



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. Conceptronic, 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).

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