

EXHIBIT 9

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United States District Court
For the Northern District of California

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

Acacia Media Technologies Corp.,

NO. C 05-01114

Plaintiff,

**ORDER RE: MOTIONS FOR
RECONSIDERATION OF CLAIM
CONSTRUCTION ORDER; FIFTH CLAIM
CONSTRUCTION ORDER**

vs.

New Destiny Internet Group, et al.,

Defendants.

And All Related and/or Consolidated
Actions.
_____ /

The Court has issued a series of Orders construing the words and phrases of the patents-in-suit. This Order addresses motions for reconsideration of several phrases.

I. STANDARDS

During the process of this litigation, the Court has stated the legal standards upon which it relies for construction of patent claims. The Court recites them here for convenience of reference.

A. General Principles of Claim Construction

Claim construction is a matter of law, to be decided exclusively by the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370, 387 (1996). When the meaning of a term used in a claim is in dispute, the Court invites the parties to submit their respective proposed definitions and a brief, outlining the basis for their proposals. In addition, the Court conducts a hearing to allow oral argument of the respective proposed definitions. After the hearing, the Court takes the matter under

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4. "storing"

The Court has been requested to reconsider its construction of the word "storing" as used in Claim 41, which provides:

A method of transmitting information to remote locations, the transmission method comprising the steps, performed by a transmission system, of:

storing items having information in a source material library;

In the Third Claim Construction Order, the Court construed the phrase "storing items having information in a source material library" to mean "placing physical items containing audio information or video information or both into a collection or original sources of information."

(Third Markman at 30.) The Court has been persuaded to reconsider its construction.

Claim 41 recites "storing" items in a source material library as the first step in the process. The Preamble requires that "storing" be "performed by the transmission system." The issue is whether the word "storing" should be construed to mean that the transmission system performs a manipulative step of "placing" items into the source material library, or whether the word should be construed to mean that the transmission system performs the step by "retaining" the items in the source material library. Plaintiff now requests that the Court re-interpret "storing" to mean "retaining." Plaintiff contends that both interpretations are supported by the plain ordinary meaning and use of the word "storing," but that "retaining" is the only interpretation which is supported by the specification.¹³

The words "to store" and "storing" are commonly used words with plain and ordinary meanings. Among others, the act of "storing items" means placing the items in a location."¹⁴ See WEBSTER'S NEW TWENTIETH CENTURY DICTIONARY, 1796 (2d ed. 1983). However, as pointed out by Plaintiff, another interpretation of "storing items" is "retaining items." The "placing" interpretation is appropriate when the phrase "storing items" is being used to describe the act of

¹³ During the course of the litigation, Plaintiff has asserted various constructions of the term. Plaintiff is once again asking the Court to construe "storing" to mean "retaining."

¹⁴ For the reasons stated in its Third Claim Construction Order, this was the interpretation used by the Court.

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1 putting the items in a location. The “retaining” interpretation is appropriate when the phrase
2 “storing items” is used to describe holding the items secure or intact in a place or condition.

3 The process of placing items in a location and retaining items are sufficiently different from
4 each other as to make it important to determine which process was meant by the inventors. In
5 making a determination of which interpretation to adopt, the Court notes that the phrase is used in a
6 step of a method claim. Although it might be subject to limitations, a step in a method claim must
7 be an act performed by an actor on a workpiece:¹⁵

8 A very important rule to remember is that the “elements” of a method claim instead
9 of being structural parts, are, and must be, acts or manipulative steps that are
performed upon an article, workpiece or chemical substance.

10 5 ROBERT C. FABER, LANDIS ON MECHANICS OF PATENT CLAIM DRAFTING, 4-2 (2006).

11 Either interpretation of “storing items” (“placing” the items in a location or “retaining” the
12 items in a location or condition) is a manipulative step. The Preamble of Claim 41 expressly
13 provides that each step, including the step of “storing” must be performed by the “transmission
14 system.” Thus, under either interpretation, in performing the step of “storing” the “transmission
15 system” is acting on a workpiece (items).

16 Upon reconsideration, the Court has determined that the interpretation of “storing items” to
17 mean “placing items” is problematic because the specification does not contain any description of
18 how the transmission system places items into the system. On the other hand, a person of skill in the
19 art reading the specification at the time of the invention, might find support in the specification for
20 interpreting “storing items” to mean “retaining items,”¹⁶ because the specification discloses a
21 component of the “transmission system,” i.e., the “source material library” as a component which
22 holds items. Thus, there is a basis for a skilled artisan to determine that when the inventors claimed
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25 ¹⁵ Plaintiff objects to this proposition. To support its position that elements of process
26 claims need not be manipulative steps, Plaintiff contends that the step of “leaving” baked goods in
27 an oven is not manipulative. The Court rejects Plaintiff’s hypothetical as illustrative of non-
manipulative conduct. A manipulative step is a step in a process performed by an actor upon a
workpiece. If the actor in Plaintiff’s hypothetical “leaves” an item in a oven for a period of time
during the baking process, active conduct is being performed.

28 ¹⁶ When possible claim language should be construed to preserve validity of the claim. See
Texas Instruments v. U.S. International Trade Commission, 871 F.2d 1054 (Fed. Cir. 1989).

1 a process in which the “transmission system” performs the step of “storing items having information
2 in a source material library,” the inventors might have meant that the “transmission system” was
3 “retaining the items” in the source material library. At this point, the Court does not decide nor does
4 Plaintiff point out what disclosed features of the “transmission system” enable it to perform
5 “retaining” activity.¹⁷ The Court leaves enablement or definiteness for consideration later if a
6 motion addressing the issue is brought before the Court.

7 Accordingly, the Court vacates its construction of the phrase “storing items having
8 information” in its Third Claim Construction Order.

9 The Court now construes the phrase “storing items having information” to mean:

10 **an act performed by the “transmission system” of retaining physical items
11 containing audio information or video information or both as a collection of
12 original sources of information in the source material library.**

12 **B. Additional Briefing Regarding Claim 45 of the ‘992 Patent**

13 In the Third Claim Construction Order, the Court declined to construe the meaning of the
14 phrase “separately storing a plurality of files” as it is used in dependent Claim 45 of the ‘992 Patent.
15 In their memorandum regarding the present motions, the parties have addressed the Court’s
16 declination to construe Claim 45. However, no formal motion is made by either party with respect
17 to the matter. Accordingly, the Court declines to take any action with respect to Claim 45 at this
18 time.

19 **C. Disposition of Pending Motions**

20 Previously, Plaintiff filed a Motion for Entry of Judgment of Non-Infringement and
21 Invalidity for Indefiniteness of U.S. Patent No. 6,144,702 and for Certification Pursuant to Federal
22 Rule of Civil Procedure 54(b) in which Defendants opposed. (See Docket Item Nos. 121, 133.)
23 Since the motion was made prior to completion of claim construction, it is DENIED without
24 prejudice to being renewed upon completion of claim construction.

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27 ¹⁷ The specification is silent as to what component of the “transmission system” is capable of
28 performing the “retaining” step. With respect to storing physical items having information, the only
component discussed in the specification is the “source material library” itself. However, the
“source material library” is only described as containing a collection of items having information.
See e.g., ‘992 Patent, Col. 6:8-22.