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14 **UNITED STATES DISTRICT COURT**
15 **SOUTHERN DISTRICT OF CALIFORNIA**
16

17 VIASAT, INC.,
18 Plaintiff,
19 vs.
20 SPACE SYSTEMS/LORAL, INC.,
LORAL SPACE &
COMMUNICATIONS INC.,
21 Defendants/Counterclaim
Plaintiffs.

Case No. 3:12-cv-00260-H-WVG

Hon. Marilyn L. Huff

**DEFENDANTS' MOTION FOR
JUDGMENT AS A MATTER OF
LAW (RENEWED) (8 OF 12)
REGARDING INDEFINITENESS**

Date: July 22, 2014

Time: 9:00am

Place: Courtroom 15A

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I. INTRODUCTION

Defendants Space Systems, Loral, LLC and Loral Space & Communications Inc. (collectively, "SS/L" or "Defendants") move for judgment as a matter of law that the asserted claims of U.S. Patent No. 8,068,827 (the "'827 Patent") and U.S. Patent No. 8,010,043 (the "'043 Patent") are invalid as indefinite.¹ Indefiniteness is a pure question of law. Because the asserted claims of the '043 and '827 Patents fail to inform with reasonable certainty those skilled in the art about the scope of the claimed invention, judgment as a matter of law is appropriate.

II. LEGAL FRAMEWORK

Under 35 U.S.C. § 112, ¶ 2, the claims of a patent must "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (2). Any claim that fails to meet this definiteness requirement is invalid. 35 U.S.C. § 282(b)(3)(A). Indefiniteness is a question of law. *Microprocessor Enhancement Corp. v. Tex. Instruments Inc.*, 520 F.3d 1367, 1374 (Fed. Cir. 2008).

Although the Federal Circuit has previously ruled that a claim is indefinite "only when it is 'not amenable to construction' or 'insolubly ambiguous,'" *Biosig*

¹ S/L hereby moves for judgment as a matter of law ("JMOL") pursuant to Rule 50(a) and, pursuant to Rule 50(b), renews the motion for JMOL that it made before the close of evidence.

In denying Defendants' motions for summary judgment that the '827 and '043 patents are invalid as indefinite, the Court initially indicated it would submit the issue of indefiniteness to the jury. *See* Dkt. No. 358 at 8; Dkt. No. 209 & 1/17 Hearing Tr. at 35-36. However, the Court later acknowledged that indefiniteness is a question of law appropriate for resolution by the court and thus declined to submit the issue to the jury. The Court instead directed Defendants to brief the issue in post-trial motions in the event the patents were found valid and infringed. *See* Trial Tr. at 1120-21, 1123.

1 *Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013), *vacated by*
2 134 S. Ct. 2120 (U.S. 2014), the Supreme Court recently rejected the Federal
3 Circuit's test for indefiniteness as "more amorphous than the statutory definiteness
4 requirement allows." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120,
5 2131 (2014). In place of the "insolubly ambiguous" standard, the Supreme Court
6 held that "a patent is invalid for indefiniteness if its claims, read in light of the
7 specification delineating the patent, and the prosecution history, fail to inform, with
8 reasonable certainty, those skilled in the art about the scope of the invention." *Id.* at
9 2124.

10 III. ARGUMENT

11 A. The Asserted Claims of the '043 Patent Are Indefinite.

12 A patent claim that recites both an apparatus and use of that apparatus is
13 invalid as indefinite. When a claim combines "two separate statutory classes of
14 invention"—apparatus and method claims—"a manufacturer or seller of the
15 claimed apparatus would not know from the claim whether it might also be liable
16 for contributory infringement because a buyer or user of the apparatus later
17 performs the claimed method of using the apparatus." *IPXL Holdings, L.L.C. v.*
18 *Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005). Such a claim therefore "is
19 not sufficiently precise to provide competitors with an accurate determination of the
20 'metes and bounds' of protection involved and is 'ambiguous and properly rejected'
21 under section 112, paragraph 2." *Id.* (quotation marks and citation omitted).

22 As explained below, Claims 1 and 7 of the '043 Patent recite both a satellite
23 and use of that satellite and are therefore indefinite as mixed method/apparatus
24 claims. Claim 3 (which depends from Claim 1) and Claim 8 (which depends from

1 Claim 7) include the same mixed format limitations and are likewise indefinite.

2 1. Claim 1 Is Invalid as Indefinite Because It Is an Apparatus
 3 Claim that Recites Use of the Claimed Apparatus.

4 Claim 1 of the '043 Patent is an apparatus claim drawn to "[a] satellite." It
 5 explicitly recites three components of the satellite: a power source, an antenna and a
 6 plurality of spot beams. Various details of the spot beams are also recited, including
 7 "the plurality of spot beams includes ... the first spot beam illuminates a first region
 8 . . . the second spot beam illuminates a second region . . . the first and second
 9 regions overlap ... the first spot beam as sent . . . the first spot beam as" Ex. B
 (V-1289).²

10 Claim 1 also describes the use of the satellite, including how the claimed
 11 satellite is operated and how a spot beam is received by a subscriber terminal. For
 12 example, Claim 1 recites that "the satellite is operated to maximize data-carrying
 13 capacity of the plurality of spot beams as measured in bits/Hz, by utilizing a beam
 14 pattern having a specific number of color(s) of frequency and polarization and
 15 specific beam spacing that results in higher data-carrying capacity of the plurality
 16 of spot beams than achieved with other alternative numbers of color(s) of frequency
 17 and polarization and beam spacings." Ex. B (emphasis added).³ The phrase "the
 18

19 ² Arguably, Claim 1 only recites two structures, a power source and an antenna, as
 20 "[t]he term spot beam refers to a directional radiation pattern provided by a satellite
 21 antenna in which the area of the geographical coverage is constrained to a footprint
 22 having a direct line of sight to the satellite." Ex. B, 1:40-44. *See also* Claim
 23 Construction Order, Dkt. No. 206 at 10 ("[T]he Court construes 'spot beam' as 'a
 focusing of electromagnetic radiation to permit communication with terminals in a
 geographical region that is a portion of the satellite's coverage area.'").

24 ³ All references to "Ex." herein refer to exhibits to the Declaration of Mark M.
 Musico, filed herewith.

1 satellite is operated" unambiguously requires the satellite to be used.⁴ Claim 1 also
 2 recites "whereby reception of signals from the first spot beam by the at least one of
 3 the first plurality of subscriber terminals is interference-dominated such that C/I is
 4 less than C/N." Ex. B (emphasis added). This limitation clearly requires the first
 5 spot beam to be received by a user (subscriber terminal).

6 The recitation in Claim 1 of how the claimed satellite is operated and details
 7 about users' reception of a spot beam both fit within the Federal Circuit rule from
 8 *IPXL Holdings* that reciting both an apparatus and a method of using the apparatus
 9 renders a claim indefinite. 430 F.3d at 1384. In *IPXL Holdings*, claim 25 recited:

10 The system of claim 2 [including an input means] wherein
 11 the predicted transaction information comprises both a
 12 transaction type and transaction parameters associated
 13 with that transaction type, and the user uses the input
 14 means to either change the predicted transaction
 information or accept the displayed transaction type and
 transaction parameters.

15 *Id.* (emphasis and alterations in original). The Court concluded that because claim
 16 25 recited both a system and a method for using that system, "it is unclear whether
 17 infringement of claim 25 occurs when one creates a system that allows the user to
 18 change the predicted transaction information . . . or whether infringement occurs
 19 when the user actually uses the input means to change transaction information"

20 *Id.* Thus, the Court held that "[b]ecause claim 25 recites both a system and the
 21 method for using that system, it does not apprise a person of ordinary skill in the art

22 ⁴ If the claim merely meant that the satellite was capable of being operated, it would
 23 have recited "the satellite is operable to...." *Cf. Interactive Gift Exp., Inc., v.*
 24 *Compuserve Inc.*, 256 F.3d 1323, 1336 (Fed. Cir. 2001) (proffered claim
 constructions that appear illogical in view of the ordinary meaning of the claim
 term are rarely proper).

1 of its scope, and it is invalid under section 112, paragraph 2." *Id.*

2 Similarly, in *Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331, 1339-
 3 1340 (Fed. Cir. 2011), the challenged claim 3 recited "[a] data transmitting device
 4 ... comprising ... first buffer means ... fractional encoding means ... second buffer
 5 means ... trellis encoding means ... and transmitting the trellis encoded frames."
 6 (emphasis added). The Federal Circuit explained that the first four elements of the
 7 claim recited apparatus elements and the final element recited method of use
 8 limitations. *Id.* at 1339 (discussing the limitation "transmitting the trellis encoded
 9 frames"). The court held the asserted claims invalid, explaining that "reciting both
 10 an apparatus and a method of using the apparatus renders a claim indefinite under
 11 section 112, paragraph 2." *Id.* (citing *IPXL Holdings, L.L.C.*, 430 F.3d at 1384).
 12 Notably, the method of use limitations in claim 3 did not explicitly refer to a user or
 13 require an action by a user. *Id.* Nonetheless, the Federal Circuit concluded that
 14 claim 3 was indefinite because the "transmitting" element is clearly a method step.
 15 *Id.*

16 Claim 1 of the '043 Patent suffers from the same problems identified in *IPXL*
 17 *Holdings* and *Rembrandt Data Technologies* by reciting:

18 (1) "the satellite is operated to maximize data-carrying
 19 capacity of the plurality of spot beams ..."; and

20 (2) "reception of signals from the first spot beam by the
 21 at least one of the first plurality of subscriber terminals is
 22 interference-dominated such that C/I is less than C/N."

23 Ex. B (emphases added). The language "reception of signals from the first spot
 24 beam by the at least one of the first plurality of subscriber terminals," describes an
 action by a user or subscriber terminal to use the spot beam, just like the limitation
 "user uses the input means" in *IPXL Holdings*. In addition, the language "the

1 satellite is operated to maximize," clearly describes a method step like the
2 "transmitting" limitation in *Rembrandt Data Technologies*, regardless of whether
3 the user or operator is expressly mentioned. Under the Federal Circuit's reasoning,
4 it is unclear whether infringement of Claim 1 of the '043 Patent occurs when one
5 builds a satellite, when one operates the satellite, or when a user receives signals
6 from the satellite. Because Claim 1 thus fails to inform with reasonable certainty
7 those skilled in the art about the scope of the claimed invention, the Court should
8 conclude that Claim 1 is indefinite.

9 2. The Problematic Language in Claim 1 Describes a Method of
10 Use and Is Not "Functional Language."

11 Claim 1 does not merely describe the claimed structure using "functional
12 language." *Compare Microprocessor Enhancement Corp.*, 520 F.3d at 1374. That
13 argument must fail in light of the Federal Circuit's holding in *Rembrandt Data*
14 *Technologies*. In that case, the Court invalidated a claim as indefinite because it
15 claimed a "data transmitting device for transmitting signals," but then recited
16 "transmitting the trellis encoded frames." 641 F.3d at 1339. Although the recited
17 action of "transmitting" was performed by the claimed transmitting device, the
18 Federal Circuit nonetheless invalidated the claim under the *IPXL Holdings* rule --
19 thereby declining to conclude that the "transmitting" limitation was merely
20 "functional language" describing the claimed apparatus.

21 Here, the reasons for invalidating Claim 1 are even stronger than they were in
22 *Rembrandt*, as the "reception of signals" in Claim 1 of the '043 Patent cannot
23 possibly be performed by the claimed satellite, as the satellite cannot receive its
24 own signals. Instead, Claim 1 makes clear that the "reception of signals" is

1 performed not by the satellite but "by the at least one of the first plurality of
2 subscriber terminals" Thus, the "reception of signals" limitation cannot be
3 describing the functionality of the satellite, but rather must be claiming methods
4 performed by the unclaimed subscriber terminals.⁵ See Dkt. No. 955-2 (Schindall
5 Report) at 202. This mixes methods and an apparatus and thus renders the claim
6 invalid.

7 3. Interference-Domination Is Not "Fixed."

8 The trial record also belies the argument ViaSat previously used to avoid
9 indefiniteness—namely, that "satellite design aspects that determine beam
10 placement, interference levels, and noise levels are well set before the satellite
11 launches and cannot be changed once in orbit." Dkt. No. 316 at 17-18. But, for
12 example, Mark Miller admitted that interference levels depend in large part on
13 ground data, not any configuration of the satellite. Trial Tr. 1337. And, in order to
14 prove that the reception of signals by one of the subscriber terminals is interference-
15 dominated, Mr. Sturza relied on "other interference sources" including "adjacent
16 satellite interference." Trial Tr. 1630-31. Whether a satellite satisfies the "reception
17 of signals" limitation is thus not determined by the satellite itself but by its mode of
18 use in combination with ground terminals and even other satellites. In other words,
19 a manufacturer like SS/L could build a satellite and fully believe, based on
20 information available to it, that C/I exceeds C/N (i.e. that there are no interference-
21 dominated locations). But through no fault of its own, in the future, another satellite
22 could launch, increasing the interference (and thus making C/I lower). Or,

23
24 ⁵ The inventors of the '043 Patent could have claimed, but did not claim, a "satellite
communication system" (the satellite and its ground equipment) in Claim 1.

1 unbeknownst to the manufacturer, ground terminals could improve in the future,
2 making N lower (and thus C/N higher).

3 4. "Operated" Does Not Mean "Configured."

4 ViaSat has also argued that "is operated to" means the same thing as "is
5 configured to." Putting aside the fact that this reading is flatly contrary to the plain
6 meaning of the claim language, ViaSat itself used the verb "to operate" in Claim 17
7 of the '043 Patent precisely to convey a method of use. Claim 17 is the method claim
8 counterpart to claim 1, and claims "[a] method for operating a satellite
9 communications system," including the method steps of (among others) (1)
10 "sending a plurality of spot beams from a satellite to service a plurality of service
11 links" and (2) "maximizing the data-carrying capacity . . . by utilizing" a particular
12 beam pattern. Ex. B at 23:36-60 (emphasis added). It is undisputable "that the same
13 terms appearing in different portions of the claims should be given the same
14 meaning unless it is clear from the specification and prosecution history that the
15 terms have different meanings at different portions of the claims." *Fin Control Sys.*
16 *Pty., Ltd. v. OAM, Inc.*, 265 F.3d 1311, 1318 (Fed. Cir. 2001). Here there is no basis
17 to overcome the presumption—ViaSat used the term "operate" to describe a method
18 of using a satellite to maximize capacity in Claim 17, and ViaSat impermissibly
19 combined that same method of use with an apparatus in Claim 1.

20 ViaSat knew how to use the phrase "configured to" when it wished to
21 describe a satellite that had been designed in a particular way, and knew how to use
22 the phrase "operated to" when describing how a satellite is used after it is launched.
23 ViaSat filed a continuation to the '043 Patent based on the same specification that
24 expressly claimed a "method for configuring a satellite" and a "satellite designed

by" that method. *See* Dkt. No. 327-3 at B-36 ('202 Patent, claims 10, 21 (emphasis added)). *NTP, Inc. v. Research In Motion, Ltd.*, 417 F.3d 1282, 1293 (Fed. Cir. 2005) ("Because [patentee's] patents all derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents."). Just as the same terms are presumed to have the same meaning, "different terms in the claims connote different meanings." *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000). The contrast between ViaSat's claimed "method of operating a satellite communications system" in Claim 17 of the '043 and "method for configuring a satellite" in claim 10 of the '202 patent reveal that the phrase "is operated to" denotes a method of use and not a functional by-product of satellite configuration.

5. Dependent Claim 3 of the '043 Patent is Invalid as Indefinite Because It Incorporates Claim 1.

Claim 3 is dependent on claim 1 and therefore incorporates all of the limitations of claim 1. To the extent claim 1 is held invalid as indefinite because of the "satellite is operated" and "reception of signals" limitations, it necessarily follows that claim 3 is invalid as well. *See, e.g., Rembrandt Data Techs.*, 641 F.3d at 1339-40 (invalidating dependent claims 4-11 because independent claim 3 was indefinite).

6. Claims 7 and 8 of the '043 Patent Are Invalid as Indefinite.

Like Claim 1, Claim 7 also recites the "reception of signals from the first spot beam by the at least one of the first plurality of subscriber terminals" Ex. B. Once again, this limitation describes an action by a user or subscriber terminal to use the spot beam, just like the limitation "user uses the input means" in *IPXL*

1 *Holdings*. This "reception of signals" cannot possibly be performed by the satellite,
 2 as discussed above. Therefore, Claim 7 recites both "[a] satellite" and use of the
 3 satellite, which renders Claim 7 invalid as indefinite for the same reasons as
 4 described above with respect to Claim 1. And because Claim 8 depends from and
 5 incorporates the same limitations from Claim 7, Claim 8 is also invalid as
 6 indefinite. *See, e.g., Rembrandt Data Techs.*, 641 F.3d at 1339-40.

7 **B. Claim 7 of the '827 Patent Is Indefinite.**

8 Claim 7 of the '827 patent (Ex. C, V-1290) is also invalid as indefinite for
 9 two reasons:

10 First, the satellite in claim 7 makes transmission determinations
 11 based on "information indicating a presence or an absence of an
 12 interference situation." But, as ViaSat would read the claim, this
 13 "information" could consist of simply the subjective opinions of a
 14 technician on the ground. A claim whose infringement turns on the
 15 subjective whims of a third-party is invalid as indefinite.

16 Second, claim 7 purports to cover circuitry that feeds to a satellite's
 17 transmitter instructions either (1) to transmit in only the
 18 geostationary ("GSO") frequency band, or (2) to transmit in both
 19 the GSO and nongeostationary ("NGSO") frequency bands. But the
 20 claim is drafted nonsensically, because the transmitter then ignores
 21 these instructions and either transmits only in the GSO band or
 22 transmits only in the NGSO band.

23 Claim 7 thus fails to inform with reasonable certainty those skilled in the art about
 24 the scope of the claimed invention. Accordingly, this Court should hold Claim 7
 invalid as indefinite. *See Nautilus*, 134 S. Ct. 2120.

1. The "Information Indicating a Presence or an Absence of an
 Interference Situation" Limitation Renders Claim 7 Indefinite.

Claim 7 is directed to a GSO satellite that includes circuitry configured to
 activate the NGSO frequency spectrum "based on information indicating a presence
 or absence of an interference situation." Ex. C. Because the claim contains no

1 requirement that the circuitry be configured to switch based on objective
2 interference information, infringement of Claim 7 may turn on the subjective
3 motivations of the individual on the ground who makes the switching decision.
4 Claim 7 is thus invalid because its "circuitry" limitation lacks an objective standard
5 to determine the scope of the claimed invention and instead may depend on any one
6 person's subjective opinion.

7 Claim language that "depend[s] solely on the unrestrained, subjective opinion
8 of a particular individual purportedly practicing the invention" is indefinite.
9 *Datamize LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005).
10 When a subjective claim term is used, "[s]ome objective standard must be provided
11 in order to allow the public to determine the scope of the claimed invention." *Id.* A
12 claim term cannot be based on a subjective construction that "would depend on the
13 unpredictable vagaries of any one person's opinion." *Id.*⁶

14 Claim 7 has this subjectivity problem in its "circuitry" limitation. As SS/L
15 urged at claim construction, the claimed GSO satellite employs on-board orbital
16 data to determine whether an interference situation is present. Dkt. No. 206. SS/L
17 proposed to construe the "circuitry" limitation consistent with this understanding:
18 "A control device that uses orbital information to select one or more appropriate
19 frequency band(s) during the presence or absence of an interference situation." *Id.*

20
21 ⁶ Courts have often held claims indefinite where certain limitations were based on
22 an individual's subjective views. *See, e.g., STX, Inc. v. Brine, Inc.*, 37 F. Supp. 2d
23 740, 746 (D. Md. 1999) ("improved handling and playing characteristics"); *Romala*
24 *Stone, Inc. v. Home Depot U.S.A., Inc.*, 2007 WL 2904110, at *5-6 (N.D. Ga. Oct.
1, 2007) ("price affordable to the average consumer"); *Crane Co. v. Sandenvendo*
Am., Inc., 2009 WL 1586704, at *13 (E.D. Tex. June 5, 2009) ("rapidly").

1 The Court, however, rejected that construction and interpreted the "circuitry"
2 limitation to mean "circuitry configured to select one or more appropriate frequency
3 bands based on information indicating the presence or absence of an interference
4 situation with an NGSO satellite system." Dkt. No. 206 at 22. Like the claim
5 language, that construction provides no guidance as to what determines the
6 existence of an interference situation or how such a determination is made. *Id.*
7 Nonetheless, the jury then found infringement by the Jupiter-1 satellite, which lacks
8 "smart" on-board circuitry and instead contains a simple switch that turns the
9 NGSO spectrum "on" or "off" based on instructions from the ground.

10 If, as the jury found, Claim 7 covers a switch activated by mere binary data
11 ("on" or "off") yet also requires circuitry configured to switch "based on"
12 interference information, infringement must turn on the subjective motivations of
13 the individual who makes the switching decision or the mode of operating the
14 satellite in any given instance. Given that a bare "on" or "off" signal indicates
15 nothing about interference, the only way to determine infringement would be to
16 ascertain the reason the signal was sent, by looking beyond the claimed satellite and
17 into the mind of the satellite operator or other indications of how the satellite is
18 being operated.⁷ The same configuration of circuitry thus may or may not infringe
19 depending on, for example, whether the satellite operator (1) instructs the GSO
20 satellite to switch off the NGSO spectrum for 5 minutes because he or she

22 ⁷ Indeed, despite the fact that Claim 7 is an apparatus claim, Mr. Sturza testified –
23 strikingly – that dynamic switching in response to interference events is "not a
24 satellite issue," and thus he "wouldn't expect to see anything about [dynamic
switching in response to interference events] in the SS/L design documents." Trial
Tr. 1715.

1 performed a calculation and determined that the satellite would be in-line with an
 2 NGSO satellite between 9:05 AM and 9:10 AM; or (2) decides to switch the NGSO
 3 spectrum off permanently starting next March, simply because he or she believes an
 4 NGSO satellite might be launched then. The latter determination would turn
 5 entirely on the satellite operator's own beliefs rather than the presence or absence of
 6 any "interference situation."⁸

7 Because Claim 7, as construed by the Court, encompasses scenarios that
 8 depend merely on the "unrestrained, subjective opinion of a particular individual
 9 purportedly practicing the invention," it is indefinite. *See, e.g., Datamize*, 417 F.3d
 10 at 1350. A claim that does not allow one of skill in the art to know from one use to
 11 the next whether they are infringing is the "epitome of indefiniteness." *Geneva*
 12 *Pharm., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003).⁹

13 2. The "Transmitter" Limitation Renders Claim 7 Indefinite.

14 Claim 7 of the '827 Patent essentially describes a three-component satellite.
 15 The first component is identified in the first limitation of Claim 7, which provides
 16 for a "receiver." Ex. C. This receiver receives two different types of signals from
 17 the ground: "[1] in a GSO frequency band and [2] in an extended frequency

18 _____
 19 ⁸ Again, Mr. Sturza conceded as much at trial:

20 Q: But the presence or absence of interference would be
 21 indicated by a ground operator theoretically deciding I'm
 22 going to send a signal to switch because of interference,
 23 right?

24 A: Yes, that's my understanding.

Trial Tr. 1709.

⁹ Stated differently, Claim 7 is also indefinite because it is an apparatus claim, but
 infringement depends on the manner in which the apparatus is used by the operator.
IPXL Holdings, 430 F.3d at 1384.

1 spectrum, the extended frequency spectrum including the GSO frequency band and
2 a non-geostationary orbit (NGSO) frequency band." Ex. C (numbering added for
3 clarity).

4 The second component of this satellite, corresponding to the second
5 limitation of the claim, is its onboard "circuitry." Ex. C. This circuitry selects an
6 "activated frequency mode . . . based on information indicating a presence or an
7 absence of an interference situation with an NGSO satellite system." V-1290. There
8 are two options for this activated frequency mode: "one of [1] a GSO frequency
9 band mode and [2] an extended frequency spectrum mode." *Id.* (emphasis and
10 numbering added for clarity). The "extended frequency spectrum mode" in this
11 limitation refers back to the "extended frequency spectrum" in the first limitation,
12 which was defined to include both GSO and NGSO. So the two "activated
13 frequency modes" here are either (1) GSO-only mode or (2) GSO+NGSO mode.

14 The third component of the claimed GSO satellite system – and the third
15 limitation of Claim 7 – is a "transmitter." This "transmitter" changes its
16 transmission characteristics based upon "the activated frequency spectrum mode."
17 Ex. C. Accordingly, the input to the transmitter is one of the two "activated
18 frequency spectrum modes" – either (1) the GSO-only mode, or (2) the
19 GSO+NGSO mode. But this is not the output of the transmitter. Rather, Claim 7
20 dictates that the transmitter will transmit "in one of [1] the GSO frequency band and
21 [2] in the NGSO frequency spectrum." Ex. C (emphasis and numbering added for
22 clarity). The claimed GSO satellite therefore does not actually transmit in a
23 combined GSO+NGSO mode. Instead, it picks "one of" the GSO frequency band
24 and the NGSO frequency spectrum. The transmitter limitation in Claim 7 is thus

1 nonsensical and, accordingly, renders the claim indefinite. *Halliburton Energy*
2 *Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008).

3 Moreover, the nonsensical nature of Claim 7 makes it impossible to
4 determine the scope of the claim with any certainty. The claim describes a satellite
5 that determines whether it should transmit in either a GSO mode or in a
6 GSO+NGSO mode, but, after having made that choice, the satellite then transmits
7 either in GSO-only or in NGSO-only. One of skill in the art could not understand
8 with reasonable certainty what was intended by this claim, insofar as it requires the
9 satellite to make a transmission determination that the satellite then explicitly does
10 not follow.

11 The Court's construction of "a transmitter configured to transmit in one of the
12 GSO frequency band and in the NGSO frequency spectrum" as "in one or more of
13 the GSO frequency band and the NGSO frequency spectrum," Dkt. No. 209 at 8,
14 does not resolve the indefiniteness of Claim 7. This construction requires three
15 modes of transmission: (1) GSO frequency band; (2) NGSO frequency spectrum; or
16 (3) GSO frequency band and NGSO frequency spectrum. Such construction
17 remains indefinite (and/or lacks written description support) because it still requires
18 that the satellite be capable of transmitting in an NGSO only mode, which the
19 patent does not teach.

20 Moreover, the Court based its construction of Claim 7 on the Federal
21 Circuit's now-defunct view that "a claim is indefinite 'only if reasonable efforts at
22 claim construction prove futile,' and 'accord[s] respect to the statutory presumption
23 of patent validity.'" Dkt. No. 209 at 8 (citing *Exxon Research & Eng'g Co. v. United*
24 *States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001)). The Supreme Court in *Nautilus*

specifically made clear that the "presumption of validity does not alter the degree of clarity that § 112, ¶ 2 demands from patent applicants; to the contrary, it incorporates that definiteness requirement by reference." *Nautilus*, 134 S. Ct. at 2130 n.10. Any attempt at a "saving" construction of the nonsensical language in Claim 7 is thus plainly inappropriate in light of the Supreme Court's decision in *Nautilus*. Cf. *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) ("[W]here as here, claims are susceptible to only one reasonable interpretation and that interpretation results in a nonsensical construction of the claim as a whole, the claim must be invalidated."); *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 782 (Fed. Cir. 2010) (stating that courts are not to "redraft claims to contradict their plain language in order to avoid a nonsensical result"). The nonsensical nature of Claim 7 is inescapable and the Claim should be ruled indefinite as a matter of law.

IV. CONCLUSION

For the foregoing reasons, Defendants respectfully request judgment as a matter of law that Claims 1, 3, 7, and 8 of the '043 Patent and Claim 7 of the '827 Patent are invalid as indefinite.

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By: /s/ Patrick C. Bageant

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CERTIFICATE OF SERVICE

I hereby certify that, on June 13, 2014, I caused the foregoing
**DEFENDANTS' MOTION FOR JUDGMENT AS A MATTER OF LAW
(RENEWED) (8 OF 12) REGARDING INDEFINITENESS** to be served on
opposing counsel via the Court's CM/ECF system.

Dated: June 13, 2014

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