, however, that “free from interference” cannot really mean zero interference, but can mean no detectable interference. (*Id.* at 27.)

f. The Use of “e.g.” Does Not Negate Reasonable Certainty.

Complainant alleges that inherent within the oft quoted excerpt from the '885 patent, “Lavelle does not teach, disclose or suggest such a relationship where interference is virtually eliminated (*e.g.*, where eavesdropping cannot occur) . . .,” is that eavesdropping is a condition indicating whether a certain degree of interference exists. (*Id.* at 28, citing Mr. McAlexander for support.) Complainant asserts that eavesdropping (the condition) is established by the extrinsic evidence references it has provided.⁹

Complainant argues the statement they made during the '885 patent history during prosecution is plainly understood, *i.e.*, “eavesdropping cannot occur” which means there is a condition where interference is “virtually eliminated.” (*Id.*) From here, Complainant alleges that the use of “e.g.” to introduce the “eavesdropping cannot occur” condition, does not change that it

⁹ I note that I have rejected the references to extrinsic evidence as having no materiality in the preceding sections. I have elected to provide some summary of this section because of the tie in to the '885 patent history, which could be relevant. However, I reiterate my holding from Order No. 12, that the part of the '885 patent history Complainant relies on is irrelevant to the meaning of “virtually free from interference.”

is a condition indicating that interference is virtually eliminated, rather than an example of interference. (*Id.*)¹⁰

Complainant next contends that the statement regarding the “eavesdropping cannot occur” condition is not the only intrinsic guidance. (*Id.*) Citing Mr. McAlexander, Complainant alleges that the statement is consistent with the “repeated guidance” in the patent specification that the invention provides private listening where a user does not hear the wireless transmissions of other devices. (*Id.*). In addition, Complainant alleges it is also consistent with the understanding of the Patent Examiner when he stated that keeping users’ transmissions separate from each other indicates that the system is “virtually free from interference.”¹¹ (*Id.* at 28-29.)

Reiterating, Complainant argues that a PHOSITA understands that eavesdropping serves the role of indicating whether or not a system operates virtually free from interference. (*Id.* at 29.) Complainant contends that the “eavesdropping cannot occur” condition in the intrinsic record provides reasonable certainty regarding the metes and bounds of virtually free from interference. (*Id.*, citing Mr. McAlexander.)

Complainant also alleges that Respondents are wrong to argue there is some supposed confusion about the “eavesdropping cannot occur” condition because, “by being stated as an example, it inherently implies that there are other ways in which the ‘virtually free from interference’ limitation may be satisfied.” (*Id.*) Complainant reasons that (1) Respondents failed to identify any of the supposed “other ways” and (2) Complainant’s alleged intrinsic guidance consistently teaches that a system operates virtually free from interference when eavesdropping

¹⁰ This is but a different twist on Complainant’s argument concerning this reference, one rejected in Order No. 12.

¹¹ I specifically find there is no such “guidance” or that any is cited by Mr. McAlexander.

cannot occur since CDMA separates device transmissions in the same spectrum, thereby achieving private listening. (*Id.* at 29-30.)

Without identifying what “guidance” they are addressing, Complainant argues the issue to be decided “involves consistent intrinsic guidance providing an unambiguous condition that indicates when a system is virtually free from interference.” (*Id.* at 30.) According to Complainant, this means Respondents’ reliance on *Interval Licensing* is misplaced, for in *Interval Licensing*, the Federal Circuit declined to rely on an “e.g.” phrase to define the term “unobtrusive manner” because it was “facially subjective” and related to separate and incompatible embodiments. (*Id.*, citing *Interval Licensing*, 766 F.3d at 1371-73.) Complainant argues the term “virtually free from interference” is not facially subjective, as evidenced by the literature’s use of the term.¹² Moreover, according to Complainant, determining virtually free from interference based on the condition of eavesdropping is consistent with the entire intrinsic record, which is to keep user transmissions separate/private through CDMA. (*Id.* at 30.)

Complainant alleges Respondents’ reliance on *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335 (Fed. Cir. 2015), “is similarly misplaced because, as Respondents admit, there “the intrinsic evidence did not indicate which of three possible measurement methods was to be used,” and thus was inconsistent and ambiguous.” (*Id.*) Complainant also argues that where example-based guidance in the intrinsic record is unambiguous, this guidance is accepted (the disputed claim term is not found to be indefinite. (*Id.* (citing *Apple Inc. v. Samsung Electronics Co.*, 786 F.3d 983, 1002 (Fed. Cir. 2015) (claim term “substantially centered” not indefinite based on example embodiment indicating “essentially centered except for a marginal

¹² I have already explained why I find all of this extrinsic evidence to not be material or relevant in preceding sections of Complainant’s argument.

space to accommodate ancillary graphical user interface elements.”); *DDR Holdings, LLC v. Hotels.com*, 773 F.3d 1245, 1259-61 (Fed. Cir. 2014) (claim term “visually perceptible elements” not indefinite based on consistent examples in the specification); *Eidos Display, LLC v. AU Optronics Corp.*, 779 F.3d 1360, 1364-68 (Fed. Cir. 2015) (claim term “a contact hole for source wiring and gate wiring connection terminals” not indefinite based on disclosure of consistent, exemplary embodiments)).) Complainant argues that Respondents’ arguments concerning *Interval Licensing* and *Teva* do not apply in this investigation because the intrinsic guidance is consistent and unambiguous. (*Id.* at 30-31.)

Complainant next alleges Respondents’ attempt to distinguish *Sinorgchem Co. v. Int’l Trade Comm’n*, 511 F.3d 1132 (Fed. Cir. 2008), is wrong. (*Id.* at 31 (citing *Motion* at 11-12).) Complainant alleges Respondents’ alleged characterization of *Sinorgchem* as holding that “examples” should be included in a claim construction, is misleading. (*Id.*) Complainant alleges the issue was whether the ITC should have considered guidance introduced via “e.g.” that related to a particular solvent. (*Id.*) According to Complainant, the Federal Circuit reversed the ITC’s exclusion of “e.g.”-related guidance, even though the ITC found that the “e.g.” language was not consistent with a preferred embodiment. (*Id.* (citing *Sinorgchem*, 511 F.3d at 1138-39).) Continuing, Complainant maintains *Sinorgchem* cannot be dismissed as a claim construction case because the definiteness inquiry tracks claim construction, which is a matter that depends on how a PHOSITA would understand the claim language after reading the entire intrinsic record, including the patent and the prosecution history. (*Id.*) Accordingly, Complainant contends that the “e.g.” in the oft quoted excerpt from the ’885 patent history provides reasonable and unambiguous guidance and does not detract from the definiteness of the term “virtually free from interference.” (*Id.*)

g. One-E-Way's Construction of VFFI [Virtually Free From Interference] Is Consistent Across the Claims

Complainant also disputes Respondents' argument that Complainant's "proposed construction is also inconsistent with the differences in the way the 'virtually free from interference' language is recited in the Asserted Claims" based on certain of the Asserted Claims reciting "audio having been transmitted virtually free from interference" and other Asserted Claims reciting "audio having been transmitted and reproduced virtually free from interference." (*Id.* (citing *Memorandum* at 13-14).) Complainant avers that Respondents argue that "the 'no eavesdropping' of Complainant's construction is determined by whether the user of the claimed device overhears someone else's audio and that the possibility of overhearing someone else's audio (eavesdropping) occurs in connection with reproduction, not transmission." *Id.* According to Complainant, again relying upon Mr. McAlexander, a PHOSITA would understand that Complainant's construction of "virtually free from interference" is consistent with the Asserted Claim reciting audio "transmitted virtually free from interference" and the Asserted Claims reciting audio "transmitted and reproduced virtually free from interference." (*Id.* at 32.)¹³ Complainant argues its construction does not recite "no interference," and instead describes that eavesdropping on certain types of signals "cannot occur." (*Id.*)

According to Complainant, a PHOSITA understands, consistent with the teachings of the intrinsic record,¹⁴ that whether or not eavesdropping can occur is instructive to all of the Asserted Claims. (*Id.* at 33.) Moreover, a PHOSITA understands that Complainant's invention relates to transmitting audio and this occurs as the audio is converted into an audio signal representation,

¹³ To the extent Respondents made this argument, it is not cited by me in Order No. 12 and does not form the basis of any opinion in this Order.

¹⁴ This is yet another example of Mr. McAlexander improperly offering a legal opinion on the meaning of the intrinsic evidence.

which is transmitted, and then initially received as an audio signal representation before being converted back into audio, which means there is no inconsistency in Complainant's construction.

(Id.)

More specifically, Complainant asserts, a PHOSITA, reading the specification and claims, understands that the Asserted Patents teach a system in which audio is converted by an analog to digital converter (ADC) into an audio signal representation, which is then modulated by a digital modulator into a digitally modulated waveform. *(Id.)*

Complainant next notes the Asserted Claims differentiate between the "audio" and the "audio signal representation." *(Id. at 34.)* Complainant observes this means a PHOSITA would know that transmission of an audio signal representation is finished once the radio receiver gets it, but the transmission of the audio is completed after the radio converts the audio signal representation into audio. *(Id.)*

Complainant argues a PHOSITA would understand that when the audio is outputted, it has been transmitted virtually free from interference since eavesdropping cannot occur.¹⁵ *(Id. at 34-35.)* According to Complainant, a PHOSITA also understands that, at the time that the audio is reproduced, the audio has been transmitted and reproduced virtually free from interference as reflected by the fact that, there too, eavesdropping *cannot* occur. *(Id. at 35.)*

Complainant also contends Respondents' argument regarding audio having been "transmitted" virtually free from interference has no bearing on the definiteness of the "virtually free from interference" term. *(Id., citing Mr. McAlexander.)* According to Complainant, Respondents presented no evidence contradicting Complainant's showing that a PHOSITA

¹⁵ This argument is a gross fallacy and merits immediate comment. It is only true that the audio signal has been transmitted free from interference, which is the correct reference to the use of the word eavesdropping in the oft quoted '885 patent history.

understands the metes and bounds of virtually free from interference. In consideration of the foregoing, Complainant alleges that contrary to Respondents' arguments, whether audio is transmitted has no relevance to the definiteness of the term virtually free from interference. (*Id.* at 36.)

3. Under Controlling Legal Authority, Respondents' Motion Must Be Denied.

Complainant alleges Respondents ask me to find the word "virtually" indefinite.¹⁶ (*Id.* at 36.) Next, Complainant agrees the word "virtually" is a "term" of degree and customary in patent practice. (*Id.*) Complainant alleges the *Nautilus* decision did not change the indefiniteness analysis drastically, with regard to terms of degree. (*Id.* at 37 (citing *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014)).) According to Complainant, the standard announced in *Nautilus* is simply that a patent claim, read in light of the specification and the prosecution history, needs to inform a PHOSITA about the scope of the invention "with reasonable certainty." (*Id.* (citing *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124).) Complainant further contends that *Nautilus* confirmed the vitality of several longstanding principles, including that definiteness is evaluated from the perspective of those skilled in the art and in the context of the specification and prosecution history. (*Id.* (citing *Nautilus*, 134 S. Ct. at 2129).) Moreover, Complainant notes that on remand, the Federal Circuit affirmed that *Nautilus* did not "render all of the prior Federal Circuit and district court cases inapplicable." (*Id.* (citing *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1381 (Fed. Cir. 2015)).)

Complainant rejects Respondents' argument that Complainant's construction is not

¹⁶ This is an egregious misrepresentation meriting an immediate response. It is undisputed Respondents moved for me to find the term "virtually free from interference," as used in the Asserted Claims indefinite, not the word "virtually."

correct because it relies on an “e.g.” statement to support definiteness,¹⁷ virtually free from interference lacks a specific meaning standing alone,¹⁸ and there is no specific definition of the term in the intrinsic record.¹⁹ (*Id.*) Complainant argues that for the term “virtually free from interference” to be found definite, Complainant need only show reasonable certainty as to its meaning and reasonable certainty can come from examples in the intrinsic record “and that such meaning need not include a specific number nor be the result of a lexicographic definition.” (*Id.*)

a. Terms Of Degree Can Be Found Definite Based On An Example In The Intrinsic Record

Complainant contends that, even after *Nautilus*, the Federal Circuit has confirmed that terms of degree can be defined by examples found in the intrinsic record. (*Id.* at 38 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1260 (Fed. Cir. 2014) (“For . . . terms of degree, specific and unequivocal examples may be sufficient to provide a skilled artisan with clear notice of what is claimed.”))). Complainant also cites *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1373 (Fed. Cir. 2014), where the Court states that: “a patent which defines a claim phrase through examples may satisfy the definiteness requirement.” (*Id.*) Complainant alleges both *DDR Holdings* and *Interval Licensing* relied on *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325 (Fed. Cir. 2010), where the term “not interfering substantially” was found

¹⁷ This is yet another misrepresentation requiring an immediate reply. My understanding of Respondents’ position and as provided in Order No. 12, is that it is not and never has been the term “e.g.” that causes the reference from the ‘885 patent history to be irrelevant. Rather, the matter is irrelevant because the comment does not address the term “virtually free from interference,” but rather its claim mate “free from interference.”

¹⁸ Order No. 12 found the term indefinite as stated therein. This characterization of “specific meaning” is rejected because there are no metes and bounds attributable to “virtually free from interference” anywhere in the Asserted Patents or their history.

¹⁹ There is no definition of the term “virtually free from interference” anywhere within the Asserted Patents or patent history. The use of the word “specific” in this context wrongfully implies there is some kind of definition within the patents.

sufficiently definite because a PHOSITA could use “the examples in the specification to determine whether interference with hybridization is substantial.”²⁰ (*Id.*, citing *Interval Licensing*, 766 F.3d 1364.)

Continuing, Complainant notes that an example from the intrinsic record can be used to find the term “substantially” definite. (*Id.* (citing in *Apple Inc. v. Samsung Elec. Co.*, 786 F.3d 983, 1003 (Fed. Cir. 2015)).) In *Apple*, Complainant alleges reliance upon an example in the form of “a discussion in the specification of an embodiment” was used to find, “based on an off-centered illustration, reasonable certainty that “substantially centered” meant “essentially centered except for a marginal spacing to accommodate ancillary graphical user interface elements.”²¹ (*Id.*) Complainant concludes by asserting that the legal authority they have cited establishes that their construction of the term of degree, “virtually free from interference,” satisfies the definiteness requirement because it stems from consistent and unambiguous guidance. (*Id.*)

b. The *Nautilus* Standard Does Not Require A Term Be Specifically Defined Or Amenable To Numerical Precision.

Complainant notes *Nautilus* does not require “absolute precision” to find definiteness. (*Id.*, at 39 (citing *Nautilus*, 134 S. Ct. at 2129).) Nor does the Federal Circuit, having said in *Apple v. Samsung*, that “Samsung’s complaint about a lack of an ‘objective standard of measure’ is seeking a level of precision that exceeds the definiteness required of valid patents.” (*Id.* (citing *Apple*, 786 F.3d at 1002).)

Complainant also argues the holding in *Biosig Instruments*, 783 F.3d at 1382 favors them

²⁰ All of this is interesting, but inapplicable and academic. The case citations use the word “may” and *DDR* requires specific and unequivocal examples. The real problem for Complainant is that there is absolutely nothing in the specifications of the Asserted Patents addressing what “virtually free from interference means,” nor are there any applicable examples anywhere else.

²¹ Another academic discussion. No such a fact exists within the Asserted Patents.

because the it was found the term “spaced relationship” to be definite even though “the specification of the [asserted] patent does not specifically define ‘spaced relationship’ with actual parameters, e.g., that the space between the live and common electrodes is one inch.” (*Id.*) Complainant asserts the scope of “spaced relationship” had reasonable certainty through “calculating the point in which EMG signals are substantially removed.” (*Id.* (citing *Biosig* at 1384).) According to Complainant, this means numeric precision is not required and that an indefinite phrase can be used to define an allegedly indefinite phrase. (*Id.*) Complainant claims this is similar to *Enzo Biochem*, where the term of degree “not interfering substantially” was found definite. (*Id.* (citing *Enzo Biochem*, 599 F.3d at 1333-36).)

According to Complainant, the Federal Circuit, before and after *Nautilus*, rejects indefiniteness challenges even if the claim term cannot be reduced to a precise numerical measurement and absent any lexicographic definition of a challenged term. (*Id.* at 40 (citing *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1359 (Fed. Cir. 2012) (“substantially planar” held definite) (*Deere*); *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119-20 (Fed. Cir. 2002) (reversing District Court finding that “substantially constant” was indefinite) (*Verve*); *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1366-69 (Fed. Cir. 2001) (“substantially uniform” held definite and construed to mean “largely, but not wholly the same in form”) (*Ecolab*); *Andrew Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819, 821-22 (Fed. Cir. 1988) (“substantially equal” and “closely approximate” held definite) (*Andrew*); *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984) (“substantially equal to” held definite) (*Seattle Box*)).)

c. Recent Authority Confirms Virtually Free From Interference Is Not Indefinite.

Complainant asserts that after Order No. 12, the Federal Circuit decided *Ethicon Endo-*

Surgery, Inc. v. Covidien, Inc. et al., No. 2014–1370, 2015 WL 4680726, *1 (Fed. Cir. Aug. 7, 2015), which reversed a summary judgment ruling of indefiniteness. (*Id.*) Explaining that the technology in *Ethicon* involved clamp-like surgical instruments that cut tissue and blood vessels, Complainant asserted the issue was whether the claim term “clamping pressure” was definite. (*Id.*) Summary Judgment had been granted because the term was found indefinite because “nothing in the specification or understanding in the art specified ‘a method of measurement, the location of measurement, and the type and amount of tissue used for the measurement of clamping force[s] and clamping pressure[s]’ recited by the claims.” (*Id.* (citing *Ethicon*, 2015 WL 4680726, at *3.) Despite an intrinsic record lacking specifics, Complainant alleges the Federal Circuit found the term definite based on un rebutted testimony of the patentee’s expert, who relied on “basic concepts of physics and mathematics” to conclude that clamping pressure would be measured at the midpoint of the tissue pad and claiming arm. (*Id.* at 41 (citing *Ethicon*, 2015 WL 4680726, at *4).) The Federal Circuit found that if “an understanding of how to measure the claimed average pressures was within the scope of knowledge possessed by one of ordinary skill in the art, there is no requirement for the specification to identify a particular measurement technique.” (*Id.* (citing *Ethicon*, 2015 WL 4680726, at *5).) Complainant contends the intrinsic evidence of the instant case is much stronger because they allege “it provides a specific condition indicating when the claim language is satisfied, and that condition is well known to those of skill in the art.” (*Id.*)

Complainant also alleges the criticism of the lower court in *Ethicon* is relevant, to wit:

The district court appeared to ignore this intrinsic evidence and the testimony in the record. It expressed concern that the claims did not specifically “refer to any particular point” on the clamping surface area at which to take the recited pressure measurements or “identify a location at which [the clamping force] is to be measured.” The district court also expressed concern that there was no industry standard method for measuring clamping forces. Indeed, the district court appears

to have believed that in order for the claims of the '501 patent to satisfy the definiteness requirement . . . the intrinsic evidence needed to identify a specific method one of ordinary skill in the art would use to measure the recited clamping/coaptation pressures.

(*Id.* (citing *Ethicon*, 2015 WL 4680726, at *5).) According to Complainant, even if the term “virtually free from interference” standing alone has no meaning and “the written description of the Asserted Patents also does not provide sufficient information for a person having ordinary skill in the art to determine how much interference is permitted by the term [virtually free from interference],” *Ethicon* establishes that it is not enough by itself to render a claim indefinite. (*Id.* at 41-42.)

Complainant argues the intrinsic evidence in the present case provides more direct and substantial guidance than the intrinsic evidence relied upon in *Ethicon*'s reversal. (*Id.* at 42.) Complainant alleges the “intrinsic record expressly provides a condition indicating when the claim term is satisfied, and does so using terminology familiar and well-known to those of skill in the art. (*Id.*) Thus, Complainant concludes that One-E-Way's unrebutted expert testimony is even more compelling than that used to reverse summary judgment in *Ethicon*. (*Id.*)

D. Complainant's Memorandum Requesting Oral Argument.

Following the two-day *Markman* Hearing in which the present issue was briefed and discussed, and following Order No. 12, there has been extensive Motion Practice on the definiteness of the term “virtually free from interference.” This means there could have been no surprise as to what needed to be briefed, discussed or argued with regard to the definiteness of “virtually free from interference.” Therefore, I decline to conduct the hearing Complainant requests and also decline to summarize the content of Complainant's request for oral argument.

E. Respondents' Reply

1. The single "eavesdropping" Mention In The '885 patent file history is unrelated to "virtually free from interference."

Respondents note that the foundation for Complainant's construction of "virtually free from interference" being where "eavesdropping . . . cannot occur," is a solitary²² reference in a June 2009 Amendment. (*Reply* at 1.)²³ In this passage, Respondents contend, the applicant sought to distinguish pending claims 24-27 from the prior art Lavelle reference. (*Id.* (citing *Memorandum*, Ex. H at 1EWAY00005561).) However, the key point is that claims 24-27 recite "free from interference," *not* "virtually free from interference." (*Id.* (citing *Memorandum* at 10-11) (emphasis added).)

Respondents contend Complainant:

now seeks to essentially argue that: (1) the examiner's rejection of claims 24-27 was based on his rejection of claim 17, which recited a "virtually free from interference" limitation in addition to the "free from interference" limitation; (2) this rejection was the substance of an interview on June 3, 2009; (3) the applicant's "eavesdropping" remark in the subsequent June 2009 Amendment was based on the interview; and therefore (4) that remark must have been related to the "virtually free from interference" limitation in claim 17.

(*Id.*)

Respondents aver Complainant's foregoing line of reasoning is convoluted and one that the intrinsic evidence fails to support. (*Id.* at 2.) Respondents observe that Complainant's interpretation of the examiner interview relies on one statement from the interview summary, *i.e.*, "The substance of the interview centered around the Final Rejection issued on May 29,

²² Respondents explain that "Due to procedural errors by the applicant, the same passage is included in several submissions between June 8, 2009 and June 30, 2009, but only the final submission was entered. (*Id.* at 1n.1 (citing Ex. H at 1EWAY00005521 ("Applicant's submission filed on 30 June 2009 has been entered"))). Respondents note that in their opening brief, they cited the June 30, 2009 amendment while Complainant cited an amendment dated June 16, 2009 in its *Opposition*. (*Id.*)

²³ The "oft quoted" excerpt from the history of the '885 patent.

2009.” (*Id.*, citing *Opposition at 9.*) Respondents maintain that Complainant contends this statement shows that the interview must have included discussion of the Examiner’s rejection of claim 17. (*Id.*) This is event though, the interview summary (drafted by Complainant) “describes only two topics that were discussed, neither of which involved claim 17 and neither of which involved interference.” (*Id.*, citing Ex. H at 1EWAY00005515-16.) One topic discussed concerned claims 12, 15, 16, 18, and 22 (all previously been allowed). (*Id.*) The other topic addressed “putative amendments to Claims 24-27 to move them to allowance.” (*Id.*) Respondents observe that the examiner then reportedly “advised that where these claims were able to positively recite the one to one correlation between transmitter, and receiver, Lavelle would be overcome.” (*Id.*)

Respondents assert that while the interview summary specifically references claims 12, 15, 16, 18, 22, and 24-27, there is no mention of claim 17, nor does the interview summary mention the “free from interference” limitation in claims 24-27, while most certainly not referencing the “*virtually* free from interference” limitation in claim 17. (*Id.*, citing 1EWAY00005515-16.) Respondents also emphasize, that if as Complainant alleges, the applicant had discussed claim 17 or the other terms in previous interviews, (*Opposition at 10*), no record of these discussions exist. (*Id.*) Thus, Respondents argue Complainant only speculates as to what might have been discussed at an examiner interview, and speculation cannot be relied upon when interpreting the Asserted Claims. (*Id.* at 2-3, citing, *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1563 (Fed. Cir. 1991); *see also* M.P.E.P. § 713.04, to wit:

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, except where the interview was initiated by the examiner and the examiner indicated on the ‘Examiner Initiated Interview Summary’ form (PTOL-413B) that the examiner will provide a written summary.”; “The complete and proper recordation of the substance of any interview should include at least the following applicable items:

(A) a brief description of the nature of any exhibit shown or any demonstration conducted; (B) identification of the claims discussed; . . .”)

Respondents explain that Complainant undermines its argument that claim 17 was the subject of its “eavesdropping cannot occur” remark because at the same time the applicant made its “eavesdropping” remark with regard to claims 24-27, it withdrew claim 17 from the application. (*Id.* at 3 (citing *Memorandum*, Ex. H at 1EWAY00005561-62).) Respondents assert it would not be logical to conclude remarks made with regard to claims 24-27 would also apply to a term in a claim which was no longer at issue. (*Id.*)

Respondents’ final argument under this section of its Reply, is that Complainant’s use of its expert [Mr. McAlexander] to opine on the meaning of the prosecution history and Complainants’ dismissal of Respondents’ arguments about the prosecution history as being “attorney argument,” is contrary to the law. (*Id.* (citing *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1342 (Fed. Cir. 2015) (“Determining the meaning or significance to ascribe to the legal writings which constitute the intrinsic record is legal analysis.”))).)

2. The Newly-Submitted Extrinsic Evidence does not Show that “Virtually Free From Interference” Has Objective Boundaries to One of Skill in the Art

Respondents assert Complainant’s newly-submitted extrinsic evidence is irrelevant to whether “virtually free from interference” as used in the Asserted Claims, is indefinite under 35 U.S.C. § 112, ¶ 2. (*Id.*) Explaining, Respondents observe that Complainant:

offers three categories of new extrinsic evidence: (1) references that use the term “virtually free from interference” (or similar); (2) references purportedly showing that the “concepts of privacy and eavesdropping go hand-in-hand in the context of wireless systems” and that “eavesdropping is a well-understood term in the art;” and (3) references about Respondents’ products accused of infringement.

(*Id.* at 3-4.)

First, Respondents observe that Complainant argues that because the term “virtually free from interference” (or similar variation thereof) was used a handful of times in literature, it is “not facially subjective.” (*Id.* at 4 (citing *Opposition* at 30).) But Respondents assert these references only highlight the issue (lack of meaning), for the references use the term inconsistently across different contexts and do not quantify or otherwise provide any specificity as to what it means to be “virtually free from interference.” (*Id.* (citing *Opposition*, Ex. 1, 2, 4, 15).) Respondents assert that, for example, in the *Deploying Voice Over Wireless LANs* reference, the phrase is used in passing to indicate that one frequency band is used less often, thus experiencing less interference than another band. (*Id.* (citing Ex. 2 at 17 (“Most sources of RF interference . . . fall within the 802.11b/g 2.4-GHz band. The 802.11a 5-GHz bands are virtually free from RF interference.”))).) According to Respondents, Complainant’s references provide no disclosure of the degree or amount of interference necessary to transmit or reproduce “virtually free.” (*Id.*) Similarly, Respondents note these references do not describe “virtually free from interference” as being where eavesdropping cannot occur, nor does Complainant so contend. (*Id.*) Instead Respondents assert Complainant merely alleges that because there is a reference to or use of the language, a PHOSITA must know what it means. (*Id.* (citing *Opposition* at 3).)

Respondents contend that even though a reference to something being “virtually free from interference” (*i.e.*, experiencing some undefined low level of interference) may be sufficient to convey a basic idea in some contexts, such a general description is insufficient to provide the objective boundaries required by 35 U.S.C. § 112, ¶ 2 for patent claims, particularly when the language at issue is not even in the relevant patent claims. (*Id.* at 4-5 (citing *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370-71 (Fed. Cir. 2014))).)

Addressing Complainant's second type of evidence, Respondents note that Complainant argues the extrinsic evidence "confirms over and over again that the concepts of privacy and eavesdropping go hand-in-hand in the context of wireless systems" and "shows that eavesdropping is a well-understood term in the art." (*Id.* at 5 (citing *Opposition* at 16 and 19).) Respondents aver that even though Complainant's "references use the terms 'privacy,' 'interference,' and/or 'eavesdropping,' they again provide no objective boundaries for what it means to be 'virtually free from interference,' nor do they define it as One-E-Way proposes." (*Id.*)

On the third point, Respondents note that Complainant improperly relies on certain Respondents' product literature allegedly showing "Respondents tout the high quality audio their products deliver." (*Id.*, citing *Opposition* at 3–4.) Respondents contend that even ignoring that "the cited literature says nothing about "interference," let alone being "virtually free from interference," how accused products allegedly infringe is irrelevant to whether the term "virtually free from interference" is indefinite." (*Id.*, citing *NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed. Cir. 2002) ("It is well settled that claims may not be construed by reference to the accused device."); see also *Cohesive Techs. Inc. v. Waters Corp.*, 543 F.3d 1351, 1367 (Fed. Cir. 2008).

3. Complainant's Reliance on *Ethicon* Is Misplaced.

Respondents explain the Asserted Patents are unlike the patent-at-issue in *Ethicon*, which provided specific guidance for the metes and bounds of the claimed "clamping pressure." (*Id.* at 6 (citing *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, No. 2014-1370, 2015 WL 4680726 (Fed. Cir. Aug. 7, 2015)).) Specifically, the claimed "clamping pressure" is part of the large claim phrases, e.g., "clamping pressure of 210 psi at the clamping surface area" and "an average

predetermined clamping pressure between and including 60 psi and 210 psi.”²⁴ (*Id.* (citing *Ethicon*, 2015 WL 4680726, at *2).) Respondents point out the *Ethicon* patent specification discloses both “*which* pressures are relevant to the claims and *how* those pressures are to be measured.” (*Id.* (citing *Ethicon*, 2015 WL 4680726, at *5) (emphasis in original).) Respondents explain that other disclosures include the fact that:

the specification states that (1) the specific range of the “clamping pressure” is between the “key 60 psi to 210 psi range;” (2) the “clamping surface area” is the “area where the blade and tissue pad are in close proximity because the clamping arm is in a closed position;” and (3) the “clamping pressure” is “an *average* pressure” that is “seen by tissue when the entire clamping surface area is in contact with the tissue.”

(*Id.* (citing *Ethicon*, 2015 WL 4680726, at *2-3) (emphasis in original).) Hence, *Ethicon’s* expert just explained the underlying physics and mathematics of how the average clamping pressures may be calculated from the specification’s detailed disclosure. (*Id.* (citing *Ethicon*, 2015 WL 4680726, at *4).)

Respondents assert there is a contrast between the specifications of the Asserted Patents and those of the *Ethicon* patent, because the Asserted Patents provide no guidance as to the metes and bounds of the subjective term “virtually free from interference.” (*Id.*) For example, Respondents note there is no explanation in the specifications as to *how* much interference is permitted while remaining “virtually free,” and Complainant’s expert provides no support in the specification to the contrary but instead improperly seeks to re-interpret the prosecution history. (*Id.* (citing *Teva*, 789 F.3d at 1342).)

VIII. FINDINGS OF MATERIAL FACT

As mentioned above, Respondents proposed a *SMF* in support of their *Motion* and

²⁴ Complainant’s failure to admit to this difference is troubling.

Memorandum. Complainant replied to the *SMF* in its *Opposition* in the form of Responses to Respondents Statements of Undisputed Facts. Complainant also alleged an additional **100** Material Facts, but seemingly has not argued (referenced) them, individually or in combination, by their number in its *Opposition*. Instead, Complainant generally cites to the latest declaration by Mr. McAlexander (or from the '885 patent history I have found inapplicable, irrelevant, etc. (*Opposition* Exhibit A.)

Regardless, I find all 100 of Complainant's additional facts are irrelevant to whether or not any material facts remain for resolution of Respondents' *Motion*, especially since Respondents have not relied upon them in making their *Motion* and Complainant has not relied or cited them in its *Opposition*. Thus, these allegations are irrelevant and not necessary for me to rule herein. Accordingly, I specifically find these 100 factual allegations by Complainant lack materiality/relevance to *Motion* underlying this Order. I also find these 100 facts are irrelevant to this investigation.

As has and will be mentioned elsewhere herein, Complainant frequently cites to Mr. McAlexander's latest declaration in its *Opposition*. (*Opposition* Exhibit A.) Mr. McAlexander's declaration is singularly unhelpful. I find it was clearly created to support Complainant's claim constructions and that it is effectively based upon (or relies upon) Mr. McAlexander's irrelevant subjective legal analysis of the intrinsic evidence and with particularity, the intrinsic evidence relating to the '885 patent history that has no applicability to the issue of "virtually free from interference." (*See* Order No. 12 at 26-28.) For example, in addition to arguing the meaning the '885 patent history, a large number of the paragraphs in Mr. McAlexander's uses the words "eavesdropping" or "eavesdrop" in his latest declaration and that this use is the central theme in his declaration. (*Opposition* Exhibit A.) Neither of these

words appear in the Asserted Patents, but only within the oft cited excerpt from the '885 patent history.²⁵ In addition, Mr. McAlexander erroneously argued what the '885 patent history meant, the opposite of that conclusively established by the documents cited by Respondents in their *Reply*, as it concerned the history of Claim 17. (*Reply* at 1-3.) The main thing here is that the facts presented by Complainant were either irrelevant or lacking in materiality and thus can have no effect on the outcome of this Order.

Below each individual *SMF*, Complainant's response is indicated. Where necessary, a separate finding is made and if appropriate, an alternative finding based upon the allegation contained in the individual *SMF*. If Complainant does not dispute an individual *SMF* and the supporting reference(s) provided by Respondents is (are) probative, then the fact is found as proven. To the extent a material fact is found proven or not proven, the standard applied is one of clear and convincing evidence. In addition, each factual allegation has been evaluated in a manner most favorable to Complainant as the non-moving party.

1. On December 8, 2014, Complainant One-E-Way, Inc. ("One-E-Way" or "Complainant") filed a complaint with the U.S. International Trade Commission against Respondents for the alleged infringement of U.S. Patent Nos. 7,865,258 (Ex. A, "the '258 Patent") and 8,131,391 (Ex. B, "the '391 Patent") (collectively, "the Asserted Patents").

Complainant does not dispute this fact; therefore it is proven.

2. The '258 Patent is a continuation of U.S. Patent No. 7,684,885 (Ex. C, "the '885 Patent"), which is a continuation of U.S. Patent No. 7,412,294 ("the '294 Patent"). (Ex. A, '258 Patent, Cover Page.)

²⁵ I am also concerned that Mr. McAlexander has effectively removed any distinction between "free from interference" and "virtually free from interference" in his declaration. (*See, e.g.*, ¶¶ 26 and 27.)

Complainant does not dispute this fact; therefore it is proven.

3. The '391 Patent is a continuation of the '258 Patent, which is a continuation of the '885 Patent, which is a continuation of the '294 Patent. (Ex. B, '391 Patent, Cover Page.)

Complainant does not dispute this fact; therefore it is found.

4. One-E-Way alleges that Respondents infringe claims 1, 3-6, and 10 of the '391 Patent and claim 8 of the '258 Patent of the Asserted Claims.

Complainant does not dispute this fact; therefore it is proven.

5. All of the Asserted Claims recite the claim limitation "virtually free from interference" as shown in the table below:

Patent	Claim	Claim Language
'391 Patent	1	virtually free from interference from device transmitted signals operating in the wireless headphone spectrum
'391 Patent	3	virtually free from interference from device transmitted signals operating in the wireless digital audio system spectrum
'391 Patent	4	virtually free from interference from device transmitted signals operating in the wireless digital audio system spectrum
'391 Patent	5	virtually free from interference from device transmitted signals operating in the digital wireless audio receiver spectrum
'391 Patent	6	virtually free from interference from device transmitted signals operating in the wireless headphone spectrum
'391 Patent	10	virtually free from interference from device transmitted signals operating in the wireless headphone spectrum
'258 Patent	8	virtually free from interference from device transmitted signals operating in the wireless digital audio system spectrum

Complainant disputes this proposed fact because Complainant claims it is misleading.

Complainant's point is the term "virtually free from interference" does not exist in isolation from the rest of the language in the claim and then Complainant provides a table with more context.

I find Respondents' recitation in this *SMF* is not misleading and that Complainant's further recitation of context adds nothing. It is plain that the term at issue is in the claims as stated by Respondents. It is equally true that a term must be construed consistently where it appears in claims of common ancestry. *Epcon Gas*, 279 F.3d at 1030. Further, to the extent necessary, I considered the entire context, which has no effect on Respondents' point.

I also note the futility of the additional argument Complainant made in response to this fact. Specifically, Complainant alleged that Mr. McAlexander, as a PHOSITA (Complainant's expert) would understand the disputed phrase to mean what Complainant says it means based upon its context. (*Opposition – Response to Facts* at 4). As explained in Order No. 12, the *Markman* Order, such an argument is wrong. It is apparent that Complainant refuses to recognize or acknowledge the obvious and Order No. 12. Specifically, I find that Complainant's (and Mr. McAlexander's) construction, besides being an improper construction of intrinsic evidence by an expert, is inconsistent with the intrinsic evidence. Moreover, I note that Complainant's construction, *i.e.*, "... that eavesdropping on device transmitted signals operating in the portable wireless digital audio system spectrum cannot occur" actually equates the term "virtually free from interference" as having the same meaning as "free from interference." Since the two terms coexist in the Asserted Claims, that is manifestly wrong or impermissible and thus I must reject any and all testimony offered by Mr. McAlexander on this point since it both transparently contradicts the intrinsic evidence and equates the two terms as having the same meaning, something Complainant admits is not so. (*Opposition* at 26.)

Further, as mentioned, the proffer of Mr. McAlexander's declaration also represents an

improper attempt by Complainant to have an expert interpret or construe the intrinsic evidence based upon his reading of the specification, rather than offer factual testimony as to what the specific term means to a PHOSITA. This kind of testimony is prohibited. *General Protecht*, at 1310-11.

Respondents' proffer of *SMF 5* stands as proven.

6. Certain claims of the '391 Patent require the audio having been wirelessly transmitted and reproduced virtually free from interference, while other claims require only the audio having been wirelessly transmitted virtually free from interference. (Ex. B, '391 Patent at 4:49-10:13.)

Complainant does not dispute this fact; therefore it is proven.

7. For example, claim 1 of the '391 Patent recites that "said audio having been wirelessly transmitted and reproduced virtually free from interference from device transmitted signals," whereas claim 5 recites that "said audio having been wirelessly transmitted from a portable audio player virtually free from interference from device transmitted signals" but does not require that the audio have been reproduced virtually free from interference. (Ex. B, '391 Patent at 5:9-11, 7:16-19.)

Complainant disputes this fact as misleading. (*Opposition - Response to Facts* at 5-6.) Complainant asserts by leaving out text at the end of each included sentence, *i.e.*, "operating in the wireless headphone spectrum," Respondents are misrepresenting the claim term at issue by suggesting the audio must have been wirelessly transmitted and produced virtually free from interference from all device transmitted signals, rather than from devices operating in the wireless headphone spectrum.

Complainant makes much ado about nothing. First, Respondents state the fact is exemplary. Second, I fully understand the text cited by Respondents is but an excerpt and must be read in its full context. I understand that the signals do matter in the Asserted Patents, they are in the wireless headphone spectrum. Hence, I find this fact to be proven and not in the slightest bit misleading.

8. Certain claims of the '885 Patent include one or both of the limitations, "virtually free from interference" and "free from interference." (Ex. C, '885 Patent at 6:41-49, 6:66-7:7, 7:63-8:6.)

Complainant does not dispute this fact; therefore it is proven.

9. Claim 11 of the '885 Patent includes the limitation: "the transmitted audio signal is reproduced, providing a user of said portable transmitter and said audio receiver with private audio reproduction of said audio signal provided by said audio source free from interference when operated in a shared space containing at least one other user of wireless devices utilizing code division multiple access (CDMA) communication and utilizing an independent portable transmitter and audio receiver." (Ex. C, '885 Patent at 6:41-49.)

Complainant does not dispute this fact; therefore it is proven.

10. Claim 12 of the '885 Patent includes the limitation: "the transmitted audio signal is reproduced, providing a user of said portable transmitter and said audio receiver with private audio reproduction of said audio signal provided by said audio source virtually free from interference when operated in a shared space containing at least one other user of wireless devices utilizing code division multiple access (CDMA) communication and utilizing an independent portable transmitter and audio receiver in a shared space." (Ex. C, '885 Patent at 6:66-7:7.)

Complainant does not dispute this fact; therefore it is proven.

11. Claim 16 of the '885 Patent includes the limitation: "the transmitted audio signal is reproduced, providing a user of said portable transmitter and said audio receiver with private audio reproduction of said audio signal virtually free from interference when operated in a shared space containing at least one other user of a wireless device utilizing an independent portable transmitter and audio receiver; and listening to said audio output free from interference from at least one other user of a wireless devices in a shared space." (Ex. C, '885 Patent at 7:63-8:6.)

Complainant does not dispute this fact; therefore it is proven.

12. On July 24, 2015, the Administrative Law Judge issued Order No. 12 Construing Terms of the Asserted Patents (Ex. D, "Order No. 12"), in which he construed terms found in the Asserted Claims.

This matter is not disputed; therefore is proven.

13. In Order No. 12, the Administrative Law Judge found "the limitation 'virtually free from interference' indefinite because one of ordinary skill in the art would be unable to discern with reasonable certainty the limitation's metes and bounds." (Ex. D, Order No. 12 at 28.)

This matter is not disputed; therefore it is proven.

14. The phrase "virtually free from interference" does not appear in the specifications of the Asserted Patents. (Ex. A, '258 Patent at 1:1-4:44; Ex. B, '391 Patent at 1:1-4:47; Ex. D, Order No. 12 at 24-25.)

Complainant does not dispute this fact; therefore it is proven.

15. The meaning of the phrase "virtually free from interference" is not discussed in the prosecution histories of the applications that led to the Asserted Patents. (Ex. E, File History

of '258 Patent at 1EWAY00000046–1EWAY00000516; Ex. F, File History of '391 Patent at 1EWAY00000517–1EWAY00000919.)

Complainant disputes this fact. Complainant argues the '885 patent history, which is both part of the intrinsic evidence and relevant, includes the following text:

As is agreed to by the Applicant and the Examiner, most recently discussed during the teleconference with the Examiner on June 3, 2009, Lavelle does not teach, disclose, or suggest such a relationship where *interference is virtually eliminated (e.g. where eavesdropping cannot occur)* where multiple receivers and transmitters occupy the same environment.

Complainant argues one of ordinary skill in the art would understand the foregoing excerpt discusses the meaning of the phrase “virtually free from interference” and cites Mr. McAlexander to this effect. (*Opposition – Response to Facts* at 9.) I find Complainant’s citation to Mr. McAlexander is irrelevant and improper, since Mr. McAlexander is not stating what the term “virtually free from interference” means to a PHOSITA in the Asserted Patents, but rather is construing the intrinsic evidence (the patent history of the '885 patent) to argue that history gives meaning to the term “virtually free from interference.” Since this is merely claims construction based upon Mr. McAlexander’s subjective reading (interpretation) of the '885 patent history, it is thus irrelevant and useless testimony. *General Protecht* at 1310-1311.

The argument concerning the '885 excerpt is the foundation of Complainant’s defense. As explained in Order No. 12, Complainant created this argument out of whole cloth (at 27). This is because Complainant’s quoted excerpt from the '885 patent has nothing to do with what “virtually free from interference” as a concept. Rather, the '885 patent (relevant to this excerpt) contains the term “free from interference” and this is the only term addressed in the history excerpt oft quoted by Complainant. Hence, Complainant’s argument, like Mr. McAlexander’s opinion, is based upon a faulty premise and ultimately must fail, for as I have often pointed out

herein, both terms cannot mean the same thing since they coexist in the Asserted Claims. Moreover, as previously mentioned, Complainant admits they have different meanings.

(*Opposition* at 26.)

In consideration of the foregoing I must find that this *SMF* is proven, for Complainant's argument in defense of its disputation of this fact is irrelevant, inapplicable, and not supported by the facts.

16. The specifications of the Asserted Patents describe a wireless digital audio system providing private listening or private audio enjoyment "without interference" from other users or wireless devices. (Ex. A, '258 Patent at Abstract, 1:64-66, 3:28-32; Ex. B, '391 Patent at Abstract, 2:1-3, 3:32-36; Ex. D, Order No. 12 at 25.)

Complainant does not dispute this fact; therefore it is proven.

17. The specifications of the Asserted Patents do not describe "private listening" or "private audio enjoyment" with a level of interference that is other than zero (*i.e.*, "without interference"). (Ex. A, '258 Patent at 1:1-4:44; Ex. B, '391 Patent at 1:1-4:47; Ex. D, Order No. 12 at 25.)

Complainant disputes this fact and quotes the following excerpt from the '391 Patent (*Memorandum*, Ex. B, at 3:32-39) in support, to wit:

Each receiver headphone **50** user may be able to *listen (privately)* to high fidelity audio music, using any of the audio devices listed previously, without the use of wires, and *without interference* from any other receiver headphone **50** user, even when operated within a shared space. The fuzzy logic detection technique **61** used in the receiver **50** could provide *greater user separation* through optimizing code division in the headphone receiver.

(emphasis by Complainant)(*Opposition – Responses to Facts* at 10.) According to Complainant, a PHOSITA "would understand that, when the patent specification refers to private listening "without interference" from other devices, it is teaching that private listening is achieved at

nonzero levels in interference, because greater separation is still possible.” (Citing Mr. McAlexander.) (*Id.*)

Complainant’s position is not supported by any relevant evidence and is legally incorrect. Respondents’ *SMF* is precise and accurate and it only equates the term “other than zero interference” to private listening. Respondents make no mention of nonzero interference or listening as having anything to do with private listening.

I note that while greater separation may be possible, the specification excerpt does not equate “greater user separation” with nonzero interference and private listening. Instead, the specification only equates private listening to the term “without interference” (zero interference). The remainder of the paragraph only discusses the possibility of greater user separation, nothing more. Hence, the specification paragraph Complainant cites from the ’391 Patent needs no further subjective (or speculative) interpretation by an expert. What is more, any reasonable reading of the Mr. McAlexander’s opinion shows no possibility that Complainant is advocating an expert opinion about the meaning of a specific term to a PHOSITA, especially the term at issue herein. Rather, Mr. McAlexander is defining or construing the last sentence of the paragraph to cover a situation that is not even mentioned therein.

Mr. McAlexander’s “interpretation” is also inconsistent with the intrinsic evidence. The only reference in the quoted excerpt to a term that could be argued to be found in the Asserted Claims is to the term “free from interference,” (zero interference²⁶) (presuming it means the same as “without interference.”) Thus, the concept of without interference is the subject of the paragraph with regard to “private listening.” There is no reference to “virtually free from interference,” even though Mr. McAlexander insists there is, because private listening could be

²⁶ Mr. McAlexander’s language - ¶ 24 of Exhibit A.

achieved through “nonzero levels of interference,” which he evidentially equates with “virtually free from interference” because greater user separation could equal a more private listening experience. (*Opposition*, Exhibit A, paragraphs 24-27.)

Complainant also argues private listening would not be understood to require “zero interference.” (*Id.*) This argument is grounded on the erroneous premise that private listening has something to do with the term “other than zero” (“virtually free from interference”) used by Respondents in *SMF* 17 because of how Mr. Mc Alexander interprets private listening can be achieved, not because Mr. McAlexander is telling us what the term “without interference” (or any other term in the excerpt) means to a PHOSITA.

The bottom line here is that Mr. McAlexander’s “creative” and also improper and irrelevant argument that private listening is described by something other than zero listening is wrong. It requires a strained extrapolation as to what is meant by the last sentence of the excerpt that has nothing to do with the meaning of the term to a PHOSITA and everything to do with the goal of connecting Respondents’ use of the term “less than zero” interference with private listening. Hence, I find this *SMF* as proven.

18. The specifications of the Asserted Patents do not mention “eavesdropping.” (Ex. A, ’258 Patent at 1:1-4:44; Ex. B, ’391 Patent at 1:1-4:47.)

This matter is not disputed; therefore it is proven.

19. The word “eavesdropping” is not discussed in the prosecution histories of the applications that led to the Asserted Patents. (Ex. E, File History of ’258 Patent at 1EWAY00000046–1EWAY00000516; Ex. F, File History of ’391 Patent at 1EWAY00000517–1EWAY00000919.)

Complainant disputes this fact. (*Opposition – Responses to Facts* at 11.) While the word “eavesdropping” appears in the ’885 patent history, the point precisely (and relevantly) made here by Respondents is that it is not *discussed*. (Eavesdropping merely appears in parenthesis, within the oft quoted excerpt from the ’885 patent history. Moreover, as explained in finding *SMF* 15, the reference is ultimately irrelevant because it does not apply to the term “virtually free from interference.” Thus, I find *SMF* 19 is proven.

20. As described in the Asserted Patents, the claimed invention may operate in the 2.4 GHz spectrum of the Industrial, Scientific and Medical (“ISM”) band. (Ex. A, ’258 Patent at 2:55-59; Ex. B, ’391 Patent at 2:59-63.)

This matter is not disputed; therefore it is proven.

21. The 2.4 GHz ISM band includes signals transmitted from many devices, including cordless phones, microwave ovens and 802.11 WLAN devices. (Ex. F, File History of ’391 Patent, Motorola’s Bluetooth Solution and Interference Rejection and Coexistence with 802.11, Application Note at 1EWAY00000588.)

Complainant disputes this *SMF* because it believes Respondents infer that all 2.4 GHz ISM band transmissions must be signals. (*Opposition – Responses to Facts* at 12.) I find no reason for Complainant’s dispute since I can find no suggestion that Respondents infer or otherwise suggest that transmissions can only be signals. Instead, Respondents only state that transmissions include signals without excluding any other kind of energy transmission. Thus, I find *SMF* 21 to be proven.

22. During prosecution of the application that led to the ’294 Patent, the applicant stated: “It is well known by those skilled in the art that radio frequency (RF) interference originates from a source (*i.e.*, transmitter) external to a RF signal path and produces undesired

artifacts in the RF signal.” (Ex. G, File History of ’294 Patent, Appeal Brief in Compliance with 37 CFR § 41.37 dated Dec. 22, 2007 at 1EWAY00002810.)

This matter is not disputed; therefore it is proven.

23. In the prosecution history of the application that led to the ’885 Patent, under the heading “Amendments to Claims 24, 25, 26 & 27,” in response to a rejection by the examiner of claims 24-27, the applicant stated:

As is agreed to by the Applicant and Examiner, most recently discussed during the teleconference with the Examiner on June 3, 2009, Lavelle does not teach, disclose, or suggest such a relationship where interference is virtually eliminated (e.g. where eavesdropping cannot occur) where multiple receivers and transmitters occupy the same environment.

(Ex. H, File History of ’885 Patent, Response dated June 30, 2009 at 1EWAY00005561; *see also* Response dated June 29, 2009 at 1EWAY00005583; Response dated June 16, 2009 at 1EWAY00005610; Response dated June 8, 2009 at 1EWAY00005628; *see also* Ex. D, Order No. 12 at 26.)

Complainant disputes this *SMF* as misleading. (*Opposition – Responses to Facts at 13.*) Complainant alleges it offered the same statement on multiple earlier occasions in connection with rejections of claims other than claims 24-27. Complainant also alleges the Office Action on which the statement was made in response to also included a rejection of Claim 17, which formed the foundation for the rejections of Claims 24-27. (*Id.*) Complainant’s offer of support for its contention is the declaration of Mr. McAlexander and his interpretation of matters of record.

Complainant’s allegation that its own interview summary is misleading is not well taken. (*See Reply at 2-3* discussing the responsibilities of an applicant.) Respondents only repeat what Complainant said and if the statement was misleading when said, then that is Complainant’s

problem and Complainant is *estopped* from disclaiming or changing the record at this point.

I also find no evidence in the intrinsic record to support Complainant's dispute or Mr. McAlexander's subjective *post hoc* musings on what was meant by the statement cited by Respondents. Specifically, as convincingly and logically noted by Respondents, the interview summary, while specifically referencing claims 12, 15, 16, 18, 22, and 24-27, fails to make any reference claim 17 at all (contrary to what Mr. McAlexander seemingly alleges in ¶¶ 31-32 of this Declaration). (*Reply* at 1-2.) Nor does the interview summary reference the "free from interference" limitation in claims 24-27, "much less the "virtually free from interference" limitation in claim 17. (*Id.*) As noted by Respondents, if the topics alleged to have been discussed in prior interviews as claimed by Complainant, there is nothing in the record to support such a conclusion and thus all that can exist is speculation. (*Id.*)

Mr. McAlexander's argumentative speculation or explanation of the intrinsic record is per se improper and irrelevant, for he is not offering an opinion on what a term meant to a PHOSITA, but rather construing clear language in the intrinsic record. *General Protecht* at 1310-1311. It is improper for Mr. McAlexander to "decode" a clear record by allegedly fulfilling the role of a PHOSITA and for Complainant to attempt to do so using him is unsuitable and unhelpful.

Based upon the foregoing, I find no material issue of fact can exist as to this *SMF* and it is therefore, proven.

24. At the time of the June 30, 2009 Response, claims 24-27 of the application that led to the '885 Patent included the term "free from interference," but not the term "virtually free from interference." (Ex. H, File History of '885 Patent, Response dated June 30, 2009 at 1EWAY00005557-1EWAY00005559; *see also* Response dated June 29, 2009 at

1EWAY00005579–1EWAY00005581; Response dated June 16, 2009 at 1EWAY00005603–1EWAY00005605; Response dated June 8, 2009 at 1EWAY00005624–1EWAY00005626; *see also* Ex. D, Order No. 12 at 26.)

This matter is not disputed; therefore it is proven.

25. In the June 30, 2009 Response, claims 24 and 25 were amended to read “free from interference from multiple CDMA wireless digital audio system transmitters ~~transmission sources and other device transmitted signals~~ operating in the wireless digital audio system spectrum,” and claims 26 and 27 were amended to read “free from interference from multiple CDMA transmission wireless digital audio system ~~sources and other device transmitted signals~~ operating in the wireless digital audio system spectrum.” (Ex. H, File History of ’885 Patent, Response dated June 30, 2009 at 1EWAY00005557–1EWAY00005559; *see also* Response dated June 29, 2009 at 1EWAY00005579–1EWAY00005581; Response dated June 16, 2009 at 1EWAY00005603–1EWAY00005605; Response dated June 8, 2009 at 1EWAY00005624–1EWAY00005626.)

Complainant disputes this *SMF* because Complainant believes Respondents have apparently made an error in not lining through the word “transmission” before the lined through word “wireless” in regard to the reference to Claims 26 and 27 of the June 30, 2009 response asserted by Respondents. (*Opposition - Responses to Facts* at 14.) Complainant does not appear to otherwise dispute the substance of the amendment. I accept Complainant’s correction as proffered and amend the *SMF* accordingly. Otherwise, I find no reason to dispute the fact alleged by Respondents and therefore find this *SMF* as proven with the noted correction. I note this change is not material to the matters raised by Respondents.

26. In his initial declaration submitted during claim construction briefing, Complainant's expert Joseph McAlexander does not express any opinion as to the meaning of "virtually free from interference" by itself to one of ordinary skill in the art at the time of the invention of the Asserted Patents. (Ex. I, Declaration of Joseph C. McAlexander III, P.E. submitted as Exhibit B to Complainant's Initial Claim Construction Brief.)

This matter is not disputed; therefore it is proven.

27. In his supplemental declaration submitted during claim construction briefing, Mr. McAlexander does not opine that the phrase "virtually free from interference" by itself has a specific meaning to one of ordinary skill in the art at the time of the invention outside the context of the Asserted Patents. (Ex. J, Supplemental Declaration of Joseph C. McAlexander III, P.E. submitted as Exhibit D to Complainant's Rebuttal Claim Construction Brief.)

Complainant disputes this *SMF* and alleges that Mr. McAlexander's supplemental declaration does include a detailed opinion regarding the meaning of "virtually free from interference" to a PHOSITA. (*Opposition – Responses to Facts* at 15, referring to ¶¶ 4-18 of Mr. McAlexander's Supplemental Declaration.)

I do not concur with the efficacy of Complainant's dispute as a matter of law.

Respondents carefully and correctly limited their *SMF* to say:

. . . Mr. McAlexander does not opine that the phrase "virtually free from interference" *by itself* has a specific meaning to one of ordinary skill in the art *at the time of the invention outside the context of the Asserted Patents*.

(emphasis added) I find Respondents are correct.

Mr. McAlexander proved incapable of establishing that a PHOSITA would know what the term "virtually free from interference" meant outside the context of what he *said* the Asserted Patents and the patent history of the '885 patent mean. In short, Mr. McAlexander provided a

plethora of irrelevant subjective musings as to why this language or that language (in the intrinsic evidence) as construed by him, meant “virtually free from interference” was connected to the fact that eavesdropping could not occur. This means Mr. McAlexander construed the term “virtually free from interference” based upon his own subjective reading of the specifications, not from what it meant to a PHOSITA at the time of the invention. This means that not only are Respondents perfectly correct, but that Mr. McAlexander’s musings are *per se* irrelevant. *General Protecht* at 1310-1311.

Based upon the foregoing, I find this *SMF* is conclusively established.

IX. ANALYSIS

A. Summary of the Material Facts

The following is a summary of the Material Facts I found in Section VIII, to wit:

SMF ¶ 1 establishes who the Complainant is and that a Complaint was filed for the violation of the Asserted Patents (the ’258 and ’391 Patents) at the ITC. In ¶¶ 2 and 3, Respondents that the ’258 is a continuation of the ’885 patent and the ’391 Patent is a continuation of the ’885 patent. Hence, the patent history of the ’885 patent is intrinsic evidence to this investigation, presuming a matter relevant thereto affects the Asserted Claims. However, as I found in Order No. 12, there is nothing material in the ’885 patent history concerning the meaning of “virtually free from interference.”

SMF ¶¶ 4 and 5 establish the Asserted Claims all contain the term “virtually free from interference.” *SMF* ¶¶ 6 and 7 explains how the term at issue is used in the ’391 Patent, *i.e.*, that is audio wirelessly transmitted and reproduced virtually free from interference, while other claims only require transmission virtually free from interference. As mentioned above, the device is transmitting in the wireless headphone spectrum.

SMF ¶¶ 8-11 discuss the '885 patent's use of the terms "free from interference" and "virtually free from interference" in various claims. These references establish the applicant knew how to use these terms in the '885 patent. (Complainant agrees these terms have a different meaning. (*Opposition* at 26.)

SMF ¶ 12 notes Order No. 12 found the term "virtually free from interference" to be indefinite. *SMF* ¶ 14 establishes the term "virtually free from interference" does not appear in the specifications of the Asserted Patents. *SMF* ¶ 15 proves the term at issue is also not discussed in the prosecution history of the Asserted Patents.

SMF ¶ 16 notes the Asserted Patents describe a wireless digital audio system providing private listening or private audio enjoyment "without interference." *SMF* ¶ 17 establishes the Asserted Patents do not describe "private listening" or "private audio enjoyment" at a level of interference of other than zero. Nor is "eavesdropping" (1) mentioned in the Asserted Patents or (2) discussed in the patent history of the Asserted Patents. (*SMF* ¶¶ 18 and 19.)

SMF ¶¶ 20-22 discuss the sources of radio interference mentioned in the Asserted Patents.

SMF ¶ 23 relates to the oft quoted text of the '885 Patent History that is the *sine qua non* of Complainant's construction. This excerpt, written by the applicant, relates only to amendments to Claims 24-27 of the '885 patent history. Claims 24-27 of the application included the term "free from interference," but not the term "virtually free from interference." (*SMF* ¶ 24.) Hence, the oft quoted excerpt can have no application to the term "virtually free from interference." In the June 30, 2009 Response, applicant amended Claims 24 and 25 to read: "free from interference from multiple CDMA wireless digital audio system transmitters ~~transmission sources and other device transmitted signals~~ operating in the wireless digital audio

system spectrum,” and claims 26 and 27 were amended to read “free from interference from multiple CDMA ~~transmission~~ wireless digital audio system sources and ~~other device transmitted signals~~ operating in the wireless digital audio system spectrum.” (*SMF* ¶ 25.)

SMF ¶¶ 26 and 27 prove Complainant did not offer the relevant evidence addressing the substance of this *Motion*. Specifically, Complainant still has presented no evidence that a PHOSITA could declare the term “virtually free from interference” by itself, has a specific meaning to that PHOSITA at the time of the invention outside the context of the Asserted Patents. Instead, Complainant offers Mr. McAlexander’s legal interpretation of what the intrinsic evidence means, including his interpretation of the oft cited excerpt from the ’885 patent history. As mentioned throughout this Order, Complainant’s attempt to have Mr. McAlexander legally construe the intrinsic evidence is legally forbidden, as it should be.

B. Application of the Law to the Material Facts

Respondents’ argument that the PTO’s failure to reject “virtually free from interference” limitation as indefinite, after rejecting many other limitations means the examiner understood the term, is ineffective. An examiner’s failure to reject a limitation in an application on ¶ 112 grounds cannot be the basis of finding that the examiner held the affirmative view that said limitation is not indefinite. Respondent’s argument is pure speculation. Moreover, even if it was not speculative, which it is, the standard I must apply in determining whether the limitation “virtually free from interference” is indefinite is whether the “claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention” (*see Nautilus*), not what the examiner thought about the limitation. Further, Complainant’s argument, to the extent it is true, relevant, or even capable of proof, is already part of the calculus that I must follow in evaluating

whether the Asserted Claims are invalid or not, *i.e.*, Respondents must prove indefiniteness (invalidity) by clear and convincing evidence. Beyond the proof standard, no other special consideration is required and I note Complainant offers no case law to support its argument.

The core of Complainant's defense remains its position that the oft quoted '885 patent history excerpt is somehow relevant to the term "virtually free from interference." Nothing has materially changed with regard to this argument from Order No. 12. However, Complainant has refined its argument concerning why the oft quoted reference from the '885 patent matters to include arguments that (1) the examiner's rejection of claims 24-27 was based on his rejection of claim 17, which recited a "virtually free from interference" limitation in addition to the "free from interference" limitation; (2) this rejection was the substance of an interview on June 3, 2009; (3) the applicant's "eavesdropping" remark in the subsequent June 2009 Amendment was based on the interview; and therefore (4) that remark must have been related to the "virtually free from interference" limitation in claim 17. Complainant's argument is void of any proof or logic. As Respondents convincingly explained in their *Reply* at 1-3, which I adopt, I find that (1) Complainant has **no** evidence to back up their speculation; and (2) logic undermines their contentions.

As I have explained throughout this Order, Complainant has wrongly sought to connect "virtually free from interference" to the '885 patent history through the declaration of its expert, Mr. McAlexander who repeatedly offered his opinions on the meaning of the prosecution history in his declaration. (*Opposition* at Ex. A.) As found throughout this Order, this kind of legal analysis is inappropriate and irrelevant under *General Protecht*. Respondents also noted this point and correctly asserted it is likewise proscribed under *Teva Pharm. USA, Inc.* at 1342

(“Determining the meaning or significance to ascribe to the legal writings which constitute the intrinsic record is legal analysis.”).

There is **no** evidence to connect the patent history of the ‘885 patent to the term “virtually free from interference.” Instead, the evidence establishes the term discussed in the patent history is “free from interference,” a term Complainant concedes has a different meaning. Absent this connection, which I have found absent, Complainant’s arguments and the declaration of Mr. McAlexander, fall apart.

Nor do I (or Respondents) use the “e.g.” reference in the oft quoted ‘885 patent history to define the term “virtually free from interference” or “free from interference” as Complainant wrongly argues. (*See Opposition* at 30.) It has been my holding since issuing Order No. 12 that nothing in the oft quoted ‘885 patent history reference matters since it is not even addressing the issue of “virtually free from interference,” but is instead addressing “free from interference.” Hence, Complainant’s point is a nullity.

The term “virtually free from interference” presents a fact pattern far different from the cases that Complainant cites to argue the term is definite. Perhaps the starkest example is Complainant’s citation to *Ethicon*. (*Opposition* at 40-41.) As Respondents cogently point out, the patent at issue in *Ethicon*, which contained examples of objective limits and boundaries and implicates a clear understanding of the disputed term to persons of ordinary skill in the art, bears no relationship to the Asserted Patents and I adopt Respondents’ analysis and logic herein, which discusses just how inapposite Complainant’s argument is concerning *Ethicon*.²⁷ It is far different for an expert (as in *Ethicon*) to explain the underlying physics and mathematics of how clamping pressures may be calculated after relying upon detailed disclosures in the specification than, as is

²⁷ Respondents’ contentions on this point are summarized, *supra*, in section VII(D)(3).

the case here, for an expert to speculate upon the meaning of a term based upon questionable re-interpretation of the prosecution history and of extrinsic references, when there is simply no discussion of how much interference is permitted to achieve the virtually free state. Unlike in *Ethicon*, here there is absolutely no guidepost for a PHOSITA to discern with reasonable certainty the meets and bounds of the limitation “virtually free from interference.”

Complainant also seems to argue that *Apple*, *DDR Holdings*, and *Eidos Display* support its arguments of definiteness. (*Opposition* at 30.) I disagree.

The term in *Apple* was found definite because there was an example embodiment that contained sufficient detail so that the term “substantially centered” had sufficient meaning to be understood and applied. *See Apple*, 786 F.3d at 1002-03. This is entirely unlike “virtually free from interference” where there is no information in the Asserted Patents that would help a PHOSITA to discern with reasonable certainty what is meant by “virtually free of interference.”

Nor does *DDR Holdings* help Complainant. In *DDR Holdings* the term was found definite because the claim term “visually perceptive elements” was based upon consistent examples in the specifications as well as an established meaning in the art. *See DDR Holdings*, 773 F.3d at 1259-61. The facts in *DDR Holdings* are inapposite of the facts here. Here, there are no examples of in the specification that would shed any light on the metes and bounds of “virtually free from interference.” In fact, as already discussed, the limitation “virtually free from interference” is not mentioned even once in the specifications of the Asserted Patents. Further, unlike in *DDR Holdings*, I have found, *supra*, the limitation “virtually free of interference” has no established meaning in the relevant art.

Eidos Display is likewise inapplicable to the current facts. That case again involved a situation where there were consistent exemplary embodiments that provided sufficient clarity as

to the meaning of the term “a contact hole for source wiring and gate wiring connection terminals.” *Eidos Display*, 779 F.3d at 1364-68. In addition, “no party dispute[d] that the state of the [relevant] art always had been to form contact holes for source wiring connection terminals that are separate from contact holes for gate wiring connection terminals.” *Id.* at 1365. Thus, the court could determine the particular physical attribute of the claimed contact hole given the series of consistent embodiments and the undisputed understanding of persons of ordinary skill in the art. In contrast, the term “virtually free from interference” has no established meaning in the relevant art, and no description, limits, or explanation, anywhere in the Asserted Patents, of how much would be sufficient to satisfy the “virtually free from interference” term.

I have also considered Complainant’s attempts to distinguish *Interval Licensing*, *Teva*, and *Sinorgchem*. (See *Opposition* at 30-31 (citing *Interval Licensing*, 766 F.3d at 1371-73; *Teva*, 789 F.3d 1335; *Sinorgchem*, 511 F.3d 1132).) Complainant is correct in describing the Federal Circuit’s indefiniteness holding in *Interval Licensing* for a “facially subjective” claim term, but again, Complainant glosses over the point that the source of the “e.g.” (the oft quoted ’885 excerpt) has no relationship to the term at issue, *i.e.*, it applies to “free from interference” and not “virtually free from interference.” Hence the distinction is really unnecessary. Nor am I the slightest bit persuaded there is anything unambiguous about the use of the term at issue, because there is absolutely no guidance concerning the “virtually free for interference” term in either the Asserted Patents or the patent history and as I have already found the limitation has no established meaning in the relevant art.

With regard to *Sinorgchem*, Complainant generally describes the holding correctly, but again misses the mark because of its incorrect insistence that the “e.g.” used in the ’885 patent

history is applicable to the term at issue. This is yet another example of how the predicate of Complainant's case, the '885 patent history, incorrectly colors every argument it makes. Further, while the patent specification in *Sinorgchem* stated "e.g., up to about 4% H₂O," it also included express definitional language that "[w]hen aniline is utilized as a solvent . . . , the upper limit is 4% H₂O." See *Sinorgchem*, 511 F.3d at 1136n.2, 1138. No such guideposts are present in the Asserted Patents or prosecution history to salvage the term "e.g." in this case, even if it did matter.

I note Complainant's argument that its construction of "virtually free from interference" has been consistent across the claims. (*Opposition* at 31-36.) This argument, like the entirety of Complainant's case relies completely on the efficacy of its arguments concerning the oft quoted excerpt from the '885 patent history. As I have consistently found since issuing Order No. 12 and throughout this Order, the oft quoted '885 patent history is inapplicable and irrelevant to the term "virtually free from interference." Accordingly, this argument can have no effect on this Order.

Complainant also argues how *Nautilus* should be applied to the term at issue. (*Opposition* at 36-40.) In that section of its argument, Complainant continues to apply the prism of the oft quoted excerpt of the '885 patent history to its argument. (*Id.* at 37.) Since I found this argument has no validity, neither do Complainant's arguments.²⁸

Intertwined with Complainant's discredited patent history argument is its insistence that

²⁸ I further note that *Nautilus* held that "definiteness is measured from the viewpoint of a person skilled in [the] art at the time the patent was filed." *Nautilus*, 134 S.Ct. at 2128 (emphasis in original). Thus, I question whether Complainant's reliance on a statement made during prosecution history, *i.e.*, after the effective filing date of the Asserted Patents (which is the same as that of their '885 parent patent) would be sufficient to cure the deficiencies under 35 U.S.C. § 112, ¶ 2, of the Asserted Patents as filed. See also *Biogen, Inc. v. Berlex Laboratories, Inc.*, 318 F.3d 1132, 1140 (Fed. Cir. 2003) ("Representations during prosecution cannot enlarge the content of the specification . . .").

the absence of a lexicographic definition (within the intrinsic evidence) does not make a term indefinite. (*Id.* at 40.) Accepting this premise does not help Complainant, even considering the case law it has cited, *i.e.*, *Deere*, *Verve*, *Ecolab*, *Andrew*, and *Seattle Box*, all of which involved terms of degree. All of these pre-*Nautilus* cases are inapposite. While I agree that terms of degree, including “virtually,” are not *per se* indefinite, under *Nautilus*, I must still determine whether the Asserted Patents’ “claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus*, 134 S.Ct. at 2129. Such an inquiry cannot be accomplished with one-size-fits-all principles (*see, e.g., Andrew*, 847 F.2d at 821 (“The criticized words are ubiquitous in patent claims . . . [and] have been accepted in patent examination and upheld by the courts.”)), but requires a case-by-case analysis of the specification, patent history, and understanding of persons having ordinary skill in the art. In the present case, as discussed above and in Order No. 12, the disputed term has no specific meaning in the relevant art, the specification is devoid of any guidance to inform those skilled in the art about the scope of the invention, and the prosecution history fails to cure the deficiencies under 35 U.S.C. § 112, ¶ 2. *See also, supra*, n. 28.

C. Overview

Nothing has changed to alter the findings, analysis, or conclusions of Order No. 12. The term “virtually free from interference” is not defined in the Asserted Patents or their history. Nor does the term “virtually free from interference” have an understood meaning in the relevant art. As found in Order No. 12, there simply is no guidepost for a PHOSITA to discern with any certainty, much less the reasonable certainty required by the law, the metes and bounds of the limitation “virtually free from interference.” Hence, the paramount problem with the term

“virtually free from interference” remains that the evidence clearly and convincingly establishes there is **nothing** in the intrinsic or extrinsic record that provides a guidepost that would inform, with reasonable certainty, a PHOSITA of the scope of the invention (*i.e.*, its metes and bounds). (*SMF* ¶¶ 8 -15, 24, 26, and 27.) The utter lack of any guidepost defeats the public notice requirement of patents. No one could discern from the term, the Asserted Claims, the Asserted Patent specifications, and the Asserted Patent history what degree of interference constitutes “virtually free from interference.” The standard set out by the Supreme Court in *Nautilus* requires that a PHOSITA be able to discern with “reasonable certainty” the scope and meaning of the claims. (*Nautilus* at 1379.) Here, the evidence shows there is no certainty, much less the reasonable certainty required under the law. Accordingly, I find the term “virtually free from interference” in the Asserted Claims indefinite because there is no guidepost in the intrinsic or extrinsic evidence from which a PHOSITA could discern the scope of the limitation.

I have carefully considered the contentions of the parties. I find those of the Respondents and the Staff to be cogent, logical, relevant, and persuasive. What is more, I find the filings of the Respondents and Staff are both legally and factually correct and thus dispositive of Respondents’ Motion for Summary Determination. I note in particular that Respondents’ short *Reply* was completely effective in its purpose.

Opposed to the cogent and logical arguments of Respondents and the Staff are Complainant’s arguments concerning the intrinsic evidence, extrinsic evidence, and the law. Unfortunately for Complainant, its arguments are, at their core, illogical and unsupportable. Compounding this is the fact that Complainant’s *Opposition* is verbose and predicated upon a morass of irrelevant premises, argument, and evidence, which all lead back to the oft quoted excerpt from the history of the ’885 patent.

In particular, I find Complainant's arguments concerning private listening to be logically flawed – even irrelevant. (e.g., *Opposition* at 13-14.) In making this argument Complainant not only ignores its own admission that the terms “free from interference” and “virtually free from interference” have different meanings (*Opposition* at 26.), but also the fact that the terms “virtually free from interference” and “free from interference” exist together in ‘885 patent that Complainant so often cites, and thus should have different meanings. See *CAE Screenplates, Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”). Consequently it is irrelevant whether or not private listening can occur with greater than zero interference, for the question remains whether the term “virtually free from interference” is defined as required by *Nautilus*.. What is more, the *sine qua non* of this argument is still the non-existent connection between the ‘885 patent history and the term “virtually free from interference,” the source of the private listening argument. Hence, anything bootstrapped from the incorrect argument concerning the oft quoted ‘885 patent history excerpt (as explained as far back as in Order No. 12) fails. See also, *supra*, note 28.

Compounding this “nothingness” with regard to the term at issue is Complainant's interjection of the word “eavesdropping” into the fray as part of its construction. As Respondents clearly establish, the word “eavesdropping” is not defined in the intrinsic record and it is only mentioned once – in parenthesis, in the ‘885 patent history. (*SMF* 18 and 19.) While we all generally understand what it means to eavesdrop,²⁹ there is no predicate or explanation in the intrinsic evidence for its use in Complainant's construction. Nor does the intrinsic evidence contain any objective standard or measure by which to determine whether or

²⁹ The dictionary definition mostly ascribed is: “to listen secretly to a private conversation of others.” (Merriam-Webster, among others.)

not there is eavesdropping, which begs the question how much eavesdropping, like interference, is enough. Thus, Complainant's reliance on eavesdropping in its proposed construction only serves to substitute one indefinite term for another.

Moreover, because "virtually free from interference" has an admittedly different meaning from the term "free from interference," Complainant's proposed construction equating "virtually free from interference" with "no eavesdropping" leads to the absurd result that "free from interference" must mean something less than "no eavesdropping." This, of course, is impossible and serves to further highlight the fallacy of Complainant's argument in opposition to the motion for summary determination.

Moreover still, as I noted in Order No. 12, with regard to the limitation "virtually free from interference" the claims are drafted in two different manners. For example, claim 3 of the '391 patent recites in pertinent part "said audio having been wirelessly transmitted from said radio player virtually free from interference ...," while claim 1 of the '391 patent recites "said audio having been wirelessly transmitted and reproduced virtually free from interference." Complainant's proposed construction and supporting argument focuses entirely on the requirement of claim 3 that the audio must be "reproduced" virtually free from interference, but entirely ignores the explicit requirement of both claims 1 and 3 that the transmission of that audio from the transmitter to the receiver must also be virtually free from interference. Patent jurisprudence requires the limitation "virtually free from interference" be construed consistently in both contexts, yet there is nothing in the intrinsic record that teaches, explains or discusses how the invention can "transmit" the audio virtually free from interference, much less how the invention can "transmit" and "reproduce" the audio virtually free from interference.

D. Conclusion

I find the *SMF* prepared by Respondents are: (1) material and relevant to the question of whether “virtually free from interference” is indefinite; and (2) conclusively established. Therefore, after applying the existing law, I find as a matter of law that the term “virtually free from interference” is indefinite under 35 U.S.C. § 112, ¶ 2. Consequently, it is my Initial Determination that Motion No. 943-015 is hereby GRANTED.

Because the limitation “virtually free from interference” is found in each of the Asserted Claims of the Asserted Patents, my Initial Determination that the limitation is indefinite, means that all of the Asserted Claims in this investigation are invalid under 35 U.S.C. § 112, ¶ 2. Thus, no violation of 19 U.S.C. § 1337 can be found. Accordingly, it is also my Initial Determination that a violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, has not occurred in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain Wireless Headsets under asserted claim 8 of U.S. Patent No. 7,865,258 and asserted claims 1, 3-6, and 10 of U.S. Patent No. 8,131,391.

This Initial Determination, along with supporting documentation, is hereby certified to the Commission. Pursuant to 19 C.F.R. § 210.42(h), this Initial Determination shall become the determination of the Commission unless a party files a petition for review of the Initial Determination pursuant to 19 C.F.R. § 210.43(a), or the Commission, pursuant to 19 C.F.R. § 210.44, orders, on its own motion, a review of the Initial Determination or certain issues herein.

SO ORDERED.



Thomas B. Pender
Administrative Law Judge

CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **PUBLIC ORDER NO. 17 INITIAL DETERMINATION** has been served upon the **Commission Investigative Attorney, Vu Bui, Esq.**, and the following parties as indicated on SEP 21 2015



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112A
Washington, DC 20436

FOR COMPLAINANTS ONE-E-WAY, INC.:

Douglas G. Meulhauser, Esq.
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvin, CA 92614

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

FOR RESPONDENTS SONY CORPORATION, SONY CORPORATION OF AMERICA, AND SONY ELECTRONICS, INC.

Paul T. Qualey, Esq.
KENYON & KENYON LLP
1500 K Street, N.W.
Washington, DC 20005

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

FOR RESPONDENT GN NETCOM A/S d/b/a JABRA

William B. Nash, (pro hac vice)
HAYNES & BOONE LLP
112 East Pecan, Suite 1200
San Antonio, TX 78205

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

FOR RESPONDENTS CREATIVE LABS, INC. & CREATIVE TECHNOLOGY LTD.

Jonathan Baker, Esq.
FARNEY DANIELS PC
411 Borel Avenue Suite 350
San Mateo, CA 94402

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: _____

**FOR RESPONDENTS BLUEANT WIRELESS PTY, LTD. AND
BLUEANT WIRELESS, INC.**

Duane H. Mathiowetz, Esq.
NOVAK DRUCE CONNOLLY BOVE & QUIGG LLP
555 Mission Street, 34th Flr.
San Francisco, CA 94105

Via Hand Delivery
 Via Express Delivery
 Via First Class Mail
 Other: _____

FOR RESPONDENTS ALIPHCOM d/b/a JAWBONE, INC.

Stephen R. Smith
COOLEY LLP
1299 Pennsylvania Ave., NW
Suite 700
Washington, DC 20004

Via Hand Delivery
 Via Express Delivery
 Via First Class Mail
 Other: _____