



January 20, 2015; Defendants' Reply Brief (ECF No. 234), filed February 3, 2015; and Plaintiff's Sur-Reply Brief (ECF No. 235), filed February 6, 2015. A hearing was held on this matter on March 4, 2015. *See* Hr'g Tr., ECF No. 259.

## **I. BACKGROUND**

Plaintiff is the current owner of three Patents-in-Suit: United States Patent Number 6,895,557 (the "'557 patent"), United States Patent Number 7,765,482 (the "'482 patent"), and United States Patent Number 8,612,515 (the "'515 patent").

The parties seek construction of nine sets of terms appearing in the Patents-in-Suit: (1) "pre-processing"; (2) "server device," "host server," "remote device," "remote server," "a device separate from said client device," and "distributing party"; (3) terms relating to the receipt, provision, or transmission of pre-processing parameters; (4) terms relating to the preambles of the '482 and '515 patents; (5) "distributing," "distribution"; (6) "said identification"; (7) "said client device"; (8) "media object identifier"; and (9) "code means . . . for enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account."

## **II. LEGAL STANDARD**

Patent infringement is the unauthorized making, using, selling, offering to sell, or importing into the United States of any patented invention during the term of the patent. 35 U.S.C. § 271(a). In a patent infringement case, a court first determines the proper construction of the patent claims, establishing the scope and boundaries of the subject-matter of the patent as a matter of law. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 384–85 (1996); *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015). The trier of fact will then be called upon to compare the properly construed claims to the allegedly infringing

devices in order to determine whether there has been infringement. *Markman*, 52 F.3d at 976.

The claims of a patent are the numbered paragraphs at the end of the patent that define the scope of the invention, and thus the scope of the patentee's right to exclude others from making, using, or selling the patented invention. *See Astrazeneca AB v. Mut. Pharm. Co.*, 384 F.3d 1333, 1335–36 (Fed. Cir. 2004). Claim construction is the process of giving proper meanings to the claim language thereby defining the scope of the protection. *See Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp.*, 55 F.3d 615, 619 (Fed. Cir. 1995).

Claim construction starts with the language of the claim itself because a patent's claims define the invention to which the patentee is entitled the right to exclude. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). “[T]he claims themselves provide substantial guidance as to the meaning of particular claim terms.” *Id.* at 1314. Moreover, claim terms should be given their ordinary and customary meaning as understood by a person of ordinary skill in the art as of the effective filing date of the patent application. *Id.* at 1313. This is because a patent is addressed to, and intended to be read by, others skilled in the particular art. *Id.* However, the patentee is free to disavow the ordinary meaning of a term and define his own terms, so long as any special definition given to a term is clearly set forth in the specification or prosecution history. *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 719 (2014).

When construing disputed claim terms, a court should look first to the intrinsic record of the patent, including the claims and the specification, to determine the meaning of words in the claims. *Nazomi Commc'ns, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1368 (Fed. Cir. 2005). “[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 (internal

quotation marks omitted). The specification acts as a dictionary when it expressly or implicitly defines terms. *Id.* at 1321. Courts should also refer to the prosecution history, if it is in evidence. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). The prosecution history is part of the intrinsic record and consists of a complete record of all proceedings before the United States Patent and Trademark Office, including prior art cited during the examination of the patent, and express representations made by the applicant as to the scope of the claims. *Id.* at 1582–83.

The Federal Circuit has also stated that district courts may “rely on extrinsic evidence, which consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.” *Phillips*, 415 F.3d at 1317 (internal quotation marks omitted). Dictionaries and treatises can be “useful in claim construction”; in particular, technical dictionaries may help the court “to better understand the underlying technology and the way in which one of skill in the art might use the claim terms.” *Id.* at 1318 (internal quotation marks omitted). As to expert testimony, the Federal Circuit has stated:

[E]xtrinsic evidence in the form of expert testimony can be useful to a court for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court’s understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field.

*Id.* However, “a court should discount any expert testimony that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent.” *Id.* (internal quotation marks omitted). Extrinsic evidence is less significant than the intrinsic record and undue reliance on it may pose a risk of changing the meaning of claims, contrary to the public record contained in the written patent.

*Id.* at 1317, 1319.

Where the meaning of a claim is unclear, the claim may be indefinite under 35 U.S.C. § 112, ¶ 2. “[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014). “The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable. The . . . certainty which the law requires in patents is not greater than is reasonable, having regard to their subject-matter.” *Id.* at 2129 (internal quotation marks omitted).

### III. CLAIM CONSTRUCTION ANALYSIS

#### A. “Pre-processing”

	<u>Plaintiff</u>	<u>Defendants</u>
<b>pre-processing</b>	modifying the [media object data/digital content data/one or more image files, video files, or audio files], <sup>1</sup> as opposed to data merely associated with the [media object/digital content/image files, video files, audio files], at the client or local device in preparation for transmission to a remote device	modification before further processing / modifying before further processing  OR  modifying the [media object data/digital content data/one or more image files, video files, or audio files], as opposed to data merely associated with the [media object/digital content/image files, video files, audio files], at the client or local [device] (sic) prior to transmission to a remote device <sup>2</sup>

Plaintiff argues that the Court should adopt substantially the same construction of the “pre-processing” term as in the previous *Summit 6* case. *See Summit 6 LLC v. Research in Motion Corp.*, No. 3:11-cv-367-O, 2012 U.S. Dist. LEXIS 186414, at \*12–31 (N.D. Tex. May 21, 2012) (O’Connor, J.) [hereinafter “previous *Summit 6* case”].<sup>3</sup> Defendants contend that “modification before further processing” better reflects the plain meaning of the term. Defs.’ Open. Br. 17, ECF

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<sup>1</sup> According to footnote two of the parties’ Joint Claim Construction Chart: “The Patents-in-Suit use different terms in the claims to describe the items that are pre-processed (*i.e.*, ‘media object,’ ‘digital content,’ ‘image files, video files, or audio files’). The bracketed text indicates the substitution of these terms in their respective claims in the Patents-in-Suit.”

<sup>2</sup> As mentioned in footnote four of the parties’ Joint Claim Construction Chart, because Defendants first posed this alternative construction in their Responsive Claim Construction Brief, *Summit 6* did not have an opportunity to respond to this argument in the briefing. *See* Defs.’ Resp. Br. 5, ECF No. 229.

<sup>3</sup> The only change Plaintiff proposes to the construction of “pre-processing” in the previous *Summit 6* case is the addition of “one or more image files, video files, or audio files” to the bracketed portion of the construction, in order to make the construction consistent with the language in the ’515 patent claims. *See* Joint Status Report Ex. A (Proposed Claim Constructions & Evidence) n.1, ECF No. 232.

No. 219. In the alternative, Defendants would accept Plaintiff's proposed construction with the phrase "prior to" replacing the "in preparation for" phrase. Defs.' Resp. Br. 5, ECF No. 229.

The briefing reflects two primary points of contention regarding the "pre-processing" claim term. First, although the parties agree that "pre-processing" involves the modification of material, the parties offer different constructions to describe what happens to the material subsequent to modification. In Summit 6's proposal, the material is modified "in preparation for transmission." In Defendants' alternate proposals, the material is modified either "before further processing" or "prior to transmission." Defs.' Open. Br. 16, ECF No. 219; Defs.' Resp. Br. 5, ECF No. 229. The parties also disagree as to whether the "pre-processing" construction should address the same three questions discussed in the previous *Summit 6* case: what material is pre-processed, where the pre-processing occurs, and where the material is transmitted. Defendants do not contest the content of the Court's prior resolution of these questions; instead, they suggest that the elaborations are not necessary to the construction of pre-processing. Defs.' Resp. Br. 4–5, ECF No. 229; *see also* Hr'g Tr. at 14:25–15:8, ECF No. 259.

1. Defendants' Initial Proposed Construction

The Court turns first to Defendants' initial proposed construction. Defendants suggest, citing Merriam-Webster's Collegiate Dictionary, that the prefix "pre-" in "pre-processing" indicates that the material must be modified in some way *before* it undergoes processing. Defs.' Open. Br. 17, ECF No. 219. They define "processing" broadly to include the transmission, uploading, transporting, publishing, and distribution of material. *Id.*; Defs.' Resp. Br. 4, ECF No. 229. Defendants further contend that their construction is superior because Plaintiff's requirement that material must be modified in preparation only for "transmission" contradicts the claims. Defs.' Open. Br. 17–19, ECF

No. 219 (citing *Phillips*, 415 F.3d at 1314). Defendants note that claims 1, 36, and 37 of the '482 patent provide that, subsequent to modification, material could be “distributed” or “published” instead of being “transmitted.” *Id.* at 17; Defs.’ App. Supp. Open. Br. Ex. 3 ('482 patent), claims 1, 36–37, App. 49, 51, ECF No. 219-1. Thus, they conclude that “modification before further processing” is the most accurate construction.

Plaintiff responds that, in every instance of “pre-processing” in the claims, the modified material first is transmitted. Pl.’s Resp. Br. 5–6, ECF No. 227. After transmission to another location, the material may then be distributed or published, but this stage is not required. *Id.*; *see, e.g.*, '482 patent, claim 1(d), App. 49, ECF No. 219-1 (“*transmitting* said pre-processed group of one or more items of digital content to said server device *for subsequent publishing . . .*”) (emphasis added). Thus, Plaintiff argues that its proposed construction does not contradict the claims and instead gives a more specific definition of the “pre-processing” claim term.

Plaintiff further objects that Defendants improperly rely on dictionary definitions over the intrinsic record. Pl.’s Resp. Br. 5–6, ECF No. 227; Pl.’s Open. Br. 10–13, ECF No. 217. Reliance on dictionaries, particularly non-technical dictionaries, risks altering the meaning of the claim beyond what it would mean to a person skilled in the particular art in the context of the patent. *See Phillips*, 415, F.3d at 1319–24. Instead, the specification or prosecution history should be the primary support for a proposed construction. *See id.* The Court agrees with Plaintiff that the intrinsic record should be the primary support for a proposed construction. *See id.*

Plaintiff next argues that Defendants’ vague interpretation of “pre-processed” could lead to jury confusion. *See* Pl.’s Open. Br. 6–10, ECF No. 217; Pl.’s Resp. Br. 6, ECF No. 227. Indeed, Defendants note that Plaintiff’s counsel misconstrued the meaning of Defendants’ initial construction



in its Opening Claim Construction Brief. *See* Defs.’ Resp. Br. 4, ECF No. 229 (“In essence, Summit 6 misconstrues Defendants’ proposed construction by construing ‘further processing’ to mean ‘further modifying.’”).

Confusion arose between the parties for two reasons. First, Defendants’ initial construction uses the word “processing” in their definition of “pre-processing,” and the construction itself does not define the word “processing.” It is only in the briefing that Defendants define “processing.” *See* Defs.’ Resp. Br. 4, ECF No. 229 (“As Defendants explained in their opening brief, ‘further processing’ includes ‘transmission of the pre-processed material,’ but may also include other types of processing, such as uploading, transporting, publishing, and distributing.”). Second, Plaintiff assumed that the “pre-” in “pre-processing” indicated that the “processing” step will occur *before* something else happens, namely “transmission”; whereas Defendants assumed that the “pre-” in “pre-processing” indicated that something, namely “modification,” would occur *before* the “processing” step. Plaintiff’s attempt to reconcile these two assumptions led it to posit that, under Defendants’ construction, “processing” is synonymous with “modification,” and thus Defendants’ “pre-processing” construction would require two stages of modification. *See* Pl.’s Resp. Br. 6, ECF No. 227. Accordingly, Plaintiff’s briefing objected that Defendants were attempting to impose an improper limitation by requiring two stages of modification when the claims are agnostic as to whether further modification will take place. *Id.*; *Hill-Rom Servs.*, 755 F.3d at 1372–73 (holding that courts “do not read limitations from the embodiments in the specification into the claims”). Defendants’ briefing clarifies that they did not intend their construction to require two stages of modification; instead, their construction of “pre-processing” would include one stage of modification and one broadly defined “processing” stage. *See* Defs.’ Resp. Br. 4, ECF No. 229.

The Court finds that Plaintiff posits a more specific definition of the “pre-processing” claim term. *See* Pl.’s Open. Br. 6–10, ECF No. 217. Plaintiff’s construction provides that every instance of pre-processing involves the “modification” of material *before* the material is “transmitted” to another location. *Id.* This description is based upon the claims and provides helpful specificity and scope to the relevant claims. *See Nautilus*, 134 S. Ct. at 2124. The Court further determines that the inclusion of what material is transmitted where, in answer to the questions at issue in the previous *Summit 6* case, adds helpful clarification to the term without imposing extraneous limitations on the claims. *See Hill-Rom Servs.*, 755 F.3d at 1372–73. Further, Defendants, in their Responsive Brief, indicated that they are willing to accept the bulk of Plaintiff’s proposed construction. Defs.’ Resp. Br. 5, ECF No. 229. Accordingly, the Court now turns to Defendants’ proposed change to one phrase of Plaintiff’s construction.

2. “In Preparation For” or “Prior To”

Defendants argue, in the alternative, that the phrase “in preparation for” should be replaced with the phrase “prior to” in Plaintiff’s construction of “pre-processing.” *Id.* As this alternate proposal was introduced in Defendants’ Response Brief, Plaintiff did not specifically address this issue in its briefing. However, in the hearing on this matter, Plaintiff had the opportunity to clarify its position. *See Hr’g Tr.* at 10:8–19, ECF No. 259. According to Plaintiff, the “in preparation” phrase serves to provide helpful context. *Id.* at 12:5–7. Plaintiff reasons that, because all of the claims require transmission of pre-processed content, the pre-processing must occur for the purpose of preparing something for transmission. *Id.* at 10:9–14; *see also* Pl.’s Open. Br. 9, ECF No. 217 (“The specification makes clear that pre-processing does not happen in the abstract, as Defendants’ construction suggests, but rather to prepare media for transmission to another device.”).

Alternatively, Plaintiff submitted that it would accept a construction that included both “prior to” and “in preparation for.” Hr’g Tr. at 30:6–18, ECF No. 259. Thus, the Court finds that the parties agree about the “when” question — that the modification of material occurs “prior to” the transmission. *See id.* at 10:2–3 (“[W]e don’t dispute that the pre-processing has to happen before transmission.”). They disagree as to the “why” question — whether the material is modified *for the purpose of* transmission. *See id.* at 10:3–5.

In the previous *Summit 6* case, the Court did not specifically analyze the “in preparation for” phrase in its construction of “pre-processing.” Thus, the Court will address the question for the first time here. *See Negotiated Data Solutions, Inc. v. Apple, Inc.*, No. 2:11-CV-390-JRG, 2012 WL 6494240, at \*5 (E.D. Tex. Dec. 13, 2012) (“[T]he previous constructions in those cases [concerning the same patent], and particularly from those in this District, are instructive but are not alone compelling or binding on the Court.”).

According to Plaintiff, the specification answers the question of why the material is transported. For support, Plaintiff at the hearing highlighted column 1, lines 7–11 and lines 58–63 of the ’557 patent. *See* Hr’g Tr. at 12:9–15, ECF No. 259. The first excerpt reads in relevant part: “The present invention relates to the handling, manipulation and processing of digital content and more particularly to the *transportation* and Internet publishing of digital content.” ’557 patent 1:8–11 (emphasis added). The second excerpt distinguishes prior art because Caught in the Web’s ActiveUpload tool had no “built in ‘intelligence’ to streamline the process of handling and *transporting* rich media objects from the front end.” *Id.* at 1:61–63 (emphasis added); *see* Hr’g Tr. at 12:16–23, ECF No. 259. Thus, from these two passages, Plaintiff concluded that the “in preparation for transmission” language is reflected in the specification.

Defendants respond that Plaintiff's "in preparation for" language imposes an unnecessary limitation on the claims. Hr'g Tr. at 17:24, ECF No. 259. They argue that Plaintiff is attempting to read out other limitations that are present in the claims through a potentially confusing construction. *See id.* at 27:5–12. For instance, some claims, such as claim 13(b) of the '482 patent, indicate that the modification takes place for a particular purpose other than transmission. *See id.* at 23:1–8. Claim 13(b) of the '482 patent reads in relevant part: ". . . pre-processing parameters controlling said client device in a placement of said digital content into a specified form *in preparation for publication* to one or more devices that are remote . . ." '482 patent, claim 13(b) (emphasis added). Defendants add that the specifications' repeated use of the language "prior to" instead of "in preparation for" also demonstrates that the applicant knew how to distinguish between terms. Hr'g Tr. at 24:6–10, ECF No. 259.

The Court is not convinced that the claims or specifications bear out Plaintiff's context argument. In both of the specification excerpts Plaintiff cited as support, "transmission" is paired along with another function and thus it is not clear why the given purpose of the modification must be "transmission." Moreover, merely because material is modified before transmission does not imply that the purpose of the modification is the transmission itself. The Court also finds persuasive Defendants' argument that the patentee knew how to clarify the purpose by using "in preparation" in some claim terms and not in others. Therefore, in order to avoid reading extraneous limitations into the claims, the Court will use the broader "prior to" language rather than the more narrow "in preparation for" phrase. *See Phillips*, 415 F.3d at 1320.

Based on the foregoing, the Court concludes that "pre-processing" means "modifying the [media object data/digital content data/one or more image files, video files, or audio files], as

opposed to data merely associated with the [media object/digital content/image files, video files, audio files], at the client or local device prior to transmission to a remote device.”

**B. “Server device,” “host server,” “remote device,” “remote server,” “a device separate from said client device,” and “distributing party”**

	<u>Plaintiff</u>	<u>Defendants</u>
<b>server device</b>	No construction necessary	device/server from which the pre-processing parameters are received by a client device, to which the pre-processed selected content is sent from the client device, and which delivers the pre-processed selected content to one or more recipient devices <sup>4</sup>
<b>host server</b>	No construction necessary	device/server that provides computers with access to data or programs and from which the pre-processing parameters are received by a client device, to which the pre-processed selected content is sent from the client device, and which delivers the pre-processed selected content to one or more recipient devices
<b>remote device</b>	device/server not co-located with the client device	device/server that is not co-located with the client device and from which the pre-processing parameters are received by the local device or the client device, to which the pre-processed selected content is sent from the local device or the client device, and which delivers the pre-processed selected content to one or more recipient devices

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<sup>4</sup> In the parties’ Joint Claim Construction Chart, Defendants include the following argument for each of the terms in this section: “In order for the claims containing this term to meet the written description requirement, the term would have to be construed to mean: [proposed construction of term.] Under this term’s plain meaning, the identified claims containing the term are invalid under 35 U.S.C. § 112 (*e.g.*[,] for lack of written description and indefiniteness).”

<b>remote server</b>	device/server not co-located with the client device	device/server that is not co-located with the client device and from which the pre-processing parameters are received by a client device, to which the pre-processed selected content is sent from the client device, and which delivers the pre-processed selected content to one or more recipient devices
<b>a device separate from said client device</b>	device other than said client device	device/server other than the client device from which the pre-processing parameters are received by a client device, to which the pre-processed selected content is sent from the client device, and which delivers the pre-processed selected content to one or more recipient devices
<b>distributing party</b>	No construction necessary	party from which the pre-processing parameters are received by a client device, to which the pre-processed selected content is sent from the client device, and which delivers the pre-processed selected content to one or more recipient devices

Defendants argue that the claim language, specification, and prosecution history demonstrate that the claim terms “server device,” “host server,” “remote device,” “remote server,” and “a device separate from said client device”<sup>6</sup> are “all one and the same.” Defs.’ Resp. Br. 7, ECF No. 229. According to Defendants, each of these terms describes a location<sup>7</sup> that performs the following three functions: (1) providing the pre-processing parameters<sup>8</sup> to the client device; (2) receiving the pre-processed digital content from the client device; and (3) delivering the pre-processed content to the recipient viewing devices. *Id.* at 6.

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<sup>6</sup> Defendants do not list the term “distributing party” in this list. *See* Defs.’ Resp. Br. 7, ECF No. 229. However, as Defendants’ proposed construction differs from the “server device” term only by substituting “party” instead of “device/server,” the Court addresses this term here as well.

<sup>7</sup> According to Defendants, this location is also sometimes described in the claims as the “second location” or the “customer’s website/server.” Defs.’ Resp. Br. 11, ECF No. 229.

<sup>8</sup> The parties agree that claim term “pre-processing parameters” means “values directing the pre-processing.” Am. Joint Statement 2, ECF No. 232.

Plaintiff argues that each term has a distinct meaning and that Defendants improperly seek to impose a “same server” requirement on the claims, limiting the claims to the preferred embodiment. Pl.’s Open. Br. 14, ECF No. 217. According to Plaintiff, the claims, specification, and prosecution history allow for different servers or devices to perform the three functions Defendants list. *Id.* at 15. For the “server device,” “host server,” and “distributing party” claim terms, Plaintiff argues that there is no construction necessary because persons having ordinary skill in the art would have readily understood the terms. *Id.* For the “remote device,” “remote server,” and “a device separate from said client device” claim terms, the parties agree that Plaintiff’s proposed constructions should be included within the terms’ ultimate definitions, at a minimum. The parties disagree as to whether the “same server” requirement also should be included in each of these terms.

Courts generally presume that distinct phrases used in the claims have different meanings. *See Chi. Bd. Options Exch., Inc. v. Int’l Sec. Exch., LLC*, 677 F.3d 1361, 1369 (Fed. Cir. 2012) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”) (quoting *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000)). Thus, Defendants bear the burden of overcoming this presumption by establishing that the patentee gave these terms the same meaning. *See* previous *Summit 6* case, at \*70 (“Looking first to the claim language, the Court agrees with Plaintiff that the terms ‘remote device,’ ‘device separate from said client device,’ and ‘server device’ are presumed to have different meanings because these distinct phrases are used differently in the same claims and across the claims of the Patents at issue.”).

District courts are instructed to “not read limitations from the embodiments in the specification into the claims.” *Hill-Rom Servs.*, 755 F.3d at 1371; *accord Am. Piledriving Equip.*,

*Inc. v. Geoquip, Inc.*, 637 F.3d 1324, 1331 (Fed. Cir. 2011) (“It is well settled that the role of a district court in construing claims is not to redefine claim recitations or to read limitations into the claims to obviate factual questions of infringement and validity but rather to give meaning to the limitations actually contained in the claims, informed by the written description, the prosecution history if in evidence, and any relevant extrinsic evidence.”).

The fact that a patent describes “only a single embodiment” does not require the invention to be limited to that embodiment. *Id.* Only when “the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest exclusion or restriction,’” will a court read the claims restrictively. *Id.* (quoting *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004)). For instance, if “the preferred embodiment is described in the specification as the invention itself,” then the claims may be limited to that embodiment. *Id.* at 1372 (quoting *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1330 (Fed. Cir. 2009)). Courts also have found disclaimers when the specifications describe “required steps,” “very important features,” or other such statements that characterize the invention as a whole rather than merely describe a particular embodiment of the invention. *See id.*

Defendants argue that the patents clearly define the invention as a web-based tool and therefore the scope of the invention should be limited to internet platforms. Defs.’ Open. Br. 10, ECF No. 219. The ’557 and ’482 patents are each titled “WEB-BASED MEDIA SUBMISSION TOOL.” Defs.’ App. Supp. Open. Br. Ex. 2 (’557 patent), App. 24, ECF No. 219-1; ’482 patent, App. 37, ECF No. 219-1. The first line of the Abstract of both patents reads, “The present invention, generally speaking, provides an improved web-based media submission tool.” *Id.* Defendants argue that the introductory phrase, “the present invention,” sets forth a characterization of the invention, thereby



creating a limitation. Defs.’ Open. Br. 10, ECF No. 21; *see also Hill-Rom Servs.*, 755 F.3d at 1372. Conversely, Plaintiff argues that the qualifier “generally speaking” explains that the description is merely the preferred embodiment of the invention, rather than the only use of the invention. Pl.’s Resp. Br. 13, ECF No. 227; *see also Thorner*, 669 F.3d at 1365–66 (holding that any disavowal of claim scope must be clearly set forth).

In the hearing, Defendants submitted that the “generally speaking” phrase is not a qualifier; instead it is included to explain that “the present invention” applies to anything “described as the embodiment within the specification.” Hr’g Tr. at 86:3–10, ECF No. 259. For example, Defendants compare the sentence to the following: “[A] dog, generally speaking, is a mammal.” *Id.* at 95:17. Defendants contend that, in that sentence, “generally speaking” serves to explain to the listener that the speaker is giving an overview of what a dog is, rather than saying that dogs only sometimes are mammals. *See id.* at 95:16–97:3. However, the Court does not find this argument to be persuasive when applied to the sentence at issue.

Instead, the Court agrees with Plaintiff that there is no clear disclaimer or disavowal of scope that would create a “same server” limitation. *See* Pl.’s Resp. Br. 11, 14, ECF No. 227; *see Liebel-Flarsheim Co.*, 358 F.3d at 906. Without such disclaiming language, Defendants’ argument reduces to an improper attempt to limit the scope of the claims to the preferred embodiment. Likewise, in the previous *Summit 6* action, the Court found that the invention’s description “as a ‘web-based media submission tool’ is not a ‘clear and unmistakable disclaimer’ of pre-processing that occurs outside of a browser.” Previous *Summit 6* case, at \*21; *see also* Pl.’s Resp. Br. 12, ECF No. 227. The Court reasoned that the patents’ discussions of pre-processing within a browser or web server referred to the preferred web-site embodiment only and could not be grafted upon the claims

as a whole. Previous *Summit 6* case, at \*21, \*71 (citing *Phillips*, 415 F.3d at 1320). The Court adopts the same reasoning here.

Plaintiff further argues that a “same server” limitation would contradict the claims themselves because the claims describe that different servers may perform some or all of the three actions. Pl.’s Open. Br. 15–16, ECF No. 217. It is not required that the same server or device perform all three actions in each instance. *See id.* For example, Plaintiff contrasts the use of the “remote device” and “server device” in claims 1 and 11 of the ’482 patent. *Id.* In claim 1, pre-processing parameters are received from a “remote device” and the digital content is sent to a “server device.” *Id.* at 15. In claim 11, the parameters are received from a “remote device” and the pre-processed media object is sent back to the “remote device.” *Id.* at 16. Thus, Plaintiff concludes, when the same server is meant to perform both actions, the language of the claims was drafted to reflect that state, as in claim 11. *Id.* The use of the same server restriction in some claims and not in others indicates that “the patentees knew how to restrict their claim coverage” and the choice to use a broader term in some claims should yield broader coverage. *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 807 (Fed. Cir. 2007). Additionally, Plaintiff contends that most claims do not require the step that Defendants put forth as the third required function, that of display or delivery. Pl.’s Resp. Br. 16, ECF No. 227. For instance, claim 1 of the ’482 patent provides for the possibility of subsequent publishing, but does not require publishing or distribution. *See id.*; ’482 patent, App. 49, ECF No. 219-1.

Defendants respond that every claim Plaintiff contends does not require the performance of the three functions actually does perform all of the three functions either explicitly or implicitly. Defs.’ Resp. Br. 8, ECF No. 229. They argue that, essentially, “[a]ll these functions are described

in the patents as the functions of a *single* web server.” *Id.* (emphasis in original). In support, they contend that the terms “server device,” “host server,” and “remote device” are not distinguishable based upon the function they perform; instead, the devices are described as performing different functions throughout the patents’ claims. Defs.’ Open. Br. 15, ECF No. 219. They argue that this usage demonstrates the interchangeability of the terms. *Id.*

To illustrate their argument, Defendants explore the use of “server device” in the claims. *Id.* According to Defendants, in claim 24 of the ’515 patent, the term is used to refer to a device that delivers pre-processing parameters to a client device. *Id.*; see Defs.’ App. Supp. Open. Br. Ex. 4 (’515 patent), App. 68, ECF No. 219-2 (claim 24: “. . . pre-processing parameters that are received from a server device”). In claims 1, 13, 35–38, and 51 of the ’482 patent, it is used to refer to a device that receives pre-processed media objects from the client device. See ’482 patent, App. 49–51, ECF No. 219-1. In claims 1 and 35–38 of the ’482 patent, it refers to a device that delivers the pre-processed media objects to the content recipients. See ’482 patent, App. 49–51, ECF No. 219-1.

The Court concludes that the fact that the server device sometimes performs different functions in different claims does not imply that the server device must perform all three functions in *every* instance. Therefore, the Court does not find Defendants’ argument persuasive.

The Court also does not find Defendants’ prosecution history argument compelling because prior art was distinguished primarily on the basis of the client-side pre-processing feature, rather than upon usage of the same web server. See *infra* Part III.D.; Defs.’ Open. Br. 13, ECF No. 12–13.

Defendants next argue that, unless their proposed constructions are adopted, the terms would be indefinite and thus invalid. Defs.’ Open. Br. 15–16, ECF No. 219. They contend that “[t]he asserted claims include generic terms such as ‘device’ and ‘server’ that would, if given a plain

meaning interpretation or a construction that is divorced from the specification and addresses only the ‘remote’ or ‘separate’ aspect of the term, stretch the scope of the claims far beyond what the patents disclose.” *Id.* at 15. Summit 6 argues that “device” and “server” require no construction because they are plain and ordinary words that people having ordinary skill in the art would have readily understood. Pl.’s Open. Br. 14–15, ECF No. 217. Defendants do not contest that the words have plain meaning, but rather argues that the plain meaning would make the claims impermissibly broad. The Court finds that the terms “server device,” “host server,” and “distributing party” are not indefinite in context, as the terms set forth boundaries that would be reasonably understood by persons skilled in the art. The Court further finds that these terms require no construction, as the parties dispute primarily concerns whether the “same server” limitation should be applied.

At this stage, the Court does not address Defendants’ arguments regarding compliance with the written description requirement because such arguments fall outside the scope of the claim construction issues presently before the Court. *See Laryngeal Mask Co. v. Ambu*, 618 F.3d 1367, 1373 (Fed. Cir. 2010); *see also Trading Techs. Int’l, Inc. v. Open E Cry, LLC*, 728 F.3d 1309, 1319 (Fed. Cir. 2013) (“Despite their similarities, however, claim construction and the written description requirement are separate issues that serve distinct purposes.”).

In accordance with the foregoing, the Court concludes that, for the “server device,” “host server,” and “distributing party” claim terms, there is no construction necessary. The Court further construes “remote device,” “remote server,” and “a device separate from said client device” according to Plaintiff’s proposed constructions.

**C. Terms Relating to the Receipt, Provision, or Transmission of Pre-processing Parameters**

	<u>Plaintiff</u>	<u>Defendants</u>
<b>pre-processing parameters received from a remote server</b>	pre-processing parameters received from a server not co-located with the client device	pre-processing parameters that are not already stored on the client device, but are received from a remote server <sup>5</sup>
<b>pre-processing parameters that are received from a device separate from said client device</b>	pre-processing parameters that are received from a device other than the client device	pre-processing parameters that are not already stored on the local device or the client device, but are received from a device separate from the client device
<b>pre-processing parameters being provided to said client device from a device separate from said client device</b>	pre-processing parameters being provided to said client device from a device other than the client device	pre-processing parameters that are not already stored on the local device or the client device, but are provided to the client device by a device separate from the client device
<b>pre-processing parameters that were provided to said client device by a device separate from said client device</b>	pre-processing parameters that were provided to said client device by a device other than the client device	pre-processing parameters that are not already stored on the client device, but are provided to the client device by a device separate from the client device

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<sup>5</sup> In the Claim Construction Chart, Defendants include the following argument for each of the terms in this section: “To the extent the claims containing these terms are not invalid under 35 U.S.C. § 112 (*e.g.*, for lack of written description and indefiniteness), this term means: [proposed construction of the term].”

**pre-processing parameters that have been provided to said client device from a device separate from said client device**

pre-processing parameters that have been provided to said client device from a device other than the client device

pre-processing parameters that are not already stored on the client device, but are provided to the client device by a device separate from the client device

**pre-processing parameters that have been loaded onto said client device by a device separate from said client device**

pre-processing parameters that have been loaded onto said client device other than the client device

pre-processing parameters that are not already stored on the client device, but are loaded onto the client device by a device separate from the client device

**receiving pre-processing parameters from a remote device**

receiving pre-processing parameters from a device not co-located with the client device

[receiving] from a remote device pre-processing parameters that are not already stored on the local device or the client device

**pre-processing parameters that are received from a remote device**

pre-processing parameters that are received from a device not co-located with the client device

pre-processing parameters that are not already stored on the client device, but are received from a remote device

**[transmitting / transmits] pre-processing parameters to said client device**

No construction necessary

[transmitting / transmits] pre-processing parameters to the client device that are not already stored on the client device

Plaintiff argues that the Court should decline to construe the “receiving” and “provided to” terms because these words have an ordinary meaning and the remaining terms in the claims are subject to their own separate constructions. Pl.’s Open. Br. 23, ECF No. 217; *see also* previous *Summit 6* case, at \*94–95 (“[T]he Court agrees with Plaintiff that these phrases do not require additional construction, since their component parts—with the exception of the straightforward terms ‘receiving,’ ‘received,’ and ‘provided to’—have already been construed.”).

Defendants argue that under the plain meaning of the claim terms, the pre-processing parameters “are not already stored on the [client/local] device.” Defs.’ Open. Br. 21, ECF No. 219. They insist that failing to include this description in the phrase improperly broadens the claims beyond what the patents disclose. *Id.* Conversely, Plaintiff argues that Defendants’ construction merely adds extraneous and improper limitations, rather than defining the terms. Pl.’s Resp. Br. 17, ECF No. 227.

Although the terms “receiving” and “provided to” do have well-understood, common definitions, this fact is not necessarily dispositive. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008). When parties fundamentally dispute “not the meaning of the words themselves, but the scope that should be encompassed by this claim language,” a court may still be called upon to construct the term as a matter of law. *Id.* Thus, the Court now turns to the parties’ arguments regarding the scope of the claims.

Defendants reason that, because the client device “receives” pre-processing parameters from a separate device, those parameters cannot already have been stored on the device. Defs.’ Open. Br. 22, ECF No. 219. If the parameters previously were stored on the device, they would not have to be received. *Id.* In other words, Defendants argue that a conclusion that logically follows from the claim

terms should be added to more clearly define the scope of the claims. *See id.* At the hearing, Defendants explained that the “not already stored” construction is intended to clarify that the parameters cannot have been “loaded onto your computer when the computer was made at the factory or when the software was installed on the computer”; instead, the parameters have to have been received during the course of the method. Hr’g Tr. at 36:3–16, ECF No. 259.

Plaintiff questions whether Defendants’ conclusion logically follows and whether Defendants’ construction would lead to jury confusion. *See Pl.’s Resp. Br. 16*, ECF No. 227. First, Plaintiff highlights claim terms that it argues are counterexamples to Defendants’ argument. *See id.* According to Plaintiff, some claims allow a device to receive new pre-processing parameters, thereby updating or overriding previously received pre-processing parameters. *Id.* Claims 16 and 18 of the ’482 patent, for example, require that the pre-processing parameters “have been previously downloaded” or “have been stored” on the client device. *Id.*; *see* ’482 patent, App. 50, ECF No. 219-1.<sup>6</sup> Plaintiff essentially argues that Defendants’ construction either would contradict these claims or it would cause confusion as to whether such a situation would fall within the claim scope. *See Pl.’s Resp. Br. 16*, ECF No. 227.

Defendants respond that Plaintiff’s purported counterexamples do not contradict their conclusion. First, Defendants note that Plaintiff conflates the terms “stored” and “downloaded.” *Defs.’ Resp. Br. 16–17*, ECF No. 229. The Court agrees that claim 16 of the ’482 patent refers only to parameters that have been “downloaded,” rather than parameters that have been “stored.” Thus,

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<sup>6</sup> Claim 16 of the ’482 patent reads: “The method of claim 13, wherein said pre-processing comprises pre-processing in accordance with one or more pre-processing parameters *that have been previously downloaded* to said client device.” ’482 patent, App. 50, ECF No. 219-1 (emphasis added).

Claim 18 of the ’482 patent reads: “The method of claim 13, wherein said pre-processing comprises pre-processing in accordance with one or more pre-processing parameters that *have been stored* in memory of said client device prior to said identification.” *Id.* (emphasis added).



the Court primarily will analyze the relationship between independent claim 13 and dependent claim 18, rather than dependent claim 16.

Next, Defendants argue that dependent claims 16 and 18 would modify the pre-processing step of independent claim 13 by allowing the *additional* use of pre-processing parameters that already have been downloaded or stored in those instances. Defs.' Resp. Br. 16, ECF No. 229. Thus, Defendants argue that the "not previously stored" limitation only restricts the scope of independent claim 13, which includes the claim term at issue. *Id.* Dependant claim 18, for example, allows for use of both parameters that have not been stored and parameters that have been previously stored. *Id.* In the hearing, Defendants further clarify that the failure to use "said" or "the" indicates that the dependent claims refer to a separate set of pre-processing parameters. Hr'g Tr. at 39:17–40:8, ECF No. 259. However, "even if these claims, 16 and 18, refer to the same pre-processing parameters, it's still the case that these claims don't mean that the pre-processing parameters could have been stored on the phone [or other device] from the very beginning." *Id.* at 39:17–21; *see also id.* at 40:9–20 ("[We] are not saying that they can never be downloaded or stored in the client device or in the phone. We are saying that they can't be pre-stored before you start performing the method here."). Therefore, Defendants conclude that there is no contradiction between Defendants' proposed construction and the claims themselves.

At the hearing, Plaintiff first responds that Defendants attempt to impose an improper limitation regarding the order of method steps and such a limitation is not supported by any disavowal in the specification or prosecution history. *Id.* at 42:12–18. According to Plaintiff, Defendants import a vague temporal limitation by requiring that the parameters must not have been "already" stored. Plaintiff questions at what exact point in time Defendants mean by "already." *See*

*id.* at 43:20–44:1. In the preferred web-site embodiment, for example, a user can obtain pre-processing parameters and then shut down the computer and come back another day with the parameters still stored on the computer. *Id.* at 44:2–13.

Plaintiff next counters Defendants’ claim differentiation argument by highlighting one “said” that does appear in dependent claim 18. According to Plaintiff, “said pre-processing” refers to the pre-processing done in claim 13, and it follows that “the pre-processing parameters are already used and have been there because the pre-processing comprises these pre-processing parameters in accordance with these already stored parameters.” Hr’g Tr. 42:12–15, ECF No. 259. Thus, Plaintiff implies that this is a typical claim differentiation scenario.

The Court finds the analysis in *Liebel-Flarsheim* instructive. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004); *see also* Pl.’s Resp. Br. 16, ECF No. 227. In general, “the presence of a dependent claim that adds a particular limitation raises a presumption that the limitation in question is not found in the independent claim.” *Liebel-Flarsheim*, 358 F.3d at 910. This “presumption can be overcome if the circumstances suggest a different explanation, or if the evidence favoring a different claim construction is strong.” *Id.* In *Liebel-Flarsheim*, the court found that the only significant difference between dependent claims and independent claims was that the dependent claims required the use of a “pressure jacket.” The court concluded that “[t]he juxtaposition of independent claims lacking any reference to a pressure jacket with dependent claims that add a pressure jacket limitation provides strong support for [the plaintiff’s] argument that the independent claims were not intended to require the presence of a pressure jacket.” *Id.*

Here, dependent claim 18 claims the method of independent claim 13 when pre-processing parameters “have been stored in memory of said client device.” ’482 patent, App. 50, ECF No. 219-

1. Thus, parameters previously having been stored is the only significant difference between the two claims. As in *Liebel-Flarsheim*, “[i]n such a setting, where the limitation that is sought to be ‘read into’ an independent claim already appears in a dependent claim, the doctrine of claim differentiation is at its strongest.” 358 F.3d at 910. Thus, Plaintiff has provided a counterexample to Defendants’ argument. Independent claim 13 does not specify that the parameters were “not already stored on the client device.” In the absence of strong support to the contrary, Defendants’ argument fails.

The Court agrees with Plaintiff that Defendants’ addition of the “not already stored” limitation contradicts at least one claim and is likely to introduce unnecessary confusion. Accordingly, Plaintiff’s constructions of the “provided to” and “received from” set of claim terms are adopted.

**D. Preambles of the ’482 and ’515 Patents**

Plaintiff

The preambles are not limitations of the claims and thus not subject to construction

Defendants

The steps of the claim performed on the client device are performed during the execution of one computer program

The parties dispute whether the preambles of the ’482 and ’515 patents should be interpreted to limit the claims. Defendants argue that the preambles specify that the claim steps must be executed in “one computer program.” Defs.’ Open. Br. 22–23, ECF No. 219. Plaintiff argues that the Court should follow its reasoning in the previous *Summit 6* case to conclude that the preambles do not limit the claims to a singular program. Pl.’s Open. Br. 24–25, ECF No. 217; previous *Summit 6* case, at \*85–93 (concluding that “while the preamble provides an antecedent basis for subsequent claim terms, it does not thereby ‘limit[] the claim’” because it does not supply any limitations not

otherwise present in the claims) (quoting *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1350 (Fed. Cir. 1998)).

District courts are instructed that there is no simple test to determine when a preamble limits claim scope, and courts must analyze the issue based upon the facts of each case. *Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010). In general, preambles do not limit claims. *Id.* A preamble “may be construed as limiting if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” *Id.* (internal quotation marks omitted). However, “when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention,” the preamble is not a limitation. *Id.* at 1358–59.

According to Plaintiff, the preambles are merely general introductions to the claims. Pl.’s Open. Br. 25, ECF No. 217. Every substantive term is fully described in the claim body, and there are no essential steps or structures found only in the preambles. Pl.’s Resp. Br. 18–19, ECF No. 227. Therefore, Plaintiff concludes, “the claim body of each claim describes a structurally complete invention.” *Id.* at 19.

Defendants present three reasons supporting their argument that the preambles should be construed as claim limitations. The Court considers each in turn.

Defendants first argue that the preambles recite essential structure necessary to give meaning to the claims by providing the antecedent basis for the claimed “said client device” and “said local device.” Defs.’ Open. Br. 23, ECF No. 219; *see Goldenberg v. Cytogen*, 373 F.3d 1158, 1164 n.2 (Fed. Cir. 2004) (concluding that claim’s reference to antecedent in preamble indicated reliance on preamble to define invention). The term “client device,” for example, is first described in the

preamble to claim 1 and then referred to in the claim as “said client device.” ’482 patent, claim 1, App. 49, ECF No. 219-1. However, Plaintiff notes that providing an antecedent basis does not always indicate reliance on the preamble; there is no such *per se* rule. Pl.’s Resp. Br. 18, ECF No. 227; *see Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (noting, as one factor to consider, that “dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope”). Plaintiff argues that, here, the terms at issue are fully described within the claims themselves, making the preambles duplicative. Pl.’s Resp. Br. 19, ECF No. 227.

Defendants next contend that the preambles resolve an unanswered question in the claims. Defs.’ Open. Br. 23, ECF No. 219 (citing *Griffin v. Bertina*, 285 F.3d 1029, 1033 (Fed. Cir. 2002)). According to Defendants, the preambles clarify that the device that performs steps a, b, and d in claim 1 of the ’482 patent is “a client device”; thus, the body does not set forth the complete invention. *Id.*

In the previous *Summit 6* case, the Court found that the preambles do not resolve this question or provide any more clarity than the claim terms themselves. Previous *Summit 6* case, at \*91–92 (“Because the preamble adds nothing to the reader’s understanding of the ‘receiving’ and ‘transmitting’ steps, the alleged deficiencies in these claim steps cannot be used to justify treating the preamble as limiting the claim.”); *see also* Pl.’s Resp. Br. 19, ECF No. 227. Claim 1’s preamble reads: “A computer implemented method of pre-processing digital content in a client device for subsequent electronic publishing, comprising[.]” ’482 patent, claim 1, App. 49, ECF No. 219-1. Defendants contend that this preamble makes it clear that each step of the method takes place in the client device, rather than merely the pre-processing step. Defs.’ Open. Br. 23, ECF No. 219.

However, as the Court previously found, the preamble's text is silent as to the location of the "receiving" and "transmitting" steps. *See* Pl.'s Resp. Br. 19, ECF No. 227. It only addresses where the "pre-processing" step takes place, which is also described in the claim step c. '482 patent, claim 1, App. 49, ECF No. 219-1. Thus, the preamble does not add any more information to the information in the claim's body.

Finally, Defendants contend that the requirement that the client-side steps must be undertaken on "one computer program" is necessary as it distinguishes the claimed invention from prior art. Defs.' Open. Br. 23, ECF No. 219. The preambles do not specifically state that the invention must operate on "one computer program." *See, e.g.*, '482 patent, claim 1, App. 49, ECF No. 219-1. Instead, Defendants argue that "the asserted patents describe the claimed 'computer implemented method' as 'an improved web-based media submission tool' that allows the alleged invention to 'handle[] *all of the[] tasks* for the user.'" *Id.* at 24 (emphasis in original) (citations to '482 patent, claim 1, App. 49, ECF No. 219-1; '482 patent, 2:3-4, 60, App. 45, ECF No. 219-1 omitted).

The Court notes that Defendants have pulled these quotes from various contexts in the '482 patent. The term "computer implemented method" comes from the preamble to claim 1. '482 patent claim 1, App. 49, ECF No. 219-1. The next quote is a generalized description of the invention found in the Summary of the Invention, which reads: "The present invention, generally speaking, provides an improved web-based media submission tool." '482 patent 2:3-4, App. 45, ECF No. 219-1. The third quote comes from the Detailed Description of the Preferred Embodiments, which reads in part:

The Prepare and Post tools refers to *browser-side components which together* provide the ability to submit and transport media objects over the web to be stored and served. Using the Prepare and Post tools, end users can submit images in an immediate, intuitive manner. No technical sophistication is required. In particular, understanding technical terms such as JPEG, resolution, pixel, kilobyte, transfer protocol, IP address,

FTP etc., is not required, since *the Prepare and Post tools handles all of these tasks for the user.*

'482 patent 2:52–61, App. 45, ECF No. 219-1 (emphasis added); *see also* Pl.'s Resp. Br. 21, ECF No. 227 (noting the plural description of the “Prepare and Post tools”). The preferred embodiment is described here as using multiple browser-side components to accomplish tasks, such as submitting and transporting images. *See id.* The description does not imply that only one computer program is used.

According to Defendants, the patent distinguishes prior art on the basis of the instant invention's use of only one computer program. The patent describes itself as an improvement over prior art on the basis that the FTP and ActiveUpload prior art were “piecemeal solutions” and lacking “built in ‘intelligence.’” Defs.' Open. Br. 24, ECF No. 219; *see* '482 patent, at 1:25–34, 1:50–67, App. 45, ECF No. 219-1. From such statements, Defendants infer that the solution the invention provided was a central, singular computer program.

The Court finds that the full context for Defendants' quotations above illustrates on what basis the FTP and ActiveUpload prior art were distinguished. First, the specification portrays the disadvantages of other “piecemeal solutions” for uploading images, such as using an FTP program, as follows:

For example, transferring a digital image may require first downloading a FTP program, then installing it, then running it and connecting to an FTP server by typing the server name in the connection dialog, then navigating to the proper subdirectory, selecting the files to be uploaded, making sure that the program is in binary transfer mode, then sending the files.

'482 patent, 1:27–33, App. 45, ECF No. 219-1. Thus, the instant invention is distinguished from an FTP program on the basis of simplicity because it requires less steps for the user. Moreover, as Plaintiff notes, the FTP program is a singular program. *See* Pl.'s Resp. Br. 27, ECF No. 227. Next,

ActiveUpload is distinguished, not on the basis of simplicity, but on the basis of user-side pre-processing as follows:

Although Caught in the Web's ActiveUpload tool simplifies the user experience, it does little toward furthering 'backend' automation in the handling and distribution of media objects and has no *built in 'intelligence'* to streamline the process of handling and transporting rich media objects from the front end.

'482 patent, 1:62–67, App. 45, ECF No. 219-1 (emphasis added). Thus, neither prior art is distinguished on the basis of the number of programs used.

According to Plaintiff, Defendants' limitation requiring "one computer program" also does not follow from the language of the claims themselves. Pl.'s Open. Br. 25, ECF No. 217. The preamble indicates that the method is "computer implemented," which does not imply that all client-side steps must be performed on only one computer program. *Id.* Moreover, Plaintiff argues that a requirement of "one computer program" would contradict the operation of the preferred website embodiment. *Id.* at 26. In the preferred embodiment, activity takes place in a browser and also in a plug-in program, such as an Active X control or Java applet. *Id.* Defendants respond that these plug-ins are described as objects within one program, operating within the web browser in the preferred embodiment. Defs.' Resp. Br. 19, ECF No. 229. Thus, Defendants argue that the one-program requirement holds. *See id.*

The Court finds that the patent specification, claims, and preferred embodiment do not support a "one computer program" limitation. The Court further finds that Defendants have not presented any compelling argument to overcome the general presumption that the preambles are merely general introductions. Even if the preferred embodiment used only one program, that reason alone would not be enough to graft a limitation onto the claims as a whole. *See Phillips*, 415 F.3d at 1320. Further, because the preambles do not add any material information to the claim body, they



do not serve as claim limitations. Accordingly, the Court concludes that the preambles are not subject to construction.

**E. “Distributing/distribution”**

	<u>Plaintiff</u>	<u>Defendants</u>
<b>[distributing / distribution]</b>	No construction necessary	making publicly available / the act of making publicly available

Plaintiff argues that the “distributing / distribution” term should be given its ordinary meaning and no construction is necessary. Pl.’s Open. Br. 26, ECF No. 217. At the hearing, Plaintiff stated that “sharing” would be an acceptable construction of the “distributing” term were the Court to decide that a construction is necessary. Hr’g Tr. at 49:2–10, 52:1–5, ECF No. 259. Defendants argue that the terms should be interpreted to mean “making publicly available / the act of making publicly available.” Defs.’ Open. Br. 24–25, ECF No. 219. The parties have stipulated that “making publicly available / the act of making publicly available” is the definition of the “publishing / publication” claim term. *See* Am. Joint Statement 2, ECF No. 232. Thus, the issue is whether “distributing” has the same meaning as “publishing.”

“When different words or phrases are used in separate claims, a difference in meaning is presumed.” *Nystrom v. Trex Co.*, 424 F.3d 1136, 1143 (Fed. Cir. 2005). However, “[d]ifferent terms or phrases in separate claims may be construed to cover the same subject matter where the written description and prosecution history indicate that such a reading of the terms or phrases is proper.” *Id.*

Defendants argue that the two terms, publication and distribution, are used interchangeably in the patents. Defs.’ Open. Br. 24-25, ECF No. 219. In support, they argue that the specification

describes the publishing of digital content and then never uses the word publishing again in the specification; instead, the word distribution is used. *Id.* at 24 (citing '482 patent 1:11–14, 1:40–45, 1:62–65, App. 45, ECF No. 219-1). In their Response Brief, Defendants add that the terms are also used interchangeably in claims 1 and 38 and in claims 9 and 34 of the '482 patent. Defs.' Resp. Br. 20, ECF No. 229 ('482 patent, claims 1, 9, 34, 38, App. 49–50, ECF No. 219-1).<sup>5</sup> Relying on *Nystrom*, 424 F.3d at 1143, and *Tate Access Floors, Inc. v. Maxcess Tech., Inc.*, 222 F.3d 958, 968 (Fed. Cir. 2000), Defendants conclude that the terms should have an identical construction because they are used interchangeably to cover the same subject matter.

Plaintiff counters that both the *Nystrom* and *Tate* courts evaluated terms used in *different* claims, and here the distribution and publication terms are sometimes used in the *same* claim. Pl.'s Resp. Br. 22, ECF No. 227. The proposition from *Nystrom* quoted by Defendants reads in part “[d]ifferent terms or phrases *in separate claims* may be construed to cover the same subject matter.” Defs.' Open. Br. 24, ECF No. 219 (quoting *Nystrom*, 424 F.3d at 1143) (emphasis added). Plaintiff notes that, in the instant action, claims 36, 38, and 51 of the '482 patent include both the publication and distribution terms. '482 patent, claims 36, 38, 51, App. 51, ECF No. 219-1; Pl.'s Resp. Br. 22, ECF No. 227.

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<sup>5</sup> Claim 9 reads: “The method of claim 1, wherein said previously received pre-processing parameters enable said client device to place said identified group of one or more items of digital content into a specified form in preparation for *publication* to one or more devices on which said identified group of one or more items of digital content is to be electronically displayed.” '482 patent, claim 9, App. 49, ECF No. 219-1 (emphasis added).

Claim 34 reads: “The method of claim 26, wherein said pre-processing parameters enable said client device to place said digital content into a specified form in preparation for *distribution* to one or more devices on which said digital content is to be electronically displayed.” *Id.* at claim 34, App. 50 (emphasis added).

In the previous *Summit 6* case, the Court also analyzed the distinction between the “publication” and “distribution” terms. The Court concluded that “[b]ecause the ’482 Patent uses the separate terms ‘publication’ and ‘distribution’ throughout the claims, and uses both terms in claim 38, the Court presumes that these terms have different meaning and scope.” Previous *Summit 6* case, at \*82 (citing *Am. Piledriving Equip.*, 637 F.3d at 1336). Concluding that publication meant “sharing with the public,” the Court also noted that the concept of “sharing” in general is “more consistent with the claim term ‘distribution,’ which is used in place of ‘publication’ in certain claims,” such as claims 26 and 38 of the ’482 patent. *Id.*; see also Hr’g Tr. at 49:2–10, 52:1–5, ECF No. 259 (noting Plaintiff’s agreement that sharing would be an appropriate construction of the term).

Accordingly, this Court presumes that the two terms have different meanings because of their use in the same claims and in different claims. See *Comark Commc’ns v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998). Moreover, Defendants have not presented any evidence, besides their use in similar claims and the introduction’s use of the word publication, that the terms are defined to cover the same subject matter. Additionally, unlike some other cases in which terms were found to be interchangeable, the words themselves do not have overlapping content. See, e.g., *Nystrom*, 424 F.3d at 1143–44 (overlap between “board” and a “wood decking board”). Without more, the Court concludes that the presumption that the terms have different meanings holds.

The Court next turns to a new argument presented at the hearing. According to Plaintiff, Defendants HTC and Motorola’s *inter partes* re-examination application concedes that the meaning of distribution is broader than the meaning of publication. Hr’g Tr. at 51:1–12, ECF No. 259. According to Plaintiff, a portion of the application reads:

One of skill in the art would understand distribution to be the transmission of information from one device to another. Publication is a particular kind of

distribution in which information is made available to the public rather than a specific recipient. One of skill in art would understand that “distribution” is a broad term which encompasses multiple means of making content available in digital form, including publication.

...

In light of the specification, one of skill in the art would consequently understand publishing, publication, distributing, and distribution to be at least as broad as making available to at least one person other than the user.

*Id.* at 51:5–12. Defendants respond that the re-examination process in the Patent Office applies different legal standards, and thus the arguments made in that context do not always carry over into the claim construction context. *Id.* at 54:20–23. The Patent Office also applies the broadest reasonable interpretation of the claim terms. *Id.* at 54:23–55:3. The Court declines to find that these statements are a concession of proper construction in the claim construction context, however, they support Plaintiff’s argument that “distribution” could be read broadly, consistent with Plaintiff’s construction.

Finally, Defendants contest Plaintiff’s assertion that no construction is required for the distribution term. The Court agrees that the parties have raised a genuine dispute about a claim term that implicates the scope of the claims, and thus, construction would be appropriate. *See U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997) (“Claim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims, for use in the determination of infringement.”).

For the foregoing reasons, the Court adopts its reasoning in the previous *Summit 6* case, and determines that “publication” is a subset of “distribution.” *See* previous *Summit 6* case, at \*82. The Court finds that “distributing” means “sharing,” and “distribution” means “the act of sharing.”

**F. “Said identification”**

	<u>Plaintiff</u>	<u>Defendants</u>
<b>said identification</b> [in claims 17–18 of the '482 patent]	said identification of digital content	Indefinite

The parties dispute whether the term “said identification” in claims 17 and 18 of the '482 patent is indefinite. Plaintiff contends that this phrase, used in dependent claims 17 and 18, refers to independent claim 13’s “said identification of digital content.” Pl.’s Open. Br. 29–30, ECF No. 217. Defendants argue that the term is indefinite for lack of a properly identified antecedent basis because the term could refer to claim 13’s “identification of digital content” or “identification of user.” Defs.’ Open. Br. 25, ECF No. 219.

According to Plaintiff, even if there could be two possible interpretations, the correct interpretation is “reasonably ascertainable.” Pl.’s Resp. Br. 24–25, ECF No. 227. However, it is unclear whether the “reasonably ascertainable” standard survives post-*Nautilus*. In *Nautilus*, the Supreme Court disapproved of the “insolubly ambiguous” and “not amenable to construction” standards of definiteness. 134 S. Ct. at 2130. Considering “ascertainability” to be similar to “amenability to construction,” the Court instead will apply *Nautilus*’ “reasonable certainty” standard to the analysis of whether a claim term’s antecedent basis is sufficiently definite. *See id.*

“[A] patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Id.* at 2124. “The definiteness requirement, so understood, mandates clarity, while recognizing that absolute precision is unattainable.” *Id.* at 2129 (internal quotation marks omitted). Therefore, “there is an indefiniteness problem if the claim

language might mean several different things and no informed and confident choice is available among the contending definitions.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014) (quoting *Nautilus*, 134 S. Ct. at 2130 n.8) (internal quotation marks omitted). Defendants bear the burden of establishing indefiniteness by clear and convincing evidence. *See Warsaw Orthopedic, Inc. v. NuVasive, Inc.*, No. 2013-1576, 2015 WL 859503, at \*3 (Fed. Cir. Mar. 2, 2015). Applying this standard, the Court now turns to the parties’ arguments.

The parties agree that, in claim 13 of the ’482 patent, step c’s “identification of a user” can occur either before or after step b’s pre-processing step. *See* Hr’g Tr. at 114:21–115:2, ECF No. 259. From this premise, the parties draw different conclusions about whether the “said identification” could refer to step c’s “identification of a user.”

Plaintiff contends that it is reasonably certain to those skilled in the art that “said identification” refers to “said identification of digital content” in light of surrounding claim language. *See* Pl.’s Open. Br. 29–30, ECF No. 217. According to Plaintiff, dependent claims 17 and 18 of the ’482 patent add a timing aspect to independent claim 13 of the ’482 patent. Pl.’s Open. Br. 29, ECF No. 217. Plaintiff specifies that the pre-processing parameters must be downloaded and stored before the pre-processing occurs. Pl.’s Open. Br. 29 & n.11, ECF No. 217. The identification of digital content in step a must also occur before the pre-processing occurs, as such content comprises what is pre-processed. Hr’g Tr. at 114:13–16, ECF No. 259. Therefore, Plaintiff concludes that the claim language in claim 17 and 18 must refer to the “identification digital content” in claim 13(a) because that is the only identification that must take place before the pre-processing. *Id.* at 114:17–20. A dependent claim referring to an identification that must occur before pre-processing cannot refer to a step that could occur after the pre-processing. *Id.* at 116:1–3.

Defendants respond that because information identifying either the user or the digital content could be downloaded and stored before pre-processing occurs, the claim term “said identification” remains ambiguous. Defs.’ Resp. Br. 22, ECF No. 229; *see also* Defs.’ App. Supp. Reply Ex. 2 (Jones Dep.) 38:23–39:5, 40:15–20, App. 24–26, ECF No. 234-1; Defs.’ App. Supp. Reply Ex. 3 (Jones Exs.), App. 58–64, ECF No. 234-1. The dependent claim may refer to either one. *See id.* Thus, Defendants conclude, the context does not make the antecedent basis reasonably clear.

Plaintiff next argues in its opening brief that the parties’ experts in the previous *Summit 6* case as well as the U.S. Patent Office Examiner “were able to discern the meaning of the term without issue.” Pl.’s Open. Br. 30, ECF No. 217. However, Plaintiff has failed to cite to any record evidence to support this allegation. *See id.*; Defs.’ Resp. Br. 22, ECF No. 229.

Plaintiff next relies upon its expert Dr. Mark T. Jones (“Jones”), who concluded that a person having ordinary skill in the art would be able to understand the scope of the term with reasonable certainty. Pl.’s Resp. Br. 25–26, ECF No. 227; Pl.’s App. Supp. Resp. Br. Ex. 1 (Jones Decl.), App. 259, ¶¶ 26–32, ECF No. 228. Plaintiff clarifies Jones’ argument further in the Sur-Reply Brief. Pl.’s Sur-Reply Br. 2, ECF No. 235. According to Jones, the meaning of “said identification” is clear because there is in fact only one claimed “identification” in claim 13 — the identification of digital content. *Id.* Jones argues that there is no “identification of user” step, contrary to Defendants’ arguments. *Id.* Instead, claim 13 merely provides for “retrieving information that enables identification of the user.” *Id.*; Pl.’s App. Supp. Sur-Reply Ex. 1 (Jones Dep.) 40:6–13, App. 4, ECF No. 235. Thus, there is only one claimed identification. *See id.* at 51:8–9, App. 6 (“Step C doesn’t require an identification.”); Jones Decl. ¶ 31, App. 261–62, ECF No. 228.

Defendants contend, contrary to Jones' testimony, that the "identification of content" and the "identification of the user" are two separate steps that occur, even if the "identification of the user" step is not specifically claimed. Defs.' Reply Br. 1 & n.1, ECF No. 234. Claim 13's "retrieving information that enables identification of the user" implies that the "identification of the user" is a method step. *See id.* Thus, claims 17 or 18's "said identification" could refer either to this implied step or to the specifically claimed identification of content step. *See id.* Defendants further note that "when the patentee wanted to reference the first 'identification' (of digital content)—as it did in claim 13 step c—the patentee referenced it as 'said received identification.'" Defs.' Reply Br. 1, ECF No. 234. Because claims 17 and 18, do not refer to the first identification of digital content in a consistent way, Defendants conclude that the term is ambiguous. *Id.*

Finally, Plaintiff notes that Defendants have failed to present expert testimony on this issue. Defendants, at the hearing, responded that there is no expert testimony required here, relying upon the *Smartflash* and *Guzik* antecedent basis cases. Hr'g Tr. at 100:5–101:8, ECF No. 259; *see Smartflash LLC v. Apple Inc.*, No. 6:13cv447, 2014 WL 6873161 (E.D. Tex. Dec. 4, 2014); *Guzik Technical Enters., Inc. V. W. Digital Corp.*, No. 11-cv-03786-PSG, 2013 WL 3934892 (N.D. Cal. July 19, 2013). The Court agrees with Defendants that the lack of expert testimony presented by one party is not necessarily dispositive of the issue before the Court.

The burden rests on Defendants to prove by clear and convincing evidence that no "informed and confident choice is available among the contending definitions" to those of ordinary skill in the art. *Interval Licensing*, 766 F.3d at 1371; *Nautilus*, 134 S. Ct. at 2130. Perfection in drafting is not required. *See id.* Here, the Court finds Jones' testimony regarding this term to be credible, and any



doubts as to the proper antecedent raised by Defendants are not sufficiently convincing to carry their burden.

Accordingly, The Court determines that the “said identification” term in claims 17–18 means “said identification of digital content.”

**G. “Said client device”**

	<u>Plaintiff</u>	<u>Defendants</u>
<b>said client device</b> [in claim 25]	said local device	Indefinite

Defendants argue that “said client device” in claim 25 of the ’482 patent is indefinite. Defs.’ Resp. Br. 23, ECF No. 229. Plaintiff argues that there was a typographical error, and the phrase should read “said local device.” Pl.’s Open. Br. 30–31, ECF No. 217. Plaintiff argues that the claim should not be stricken for indefiniteness and requests that the Court judicially correct this error. Pl.’s Resp. Br. 26, ECF No. 227.

In both parties’ Reply briefs, the parties disagree about the appropriate legal standard to apply when addressing alleged typographical errors. Defendants argue that a district court may only correct an error in a patent if the error is evident “from the face of the patent.” Defs.’ Reply 1, ECF No. 234 (citing *H-W Tech., L.C. v. Overstock.com, Inc.*, 758 F.3d 1329, 1333 (Fed. Cir. 2014); *Grp. One, Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297, 1303 (Fed. Cir. 2005)). Defendants argue that a court may not consult the prosecution history to determine whether an error may be corrected. Plaintiff counters that consulting the prosecution history along with the patent is required. Pl.’s Sur-Reply Br. 2, ECF No. 235 (citing *Grp. One, Ltd.*, 407 F.3d at 1303). Plaintiff alternatively suggests that it would be appropriate to correct an error whenever it is evident on the face of the patent that there is an error,

even if the proper correction is not evident. Hr’g Tr. at 139:25–140:25, ECF No. 259 (relying on *Fargo Elecs., Inc. v. Iris, Ltd., Inc.*, 287 F. App’x 96, 101 (Fed. Cir. 2008)).

District courts are instructed that they may judicially correct a patent only when “(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims.” *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1353 (Fed. Cir. 2009) (quoting *Novo Indus., LP v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003)). “[A]lthough courts cannot ‘rewrite claims to correct material errors,’ . . . if the correction is not subject to reasonable debate to one of ordinary skill in the art, namely, through claim language and the specification, and the prosecution history does not suggest a different interpretation, then a court can correct an obvious typographical error.” *Id.* According to the Federal Circuit, “evidence of error in the prosecution history alone [is] insufficient to allow the district court to correct the error”; the error must be evident on the face of the patent. *H-W Tech.*, 758 F.3d at 1334. A district court does not have authority to correct the patent when “one cannot discern what language is missing simply by reading the patent.” *Id.* Thus, merely detecting the presence of an error is not sufficient if someone skilled in the art is not able to discern which language is missing.

The Court concludes here that the error is not evident from the face of the patent alone and correction would substantially impact the understanding of the claim by substituting one defined term for another. *See Atlas IP, LLC v. St. Jude Med., Inc.*, No. 14-21006-CIV, 2014 WL 3764129, at \*13 (S.D. Fla. July 30, 2014) (refusing to correct “received by the hub” to “received by the remotes” because the change “substantially impacts the understanding of the claim”). The error also is not apparent from the face of the patent, unlike a grammatical or mathematical error, for instance.

*See Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331, 1339 (Fed. Cir. 2011) (distinguishing *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339 (Fed. Cir. 2009), “because in that case, the court merely added a comma to a chemical formula because the plaintiff demonstrated that the claimed formula  $C_9 S_3 S_3 Ca(fcl)_2$  corresponds to no known mineral”) (internal quotation marks omitted). Thus, judicial correction of the patent here is not appropriate. Moreover, “[e]ven assuming this change would save the term from indefiniteness, the Court cannot grant a change merely to sustain its validity.” *See Atlas IP*, 2014 WL 3764129, at \*13; *accord Rembrandt Data*, 641 F.3d at 1339 (The Federal Circuit “repeatedly and consistently has recognized that courts may not redraft claims, whether to make them operable or to sustain their validity.”).

Thus, the Court concludes that judicial correction is inappropriate, and “said client device” in claim 25 of the ’482 patent is indefinite.

#### H. “Media object identifier”

	<u>Plaintiff</u>	<u>Defendants</u>
<b>media object identifier</b>	No construction necessary	Indefinite

The parties dispute the definiteness and meaning of the “media object identifier” claim term. Plaintiff argues that there is no construction necessary for the term because it has a reasonably certain meaning that is sufficiently defined in the claims. Pl.’s Resp. Br. 27, ECF No. 227. Defendants contend that the patent does not define what a media object identifier is, only what it does — which is impermissible “functional claiming” of a structural element.<sup>6</sup> Defs.’ Open. Br. 32–34, ECF No. 219. Plaintiff disputes Defendants’ assertion that functional claiming is prohibited. Pl.’s Resp. Br.

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<sup>6</sup> The parties agree that a media object identifier is not a means-plus-function term. *See Hr’g Tr.* at 172:1–11, ECF No. 259.

27, ECF No. 227. The Court first turns to a preliminary challenge to Defendants' expert and then discusses the relevant legal standards.

1. Daubert Challenge

At the hearing, Plaintiff submitted that Defendants' expert Dr. Emery Berger's ("Berger") testimony is deficient under *Daubert*, and thus, Defendants have not put forth sufficient evidence to carry their burden of showing indefiniteness. Hr'g Tr. at 185:13–18, ECF No. 259. In support, Plaintiff explains that Berger did not read the relevant *Nautilus* opinion before giving his expert opinion about indefiniteness. *Id.* at 183:14–21. The Court finds that the experts in this case were called upon to present their opinions about what a person of skill in the art would have interpreted the claims to mean at the relevant time and considering the relevant evidence. The experts were not called upon to present legal opinions. Moreover, even if Berger's testimony that a term is indefinite were a conclusion based upon the prior legal standard, that would not defeat the usefulness of the testimony. If a term is not "reasonably ascertainable," or capable of being construed under the prior legal standard, then it also would not be "reasonably certain" under *Nautilus*' more strict reading.

Next, Plaintiff argues that Berger's failure to review all of the prosecution history undermines the validity of his expert opinions. Hr'g Tr. at 184:15–185:18, ECF No. 259. Defendants respond that Berger reviewed every portion of the prosecution history that was cited by either party. *Id.* at 198:9–21. Accordingly, the Court finds that the testimony is based upon sufficient facts or data, withstanding a *Daubert* challenge. *See* Fed. R. Evid. 702(b). Therefore, the objection to Berger's testimony is overruled.

2. Media Object Identifier Analysis

“[D]istrict courts are not (and should not be) required to construe every limitation present in a patent’s asserted claims.” *O2 Micro Int’l Ltd.*, 521 F.3d at 1362. For example, when a term is a common term with a commonly understood meaning, construction may not be required. *Id.* at 1360. However, “[w]hen the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.” *Id.* at 1362. “A determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.” *Id.* at 1361.

According to Plaintiff, because the “media object identifier” term has a reasonably certain meaning to a person of ordinary skill in the relevant art in light of the claims and prosecution history, no construction is required. Pl.’s Open. Br. 34, ECF No. 217. However, the fact that a given term has a clear meaning merely means that the term is not indefinite. Every claim for which a construction is given must meet this minimum standard of definiteness. *Interval Licensing*, 766 F.3d at 1369–70. When there is a genuine dispute about the meaning of a material claim term, such as in the instant situation, the Court must resolve the dispute. *See O2 Micro Int’l Ltd.*, 521 F.3d at 1362. In order to resolve the dispute here, the Court finds that it must determine the proper construction of the “media object identifier” claim term, if the “media object identifier” claim term is not indefinite.

Defendants’ conclusion that the term is indefinite is based upon their argument that functional claiming is prohibited. Defs.’ Open. Br. 32, ECF No. 219. However, as the Federal Circuit has explained, defining a particular claim term by its function is not necessarily improper. *Hill-Rom Servs.*, 755 F.3d at 1374–75; *Microprocessor Enhancement Corp. v. Tex. Instruments Inc.*, 520 F.3d

1367, 1375 (Fed. Cir. 2008). A claim term defined using functional language may be indefinite if the functional language fails “to provide a clear-cut indication of the scope of subject matter embraced by the claim” to a person of ordinary skill in the art. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008); *accord Interval Licensing LLC*, 766 F.3d at 1374. After *Nautilus*, the scope of a claim must be able to be defined with reasonable certainty in order to escape an indefiniteness fate under 35 U.S.C. § 112, ¶ 2. *Interval Licensing*, 766 F.3d at 1369–70. The Court now must determine whether Defendants have met their burden to show by clear and convincing evidence that the claim is indefinite. *See Warsaw Orthopedic*, 2015 WL 859503, at \*3.

The parties agree that “media object identifier” is an element without a standard definition within the computer programming art. *See* Defs.’ Reply Br. 1, ECF No. 234. Plaintiff’s expert Jones indicated that, to his knowledge, “media object identifier” is not a term of art within any computer programming language. *See* Jones Dep. 83:20–84:15, 85:14–24, App. 37–39, ECF No. 234-1. Plaintiff contends that the term’s meaning derives from the specifications in the patents themselves. *See id.* Thus, the parties are in agreement that the meaning, if any, must derive from the patents’ claims, in light of the specification and prosecution history.

The crux of Defendants’ argument is that the structure of the “media object identifier” apparatus is undefined. According to Defendants, the term “covers any and all software that is capable of providing an ‘interface for acquiring and pre-processing a media object’—no matter how the software performs these functions.” Defs.’ Resp. Br. 24, ECF No. 229 (quoting Pl.’s Open. Br. 33, ECF No. 217). A media object identifier is an apparatus because it is described as a “thing,” rather than a method, step or process.<sup>7</sup> Hr’g Tr. at 167:18–20, ECF No. 259. Defendants conclude

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<sup>7</sup> Plaintiff argues that Defendants have not demonstrated that the media object identifier is an apparatus, rather than a method in which specific steps are described. *See* Pl.’s Resp. Br. 30, ECF No. 227.

that the purely functional description of the media object identifier is impermissibly indefinite. *Id.* at 169:23–170:21 (relying on *O’Reilly v. Morse*, 56 U.S. 62 (1854); *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946)).

Defendants continue that the media object identifier does not fit within the only exception to the prohibition on functional claiming—means-plus-function claiming under 35 U.S.C. § 112(6). A means-plus-function element may be described using functional language in the claims provided that the specification yields sufficient structure to define the term. *See Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1312 (Fed. Cir. 2012). Defendants argue that because this is not a means-plus-function element, Plaintiff cannot look to the specification for support, even were there any support in the specification. Hr’g Tr. at 168:1–18, ECF No. 259. They contend that there is no structure given in either the claims or the specification, and therefore the term is indefinite. *Id.* at 167:24–168:3.

Plaintiff relies on Jones’ testimony to argue that the term is not indefinite. Plaintiff argues that the claims clearly define the “media object identifier” term as software that encompasses a graphical user interface and performs several functions, including pre-processing media objects. *See* Pl.’s Resp. Br. 8, ECF No. 227 (“[A] ‘media object identifier’ is something used to acquire and pre-process media objects.”); Jones Dep. 85:21–23, 86:5–13, 87:13–23, App. 9–10, ECF No. 235. According to Jones’ Declaration, “[o]ne of ordinary skill in the art can look to the asserted claims of the ‘557 patent to ascertain with reasonable certainty the meaning of media object identifier; in fact, one of ordinary skill would observe that the asserted claims include limitations that describe the media object identifier, including dependent claims that further describe it.” Jones Decl. ¶ 46,

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As a preliminary matter, the Court determines that the “media object identifier” is described in the claims and by the parties as something that performs a function, rather than a method. *See, e.g.*, Pl.’s Resp. Br. 8, ECF No. 227 (“[A] ‘media object identifier’ is something used to acquire and pre-process media objects.”).

App. 264, ECF No. 228. He explains, for instance, that “[b]ecause independent claims 1, 15, 28, and 37 specify ‘pre-processing the media object by the media object identifier’, they necessarily require that the media object identifier be capable of pre-processing media objects.” *Id.* at ¶ 46, App. 265. In response to Defendants’ allegations of indefinite structure, Jones asserts, “[s]hort of giving source code, I don’t think -- I can’t imagine giving much more structure than this.” *Id.* at 126:12–14.

At the hearing, Plaintiff argued that the plain meaning of “media object identifier” to one skilled in the art based upon the patent is “software that includes a graphical user interface for acquiring media objects, such as a photo, video, or audio files, and pre-processing them in preparation for transmission elsewhere.” Hr’g Tr. at 187:23–11, ECF No. 259. Plaintiff adopts this definition based upon Jones’ deposition. *Id.* Plaintiff advocates for such a construction if the Court determines that construing the term is necessary. *Id.*

Defendants contend that Jones’ testimony gives “only shifting, functional descriptions,” such as “providing a graphical user interface” and “pre-processing,” instead of describing what a “media object identifier” is. Defs.’ Reply 2, ECF No. 234; *see also* Jones Dep. 86:23–87:03, 87:17–23, App. 40–41, ECF No. 234-1. From these definitions, Defendants conclude that “Summit 6 seeks to cover *any* structure that performs the disclosed functions, to the extent those functions can even be identified.” Defs.’ Reply 2, ECF No. 234 (emphasis in original).

The Court finds that because the parties are in agreement that the term does not invoke means-plus-function claiming, Plaintiff is not required to establish structure. *Cf. Noah Sys.*, 675 F.3d at 1312. Rather, Defendants bear the burden of establishing by clear and convincing evidence that the term is indefinite. *See Warsaw Orthopedic*, 2015 WL 859503, at \*3. Accordingly, the “media object identifier” term will survive definiteness review if Plaintiff demonstrates that the term is



defined such that the claims containing the term have a reasonably clear meaning to one of skill in the art in light of the claims and prosecution history.

Here, Plaintiff has demonstrated that the primary functions and uses of the media object identifier are clear, thus giving the term boundaries. Plaintiff provides that “the intrinsic record describes an ‘interface’ and recites the pseudo-code (and a related textual description) of the media object identifier.” Pl.’s Resp. Br. 33–34, ECF No. 227. Plaintiff relies upon *High Point Sarl*, for the proposition that an “interface” is “a sufficient recitation of structure.”<sup>8</sup> *Id.*; *High Point Sarl v. Sprint Nextel Corp.*, No. 09-02269-CM, 2012 U.S. Dist. LEXIS 108485, at \*15 (D. Kan. Aug. 3, 2012) (finding “interface” to have “a well-known meaning to those of skill in the art”). Such a definition clarifies one aspect of the media object identifier. *See* Jones Dep. 86:5–13, 87:13–23, App. 10, ECF No. 235. The prosecution history reflects that the media object identifier is not merely a “media container” or “image well,” which is a general term for the space on the screen into which the user may insert a media file; instead, the media object identifier also has a functional component. *See* Defs.’ Open. Br. 36, ECF No. 219.

To define the pre-processing aspect of the media object identifier, Plaintiff proffers that the textual descriptions and pseudo-code provide sufficient structures.<sup>9</sup> Pl.’s Resp. Br. 33–34, ECF No. 227 (citing *Bedrock Computer Techs., LLC v. Softlayer Techs., Inc.*, No. 6:09-cv-269 LED-JDL, 2011 U.S. Dist. LEXIS 3512, at \*47–48 (E.D. Tex. Jan. 10, 2011)). The Court agrees that such

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<sup>8</sup> In the briefing, Plaintiff offered this argument in a different context to demonstrate that 35 U.S.C. § 112, ¶ 6 does not apply because there are sufficient structures disclosed.

<sup>9</sup> In the briefing, Plaintiff offered this argument in a different context to demonstrate that 35 U.S.C. § 112, ¶ 6 does not apply because there are sufficient structures disclosed.

descriptions could provide sufficient boundaries for an invention and that fully elaborated code is not necessary. *See Noah Sys.*, 675 F.3d at 1312.

Defendants argue that the descriptions and disclosed code only describe the invention from the point of view of the client, rather than giving information about how the software is implemented. Defs.’ Resp. Br. 26, ECF No. 229. For instance, Appendix A of the ’557 patent discloses the code that a client would add to their website to use the preferred embodiment, but does not detail the code necessary for the media object identifier to pre-process an object. *See id.*; ’557 patent, 5:39–41, App. 32, ECF No. 219-1; Defs.’ App. Supp. Open. Br. Ex. 16 (Berger Decl.) ¶ 50, App. 316, ECF No. 219-4; *see also* Berger Decl. ¶ 50, App. 316, ECF No. 219-4. The text instead describes the use and function of the invention.

The Court finds that Plaintiff has provided sufficient support to define the appearance and operation of the media object identifier, and therefore Defendants have not met their burden to show that there is no clear limitation for how the media object identifier performs the pre-processing. *See Hill-Rom Servs.*, 755 F.3d at 1374–75 (holding claim terms may be defined with reference to their function); *High Point Sarl*, 2012 U.S. Dist. LEXIS 108485, at \*15. Therefore, the claims containing the term are not indefinite. *See Nautilus*, 134 S. Ct. at 2130. Accordingly, the Court adopts Plaintiff’s construction, finding that the “media object identifier” means “software that includes a graphical user interface for acquiring media objects, such as a photo, video, or audio files, and pre-processing them in preparation for transmission elsewhere.”

**I. “Code means . . . for enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account.”**

Plaintiff

Defendants

<p><b>code means . . . for enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account.</b></p>	<p>Function: enabling a receipt of an identification of one or more image files, video files, or audio files to associate with said account;</p> <p>Structure: Figs. 1–4B; ’515:3:18–54, 4:4–6, 4:17–34, 5:13–6:36; and equivalents thereof.</p>	<p>Function: enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account;</p> <p>Structure: Not disclosed. The term is indefinite.</p>
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The parties agree that “code means . . . for enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account” is a means-plus-function clause triggering 35 U.S.C. § 112, ¶ 6. The parties also agree that the claim term’s function is “enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account.” The parties disagree as to whether the corresponding structure to implement the function is sufficiently defined.

“[A] means-plus-function clause is indefinite if a person of ordinary skill in the art would be unable to recognize the structure in the specification and associate it with the corresponding function in the claim.” *Noah Sys.*, 675 F.3d at 1312 (quoting *AllVoice Computing PLC v. Nuance Commc’ns, Inc.*, 504 F.3d 1236, 1241 (Fed. Cir. 2007)). “[A] challenge to a claim containing a means-plus-function limitation as lacking structural support requires a finding, by clear and

convincing evidence, that the specification lacks disclosure of structure sufficient to be understood by one skilled in the art as being adequate to perform the recited function.” *Chi. Bd. Options Exch., Inc. v. Int’l Sec. Exch., LLC*, 748 F.3d 1134, 1141 (Fed. Cir. 2014) (quoting *Budde v. Harley–Davidson, Inc.*, 250 F.3d 1369, 1376–77 (Fed. Cir. 2001)). “Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *Minks v. Polaris Indus., Inc.*, 546 F.3d 1364, 1377 (Fed. Cir. 2008). When the means-plus-function limitation is computer-implemented, the specification must disclose an algorithm, or a step-by-step process for achieving the function. *Noah Sys.*, 675 F.3d at 1312. The specification can express the algorithm “in any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.” *Id.* “[F]ailure to disclose adequate structure corresponding to the recited function in accordance with 35 U.S.C. § 112, paragraph 1, results in the claim being of indefinite scope, and thus invalid, under 35 U.S.C. § 112, paragraph 2.” *Budde*, 250 F.3d at 1376.

Defendants argue that there is insufficient structure disclosed to explain how information is received. Citing *Noah System* and *Aristocrat Technologies*, they argue that disclosing generic “software” as the structure corresponding to means-plus-function limitations is not sufficient without disclosing the step-by-step procedure. *See Noah Sys.*, 675 F.3d at 1312; *Aristocrat Techs. Austl. PTY Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). Defendants argue that there is no description of a procedure that would communicate file names or correlate files with account information. Defs.’ Open. Br. 28, ECF No. 219. In response to the support Plaintiff lists in the proposed claim construction chart, Defendants present five specific arguments for a lack of structure.

First, Defendants argue that the diagrams in Figures 1 and 2 offer only a proposed user interface, not any indication of “a procedure that would communicate files names or correlate files with account information.” Defs.’ Open. Br. 28, ECF No. 219 (citing Berger Decl. ¶ 31, App. 310, ECF No. 219-4).

Second, Defendants concede that Figures 3 and 4A–4B present some information about the media object identifier and the media sender, but, Defendants argue, the figures do not adequately disclose the structures. Defs.’ Open. Br. 29, ECF No. 219. According to Defendants, “[s]ome entries in the figures, such as ‘fileName’ and ‘imageName,’ are merely variables. Although others are labeled as functions, in fact they are merely ‘declarations’ that provide ‘the functions’ name and the identity of the inputs (*i.e.*, parameters) that will go into [the functions].” *Id.* (citing Berger Decl. ¶ 25, App. 308, ECF No. 219-4). Defendants’ expert concludes that no entry in the figures defines the operations that the named function would actually perform on the inputs. *Id.* Defendants also argue that Figures 4A and 4B are unrelated to “enabling a receipt of [content],” which is essential for the “code means” term; instead, they depict transmissions. Defs.’ Open. Br. 29, ECF No. 219; *see* ’515 patent, 3:21–25, 6:37–38, App. 65, ECF No. 219-2.

Third, Defendants contend that column 3 lines 18–54 of the ’515 patent do not present any structure and instead define the media object identifier using purely functional terms. According to Defendants, merely describing how a user could interact with the media object identifier does not disclose how the software performs the function of “enabling a receipt of an identification of one or more . . . files.” *See* Berger Decl. ¶¶ 28, 30, App. 309–10, ECF No. 219-4; *see also Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1318 (Fed. Cir. 2013) (“It is well settled that [s]imply disclosing software, however, without providing some detail about the means to accomplish the function[,] is

not enough.”)(internal quotation marks omitted). Defendants also contend that Plaintiff’s disclosure that the media object may be an ActiveX or Java component is irrelevant because ActiveX and Java are only languages in which software may be written, rather than particular structures. Defs.’ Open. Br. 30, ECF No. 219 (citing ’515 patent 3:33–36, 3:40–42, App. 65, ECF No. 219-2; Berger Decl. ¶ 29, App. 309–10, ECF No. 219-4).

Fourth, Defendants argue that passages at column 4, lines 4 through 6 and lines 17 through 34 of the ’515 patent do not provide information about corresponding structures. Instead, Defendants argue that they merely give extraneous information about additional features. Defs.’ Open. Br. 30–31, ECF No. 219.

Fifth, Defendants note that the ’515 patent, unlike the other Patents-in-Suit, does not contain the HTML template “Appendix A.” *Id.* at 31; Berger Decl. ¶¶ 23, 33, App. 308, 311, ECF No. 219-4. Moreover, Appendix A in the ’557 and ’482 patents also does not present the relevant source code, namely the code underlying the “PWT.addimagecontrol( );” script. Defs.’ Open. Br. 31, ECF No. 219; Berger Decl. ¶ 24, App. 308, ECF No. 219-4; ’482 patent (Appendix A), App. 48, ECF No. 219-1. Instead, the HTML template in Appendix A provides that the relevant code will be downloaded from the PictureWorks Server. Berger Decl. ¶¶ 24, 33, App. 308, 311, ECF No. 219-4; ’482 patent (Appendix A), App. 47–49, ECF No. 219-1; *see also DePuy Spine*, 469 F.3d at 1023 (holding that incorporation by reference is not sufficient disclosure).

Plaintiff argues that the patent has disclosed sufficient information about the structure of the “code means” term through prose, code, and pseudo-code, and thus the term is not indefinite. Pl.’s Open. Br. 35, ECF No. 217 (relying on *TecSec, Inc. v. Int’l Bus. Mach. Corp.*, 731 F.3d 1336, 1348–49 (Fed. Cir. 2013)) (finding the structure of means plus function terms such as “selecting an

object to encrypt,” and others, to be sufficiently disclosed when the specification provided examples of using software to perform the claimed function). According to Plaintiff, it has provided a detailed example of using the software, satisfying the need for structure. For instance, Plaintiff argues that it has presented two separate ways in which the media object identifier structures enable the claimed function, the “drag and drop” and “browse dialogue” features. Pl.’s Resp. Br. 36, ECF No. 227. Plaintiff explains that a person of ordinary skill in the art would have readily understood the functionality being described because drag-and-drop and click-to-browse features were already well known in the art at the time of the invention. *Id.* at 37. In essence, Plaintiff argues that Defendants demand a particular type of disclosure, namely source code, which is “well beyond what is required by the case law and should be rejected.” Pl.’s Sur-Reply Br. 3, ECF No. 235.

In its Sur-Reply Brief, Plaintiff points to excerpts of Jones’ declaration and deposition as examples of structure associated with the “code means” term. *Id.* (citing Jones Dep. 115:10–118:10, App 13-14, ECF No. 235). In the deposition excerpts, Jones explains:

The specification describes, first of all, that this is a media object identifier, that it is sized according to parameters it receives, that it is displayed on the pages as disclosed separately for ActiveX and Java in Figures 1 and 2. It describes the user interaction, which is specifically would be detecting that the mouse pointer is over the display of the media object identifier, and then the interaction -- that the user releases their button, so both of those events are detected in the drag-and-drop operation.

Jones Dep. 116:10–21, App 13-14, ECF No. 235. In response to the next question asking whether the above description is the extent of the algorithm for accomplishing function, Jones continues:

That allows the acquisition of the -- the identification of the media object. It also -- the specification also describes a filename that is -- it's described as an object that stores the name of the identified file, and then it also describes the capability of the media object identifier to -- how it can receive information about, for example, an account, like a user ID or password.

*Id.* at 116:24–117:7. He concludes that, beyond these steps, the specification “does not describe another level below that,” such as source code. *Id.* at 118:5–6.

The Court finds that the detailed step-by-step instructions given in the ’515 patent are only presented from the user’s perspective. Jones has explained that the patent clearly describes the appearance of the media object identifier on a web-page in the preferred embodiment. *See id.* at 116:10–21. Jones further explained “the user interaction,” in which a user selects content using a browse dialogue or a drag and drop feature. *Id.* The media object identifier uses a user ID or password to receive information about an account. *Id.* at 116:24–117:7. However, despite Plaintiff’s arguments to the contrary, there is nothing more to describe how the user information is actually associated with the account or how the software functions. *See id.* at 118:5–6.

The Court finds this instant case to be analogous to the *Augme Technologies*. In *Augme Technologies*, the Federal Circuit held that “[s]imply disclosing a black box that performs the recited function is not a sufficient explanation of the algorithm required to render the means-plus-function term definite.” *Augme Techs., Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1338 (Fed. Cir. 2014). In the case, the specification describes that the “code assembler instructions” assemble the second code module. The specifications disclose inputs and outputs of the “code assembler instructions.” *Id.* There is no disclosure of how the second code module is assembled. *Id.* The purported software code merely explained that the “code assembler instructions” were the element that does the assembly. *Id.* In the instant action, Plaintiff’s code means that enables receipt of an identification of content, without further explanation of the algorithm, is merely a black box.

The Court next will consider *TecSec*, the case upon which Plaintiff relies for the proposition that providing examples of using the software is sufficient disclosure. 731 F.3d at 1348–49. In



*TecSec*, the examples were far more inclusive and detailed than the descriptions given in the patents in the instant case. *See id.* at 1349. For instance, one example not only “describes how a user interacts with the software applications to cause them to select an object to encrypt, select a label for the object, select an encryption algorithm, encrypt the object, and label the encrypted object,” it goes on and “details how the software determines if the user is authorized to view the object and, if so, decrypts the object.” *Id.* Thus, the patents in *TecSec* give both descriptions of the function from a user-interface standpoint and descriptions of how the software determines if the user is authorized. *See id.*

Here, by contrast, the Court finds that the “drag and drop” and “browse dialogue” features merely describe the user interface, in particular how a user selects media content, rather than how such features work. The Court finds defense expert Berger’s explanation to be credible. Berger described that software to accept a selection of media content using a drag and drop feature or a browse dialogue could be written in “countless ways.” Berger Decl. ¶ 46, App. 314–15, ECF No. 219-4. Thus, disclosing that a “media object identifier” accepts user input in these ways “does not indicate to a person having ordinary skill in the art how that function is implemented.” *Id.* “Simply disclosing a black box that performs the recited function is not a sufficient explanation of the algorithm required to render the means-plus-function term definite.” *Augme Techs.*, 755 F.3d at 1338.

Accordingly, the Court finds that Defendants have met their burden of showing by clear and convincing evidence that there is no corresponding structure to support the “code means” function, and therefore the term is indefinite.

#### **IV. CONCLUSION**

In summary, the Court construes the disputed terms from the Patents-in-Suit as follows:

(1) “Pre-processing” means “modifying the [media object data/digital content data/one or more image files, video files, or audio files], as opposed to data merely associated with the [media object/digital content/image files, video files, audio files], at the client or local device prior to transmission to a remote device.”

(2) For “server device,” “host server,” and “distributing party,” there is no construction necessary. “Remote device,” “remote server,” and “a device separate from said client device” are construed according to Plaintiff’s proposed constructions.

(3) Terms relating to the receipt, provision, or transmission of pre-processing parameters are construed according to Plaintiff’s proposed constructions.

(4) For terms relating to the preambles of the ’482 and ’515 patents, there is no construction necessary.

(5) “Distributing” and “distribution” mean “sharing.”

(6) “Said identification” means “said identification of digital content.”

(7) “Said client device” is indefinite.

(8) “Media object identifier” means “software that includes a graphical user interface for acquiring media objects, such as a photo, video, or audio files, and pre-processing them in preparation for transmission elsewhere.”

(9) “Code means . . . for enabling a receipt of an identification of one or more image files, video files or audio files to associate with said account” is indefinite.

**SO ORDERED** on this **21st day of March, 2015.**

  
Reed O'Connor  
UNITED STATES DISTRICT JUDGE