

EXHIBIT 5

**THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

PERSONALWEB TECHNOLOGIES, LLC, §
et al., §

Plaintiffs, §

v. §

CASE NO. 6:12-CV-661-JRG
(LEAD CASE)

INTERNATIONAL BUSINESS §
MACHINES CORPORATION, §

Defendant. §

PERSONALWEB TECHNOLOGIES, LLC, §
et al., §

Plaintiffs, §

v. §

CASE NO. 6:12-CV-659-JRG
(CONSOLIDATED CASE)

RACKSPACE US, INC., et al., §

Defendants. §

MEMORANDUM OPINION AND ORDER

Before the Court are Plaintiff PersonalWeb Technologies, LLC’s Opening Claim Construction Brief (Dkt. No. 85), Defendants’ response (Dkt. No. 90), and Plaintiff’s reply (Dkt. No. 94).

The Court held a claim construction hearing on March 7, 2016.

Table of Contents

I. BACKGROUND	3
II. LEGAL PRINCIPLES	4
III. CONSTRUCTION OF AGREED TERMS	8
IV. CONSTRUCTION OF DISPUTED TERMS	9
A. “data item”	9
B. “given function of the data [in the data item / data file]” and “applying a function to the contents of the corresponding file”	15
C. “licensed” and “unlicensed”	21
D. “authorized,” “unauthorized,” “authorization”	25
E. “file name”	29
F. “substantially unique value”	34
V. CONCLUSION	35

I. BACKGROUND

Plaintiff brings suit alleging infringement of United States Patents No. 6,415,280 (“the ’280 Patent”), 6,928,442 (“the ’442 Patent”), 7,802,310 (“the ’310 Patent”), and 8,099,420 (“the ’420 Patent”) (collectively, “the patents-in-suit”). (Dkt. No. 85, Exs. A-D.) The remaining Defendants are International Business Machines Corporation and GitHub, Inc.

The patents-in-suit are related to United States Patent No. 5,978,791 (“the ’791 Patent”) (*id.*, Ex. E), which is no longer asserted in the present case. The parties submit that “[a]lthough the ’791 patent is no longer asserted, the parties cite to the ’791 patent because its specification is identical to the specifications of the asserted patents and because the Court cited to the ’791 patent specification when previously construing terms from the asserted patents.” (Dkt. No. 78, Ex. B at 1.)

The ’791 Patent, titled “Data Processing System Using Substantially Unique Identifiers to Identify Data Items, Whereby Identical Data Items Have the Same Identifiers,” issued on November 2, 1999, and bears an earliest priority date of April 11, 1995. The Abstract states:

In a data processing system, a mechanism identifies data items by substantially unique identifiers which depend on all of the data in the data items and only on the data in the data items. The system also determines whether a particular data item is present in the database by examining the identifiers of the plurality of data items.

The Court previously construed terms in the patents-in-suit in *PersonalWeb Technologies, LLC v. NEC Corp., et al.*, No. 6:11-CV-655, Dkt. No. 103 (E.D. Tex. Aug. 5, 2013) (Davis, J.) (“*PersonalWeb I*”) (attached to Plaintiff’s opening brief, Dkt. No. 85, at Ex. F), and that action also included Civil Actions No. 6:11-CV-656, -657, -658, -660, -683, and 6:12-CV-658, -660, -662.

II. LEGAL PRINCIPLES

It is understood that “[a] claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using or selling the protected invention.” *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1340 (Fed. Cir. 1999). Claim construction is clearly an issue of law for the court to decide. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996).

To ascertain the meaning of claims, courts look to three primary sources: the claims, the specification, and the prosecution history. *Markman*, 52 F.3d at 979. The specification must contain a written description of the invention that enables one of ordinary skill in the art to make and use the invention. *Id.* A patent’s claims must be read in view of the specification, of which they are a part. *Id.* For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Id.* “One purpose for examining the specification is to determine if the patentee has limited the scope of the claims.” *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882 (Fed. Cir. 2000).

Nonetheless, it is the function of the claims, not the specification, to set forth the limits of the patentee’s invention. Otherwise, there would be no need for claims. *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc). The patentee is free to be his own lexicographer, but any special definition given to a word must be clearly set forth in the specification. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992). Although the specification may indicate that certain embodiments are preferred, particular embodiments appearing in the specification will not be read into the claims when the claim language is broader than the embodiments. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994).

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