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No. 2009-1386

United States Court of Appeals for the Federal Circuit

VIZIO, INC. and AMTRAN TECHNOLOGY CO., LTD.,

Appellants,

and

TPV TECHNOLOGY LTD., TPV INTERNATIONAL (USA), INC., TOP VICTORY ELECTRONICS (TAIWAN) CO., LTD., and ENVISION PERIPHERALS, INC.,

Appellants,

v.

INTERNATIONAL TRADE COMMISSION,

Appellee,

and

FUNAI ELECTRIC CO., LTD. and FUNAI CORP.,

Intervenors.

On appeal from the United States International Trade Commission in Investigation No. 337-TA-617

APPELLANTS' REPLY BRIEF

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CERTIFICATE OF INTEREST

Counsel for appellants Vizio, Inc. and AmTran Technology Co., Ltd., certify the following in accordance with Fed. R. App. P. 26.1 and Fed. Cir. R. 47.4(a):

The full name of every party represented by me is:

Vizio, Inc.; AmTran Technology Co., Ltd.

The names of the real parties in interest, if the parties named in the caption are not the real parties in interest, represented by me are:

The parties named in the caption are the real parties in interest.

All parent corporations and any publicly held companies that own ten percent or more of the stock of the parties or amicus curiae represented by me are:

Vizio, Inc. has no parent corporations. AmTran Technology Co., Ltd. (a Taiwanese publicly traded company) owns approximately 20% of Vizio, Inc.

AmTran Technology Co., Ltd. has no parent corporation, nor does any publicly-held company own 10% or more of its stock.

The name of all law firms and the partners and associates that have appeared for the parties now represented by me in the lower tribunal or are appearing in this Court are:

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TABLE OF CONTENTS

Page

TABLE OF CONTENTS
(continued)

Page

TABLE OF AUTHORITIES

Page

CASES

STATUTES

TABLE OF ABBREVIATIONS

In addition to the terms defined in Appellants' opening brief (at xi-xii), this Reply Brief uses the following abbreviations:

Defined Terms

FBr.	Funai's response brief
ITCBr.	Commission's response brief
VBr.	Appellants' opening brief

All emphasis in this reply brief is added unless otherwise indicated.

INTRODUCTION

The arguments for affirmance offered by Funai and the ITC are born of convenience, not law or logic. Where infringement is at issue (*i.e.*, with respect to the "identifying channel map information . . ." requirement of claims 1, 5, and 23), they offer broad interpretations of the claims that sweep Appellants' accused products within their scope, without regard to the clear disavowal contained in the prosecution history that allowed Funai to obtain the '074 patent in the first place. But where the validity of Funai's patent is at risk, they are quick to read in narrowing limitations. In both instances, moreover, they conveniently rely—quite heavily, in fact—on extrinsic evidence. The fact that Funai and the ITC have to engage in these stratagems to make a case for affirmance is a telling marker indeed. Appellants' case for reversal, by contrast, is true to the intrinsic patent record, and to this Court's case law.

The ITC's judgment should be reversed and its remedial orders vacated.

ARGUMENT

I. "IDENTIFYING CHANNEL MAP INFORMATION ... AND ASSEMBLING SAID INFORMATION" EXCLUDES ACQUISITION AND USE OF THE PMT

Appellants showed (VBr. 23-34) that the patentees disavowed acquisition and use of the PMT, a conclusion compelled by the '074 patent itself (VBr. 24-27), and the prosecution of the patent (VBr. 27-30). The patentees had to overcome the Wasilewski reference, in which the "PMT . . . is needed to demultiplex the service

components of the selected program" (A41376), and they did so by amending the claims (to remove references to "tables") and by arguing that in their patent, *contra* Wasilewski, (i) "the PMT is **NOT** needed to demultiplex program components" (A41376 (emphasis in original)), and (ii) the decoder directly configures and tunes channels "without acquiring and using the [PMT]" (A41377).

On appeal, Funai and the ITC urge that the patentees overcame Wasilewski with an invention that merely "dispens[es] with the *necessity* of using the PMT," but still allows the PMT to be used to demultiplex program components. (FBr. 22 (emphasis in original); *see* ITCBr. 28-34.) This argument deprives these critical amendments and arguments of any significance, and would not have overcome the rejection based on Wasilewski. That, as with the other arguments offered by Funai and the ITC, does not stand in the way of reversal.

A. Funai's And The ITC's Efforts To Minimize The Force Of the Patentees' Disclaimer Are Unavailing

Funai and the ITC claim that it "is plain from the full context of the inventors' statement" that forgoing use of the PMT "is simply an explanation of the benefit of the patented invention, not a disclaimer." (FBr. 29; *see* ITCBr. 28-29.) But they offer no analysis of the specification to support this assertion, which is untenable in any event: As explained in Appellants' opening brief, the specification and prosecution history make clear (a) that the purpose of the claimed invention is to reduce channel latency, and (b) that the claimed invention

accomplishes reduced latency by using replicated information, **and not** the PMT. (VBr. 24-30.)

1. The Specification. The specification explains that the purpose of the claimed invention is reduced channel latency:

> The SLD program map information replicates information already present with the Program Map Table (PMT) segment of the MPEG compatible transport stream input to decoder 100. However, by incorporating the SLD within the CIT, ***the time required to acquire a program being transmitted on selected sub-channel SC is advantageously reduced.***

(A1561:7:36-43; A1558:1:42-59.) The three sentences that follow then explain that the claimed invention achieves this purpose by using the replicated information "without acquiring and using" the PMT:

> ***This is because*** the CIT and SLD provide formatted and linked information sufficient to enable processor 60 ***to directly configure*** and tune the system of FIG. 1 to receive the selected sub-channel SC. Specifically, the CIT and SLD directly associate individual first and second sub-channel identification numbers with the PIDs for identifying the datastreams that constitute a program being conveyed on this sub-channel. ***This enables processor 60 to configure the system of FIG. 1*** to receive the selected sub-channel SC ***without acquiring and using the Program Map Table (PMT) information in the MPEG compatible transport stream input to decoder 100.***

(A1561:7:43-53.) Thus, the entire point of the claimed invention is that the replicated information does the work that the PMT did in the prior art.

While Funai and the ITC reflexively argue that avoidance of the PMT is a "benefit of the patented invention, not a disclaimer" (FBr at 29; *see* ITCBr. 28-29), neither provides any meaningful analysis of the specification to support the assertion. In doing so, Funai and the ITC conflate the purpose of the invention—reduced channel latency—with the patent's definitive teaching of accomplishing that purpose by using replicated information "without acquiring and using the Program Map Table (PMT) information." (A1561:7:47-52; *see also* A41377 (arguing same to overcome prior-art rejection).) The patent cannot now be read—as it was here—to cover reducing channel latency ***with*** acquiring and using the PMT.

2. The Prosecution History. As Appellants showed (VBr. 27-33), the Examiner rejected the originally filed claims, stating that a prior-art patent issued to Wasilewski et al. disclosed replication of the PMT data:

> [In Wasilewski,] [t]he channel map data replicates data conveyed in the MPEG program map table [PMT]...to indicate to the viewer which programs correspond to which channels, thereby meeting claims 1, 13, 16, 23 and 24.

(A41325.) To overcome this prior-art rejection, the patentees emphasized that their claimed invention reduces channel latency by using replicated information and "**NOT**" (bolded and capitalized by the patentees) the PMT—"in the claim 1 system the PMT is **NOT** needed ... since the 'channel map' contains the required

information." (A41376 (original emphasis).) The patentees went on to urge that their invention was distinguishable from Wasilewski because "the channel map, together with the replicated information, enables a decoder to directly configure and tune to receive a selected channel desired by a User ***without acquiring and using the Program Map Table (PMT) information.***" (A41377.) These are classic statements of exclusion: Such "explicit arguments made during prosecution to overcome prior art can lead to narrow claim interpretations.... [B]y distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover." *Lampi Corp. v. American Power Prods. Inc.*, 228 F.3d 1365, 1374 (Fed. Cir. 2000).

Funai argues that these statements about not using the PMT are "simply an explanation of a benefit of the patented invention." (FBr. 29.) But this is not just "a benefit"—it is the salient feature of the claimed invention, which the patentees repeatedly extolled to obtain allowance, and the feature through which the invention accomplishes its stated purpose. Funai's attempt to distract from the "**NOT** needed" statement, by arguing that the novel aspect of the invention is using replicated information (FBr. 32), does not diminish the strength of patentees' disclaimer. Rather, it proves the truth of the disclaimer because the claims use the replicated information to do the work that the PMT performed in the prior art. "Claims cannot be construed as encompassing the prior art that was distinguished

in the specification and disclaimed during prosecution." *Kinik Co. v. International Trade Com'n.*, 362 F.3d 1359, 1365 (Fed. Cir. 2004).

Funai now seeks to mitigate the clear import of the patentees' statement that, "in contrast" to the prior art, "in the claim 1 system the PMT is **NOT** needed" (A41376 (original emphasis)), by urging that "the claimed invention was not absolutely dependent on the PMT." (FBr. 33.) That argument, too, is unavailing. Statements made during prosecution are evaluated based on "whether a competitor would reasonably believe that the applicant had surrendered the relevant subject matter." *Abbott Labs v. Dey L.P.*, 287 F.3d 1097, 1104 (Fed. Cir. 2002). Here, the prosecution does not contain any nuance in language, equivocation, or conditional surrender. Rather, the patentees emphatically stated, using their own bolding and capitalization, that "in contrast" to the prior art, "the PMT is **NOT** needed" in the claimed invention. (A41376.) Given the purpose of this statement and the manner in which it was made, a reasonable competitor could only understand this statement as an express disclaimer of the use of the PMT. Indeed, "it would be peculiar for the claims to cover prior art that suffers from precisely the same problems that the specification focuses on solving." *LizardTech, Inc. v. Earth Resources Mapping, Inc.*, 424 F.3d 1336, 1343-44 (Fed. Cir. 2005).

Presented with similar statements, such as "the present invention does not require" a feature found in the prior art, or that certain aspects of the prior art "need

not be" used or are "unnecessary," this Court has not hesitated to find a clear and unequivocal disclaimer of claim scope, even though that language did not say that the unnecessary aspects of the prior art were "absolutely" forbidden.[1] So, too, here. *See, e.g., Astrazeneca AB v. Mutual Pharm. Co.*, 384 F.3d 1333, 1340 (Fed. Cir. 2004) (holding patentee disclaimed scope and explaining that a clear disclaimer does not have to take "the form of 'My invention does not include _____.'").

Perhaps more importantly, a reasonable competitor would not understand the claims to cover embodiments that use, as well as embodiments that do not use, the PMT. Such a construction of the claims would yield the illogical and impermissible conclusion that the inventors ***broadened*** their claims in response to the rejection in order to avoid the prior art. (VBr. 31-32; *see Research Plastics, Inc. v. Federal Packing Corp.*, 421 F.3d 1290, 1297 (Fed. Cir. 2005) (rejecting a

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[1] *See, e.g., RFID Tracker, LTD v. Wal-Mart Stores, Inc.*, 2009 WL 2502792 at *3-4 (Fed. Cir. Aug. 18, 2009) (non-precedential) (holding that patentee disclaimed coverage of a transmitter given statement during prosecution that the "present invention ***does not require*** the interrogator/reader do anything more than receive transmitted signals"); *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1376 (Fed. Cir. 2008) (holding that patentee disclaimed coverage of built-in display or keyboard given statement in prosecution that claimed invention had "***an advantage*** over laptop computers in that higher quality peripherals will more likely be used since they ***need not be*** transported"); *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 997-98 (Fed. Cir. 2006) (holding that patentee disclaimed coverage of inert additives when the specification stated that "it is '***unnecessary*** to employ special additives to increase [] selectivity; the elimination of additives employed in the mixed catalysts ***enables*** the manufacture of the catalyst to be simplified and thereby its cost to be reduced'").

"construction that would not avoid the prior art that [patentee] distinguished").) Neither Funai nor the ITC respond to this argument. Indeed, if the claimed invention were allowed to cover even occasional use of the PMT, then the claims would not have been patentable over Wasilewski, because they still would have included use of the PMT. *See, e.g., Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003) (affirming finding of anticipation and explaining that prior art which "sometimes, but not always, embodies a claimed method nonetheless teaches aspects of the invention"). Thus, the only reasonable reading of the patentees' statements to the Examiner is as a complete disclaimer of use of the PMT.

Funai and the ITC also suggest that the asserted claims were allowed over Wasilewski on the alternative ground that the "novel aspect of their invention" was "replication of program map information in a separate channel map." (FBr. 32; *see* ITCBr. 30-31.) That argument, however, completely ignores the Examiner's reason for rejecting the originally filed claims—that Wasilewski "replicates data conveyed in the MPEG program map table." (A41325.) Further, even if Funai's view of the prosecution history were correct, it cannot undo the otherwise clear disclaimer regarding the PMT. "An applicant's invocation of multiple grounds for distinguishing a prior art reference does not immunize each of them from being used to construe the claim language. Rather, as we have made clear, an applicant's

argument that a prior art reference is distinguishable on a particular ground can serve as a disclaimer of claim scope even if the applicant distinguishes the reference on other grounds as well." *Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1374 (Fed. Cir. 2007).

Finally, as Appellants showed in their opening brief (VBr. 32), even if could be said that the patentees only disclaimed the use of the PMT at the identification stage in favor of using replicated information, such disclaimer would still require reversal because Appellants' products ***do*** use the PMT at the identification stage. Funai and the ITC have no answer to this argument.

B. Funai and the ITC's Reliance on Expert Testimony Is Erroneous

Funai and the ITC's argument that the "claims are silent on use or nonuse of the PMT," which is in turn based on an equivocal statement from an expert as support (FBr. 27-28; *see* ITCBr. 25, 28), is unsustainable. "It is a truism that the claims of a patent define the invention that is claimed, but prosecution history can often 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." *Regents of Univ. of Calif. v. Dakocytomation, Inc.*, 517 F.3d 1364, 1372 (Fed. Cir. 2008). Accordingly, Funai "is not entitled to a claim construction divorced from the context of the written description and prosecution history." *Nystrom v. TREX Co.*, 424 F.3d 1136, 1144-45 (Fed. Cir. 2005). Here,

as noted above, the specification and prosecution history demonstrate that the inventors disclaimed coverage of systems using the PMT to identify and assemble "channel map information." (*See also* VBr. 27-34.)[2]

Here, appellees cannot even identify Dr. Krauss' opinion regarding claim construction; rather, they rely on an equivocal "I don't recall." (A30187:23-188:1.) Such extrinsic evidence cannot overcome the inventors' unambiguous statement that "the PMT is **NOT** needed" in the claimed inventions. (A41376 (original emphasis).) Moreover, the record is replete with expert testimony explaining that a person skilled in the art would understand the specification and prosecution history to exclude use of the PMT. (A30769:5-70:19.)

C. There Is No Dispute That Appellants' Products Use The PMT To Identify And Assemble Channel Map Information

Funai and the ITC do not dispute that the Appellants' products use the PMT to identify and assemble channel map information. Accordingly, under a proper construction that excludes use of the PMT, this Court can—and should—enter judgment of non-infringement without remand.

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[2] The ITC—but not Funai—perplexingly suggests that Appellants' construction would somehow require the patentees to have drafted a "means for using" limitation. (ITCBr. 26.) That is incorrect. Appellants' proffered construction of the step of "identifying channel map information ... and assembling said information" simply excludes from its ambit the acquisition and use of the PMT; this is a common consequence of prosecution-history disclaimers. (The ITC's concomitant argument that "there is no claim term on which Appellants' disavowal is based" (ITCBr. 33), is therefore incorrect for the same reason.)

II. APPELLANTS' WORK-AROUND PRODUCTS ARE NON-INFRINGING EVEN UNDER THE ALJ'S CONSTRUCTION

As explained in Appellants' opening brief, the work-around products do not "form a channel map for identifying said individual packetized datastreams" (claim 1) nor do those products "form a channel map suitable for use in identifying said individual packetized datastreams" (claim 23). Rather, the unchallenged expert testimony—set forth at length in Appellants' opening brief—establishes that those products neither use, nor can use, the transmitted VCT data to identify packetized datastreams. (VBr. 35-40.)

Rather than address this evidence, Funai advances a spurious waiver argument. (FBr. 34.) The ALJ, however, decided the infringement issue based on the substance of those arguments, not on Funai's waiver assertion. (A562.) In such cases, "courts may not accept appellate counsel's *post hoc* rationalizations for agency action; *Chenery* requires that an agency's discretionary order be upheld, if at all, on the same basis articulated in the order by the agency itself." *Burlington Truck Lines, Inc. v. United States*, 371 U.S. 156, 168-69 (1962). Notably, the ITC does not argue waiver. (*See* ITCBr. 36-41.)

On the merits, Funai suggests that Appellants' non-infringement argument adds limitations "beyond the scope of the claims." (FBr. 36.) But the exact opposite is true: Funai and the ITC, like the ALJ before them, ignore that the claims recite more than just "form[ing] a channel map"; they additionally require

that the formed channel map must be "for identifying . . ." or "suitable for use in identifying said individual packetized datastreams." (A1563:11:33-35; A1564:14:15-18.) Thus, Appellants' non-infringement showing—which is focused on these latter requirements—comports with the axiomatic principle that "infringement requires that each and every claim limitation be present in the accused product." *Abraxis Bioscience, Inc. v. Mayne Pharma Inc.*, 467 F.3d 1370, 1378 (Fed. Cir. 2006). By contrast, Funai truncates the infringement analysis by completely ignoring those express claim limitations. The reason for doing so is not surprising: the record evidence uniformly establishes that the work-around products do not and cannot use the VCT as stored in the DRAM. (VBr. 35-40.)[3]

Funai also contends that infringement is possible because "one of ordinary skill in the art would know that the type of reformatting Vizio mentions is routine and trivial in the art." (FBr. 36.) Even were that true, Funai's argument is irrelevant: This Court has repeatedly rejected the notion that "if a particular device can be altered without undue difficulty to operate in an infringing manner, the device, as sold, must be deemed to infringe." *High Tech Med. Instrumentation, Inc. v. New Image Indus., Inc.*, 49 F.3d 1551, 1555 (Fed. Cir. 1995).

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[3] The ITC argues that certain record evidence indicates that Appellants' products use the transmitted VCT (ITCBr. 40-41), but the evidence it cites pertains solely to Appellants' legacy products, not the work-around products that are the subject of this appeal.

Similar to Funai's approach, the ITC attempts to side-step the record evidence establishing that the work-around products cannot and do not use the transmitted VCT, by arguing that it is the content rather than the format of the channel map that determines suitability for use. (ITCBr. 38-39.) Neither the claims, nor the specification, nor any of the ALJ's constructions support the ITC's distinction between "content" and "format." Moreover, nothing in the ITC's distinction alters the fundamental point of the unrebutted expert and third-party testimony: The VCT data, as transmitted and stored in the work-around products, cannot and is not used, regardless of the content or format of such data. (VBr. 35-38.)

III. THE PROPER CONSTRUCTION OF "CHANNEL MAP INFORMATION" DOES NOT REQUIRE INCLUSION OF PCR_PIDS, STREAM_TYPES, AND PROGRAM_NUMBERS

A. Appellees Fail To Identify Any Support In The Claim Language For Construing "Channel Map Information" To Require PCR_PIDs, Stream_Types, And Program_Numbers

Whereas Funai urged broad constructions of claim language where only infringement was at issue, it urged an impermissibly narrow construction of "channel map information" in order to avoid an otherwise-inevitable finding of invalidity. Appellants showed (VBr. 42-45) that nothing in the claim language even suggests, much less requires, inclusion of the PCR_PID, stream_type, and program_number data as part of the "channel map information" limitation. In

response, Funai asserts—without any support from the intrinsic patent record—that the claims require that "'channel map information' replicates ***all*** information from the MPEG program map information" and that such information "necessarily includes all the datastream content and timing information." (FBr. 41-42.)

The claim language certainly contains no such requirement. It simply recites that "channel map information replicates information conveyed in said MPEG compatible program map information ... and said replicated information associates packet identifiers with individual packetized datastreams." (A1564:14:33-37.) Nowhere do the claims make any reference to "***all*** information from the MPEG program map," nor do the claims refer to any "content and timing information," let alone specify PCR_PID, stream_type, and program_number data as required components of the "channel map information." Indeed, the fact that the claim language by its terms, only requires that elementary _PIDs (*i.e.*, "packet identifiers with individual packetized datastreams") be part of the "channel map information" is a powerful indicator that no other type of information is required by the term "channel map information"—the interpretive doctrine of *expressio unius* compels the conclusion that if this one type of information is expressly required by the claim language, other types that are not specifically mentioned are not required. *See, e.g., Cook v. Principi*, 318 F.3d 1334, 1339 (Fed. Cir. 2002) (applying "the familiar canon of *expressio unius est exclusio alterius*" to interpret congressional

statute and "conclud[ing] that Congress did not intend to allow exceptions to the rule of finality in addition to the two that it expressly created"); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 987 (Fed. Cir. 1995) ("The more appropriate analogy for interpreting patent claims is the statutory construction analogy.").[4]

Similarly, Funai and the ITC have no response to Appellants' showing (VBr. 43-45) that the patentees clearly knew how to describe use of PCR_PIDs, stream_types, and program_numbers—having explicitly done so in other claims as well as in an exemplary embodiment in the specification. (A1561:7:23-35.) "Had the inventor meant [PCR_PID, stream_type, and program_number data], he could have used th[ose] word[s]. However, we must consider the word[s] that the inventor actually chose." *International Rectifier Corp. v. IXYS Corp.*, 361 F.3d 1363, 1374 (Fed. Cir. 2004); *see Superguide Corp. v. DirectTV, Inc.*, 358 F.3d 870, 880 (Fed. Cir. 2004) ("Had the patentees intended to limit the disputed claim terms to 'analog' technology, they could have easily done so by explicitly modifying the disputed claim language with the term 'analog.'").

[4] Funai and the ITC make the bizarre claim that Appellants provide no basis for including elementary_PIDs as part of the "channel map information" (FBr. 41; ITCBr. 56-57), but it is right there in the claim language. (A1563:11:35-41; A1564:14:19-24.)

Further, while Funai and the ITC attempt to downplay the importance of claim differentiation (FBr. 45-47; ITCBr. 53-54), this Court's precedent establishes that "[d]ifferences among claims can ... be a useful guide in understanding the meaning of particular claim terms." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*). Applying this principle in *Kara Technology Inc. v. Stamps.com*, this Court recently refused to construe the term "information" as requiring a "key," explaining: "[W]hen the inventor wanted to restrict the claims to require the use of a key, he did so explicitly. None of the claims at issue on appeal recite the term 'key.' By contrast, all of the other independent claims require either an 'encryption key' or 'key data.' In addition, dependent claim 2 ... explicitly adds the limitation to claim 1 ... that the security indicia 'is validated by key information...' This further indicates that the claims at issue ... do not require the use of a key." 2009 WL 3030360 at *5 (Fed. Cir. Sept. 24, 2009).

The same reasoning should lead to the same outcome here. Whereas the asserted claims are silent regarding PCR or stream_type data, several unasserted claims expressly require a "program clock reference (PCR) value" and a "datastream type indicator." (A1563:11:42-45 (claim 2); A1563:12:10-17 (claim 10).) Thus, when the patentees desired to claim the invention as requiring such data, they did so by explicitly adding those limitations to the claims. (VBr. at 43-44.)

Finally, appellees argue that "channel map information" must be construed to include PCR_PID, stream_type, and program_number data; otherwise, a program will not be properly decoded. (FBr. 42-43; ITCBr. 54-56.) This argument simply rehashes the ALJ's erroneous analysis while ignoring Appellants' refutation of that argument. (VBr. 49.) Like the ALJ's analysis, appellees' argument is wrong in several respects. First, the argument hinges entirely on extrinsic evidence, rather than the claim language or specification. Second, the argument is refuted by well-established precedent that it is error to "import[] the functions of a working device into the[] specific claims, rather than reading the claims for their meaning independent of any working embodiment." *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999). Simply put, it is not this Court's job to rewrite Funai's claims to make them more or better functional. *See Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) ("This court, however, repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity.").

B. Appellees Fail To Identify Anything In The Specification Or Prosecution History Mandating Inclusion Of PCR_PIDs, Stream_Types, Program_Numbers In The "Channel Map Information"

"[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315. Yet Funai strives mightily to avoid

any discussion of this "single best guide," limiting its discussion of the specification to a passing reference to Figure 4 coupled with the bare assertion that the specification and prosecution history require the claims to include "all" the PCR_PID, stream_type, and program_number data. (FBr. 43.) Funai, however, fails to identify any evidentiary support for that assertion. Likewise, the ITC limits its discussion of the specification to selective quotes from the specification that conspicuously omit the patent's clear statements that Figure 4 simply "exemplifie[s] [ ] the data format" of channel map information. (ITCBr. 45-46.)

As explained in Appellants' opening brief (VBr. 45-48, 50), the '074 patent repeatedly demonstrates that such data is merely "exempl[ary]" of the information that may be included in the "channel map information." The '074 patent expressly states that "[t]he SLD program map information is ***exemplified*** by the data format of Fig. 4" (A1561:7:23-25), and that the "associated descriptors acquired and collated by processor 60 incorporates advantageous features ***exemplified*** in the data formats in Figs. 2-9." (A1560:5:62-65.) Indeed, Funai itself concedes that Figure 4 provides an "***exemplary*** SLD table." (FBr. 43.)

The ITC's argument that "channel map information" must be limited to the data in Figure 4 because it is the "only embodiment of the SLD as the 'channel map'" is likewise unavailing. (ITCBr. 46.) This Court will "not import limitations into claims from examples or embodiments appearing only in a patent's written

description, ***even when a specification*** describes very specific embodiments of the invention or even ***describes only a single embodiment***, unless the specification makes clear that the patentee intends for the claims and the embodiments in the specification to be strictly coextensive." *JVW Enters., Inc. v. Interact Access., Inc.*, 424 F.3d 1324, 1335 (Fed. Cir. 2005). Here, the specification's consistent discussion of the PCR_PIDs, stream_types, and program_numbers as "exemplary" information establishes that the asserted claims and the embodiment in Figure 4 are not co-extensive.

C. Funai's and the ITC's Extrinsic Evidence Cannot Contradict The Intrinsic Evidence Establishing That "Channel Map Information" Does Not Require PCR_PIDs, Stream_Types, And Program_Numbers

While giving cursory treatment to the intrinsic evidence, Funai and the ITC dedicate a large part of their briefs to shoehorning statements from extrinsic sources into the claim language. (FBr. 46-56; ITCBr. 46-51.) Specifically, they attempt to graft a statement from Annex C of the MPEG-2 standard—namely, that the MPEG-2 "requires a minimum of program identification: program number, PCR-PID, stream types and program element PIDs" (FBr. 42; ITCBr. 48-49)—onto the claim language.

These arguments fail in several respects. *First*, Annex C of the MPEG-2 standard was not made of record during prosecution of the '074 patent. Accordingly, it "is purely extrinsic evidence and therefore merits little

consideration." *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 809 (Fed. Cir. 2007). As extrinsic evidence, Annex C "may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history." *Bell Atl. Network Serv. Inc. v. Covad Communications Grp., Inc.*, 262 F.3d 1258, 1270 (Fed. Cir. 2001); *see Interactive Gift Exp., Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1334 (Fed. Cir. 2001) ("Given the lack of ambiguity in the intrinsic evidence, it would be improper to address any of the parties' arguments relating to extrinsic evidence, such as other examples of point of sale locations and standard references."). Yet, that is precisely what Funai and the ITC attempt to do by forcing a statement from Annex C into the claims, even though nothing in the claim language requires PCR_PIDs, stream_types, or program_numbers and the specification repeatedly notes that such data are examples of information that may be included in the "channel map information."

Second, Funai and the ITC argue as if the '074 patent somehow defined "channel map information" through incorporation by reference of Annex C into the patent. That, of course, is not the case. Not only is Annex C never mentioned in the '074 patent, but the patent repeatedly states that the claims are not restricted to the MPEG-2 format. Rather, the "principles of the invention ***apply to any form of MPEG*** [ ] compatible electronic program guide." (A1563:11:13-15; A1558:1:19-22, 2:50-54) (stating that disclosure of system in an MPEG-2 compatible format "is

exemplary only").) Moreover, even the ITC recognizes that Annex C is "an 'informative' section of the MPEG-2 standard" (ITCBr. 48), and Funai's own expert conceded that informative sections are not "a formal part of the standard." (A28809.)[5]

Third, Funai and the ITC's reliance on section 2.4.4 of the MPEG-2 standard also fails to support a narrow construction of "channel map information." (FBr. 42-43; ITCBr. 48-51.) Far from requiring the invention to use the information in Section 2.4.4, the '074 patent explains that the "program specific information ***may be of a variety of types. For example, it may comply*** with the Program Specific Information (PSI) requirements specified in Section 2.4.4 of the MPEG systems standard or it may comply with [other standards]." (A1558:2:54-64.) The patent's use of "may" and "example" underscores that the data requirements in Section 2.4.4 are permissive rather than compulsory. *See Prima Tek II, LLC v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1150-51 (Fed. Cir. 2003) (rejecting narrow construction because "[t]he written description only states that the floral holding material 'may be' (not must be) the type of material commonly referred to in the art as floral

[5] Funai and the ITC's citation to *LG Elecs., Inc. v. Bizcom Elecs., Inc.*, 453 F.3d 1364 (Fed. Cir. 2006), concerning the propriety of construing the asserted claims by reference to Annex C (FBr. 39; ITCBr. 50, 52), is misplaced. In that case, unlike here, the disputed prior-art reference was cited during prosecution and thus presumptively considered by the examiner. *Id.* at 1375.

foam or soil" and concluding that examples in specification are "merely illustrative" rather than limiting).

Funai's and the ITC's reliance on extrinsic expert testimony regarding the meaning of "channel map information" (FBr. 41-43; ITCBr. 52-53), fares no better. Nowhere do they contend that the intrinsic evidence is ambiguous or that it is insufficient to construe the term "channel map information." Accordingly, "where the patent documents are unambiguous, expert testimony regarding the meaning of a clam is entitled to no weight." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996). Further, their reliance on expert testimony as a primary source for narrowing the claims to require PCR_PIDs, stream_types, and program_numbers is improper because "expert testimony cannot overcome more persuasive intrinsic evidence." *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1329 (Fed. Cir. 2008). In any event, the expert testimony demonstrates that the claims do not require such data because the claim language recites "MPEG compatible," and the experts were in agreement that a person skilled in the art would understand that "compatible" does not require use of all information available in an MPEG standard. (VBr. 45.) Funai attempts to explain away this testimony with lawyer argument that "MPEG compatible" allows omission only of optional information. (FBr. 44.) That argument, however, finds no support in the record. Funai certainly cites to none.

D. There Is No Dispute That The Asserted Claims Are Anticipated Under A Proper Construction Of "Channel Map Information"

Neither Funai nor the ITC contest that when "channel map information" is construed as not requiring PCR_PIDs, stream_types, and program_numbers, the asserted claims are anticipated by the A/55 standard. Accordingly, this Court should enter a judgment of invalidity without need for remand.

IV. THE ASSERTED CLAIMS ARE INVALID AS ANTICIPATED AND OBVIOUS

A. Appellants Properly Focused Their Invalidity Arguments On The "Channel Map Information" Limitation And Did Not Waive A Validity Challenge To Claim 5

Funai argues that Appellants fail to establish invalidity because they addressed only the "channel map information" limitation in their appellate brief rather than all the claim limitations. (FBr. 47-49.) This is an appeal from an administrative agency, in which the ALJ's ***only*** stated ground for finding the asserted claims not invalid was that the prior art purportedly failed to disclose "channel map information" under the ALJ's construction. (A569-70.) As noted above, "[t]he *Chenery* principle precludes judicial affirmance of an agency order or determination for reasons other than those stated by the agency." *Garrison v. Nicholson*, 494 F.3d 1366, 1369 n.3 (Fed. Cir. 2007). Accordingly, Appellants focused on the "channel map information" limitation because that is the only ground on which this Court can affirm the ALJ's finding that the A/55 standard is not anticipatory.

Funai's argument that Appellants waived a validity challenge to claim 5 fails for the same reason: The ALJ found that all the asserted claims (including claim 5) were not invalid based on the absence of "channel map information" in the prior art. (A569-70.) Thus, the ALJ's ruling of non-invalidity of the all the asserted claims stand or fall together on that ground.

B. The A/55 Standard Is Anticipatory

1. The A/55 Standard Discloses Program_Numbers

Attempting to contravene the A/55 standard's clear teaching that "[t]he channel number corresponds to the program number in the MPEG system" (A37006), Funai argues that the channel number in the A/55 standard has a different "syntax" than the program_number in the '074 patent. (FBr. 51-52.) However, like the ALJ's flawed reasoning, Funai fails to identify anything in the claim language, the specification, or the ALJ's restrictive construction that mandates a particular syntax. The ITC's argument "that there is no requirement that the differences between the claimed invention and a prior art reference be material" (ITCBr. 58-59) fares no better, because a patentee cannot avoid anticipation by relying on unclaimed features. *See, e.g., In re Gleave*, 560 F.3d 1331, 1336 (Fed. Cir. 2009) ("Certainly where the claims themselves do not require a particular activity, we have no call to require something more from the anticipating reference.").

Further, Dr. Eyer's testimony confirmed that the "channel number in the A/55 standard ***is the same as*** the MPEG program number." (A30232:12-13.) Funai's attempt to paint Dr. Eyer as unqualified to render such testimony is unavailing. (FBr. 53.) Dr. Eyer was intimately involved in the promulgation of the MPEG and ATSC standards when the application for the '074 patent was filed. (A30205:19-209:20.)

As a last resort, Funai attempts to frame the issue as a "conflict in the testimony and interpretation of the evidence." (FBr. 53.) However, the litigation-induced word play from Funai's expert regarding the interpretation of "corresponding" in the A/55 standard cannot disturb the standard's clear teaching that the "channel number corresponds to the program number in the MPEG standard" (A37006), and testimony from a disinterested third-party witness confirming that the disclosed channel number is the same as the program_number in the ALJ's construction. (A30232:12-13.)

2. The A/55 Standard Discloses PCR_PIDs

The A/55 standard makes clear that the "time_base_PID in this list can be any of those PCR carrying PIDs." (A36999.) Indeed, Funai's own expert conceded that the A/55 standard discloses a data structure that contains a PCR_PID. (A32842:14-A32843:2.)

In an effort to stave off anticipation, appellees argue that the time_base_PID cannot be a PCR_PID because the A/55 standard states that, in certain instances, "the time_base_PID ... may not be valid for a specific program." (A36999.) The fact that time_base_PID is not always a valid PCR_PID is legally irrelevant for purposes of anticipation because prior art which "sometimes, but not always, embodies a claimed method nonetheless teaches aspects of the invention." *Hewlett-Packard*, 340 F.3d at 1326.

C. The Asserted Claims Are Obvious In View Of The A/55 Standard In Combination With The Eyer Patent

Appellees focus their obviousness argument on two grounds: (1) that the combination of A/55 standard with Eyer does not disclose PCR_PIDs, and (2) that there is no motivation to combine the two references. Both of these arguments fail because of the record evidence and the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

First, Funai and the ITC argue that the combination of A/55 and the Eyer patent does not disclose replication of the PCR_PID with MPEG program map information. (FBr. 58-59; ITCBr. 64-65.) In doing so, they ignore the testimony of Funai's own expert, who explained that not only were PCR_PIDs well known in the art, but that a person of ordinary skill would have known to use PCR_PIDs to avoid "sync problems" between video and audio data. (A32892:16-A32894:14; A32921:23-24.) Moreover, the A/55 standard itself suggests, if not expressly

discloses, replicating PCR_PIDs from the program map table by explaining that "[t]he valid time base for each time-related program is defined in the Program Map Table section for that specific program through the PCR_PID definition." (A35677.)

Second, Funai and the ITC suggest that combining prior-art references somehow requires the reference to have a magic incantation or explicit direction to do so. Yet that is precisely the argument that the Supreme Court rejected in KSR—an obviousness "analysis need not seek out precise teachings directed to specific subject matter of the challenged claim, for a court can take account of inferences and creative steps that a person of ordinary skill in the art would employ." 550 U.S. at 418. Here, the reasons for combining the A/55 standard with the Eyer patent are evident from the references themselves: (1) both references relate to contemporaneous ATSC standards for implementing system information in digital television transmission (A45583:10:59-63); and (2) both references describe systems for easing channel navigation in digital television through "information regarding a channel grouping list" (A36990; A45579:1:5-7 (disclosing a system "for grouping a number of television channels according to a grouping criteria"). When, as here, the prior-art references disclose all the elements of the claims, the combination of such references is "grounded in

common sense." *Ball Aerosol & Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 992 (Fed. Cir. 2009).

CONCLUSION

For these reasons, and those set forth in Appellants' opening brief, the ITC's determination that Appellants violated 19 U.S.C. § 1337 should be reversed, and the ITC's remedial orders vacated.

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