

Keywords: infringement; claim construction; extrinsic evidence; validity; 112-6 structure.

General: To define a word in a claim, first consider surrounding claim language and ordinary meaning (i.e., via a dictionary) prior to consulting the written description and prosecution history. Furthermore, for a 112, para. 6 claim, a single structure disclosed in the specification may support (be linked to) more than one function in the claim.

Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.
67 U.S.P.Q.2d 1385 (Fed. Cir. 2003)
Decided July 21, 2003

I. Facts

Intellectual Property Development (IPD) is the exclusive licensee of a patent directed to “Broadcast Systems with Fibre Optic Transmission Lines,” the patent asserting an improvement over the two conventional wired broadcast systems – (1) coaxial cable and (2) twisted pairs of conductors within a common cable. Communications Patents Ltd is the owner of the patent. The defendant Cablevision (including TCI) owned and/or operated cable television systems in the very high frequency (VHF) range, i.e. 30-300 MHz, throughout the U.S. On 9/1/94, IPD sued Cablevision for infringement of the patent (‘202 patent). Cablevision counterclaimed for a declaratory judgment of non-infringement and invalidity.

In the infringement analysis, the claim term at issue was “high frequency carrier.” Specifically, the question was whether “high frequency” (HF) was limited to 3-30 MHz, or did the term also encompass the VHF range. The district judge (SDNY) consulted a dictionary to determine that HF was a term of art limited to a range of 3-30 MHz and did not encompass the higher VHF range. Thus, the district judge concluded no infringement by Cablevision of the ‘202 patent and granted summary judgment to the defendant Cablevision.

The district judge also granted summary judgment to the defendant Cablevision on the validity issue, ruling that claim 1 (the only independent claim and the only claim in issue) was invalid because it failed to meet the definiteness requirement of 112, para. 2. The district judge held that the 202 patent failed to disclose a structure linked to the claim element, “light beam demodulation means,” thus rendering claim 1 indefinite. He ruled that a single structure (a “photo-sensitive detector”) could not support both “light demodulation means” and “photo-sensitive detector means” as asserted by IPD. The district judge also determined that the “common optical fibre” limitation in claim 1 was indefinite. He asserted that one skilled in the art would understand the “common optical fibre” limitation in claim 1 to require a common optical fiber to extend between the electro-optical transducer and photo-sensitive detector, but also to do so via separate, non-common vertical splints. The district judge concluded that the internal inconsistencies of that interpretation – the requirement of a common fiber, achieved through the use of non-common connections – rendered the “common optical fibre” limitation indefinite.

II. Issues

1. In the infringement analysis, did the district court erroneously resort to selected extrinsic evidence, including dictionaries, to construe the term “high frequency” in the range of 3-30 MHz? (The issue of infringement turned solely on claim construction.)

2a. Did a single common structure (photo-sensitive detector) disclosed in the ‘202 patent specification support two means-plus-function limitations of claim 1?

2b. Is the “common optical fibre” limitation of claim 1 indefinite – is it inconsistent for a “common” fiber shared by two or more TV subscribers to have branching to the various TV subscribers?

III. Discussion

1. No. Affirmed for defendant Cablevision on non-infringement. In construing claims, the analytical focus must begin and remained centered on the language of the claims themselves, and in the absence of an express intent to impart a novel meaning to claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. Such meaning may be determined by reviewing a variety of sources (in the following order): (1) the claims themselves; (2) dictionaries and treatises (i.e., objective, unbiased resources); and (3) the written description, the drawings, and the prosecution history. The Federal Circuit asserted that to consult the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of their precedent counseling against importing limitations into the claims. In the present case, the dictionary definition of “high frequency” is 3-30 MHz, and nothing in the written description expressly re-defined “high frequency.”

2a. Yes. Reversed for plaintiff IPD on invalidity. The claims of a patent are afforded a statutory presumption of validity, which can only be overcome by clear and convincing evidence. In the present case, there is no issue of fact as both parties’ experts agree that the claimed “light beam demodulation means,” which performs the function of converting the light beam into demodulated high frequency carrier radio wave signals modulated with video broadcast signals – is performed in the photo-sensitive detector. The specification and prosecution history clearly links and associates this demodulation function to the photo-sensitive detectors (structure). See footnote 9.

2b. No. Reversed for plaintiff IPD on invalidity. The district court erred in holding the “common optical fibre” limitation indefinite. The determination of whether a claim is invalid as indefinite “depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification.” In this case, one skilled in the art would understand the scope of the claim when the claim is read in light of the specification. The common optical fiber is a fiber that carries signals for a plurality of subscribers and that it extends between the transducer and the detector. A single fiber extending over a large distance need not be unitary continuous strand of glass. Thus, even if the Fiber (Fig. 1) were viewed as consisting of a horizontal segment with a vertical segment of fiber branching off from it, that would not preclude a person skilled in the art from considering such a multi-segment fiber leading to the detector to be a single “optical fibre” that is common to (i.e., shared by) the end-users served by it.