

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

**INTELLECTUAL VENTURES I LLC,
INTELLECTUAL VENTURES II LLC,
Plaintiffs,**

v.

**ZEBRA TECHNOLOGIES
CORPORATION,**
Defendant.

W-23-CV-00292-ADA

CLAIM CONSTRUCTION ORDER

Before the Court are Zebra Technologies Corporation (“Zebra’s”) and Intellectual Ventures’ (“IV’s”) claim construction briefings in the above captioned matter. Dkts. 43, 45, 47, 49, 50. The patents-in-suit are U.S. Patent Nos. 7,325,140 (“the ‘140 patent”); 8,474,016 (“the ‘016 patent”); 7,089,443 (“the ‘443 patent”); 7,623,439 (“the ‘439 patent”); and 7,646,835 (“the ‘835 patent”). Pursuant to this Court’s Order Governing Proceedings, the parties were given the Court’s preliminary constructions via email on May 21, 2024. The parties then notified the Court that no hearing was necessary, and they would rest on their briefing. The Court enters this memorandum order to memorialize the rulings of the Court.

I. LEGAL STANDARD

A. General Principles

The general rule is that claim terms are generally given their plain-and-ordinary meaning. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*); *Azure Networks, LLC v. CSR PLC*, 771 F.3d 1336, 1347 (Fed. Cir. 2014), *vacated on other grounds*, 575 U.S. 959, 959 (2015) (“There is a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time.”) (internal quotation omitted). The plain-and-ordinary

meaning of a term is the “meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips*, 415 F.3d at 1313.

The “only two exceptions to [the] general rule” that claim terms are construed according to their plain-and-ordinary meaning are when the patentee (1) acts as his/her own lexicographer or (2) disavows the full scope of the claim term either in the specification or during prosecution. *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). The Federal Circuit has counseled that “[t]he standards for finding lexicography and disavowal are exacting.” *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014). To act as his/her own lexicographer, the patentee must “clearly set forth a definition of the disputed claim term” and “‘clearly express an intent’ to [define] the term.” *Thorner*, 669 F.3d at 1365.

“Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent.” *Phillips*, 415 F.3d at 1317. In “distinguishing the claimed invention over the prior art, an applicant is indicating what a claim does not cover.” *Spectrum Int’l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1379 (Fed. Cir. 1998). The doctrine of prosecution disclaimer precludes a patentee from recapturing a specific meaning that was previously disclaimed during prosecution. *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003). “[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable.” *Id.* at 1325–26. Accordingly, when “an applicant’s statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable.” *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013).

A construction of “plain and ordinary meaning” may be inadequate when a term has more than one “ordinary” meaning or when reliance on a term’s “ordinary” meaning does not resolve

the parties' dispute. *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008). In that situation, the Court must describe what the plain-and-ordinary meaning is. *Id.*

“Although the specification may aid the court in interpreting the meaning of disputed claim language..., particular embodiments and examples appearing in the specification will not generally be read into the claims.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988). “[I]t is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004).

Although extrinsic evidence can be useful, it is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004)). Technical dictionaries may be helpful, but they may also provide definitions that are too broad or not indicative of how the term is used in the patent. *Id.* at 1318. Expert testimony may also be helpful, but an expert's conclusory or unsupported assertions as to the meaning of a term are not. *Id.*

B. Preambles

Courts presume that the preamble does not limit the claims. *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010). But “[i]n general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). “Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention

in the claim body and uses the preamble only to state a purpose or intended use for the invention.” *Catalina Mktg.*, 289 F.3d at 808 (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)). The Federal Circuit has provided some “guideposts” regarding whether the preamble is limiting: (1) preamble provides antecedent basis, (2) preamble is essential to understand limitations or terms in the claim body, (3) preamble recites “additional structure or steps underscored as important by the specification,” and (4) “clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art.” *Id.*

C. Indefiniteness

“[I]ndefiniteness is a question of law and in effect part of claim construction.” *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir. 2012). Patent claims must particularly point out and distinctly claim the subject matter regarded as the invention. 35 U.S.C. § 112, ¶ 2. A claim, when viewed in light of the intrinsic evidence, must “inform those skilled in the art about the scope of the invention with reasonable certainty.” *Nautilus Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). If it does not, the claim fails § 112, ¶ 2 and is therefore invalid as indefinite. *Id.* at 901. Whether a claim is indefinite is determined from the perspective of one of ordinary skill in the art as of the time the application was filed. *Id.* at 911.

In the context of a claim governed by § 112, ¶ 6, the claim is indefinite if the claim fails to disclose adequate corresponding structure to perform the claimed functions. *Williamson*, 792 F.3d at 1351–52. The disclosure is inadequate when one of ordinary skill in the art “would be unable to recognize the structure in the specification and associate it with the corresponding function in the claim.” *Id.* at 1352. Computer-implemented means-plus-function claims that require an algorithm are indefinite unless the specification discloses an algorithm to perform the function associated with the limitation. *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1319 (Fed. Cir. 2012).

II. CLAIM CONSTRUCTION

A. Preambles ('835 Patent, Claims 1, 7, 12, 20, and 23)

IV's Proposed Construction	Zebra's Proposed Construction	Court's Construction
Preamble is not limiting	Preamble is limiting	Preamble is not limiting.

The '835 Patent relates to adjusting the timing of various signals for an integrated circuit. '835 Patent at Abstract. Zebra argues the preambles of these claims are limiting based on the prosecution history of the '835 Patent and references to the “present invention” in the specification. Dkt. 43 at 5–9. The Court disagrees. The preambles are not limiting because the claims define “a structurally complete invention in the claim body and use[] the preamble only to state a purpose or intended use for the invention.” *Catalina Mktg.*, 289 F.3d at 808 (quoting *Rowe*, 112 F.3d 73 at 478).

Regarding Zebra's prosecution history argument, the statement Zebra quotes and emphasizes in its brief and describes as “essentially the substance of the preamble” is quoting language from the last limitation of Claim 1 (and others), not the preamble. The evidence Zebra identifies is not a clear and unmistakable reliance on the preamble to distinguish prior art during prosecution and is insufficient to convert a statement of intended use into a claim limitation. *See id.* at 809 (“Again, statements of intended use or asserted benefits in the preamble may, in rare instances, limit apparatus claims, but only if the applicant clearly and unmistakably relied on those uses or benefits to distinguish prior art.”).

Regarding Zebra's other arguments, the preambles do not recite “additional structure or steps underscored as important by the specification.” *Catalina Mktg.*, 289 F.3d at 808. The statements Zebra identifies from the specification are similarly worded to the preamble and are similarly statements of purpose and intended use.

B. “the valid operation range includes an optimal operation point for the integrated circuit device” (‘835 Patent, Claims 1, and 7)

IV’s Proposed Construction	Zebra’s Proposed Construction	Court’s Construction
Plain and ordinary meaning	Indefinite	Plain and ordinary meaning. Note: this claim element does not require determining the optimal operation point.

Zebra argues this term is indefinite because it includes the phrase “optimal operation point,” which Zebra contends is a subjective term of degree that the specification fails to provide objective boundaries for determining. Dkt. 43 at 9–12. Zebra argument rests on the incorrect premise that the claims require determining “an optimal operation point.” This term is not indefinite because all the claim requires is that the valid operation range *include* an optimal operation point, not *determining* the optimal operation point within that range. Zebra does not argue for any constructions in alternative to the plain and ordinary meaning.

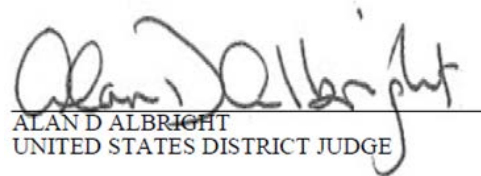
C. cyclically advancing the first OFDM packet by shifting the samples in a first direction” (‘439 Patent, Claims 1 and 7)

IV’s Proposed Construction	Zebra’s Proposed Construction	Court’s Construction
Plain and ordinary meaning	“cyclically advancing the first OFDM packet by shifting the samples in the direction of transmission”	“cyclically advancing the first OFDM packet by shifting the samples in the direction of transmission”

The ‘439 Patent relates to providing cyclic diversity by cyclically advancing packets in packet-based transmission systems. ‘435 Patent at Abstract. The parties dispute whether the claimed “a first direction” should be limited to “the direction of transmission.” During prosecution, the applicant argued that the claimed invention was different from cited prior art because of the

direction of the shift, and stated: “Larsson, however, does not appear to suggest the ‘cyclical advancements’ be applied to the OFDM packet as set forth in claim 24 and Fig. 8.” Dkt. 43-7 at 10 (Ex. F to Defendant’s Claim Construction Brief). The applicant argued that Larsson’s shift would be in the wrong direction “and thereby cause intersymbol [sic] interference.” *Id.* The applicant further explained that claimed invention would avoid that problem “due to the directional shift as set forth in Fig. 8, in which the first OFDM packet 804 is left shifted” *Id.* at 10–11. The shift to the left in Fig. 8 of the ’439 Patent is in the direction of transmission. ’439 Patent at 7:31–58, Fig. 8. Based on the clear and unmistakable statements made during prosecution by the applicant to distinguish prior art, the Court agrees with Zebra that the first direction is limited to the direction of transmission.

SIGNED this 9th Day of July, 2024.



ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE