

States Patent Number 7,765,482 (the “482 Patent”), a continuation of the ‘557 Patent application filed on October 8, 2004 and issued on July 27, 2010. The parties seek construction of twelve sets of terms appearing in one or both of the ‘557 and ‘482 patents: (1) “pre-processing”; (2) “pre-processing parameters” and “parameters used to control the pre-processing”; (3) “pre-processing the media object by the media object identifier for the requirements of the third-party website, the pre-processing being done without [additional] user selection of the pre-processing”; (4) “pre-processing the media object . . . for the requirements of the third-party web site”; (5) “placement of . . . digital content into a specified form” or “to place . . . digital content in a specified form”; (6) “remote device” or “device separate from said client device”; (7) “information that enables identification of a user” or “user identifier” or “user information”; (8) “publishing” or “publication”; (9) “a computer implemented method of pre-processing digital content in a client device for subsequent electronic [publishing / distribution]”; (10) “receiving . . . from a remote device” or “received . . . from a device separate from a client device” or “provided to said client device by a device separate from said client device”; (11) “displaying a preview image of said selected digital content”; and (12) “pre-processing in accordance with one or more pre-processing parameters that have been stored in memory of said client device” and similar terms. The parties have agreed on the construction of two additional terms: (13) “combining (including stitching) of multiple media objects,” and (14) “adding text or other annotation to the media object.”

II. LEGAL STANDARDS – PATENT CLAIM CONSTRUCTION

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

by establishing, as a matter of law, the scope and boundaries of the subject-matter of the patent. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370, 384-85 (1996). Second, the trier of fact compares the properly construed claims to the allegedly infringing devices and determines whether there has been an infringement. *Id.* Here, the issue currently before the Court is the proper construction of certain disputed claims in the '557 Patent and the '482 Patent.

A. Rules of Claim Construction

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) (internal citations omitted).

Claim construction starts with the language of the claim itself since 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 define his own terms, so long as any special definition given to a term is clearly defined in the specification. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed. Cir. 1992).

When construing disputed claim terms the 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. Conceptiontronic, 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.*

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.” *Philips*, 415 F.3d at 1317 (internal quotation marks omitted). Dictionaries and treatises can be “useful in claim construction[,]” particularly technical dictionaries which 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.

III. CLAIM CONSTRUCTION ANALYSIS

1. “pre-processing”

<u>Plaintiff</u>	<u>Web Defendants</u>	<u>Mobile Phone Defendants</u>
“in preparation for transmission, modifying the underlying data of the media object [digital content] in accordance with the requirements of another device”	“modifying the [media object data / data of the digital content] at the browser before transmitting to a server device”	“modifying the digital content at the client device before transmitting to a server device”

The parties agree that pre-processing involves modification of the material being pre-processed and that pre-processing occurs prior to transmission of the pre-processed material. However, the parties dispute: (a) what material is pre-processed; (b) where pre-processing occurs; (c) where the pre-processed material is transmitted; and (d) whether pre-processing is done “in accordance with the requirements of another device.”

a. What material is pre-processed?

The Plaintiff, the Web Defendants, and the Mobile Phone Defendants offer the following

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