

In The
**United States Court of Appeals
For The Federal Circuit**

NOBELBIZ, INC.,

Plaintiff-Appellee,

v.

GLOBAL CONNECT, L.L.C.; T C N, INC.,

Defendants-Appellants.

**ON APPEALS FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
CASE NOS. 6:12-CV-00244-RWS, 6:12-CV-00247-RWS,
6:13-CV-00804-MHS, AND 6:13-CV-00805-MHS
JUDGE MICHAEL H. SCHNEIDER, JUDGE ROBERT W. SCHROEDER, III**

PETITION FOR REHEARING EN BANC

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CERTIFICATE OF INTEREST

Counsel for the Appellee NobelBiz, Inc. certifies the following:

1. The full name of every party represented by the undersigned is NobelBiz, Inc.
2. The name of the real party in interest represented by me is NobelBiz, Inc.
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party represented by me are Nobel Limited Liability Company.
4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the District Court or agency or are expected to appear in this court are:

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Dated: September 1, 2017

/s/Ralph A. Dengler
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STATEMENT OF COUNSEL – FEDERAL CIRCUIT RULE 35(B)(2)

Based on my professional judgment, I believe the panel decision is contrary to the following precedent of this Court: *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283 (Fed. Cir. 2015); *Lazare Kaplan Int’l, Inc. v. Photocopy Techs., Inc.*, 628 F.3d 1359 (Fed. Cir. 2010); *Unwired Planet, LLC v. Apple Inc.*, 829 F.3d 1353 (Fed. Cir. 2016); *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362 (Fed. Cir. 2012); *Apple v. Samsung Elecs. Co., Ltd.*, 839 F.3d 1034 (Fed. Cir. 2016) (en banc).

Further, based on my professional judgment, I believe this appeal requires an answer to the following precedent-setting questions of exceptional importance:

1. May a district court ever assign a “plain and ordinary meaning” construction? Or is an express construction required whenever a litigant asserts an *O2 Micro* “dispute,” as dictated by *NobelBiz* and *Eon*?
2. May the Federal Circuit narrow claim scope without finding lexicography or prosecution disclaimer, by parsing the intrinsic record and relying on “extra-record extrinsic evidence,” as occurred in *NobelBiz*?
3. May a district court refer the question of infringement to a jury when claim terms are assigned their plain and ordinary meaning?

Dated: September 1, 2017

/s/ Ralph A. Dengler
Ralph A. Dengler

INTRODUCTION

This case presents fundamental issues of claim construction crucial to the orderly and efficient disposition of patent litigation. The 2-1 majority in *NobelBiz* held that a district court has an absolute duty to provide an express construction whenever a litigant argues a “dispute” under *O2 Micro*.¹ But precedent holds that a “plain and ordinary meaning” construction resolves such a dispute when the terms are readily understood by a jury or the dispute relates to a factual question of infringement. Both were true here. The intra-circuit divide has not only affected *NobelBiz* and other litigants, but also created uncertainty for district courts in resolving *O2 Micro* disputes. Without guidance, parties and district courts will expend significant resources on litigation and trial, while reversible error looms unless all “disputed” terms are construed.

In addition to requiring express constructions, the majority narrowed three claim terms based on parsed statements from the intrinsic record. This violates the Court’s precedent requiring lexicography or disclaimer before narrowing the meaning of claim terms. Lastly, this decision undermines a jury’s fact finding role. Under *NobelBiz*, juries have no latitude to determine if evidence satisfies a term’s plain and ordinary meaning for infringement.

¹ While the opinion is designated as “non-precedential,” *NobelBiz* involves critical aspects of patent law. These issues have significant ramifications beyond this decision, requiring en banc resolution.

I. En banc review is necessary to determine when, if ever, a plain and ordinary meaning construction resolves a purported *O2 Micro* dispute.

A. After *O2 Micro*, this Court and district courts are deeply divided.

Under one line of cases (respectfully, the proper view), a plain and ordinary meaning construction resolves an *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351 (Fed. Cir. 2008) dispute in two instances. First, the claim terms can be readily understood by a jury. *Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283, 1290–91 (Fed. Cir. 2015) (“‘Being provided to’ is comprised of commonly used terms” so plain and ordinary meaning resolved *O2 Micro* dispute); *see also NobelBiz, Op.*, at 1 (Newman, J., dissenting) (“outbound call” and “replacement telephone number” “readily understood by judge and jury”); *Eon Corp. IP Holdings LLC v. Silver Spring Networks, Inc.*, 815 F.3d 1314, 1324 (Fed. Cir. 2016) (Bryson, J., dissenting) (“‘portable’ and ‘mobile’ were used in their ordinary sense”).

Second, the dispute is factual, related to determining infringement. *Lazare Kaplan Int'l, Inc. v. Photoscribe Techs., Inc.*, 628 F.3d 1359, 1376 (Fed. Cir. 2010) (“parties’ dispute concerns factual questions relating to the test for infringement and not the legal inquiry of the appropriate scope”); *ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1326 (Fed. Cir. 2012) (appropriate for jury to determine if accused system satisfied the plain meaning).

In direct conflict, other panels have held over dissent that a “plain and ordinary meaning” claim construction does not resolve an *O2 Micro* dispute because it

purportedly leaves claim scope unanswered. *See, e.g., Eon*, 815 F.3d at 1319 (“plain and ordinary meaning . . . left this question of claim scope unanswered This was legal error.”); *Op.*, at 5-6, n.1 (quoting *O2 Micro* that “plain and ordinary meaning . . . does not resolve the parties’ dispute”); *see also Every Penny Counts, Inc. v. Am. Express Co.*, 563 F.3d 1378, 1383 (Fed. Cir. 2009).

These mixed messages leave district courts uncertain whether a plain and ordinary meaning construction resolves an *O2 Micro* dispute, such that a jury can decide infringement, or if an express construction is required. Some state the former is proper. *See Konami Gaming, Inc. v. Marks Studios, Ltd. Liab. Co.*, 2017 U.S. Dist. LEXIS 116669, at *20, 24, 30, 32 (D. Nev. Jul. 25, 2017) (terms “familiar” to jury so plain meaning appropriate and jury could decide infringement); *Oxford Immunotec Ltd. v. Qiagen, Inc.*, 2017 U.S. Dist. LEXIS 91434, at *10, 13, 20 (D. Mass. Jun. 14, 2017) (terms relating to diagnosing tuberculosis “clear” so plain meaning proper); *Riddell, Inc. v. Kranos Corp.*, 2017 U.S. Dist. LEXIS 79242, at *18–19, 21–22 (N.D. Ill. May 24, 2017) (terms “readily apparent” so plain meaning sufficient); *Cave Consulting Grp., Inc. v. Truven Health Analytics, Inc.*, 2017 U.S. Dist. LEXIS 62821, at *12 (N.D. Cal. Apr. 25, 2017) (can “explain to the jury why the accused software does or does not satisfy the plain and ordinary language”).

Other district courts have construed even simple words because a litigant asserted an *O2 Micro* “dispute.” *See, e.g., Finjan, Inc. v. Symantec Corp.*, 2017 U.S.

Dist. LEXIS 19526, at *54 (N.D. Cal. Feb. 10, 2017) (construing “web client” to “avoid any claims of an *O2 Micro* violation at trial”); *InfoGation Corp. v. ZTE Corp.*, 2017 U.S. Dist. LEXIS 69252, at *15–27 (S.D. Cal. May 5, 2017) (construing “non-proprietary” and “natural language” because disputed); *UUSI, LLC v. United States*, 131 Fed. Cl. 244, 268 (2017) (“until” construed because disputed); *Julius Zorn, Inc. v. Medi Mfg.*, 2017 U.S. Dist. LEXIS 35826, at *7–8, 55–57 (S.D. Cal. Mar. 13, 2017) (construing “proximal and distal edges” because disputed).

Thus, plain and ordinary meaning jurisprudence is unsettled as to *O2 Micro*: Federal Circuit precedent conflicts; *Eon* and *NobelBiz* were split panel opinions; and district courts are uncertain if they must construe every disputed term.

B. The en banc court must clarify that a plain and ordinary meaning claim construction is not dead.

A district court should not be obliged to construe terms that are readily understood by a jury, thereby engaging in resource-intensive claim construction any time a party cries “dispute.” *Summit 6*, 802 F.3d at 1291. NobelBiz’s claim terms (“outbound call” and “replacement telephone number”) could not be simpler:

These terms are not scientific or technologic They are words that are readily understood by judge and jury, . . . [used] according to their plain and ordinary meaning.

Op., at 1 (Newman, J., dissenting). Indeed, despite Defendants’ manufactured dispute, their own witnesses readily understood the terms. Appx8982, 47:12–48:5 (Global Connect controls “outbound call”); Appx9082, 11:16–19 (TCN describing

its “outbound call”); Appx8676 (TCN: “How does the replacement happen”). The majority did not consider this record evidence. If the plain and ordinary meaning is improper for the readily understood terms that Defendants’ employees used in conducting business, then plain and ordinary meaning is dead.

The majority—without distinguishing NobelBiz’s precedent—held that each claim term required an express construction. It then reformulated a three-word term (“replacement telephone number”) and a two-word term (“outbound call”) into complicated, multi-layered reconstructions (e.g., “outbound call” is not only a “call placed by an originator to a target,” but also has to occur in a system that “acts on an already extant call”). *Op.*, at 6–9. Such complicated constructions cannot represent the “plain and ordinary meaning” and are unfaithful to the intrinsic record.

A district court also should not be compelled to decide factual disputes about infringement at claim construction. *NobelBiz*, and *Eon*, improperly “convert[] such factual aspects into legal issues of claim construction,” whenever a litigant asserts an *O2 Micro* dispute. *Op.*, at 4 (Newman, J., dissenting); *Eon*, 815 F.3d at 1329–31 (Bryson, J., dissenting).² The dispute in *NobelBiz* was not related to claim scope, but rather whether Defendants’ systems infringed the claims:

The district court appropriately submitted to the jury the factual

² “The Federal Circuit has increasingly . . . [held] that any dispute over the meaning of a construed claim term is a dispute of claim construction, not infringement.” Jeanne C. Fromer and Mark A. Lemley, *The Audience In Intellectual Property Infringement*, 112 MICH. L. REV. 1251, 1266 n.80 (2014).

infringement question of whether the accused systems, in which there is no capture of a pre-dialed call, are within the literal or equivalent scope [of the claims].

Op., at 2–3 (Newman, J., dissenting); Dkt. No. 43, 40–47 (marshaling record). A jury should resolve such factual disputes, not a court. *Lazare*, 628 F.3d at 1376; *ActiveVideo*, 694 F.3d at 1326; Dkt. No. 43, at 14–15.

This intra-circuit conflict will continue to create confusion and waste. The *Eon* panel overturned a \$13 million verdict years after the district court assigned plain and ordinary meaning claim constructions. *Eon*, 815 F.3d at 1316. Likewise, the *NobelBiz* panel overturned a \$2 million jury verdict after the parties litigated under such constructions for several years—only to be told on appeal that a plain and ordinary meaning construction is not proper. District courts will be burdened too: without en banc resolution, parties will manufacture *O2 Micro* disputes, forcing district courts to construe all terms. And if not all construed, they will face requests for interlocutory appeals in view of *Eon* and *NobelBiz*.

II. En banc review is required to confirm that claim scope may only be narrowed upon a showing of lexicography or prosecution disclaimer.

A. The Asserted Patents are directed to creating a call.

NobelBiz’s U.S. Patent No. 8,135,122 (“the ‘122 Patent”) recites selecting one caller ID from a database, inserting that caller ID (which matches the area code of a call target) into the originator of the call, and then transmitting that caller ID.

1. A system for processing an **outbound call** from a call originator to a

call target, the system comprising:

a database storing a plurality of outgoing telephone numbers;

an information processor controlled by the call originator and configured to process a trigger comprising a telephone number of the call target;

access the database and select a **replacement telephone number** from the plurality of outgoing telephone numbers based on at least an area code of the telephone number of the call target;

modify caller identification data of the call originator to the selected replacement telephone number, the selected replacement telephone number having at least an area code the same as an area code of the telephone number of the call target; and

transmit the modified caller identification data of the call originator to the call target.

Appx390, 5:4–21 (emphasis added). U.S. Patent No. 8,565,399 (“the ‘399 Patent”), sharing a common specification with the ‘122 Patent, also has claims directed to the call originator with one disputed term: “outbound call.” Appx400, 5:5–23 (“1. A system for handling an **outbound call** from a call originator to a call target, the system comprising: d) transmit the caller identification data to the call target in connection with the **outbound call.**”) (emphasis added).

B. The majority redefines three claim terms on appeal.

The majority adopted narrow, wordy constructions for plain English terms merely because “[t]he intrinsic evidence **better supports** the Defendants’ proposed construction” Op., at 9 (emphasis added). This admission concedes that the

intrinsic evidence also does support NobelBiz’s proposed construction. Yet, the majority selected more narrow constructions without satisfying the high burden that NobelBiz: 1) acted as its own lexicographer; or 2) disavowed claim scope in the specification or during prosecution. *Op.*, at 6–9; *Unwired Planet, LLC v. Apple Inc.*, 829 F.3d 1353, 1358 (Fed. Cir. 2016) (reversing construction that read limitations into claim where no disavowal found in specification); *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1369 (Fed. Cir. 2012) (reversing constructions because court imported limitation from specification).

Other decisions from this Court have narrowed the plain and ordinary meaning without finding lexicography or disclaimer. *Trustees of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1363–66 (Fed. Cir. 2016) (narrowing term based on embodiments in the specification); *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011) (limiting term). *NobelBiz* exemplifies why lexicography and disclaimer are critical and this Court’s discord on the issue should be resolved here. Panels should not “redefine a claim term to match [their] view of the scope of the invention as disclosed in the specification. [They] are not the lexicographers.” *Retractable Techs. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1371 (Fed. Cir. 2011) (Moore, J., dissenting).

“Outbound Call.” Claim 1 recites: “A system for processing an outbound call from a call originator to a call target” This claim expressly recites that the

“outbound call” is created and transmitted by an originator of the call. Dkt. No. 43, at 3–4, 22–23 (reciting the “information processor **controlled by the call originator** . . . transmit the modified caller identification data **of the call originator** to the call target.”). However, the majority limited “outbound call” to a system in the telecommunications or carrier networks that receives and acts upon an outbound call, denoted by the majority as an “extant call.” Op., at 8–9.

But **the claims (and specification) do not mention “extant call” anywhere**; rather, they expressly recite call originator multiple times. The majority abandoned this threshold claim analysis. *See Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 805 (Fed. Cir. 2007) (“When construing claims, a court must begin by look[ing] to the words of the claims”) (citations and quotations omitted); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) (“[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms.”) (citations omitted).³ Indeed, the majority created its own extrinsic definition of the word “outbound,” instead of construing the claim term “outbound call.” Op., at 8 (no citation for purportedly “giv[ing] meaning to the word ‘outbound’”). However, a panel “cannot rely on extra-record extrinsic evidence in the first instance . . . about

³ The carrier network embodiment appears only in dependent claim 2. Dkt. No. 43, at 23. The majority’s reading that limitation into claim 1 violates claim differentiation. *See InterDigital Commc’ns., LLC v. ITC*, 690 F.3d 1318, 1324 (Fed. Cir. 2012).

the plain meaning of a claim term[.]” *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1039 (Fed. Cir. 2016) (en banc).

The majority similarly disregarded the specification’s disclosure that a call originator is a “call center, person or organization”—it is not limited to a carrier network. Dkt. No. 43, at 3–5, 22. Thus, call originator expressly includes a “call center,” which is where Defendants’ systems operate. *Id.*, at 2–3; *Thorner*, 669 F.3d at 1367 (“[P]atentee . . . obtain[s] full scope of its plain and ordinary meaning unless the patentee explicitly redefines the term or disavows its full scope.”).

The specification also states that the “system and method may operate in Originator’s 100 PBX . . . or may be attached to or embedded within Originator’s 100 communication device.” Appx388, 2:58–62; Dkt. No. 43, at 3–5, 22–24; Op., at 3 (Newman, J., dissenting) (“claimed system may alternatively operate in an origination device, before the call is sent”). This embodiment has to be “embedded [or incorporated] within Originator’s” device;⁴ thus, it cannot exist in the network.

Excluding this express embodiment, the majority required NobelBiz to disprove the technical functionality under its construction. Op., at 9 (“NobelBiz fails to show why a PBX or communication device cannot operate on an extant call”). But this is legally infirm. *See Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed.

⁴ The parties agreed that “embedded” means “[i]ncorporated within.” Appx58.

Cir. 2008) (court “normally do[es] not interpret claim terms in a way that excludes embodiments disclosed in the specification”); *Phillips*, 415 F.3d at 1323 (warning against confining claims to certain embodiments). Factually, because Defendants as Call Originators use a PBX to launch calls—found by the jury—the majority’s extrinsic understanding is unsupported. Dkt. No. 43, at 28–29, 31 (Defendants each operate a PBX to launch calls); *Apple*, 839 F.3d at 1039; *see also* Appx. 8941, 69:14–72:4 (discussing that a PBX operates in a call originator).

“Replacement Telephone Number.” Claim 1 recites: “replacement telephone number” and “modify caller identification data.” The majority narrowed the first term to require that a second telephone number must substitute for a first or original telephone number, while the second term was construed as “change caller identification data.” *Op.*, at 6–7.

But nothing in the claims supports that a first telephone number must be inserted into the caller identification data and then replaced with another telephone number. Rather, the independent claim recites **only one telephone number**—the single number selected from the database. Dkt No. 43, at 4, 19–22. It states: “select a replacement telephone number from the plurality of outgoing telephone numbers based on at least an area code of the telephone number of the call target” and then “modify caller identification data of the call originator **to the selected replacement telephone number.**” *Id.* at 4.

The claim only requires that, after the replacement telephone number (one telephone number) is selected based on a match, it is inserted into the caller ID data. *Id.* at 19–20. In other words, inserting the selected caller ID number satisfies the plain and ordinary claim element of “modify[ing] caller identification data . . . to the selected replacement number.”

The specification reinforces this conclusion; nowhere does it require a first telephone number to be inserted into the caller identification data and then substituted for by a second telephone number. Nor does the prosecution history support the majority’s strained construction. *Op.*, at 7. First, the amendment discussed in the opinion was made by the Examiner without comment, and this Court has repeatedly warned against speculating as to the reasons for such amendment. *See Frans Nooren Afdichtingssystemen B.V. v. Stopaq Amcorr Inc.*, 744 F.3d 715, 719–20 (Fed. Cir. 2014) (rejecting exclusion because “Applicants never said anything that states or implies such an exclusion” and “examiner’s language” was unclear). Second, NobelBiz made no statement narrowing “replacement telephone number” or “modify . . .” to require a first telephone number and a second telephone number. *See id.*; Dkt No. 43, at 21–22.

Instead of adhering to the intrinsic record, the majority again created its own extrinsic definition of the word “replacement” (not the claim term “replacement telephone number”) to reach its constructions. *Op.*, at 6 (with no citation, the

majority states: “The word ‘replacement’ indicates the replacement telephone number must actually *replace* something.”); *Apple*, 839 F.3d at 1039. To the contrary, a “replacement telephone number” can still replace “something” without having a first telephone number already in the call identification data. That is, the caller ID selected from the database replaces what otherwise would have been used by the call originator as a number.

En banc review is necessary to confirm that panels may narrow claim scope only after finding lexicography or disclaimer, and not by relying on “extra-record extrinsic evidence” or parsing the intrinsic record.

III. En banc review is needed to confirm that a jury should determine if evidence satisfies a claim’s plain and ordinary meaning for infringement.

The majority’s decision undermines the fact-finding role of the jury. Over a six-day trial in *NobelBiz*, there were “witnesses . . . pointing out the similarities and differences between the patented system and the accused systems.” *Op.*, at 4 (Newman, J., dissenting). “[T]he district court, in its measured judgment, refer[red] the question of infringement to the jury.” *Id.* at 6 (Newman, J., dissenting). The jury resolved the parties’ factual disputes and determined infringement. *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150–51 (2000) (juries, not judges, weigh evidence).

Yet, the majority reversed without providing any deference to the jury’s finding of facts as to infringement. *Op.*, at 6 (Newman, J., dissenting) (“it is not the

appellate role to require that the trial be repeated.”). *NobelBiz* gives a jury no latitude to consider whether evidence falls within a claim’s plain and ordinary meaning; now, anytime a defendant insists on a construction (i.e., invokes an *O2 Micro* “dispute”), the jury cannot determine whether the accused system fits within that meaning. *See Apple*, 839 F.3d at 1039 (Federal Circuit “require[s] appropriate deference be applied to the review of fact findings.”).

Experts also cannot argue why their clients’ evidence does or does not support a finding. In *NobelBiz*, Defendants converted expert testimony they elicited into an excuse for reversal (Op., at 5), despite never taking issue with this purportedly improper testimony. Dkt. No. 43, at 15, 22; *see also CytoLogix Corp. v. Ventana Med. Sys.*, 424 F.3d 1168, 1173 (Fed. Cir. 2005) (“no ground for reversal . . . [if] no objection to the expert testimony as to claim construction.”). And courts are required, whenever litigants demand constructions, to construe all terms—even simple ones. This opinion upsets the traditional roles of all trial participants and creates needless work for district courts.

CONCLUSION

This Court’s intra-circuit conflict on the viability of plain and ordinary meaning, mixed messages on narrowing claim scope, and encroachment into the jury’s fact finding role are issues of exceptional importance. En banc review is necessary to provide clear instruction on these issues to lower courts and litigants.

Respectfully submitted,

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NobelBiz, Inc.*

CERTIFICATE OF FILING AND SERVICE

I hereby certify that, on this the 1st day of September, 2017, I caused the foregoing to be electronically filed with the Clerk of the Court using the CM/ECF system, which will send notice of such filing to all registered users.

I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be deposited with United Parcel Service for delivery to the Clerk, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, 717 Madison Place, N.W., Washington, D.C., 20439.

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CERTIFICATE OF COMPLIANCE

Counsel for Plaintiff-Appellee NobelBiz, Inc. here certifies that:

1. The brief complies with the type-volume limitations of Federal Rule of Appellate Procedure 40(b) because exclusive of the exempted portions it does not exceed 15 double-spaced pages.

2. The brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type-style requirements of Federal Rule of Appellate Procedure 32(a)(6) because it has been prepared using Microsoft Word 2013 in a proportionally spaced typeface: Times New Roman, font size 14 point.

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