1   ROBERT T. HASLAM (State Bar No. 71134)
    robert.haslam@hellerehrman.com
2   NITIN SUBHEDAR (State Bar No. 171802)
    nitin.subhedar@hellerehrman.com
3   BHANU K. SADASIVAN (State Bar No. 233429)
    bhanu.sadasivan@hellerehrman.com
4   HELLER EHRMAN LLP
    275 Middlefield Road
5   Menlo Park, CA 94025-3506
    Telephone: (650) 324-7000
6   Facsimile: (650) 324-0638

7   JOHN C. ULIN (State Bar No. 165524)
    john.ulin@hellerehrman.com
8   HELLER EHRMAN LLP
    333 South Hope Street, 39th Floor
9   Los Angeles, CA 90071-3043
    Telephone: (213) 689-0200
10 Facsimile: (213) 614-1868

11 MATTHEW C. LAPPLE (State Bar No. 193546)
    matt.lapple@hellerehrman.com
12 4350 La Jolla Village Drive, 7th Floor
    San Diego, CA 92122
13 Telephone: (858) 450-8401
    Facsimile: (858) 587-5953
14
    Attorneys for Defendant
15 REVENUE SCIENCE, INC.

16

17   UNITED STATES DISTRICT COURT

18   CENTRAL DISTRICT OF CALIFORNIA

19   WESTERN DIVISION

20

21 VALUECLICK, INC.,   Case No.: CV 07 2052 MMM
    a Delaware Corporation,   (JCX)
22
                            Plaintiff,   **DEFENDANT REVENUE
23   SCIENCE, INC.'S
            v.   RESPONSIVE *MARKMAN*
24   BRIEF**
    REVENUE SCIENCE, INC.,
25 a Washington Corporation,

26   Defendant.

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TABLE OF ABBREVIATIONS

RSI	Defendant Revenue Science, Inc.
ValueClick	Plaintiff ValueClick, Inc.
'396	U.S. Patent No. 5,848,396, attached as Exhibit 1 to the Declaration of Bhanu K. Sadasivan In Support Of RSI's Opening Markman Brief
'735	U.S. Patent No. 5,991,735, attached as Exhibit 3 to the Declaration of Bhanu K. Sadasivan In Support Of RSI's Opening Markman Brief
112(6)	35 U.S.C. § 112, paragraph 6
DI 23	The Joint Claim Construction Chart ("JCCC") filed by the parties on September 28, 2007
'396 F.H.	The prosecution history of the '396 patent before the U.S. Patent & Trademark Office, attached as Exhibit 2 to the Declaration of Bhanu K. Sadasivan In Support Of RSI's Opening Markman Brief
'735 F.H.	The prosecution history of the '735 patent before the U.S. Patent & Trademark Office, attached as Exhibit 4 to the Declaration of Bhanu K. Sadasivan In Support Of RSI's Opening Markman Brief
MPEP	The Manual of Patent Examining Procedure
Roman ¶	Declaration Of Kendyl Roman In Support Of RSI's Opening Markman Brief
Roman Response ¶_	Declaration Of Kendyl Roman In Support Of RSI's Responsive Markman Brief
Kent Decl.	Declaration of Peter Kent In Support of ValueClick, Inc.'s Claim Construction Brief
VC Brief	Plaintiff ValueClick, Inc.'s Claim Construction Brief, dated October 15, 2007

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I.   INTRODUCTION

ValueClick's opening brief appears to be intended to achieve one overarching goal, and that is to divorce the claims completely from the intrinsic record of which they are a part. The entire focus of the patents-in-suit – indeed, the very thing touted by the patentee as the benefit of the alleged invention – is a method of creating a psychographic profile for an *individual user* and then utilizing it to display content in a layout that is customized to *that individual's* particular interests and preferences. Yet, while the constructions that RSI has proffered through the use of well-established claim interpretation principles remain faithful to this focus, ValueClick's proposals mysteriously do not. Instead, ValueClick asks the Court to adopt claim term meanings that are not only untethered to the patent specifications or file histories, but that are instead grounded in questionable extrinsic evidence that often conflicts with the intrinsic record. The improper techniques that ValueClick uses to achieve this result can be grouped into three broad categories.

First, ValueClick repeatedly ignores the fundamental purpose of the technology claimed in the patent – the creation of an *individualized* user experience. For example, ValueClick's definition of "user" as a particular computer, rather than a *particular individual* who uses that computer, vitiates this critical aspect of the patents-in-suit. A user at an Internet café wants her experience tailored to her personal psychographic profile, not to the forty users who preceded her on that computer. Similarly, a given advertisement sponsor is interested in reaching a particular individual who has certain interests and preferences, and composite data relating to the last forty users of a given computer is of no use for such purposes. Thus, the intrinsic record, the purpose of the invention, and common sense dictate that RSI's proposed construction – that a "user" is an individual person, not a computer – is the only correct one.

Second, ValueClick cherry picks disclosures from the patent that support its broad definitions, while ignoring parts of the patent specification that contradict its

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1   position. In contrast, RSI's definitions track the claim terms as understood by one of

2   ordinary skill in the art when read in the context of the entire intrinsic record. For

3   example, RSI correctly defines "psychographic profile" to include content and format

4   preferences. As the patents state, "[p]references with respect to color schemes, text

5   size, shapes, and the like are recorded as part of the psychographic profile of a user."

6   ('396 col. 2:16-23). ValueClick simply ignores the repeated references in the patent

7   and the file history to format preferences being part of the psychographic profile, and

8   instead defines psychographic profile as including only content preferences by

9   offering up selective and misleading quotations from the specification.

10   Third, ValueClick brushes aside established Federal Circuit precedent on claim

11   construction. More specifically, ValueClick disregards or misapplies settled law on

12   the consideration of extrinsic evidence, the rules on claim differentiation, the

13   requirement that all claim terms must have meaning so as to not render a term

14   superfluous, and even the basic principle that claim terms must be construed as

15   understood by a person of ordinary skill in the art.

16   For all of these reasons, RSI respectfully submits that the Court should adopt

17   RSI's definitions, and reject ValueClick's flawed constructions in their entirety.

18   **II.   VALUECLICK'S DESCRIPTION OF THE PATENTS-IN-SUIT IS**
19   **   INACCURATE AND MISLEADING**

20   In its Opening Claim Construction brief, ValueClick provides an extensive

21   discussion regarding the alleged invention and the manner in which the software

22   components of the alleged invention interact. VC Brief, at 1-6. ValueClick's

23   discussion, however, is selective, confusing, and potentially misleading.

24   Accordingly, RSI provides a brief recitation here of the operation of the key

25   components of the alleged invention, and then reveals the errors in ValueClick's

26   description of the technology.

27   **A.   Overview of the patents-in-suit**

28   The alleged invention disclosed in the patents-in-suit is program 31 that resides

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1 in a single web server 27 connected to several servers and user computers in several

2 networks. (Fig. 1). As shown in Figure 2 of the patents-in-suit, Program 31 has four

3 components, each with a specific function:

4 　　　1) **an agate data assembly 71** (the function of which is to store various agate

5 information for user viewing);

6 　　　2) **a user profiling member 73** (the function of which is to record information

7 regarding each user, including user's identification, categories of interest to the user,

8 and the user's display preferences for each category);

9 　　　3) **an advertisement module** (the function of which is to hold sponsor

10 information and their advertisements, with target audience profile indicated for each

11 advertisement); and

12 　　　4) **a program controller 79** (the function of which is to respond to commands

13 – *e.g.,* log in and menu selection – transmitted over the Internet by an end user, and to

14 obtain the necessary information from 71, 73, and 75 to generate and display

15 appropriate screen views to the user). ('396, 4:39-55).

16 　　　In the preferred embodiment, program 31 is implemented as an object oriented

17 program. A set of Objects provide the functional equivalent for each of the

18 components.[1] When a user logs in for the first time, the program controller 79

19 assigns a unique "users computer ID," and also a user name and password, to the new

20 user. The program controller 79 also obtains initial agate information (*e.g.* a sports

21 score, or a weather report) from the agate data assembly 71 to display as part of the

22 Home Page to the new user. The assignment of an ID to the user enables user

23 profiling member 73 to begin tracking the new user's activity. ('396, 4:66-5:7).

24 　　　[1] Figure 3 in the patents-in-suit discloses the names of the Objects that provide

25 the functional equivalent for each of the components. Specifically, the Agate Data
Assembly 71 finds its functional equivalent in Objects 35a-c, the User Profiling

26 Member 73 has a functional equivalent in Objects 37a-f, the Advertisement Module 75
is functionally equivalent to Objects 33a-d, and the Program Controller 79 is

27 functionally equivalent to Main Routine 39. ('396, 5:54-62). As explained in RSI's
Opening Brief, and below, these descriptions do not satisfy the requirements of 112(6)

28 that the patent specification must disclose adequate corresponding structure.

3

1   As the user makes selections, the user profiling member 73 records the user's

2   activities and thus builds a psychographic profile of the user. ('396, 5:8-14).

3   Specifically, User Object 37a records the user provided name and password, while

4   User Interface Object 37c holds the user's "categories of interest" and "category

5   display," *i.e.,* display or format preferences. ('396, 14:14-17). The Program

6   Controller 79 responds to the user's selections and viewing actions by using the agate

7   data assembly 71 to obtain and display the requested information. ('396, 5:8-12).

8   When the user logs in a second or subsequent time, the Program Controller 79

9   obtains user preference information from the records of the User Profiling Member

10   73. Then, the Program Controller uses agate information from agate data assembly

11   71 to generate a screen view formatted to the user's recorded preferences. ('396,

12   5:56-64). The Program Controller 79 also enables display of advertisements

13   customized to the user by obtaining presentation details from the user profiling

14   member 73 and content from the advertisement module 75. ('396, 5:19-25).

15   **B.   ValueClick's Erroneous Description of the Technology**

16   ValueClick's description of the system disclosed in the patents-in-suit contains

17   two critical errors, both of which contribute to its incorrect claim term definitions.

18   The first of these is ValueClick's suggestion that it is the "categories of interest" data

19   field found within User Interface Object 37c that constitutes the "psychographic

20   profile" referenced in all of the asserted claims. *See* VC Brief, at 2. ValueClick's

21   argument in this regard is misleading at best.

22   As an initial matter, the patent does not state that the psychographic profile is

23   held entirely within one of the several disclosed User Objects (*i.e.,* Objects 37a-f in

24   Figure 3). Accordingly, ValueClick's assertion that Object 37c is where the entirety

25   of the psychographic profile can be found is a claim without any basis. Moreover,

26   even if Object 37c could, in fact, be said to hold the entire psychographic profile,

27   ValueClick offers no explanation as to why it selectively focuses its attention on the

28   "categories of interest" field and ignores everything else. Specifically, the

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1 specification makes abundantly clear that Object 37c – in addition to holding a given

2 users "categories of interest" – also holds the closely-related data field of "category

3 display" (*i.e.,* the user's display format preferences). *See* Fig. 3D; ('396, 17:1-5).

4 Thus, to the extent that Object 37c can be said to hold the psychographic profile, the

5 profile includes both "categories of interest" *and* "display" preferences.

6   ValueClick's second mischaracterization pertains to the Ad Series Object 33c

7 and Ad Object 33d. According to ValueClick:

8   Ad Series Object 33c (the one said to hold the "psychographic profile" for the

9   ad, 12:27-32) does **not** contain any data about "display characteristics" and

10   "graphic references" of the ad (e.g. color, format, location on the page, etc.).

11   A **different** object holds those – "Ad Object 33d," depicted in Fig. 5D.

12 VC Brief, at 5.

13   ValueClick's bold statement that the Ad Series Object 33c is "said to hold the

14 'psychographic profile' for the ad" is demonstrably false, as even a cursory review of

15 the cited passage reveals. What the text actually says is that, "In a preferred

16 embodiment, the sponsor specifies in Ad Series Object 33c the required and/or

17 **preferred psychographic** and/or demographic **criteria** and relative importance (*e.g.,*

18 weight) with respect to each criterion." *See* '396, 12:27-31 (emphasis added). These

19 "psychographic *criteria*" are used to determine the ideal audience for a given ad, and

20 they represent an entirely different concept than the "psychographic *profile*" called

21 out in the asserted claims. ValueClick's attempt to conflate the two represents little

22 more than a diversionary sleight of hand.

23   The balance of the ValueClick quote set forth above is no less inaccurate.

24 While ValueClick suggests that the terms "display characteristics" and "graphic

25 references" as used in connection with Ad Object 33d refers to "color, format,

26 location on the page, etc.," the specification again tells a very different story. In

27 particular, the patent makes clear that these terms relate to the "daily start time" and

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"daily end time" for displaying the ad, and to the graphical or multimedia portions of the advertisement. *See* Fig. 5; '396 12:48-52. Thus, here again, ValueClick seeks refuge in misdirection in an attempt to change the substance of the patent disclosure.

III.   VALUECLICK'S CLAIM CONSTRUCTION METHODOLOGY IS FLAWED

A.   Claim Terms Are Given Their Ordinary Meaning As Understood By The Person Of Ordinary Skill In The Art In The Context Of The Entire Patent

ValueClick makes three fundamental mistakes in arguing what it believes constitutes the "ordinary meaning" of each claim term.

First, ValueClick's expert, Peter Kent, employs a flawed methodology for several claim terms, by looking for a "special meaning" for the term rather than the "ordinary meaning" as understood by the person of ordinary skill in the art at the time of filing of the patents-in-suit. "[T]he words of a claim 'are generally given their ordinary and customary meaning,'" not any special meaning. *Phillips v. AWH Corp.,* 415 F.3d 1303, 1312 (Fed. Cir. 2005).   For example, Mr. Kent avers that the term "computer apparatus" has no "special meaning" to persons of skill in the art. Then, based on this perceived lack of "special meaning," Mr. Kent argues that the "ordinary meaning" – which in many cases is the dictionary definition of ValueClick's choice – should be adopted. This flawed approach, by itself, renders Mr. Kent's opinion on such claim terms irrelevant and of no weight.

Second, Mr. Kent repeatedly refers to what a *lay person* or a "*person of skill*" in the art would understand a particular term to mean. Yet, terms must be understood from the perspective of a person of <u>ordinary</u> skill in the art – not one of extraordinary skill in the art, not one of below ordinary skill in the art, and not a lay person. "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question." *Phillips,* 415 F. 3d at 1313. This Court should reject Mr. Kent's opinion based on such flawed methodology.

Finally, ValueClick posits that the "ordinary meaning" of a term can simply be

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1 found in dictionary definitions (even, remarkably, those that post-date the filing of

2 the patents-in-suit by several years). This is incorrect. The "ordinary meaning"

3 cannot simply be gleaned from Wikipedia, Dictionary.com, or the American Heritage

4 Dictionary. *See* VC Brief, at 12. Rather, in defining the ordinary meaning of a term,

5 "the person of ordinary skill in the art is deemed to read the <u>claim term not only in</u>

6 <u>the context of the particular claim in which the disputed term appears, but in the</u>

7 <u>context of the entire patent, including the specification</u>." *Phillips,* 415 F.3d at 1313

8 (emphasis added).[2]

9   **B.   The Court Should Construe All The Claim Terms At Issue**

10   ValueClick argues that the terms identified by RSI, which are listed in Section

11 VI of its brief, do not require construction by the Court. Specifically, ValueClick

12 contends that the Court should give these terms to the jury without first construing

13 them because the term "is clear to a layperson, and takes on its ordinary meaning."

14 VC Brief, at 20.

15   ValueClick's reasoning is flawed for the following reasons. *First*, ordinary

16 meaning is determined from the perspective of a person of ordinary skill in the art at

17 the time the patent was filed, not from the perspective of a lay juror sitting at trial.

18 For this reason, a juror is *least* qualified to determine the correct "ordinary meaning"

19 of a term. *Second*, claim construction is the province of the judge, not the jury.

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21   [2] Courts have pointed out that Wikipedia is a highly questionable source of evidence. *See, e.g., Campbell v. Sec'y of Health & Human Servs*., 69 Fed. Cl. 775,

22 781 (2006)("The articles that the Special Master culled from the Internet do not - at least on their face - remotely meet this reliability requirement. . . . A review of the

23 Wikipedia website reveals a pervasive and, for our purposes, disturbing series of disclaimers, among them, that: (i) any given Wikipedia article 'may be, at any given

24 moment, in a bad state: for example it could be in the middle of a large edit or it could have been recently vandalized;' (ii) Wikipedia articles are 'also subject to

25 remarkable oversights and omissions;' (iii) 'Wikipedia articles (or series of related articles) are liable to be incomplete in ways that would be less usual in a more tightly

26 controlled reference work;' (iv) 'another problem with a lot of content on Wikipedia is that many contributors do not cite their sources, something that makes it hard for

27 the reader to judge the credibility of what is written;' and (v) 'many articles commence their lives as partisan drafts' and may be 'caught up in a heavily

28 unbalanced viewpoint.'").

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1 *Markman. Third*, it is to resolve exactly this type of dispute — a differing

2 interpretation of what "ordinary meaning" is — that the Court must construe claim

3 terms.

4   The cases cited by ValueClick do not say otherwise. *See* VC Brief, at 20. In

5 *W.E. Hall Co., Inc. v. Atlanta Corrugating, LLC*, the parties did not dispute the

6 meaning of the term "single piece," but did dispute the term "single piece

7 construction." The Court found no need to construe the former term, but it *did*

8 ultimately construe the latter. 370 F.3d 1343, 1350 (Fed. Cir. 2004). And in

9 *Hastings v. United States,* 78 Fed. Cl. 729, 731 (2007), a non-precedential Federal

10 Claims Court case, the Court summarily declined to adopt the parties' proposed

11 definition for the disputed term "more easily penetrated" as "easier to pass into or

12 through" – a definition that was clearly little more than a rewrite of the original term

13 itself. Here, unlike *W.E. Hall*, there is an actual dispute between the parties over the

14 correct interpretation of certain terms. And unlike *Hastings*, RSI seeks definitions

15 that are not just slightly different articulations of the terms themselves, but that are

16 instead accurate definitions that accurately capture what is disclosed by the patent

17 when examined from the perspective of a person of ordinary skill in the art.

18 Accordingly, the cases cited by ValueClick are inapposite.

19 **IV.   VALUECLICK'S DEFINITIONS ARE INCONSISTENT WITH THE
        PATENT SPECIFICATION AND FILE HISTORY**

20

21   To avoid repetition of arguments, RSI will only address arguments that were

22 not previously addressed in RSI's Opening Brief. To the extent the definition of a

23 particular term is not addressed in this responsive brief, RSI respectfully directs the

24 Court's attention to its Opening brief and the attached opening declaration of RSI's

25 expert, Kendyl Roman.

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A.   Non-112(6) claim elements

1.   user [all asserted claims]

RSI proposes that "user" should be defined as: "A uniquely identifiable individual person, as distinct from the digital processor he/she is using, who interacts with a network client program (*e.g.,* web browser)."

ValueClick argues that a user is anyone who views screens on a computer, and that a computer ID is one way of identifying a user. VC Brief, at 21-22. ValueClick's attempt to equate a user with a computer, however, runs afoul of the very essence of the patent. Because there can be many users of a single computer, tracking activity on a given machine is likely to be of little value. Whether one considers a user sitting at an Internet café, a family of six that shares a single home computer, or college dorm residents who access a single computer room, in each of these circumstances, all of the relevant players want and need to have the individual person who is sitting at the terminal at a given moment in time uniquely identifiable. The individual user herself wants her experience to be tailored to her personal psychographic profile, not to the countless other individuals who preceded her in using that computer. The advertiser wants to target his ad properly to the individual sitting before the computer screen right now, not to some unknown "composite" person whose content and display preferences consist of the aggregated preferences of every individual who ever sat at that computer in the past. *See* '396, 33:43. And the website publisher wants to keep both the individual user and the advertiser happy, by ensuring that the content and display are optimally configured for that individual user's preferences. This ability to provide an *individualized experience* for each unique user is precisely the benefit touted in the patents-in-suit as being offered by the alleged invention.[3] Accordingly, any definition of "user" that eviscerates the primary purpose of the alleged invention itself cannot possibly be correct.

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[3] "To that end, **for each user** the present **invention** program 31 creates a user profile from the agate information viewing habits of the user. The system then

9   *(Footnote Continued)*

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1   Moreover, ValueClick's proposal that psychographic profile can be a profile of

2 a group of users is simply a linguistic ploy to shift the focus of "user" from an

3 individual to a computer. In the internet café example, ValueClick's definition

4 would sweep in the "group" of users who had used the internet café since the

5 computer was first put in use. Likewise, ValueClick's definition would sweep in the

6 entire family who uses one home computer as the "group" whose psychological

7 profile is important. But that result would not be faithful to the alleged invention: the

8 ability to tailor content and advertisements to an individual user's preferences – *e.g.,*

9 the specific preferences of a 12 year old boy, a teenage daughter, a husband who is a

10 sports fan, and a wife who is a stock broker, all of which are likely to be very

11 different from one another.[4]

12   Furthermore, the only system disclosed in the patent itself includes a

13 mechanism for customization at the individual user level, namely the use of a

14 particular user login ('735, 5:16-20). ValueClick, however, argues that "logging in is

15 optional, since the user may obtain a user ID and password 'at the user's

16 convenience.'" VC Brief, at 21-22. Once again, however, ValueClick selectively

17 misreads the patent specification. The complete quote from the cited passages states

18 "Program controller 79 also obtains user identification information from the user to

19 assign a user name and password at the user's convenience." ('396, 5:5-7). Thus, the

20 phrase "at the user's convenience" does not refer to optional logging in, but rather to

21 the assignment of a username and password when a user logs in for the first time. As

22 described by the specification, logging in to the claimed system is mandatory in order

23 for it to function properly. ('396, 4:56-5:7; Roman Decl. ¶¶ 32-33). ValueClick

24

25 generates a custom Home Page, including a user's preferred (content and presentation)
   agate information. On subsequent visits to program 31 (as a Website) by the user,

26 program 31 displays the customized Home Page for that user instead of the initial
   Home Page." '396, 4:21-29. (emphasis added).

27   [4] ValueClick's "group of users" definition is also severely undercut by the fact
   that nowhere in the patents is a user's psychographic profile referred to in the plural,

28 *i.e.,* a "users' profile."

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1 additionally argues that because a computer ID may be used in the process of

2 identifying a user, ValueClick's construction that a user is not uniquely identifiable is

3 correct. VC Brief, at 22. ValueClick here again mischaracterizes the patent

4 disclosure and reaches the wrong conclusion. The specification states that *in addition*

5 *to* computer ID, the program *also* uses a username and password to identify the user

6 – thus making clear that the alleged invention necessarily has the ability to identify a

7 unique individual. ('396, 4:66-5:7; Roman Decl. ¶¶ 38-39).

8   Finally, giving "user" the definition mandated by both its ordinary meaning

9 and its use in the context of the specification does not impermissibly limit the claim

10 to an embodiment, but rather gives the claims a scope that is commensurate with

11 what the inventor stated, in his application, is his alleged invention. *Phillips*, 415

12 F.3d at 1316 ("Ultimately, the interpretation to be given a term can only be

13 determined and confirmed with a full understanding of what the inventors actually

14 invented and intended to envelop with the claim. The construction that stays true to

15 the claim language and most naturally aligns with the patent's description of the

16 invention, will be, in the end, the correct construction.") (internal quotation omitted).

17 In sum, the Court should adopt RSI's definition of user.

18   **2.   Psychographic profile of a (each) user [all asserted claims]**[5]

19   RSI proposes that the Court construe this term to mean: **"**Presentation format

20 preferences and content preferences of a uniquely identifiable individual person (*i.e.,*

21 the user), based on that person's responses to prompts regarding that person's

22 preferences and lifestyle and modified by that person's viewing and selection

23 history."

24   ValueClick counters that psychographic profile includes only "content

25 preferences" and does not include "format preferences." In support of its position,

26 ValueClick sets forth several arguments, each of which is discussed below in turn.

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        [5] RSI will note in square brackets beside each term the asserted patent claims in
28 which that term appears.

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a.   Claim Language Supports RSI's Definition

ValueClick first argues that the '396 and '735 patent claims support its construction, making a number of flawed attempts at claim differentiation. For example, pointing to unasserted claim 3 of the '735 patent, ValueClick contends that the term "psychographic profile" in the base claim 1 of the '735 patent must necessarily be limited to include only a user's content preferences, and to exclude the user's format preferences. VC Brief, at 12. A closer review, however, demonstrates that this is incorrect.

Claim 3 of the '735 Patent provides:

A computer program as claimed in claim 1 wherein:

the user profiling member records format preferences of users with respect to

presentation of certain agate information, the format preferences including

color schemes, text size and shapes; and

in response, the data assembly provides agate information for display to a user

(a) in a manner customized according to the format preferences of the user and

(b) having contents corresponding to the psychographic profile of the user.

The base claim 1 does state that the "user profiling member" records a variety of information, and thereby "enables creation of a psychographic profile." The first element of claim 3 then simply states that the "format preferences" that the "user profiling member" records must include *particular types* of format preferences *not* required by claim 1 – namely "color schemes, text size and shapes." Thus, there is nothing about the first element of claim 3 that suggests that format preferences are not included in the definition of "psychographic profile." Instead, it supports the opposite, by providing further limitations about those format preferences.

The second element of claim 3 simply states how agate information is displayed to a user. It says nothing about whether display preferences are, or are not, contained within the "psychographic profile" of the claim. Other claims, however, answer this question definitively. Claim 16 of the '735 Patent provides:

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1   The method of claim 15 wherein:

2   said composing includes selecting content and formatting layout of content

3   according to the determined psychographic profile.

4 As should be apparent, this claim requires selecting both content *and* formatting

5 layout "according to the determined psychographic profile," which can only mean

6 that the "psychographic profile" contains information both about content preferences

7 and format layout preferences. Thus, while claim 3 may be agnostic about whether

8 format preferences are included in "psychographic profile," claim 16 decidedly

9 answers that question in the affirmative. The Court should accordingly adopt RSI's

10 definition of "psychographic profile" as including both the user's content preferences

11 and the user's format preferences.

12   **b.   ValueClick's Reliance on the Specification is Unavailing**

13   ValueClick once again resorts to incomplete citations to and misleading

14 characterizations of the specification in order to support its position regarding the

15 proper definition of the term "psychographic profile." The Court should reject

16 ValueClick's arguments in their entirety.

17   *First*, ValueClick provides a lengthy quote in its brief from column 2 of the

18 '396 patent, underlining words and phrases that it believes supports its position. *See*

19 VC Brief, at 14 (citing '396, col. 2:3-15). Yet, a mere three lines later in the

20 specification – at column 2, line 18 – is a quote that inescapably demonstrates the

21 lack of merit in ValueClick's position. Remarkably, ValueClick stops its block quote

22 before reaching this critical passage, which states as follows:

23   Further the tracking and profiling member records presentation (format)

24   preferences of the users based on user viewing activity. Preferences with

25   respect to color schemes, text size, shapes, and the like are recorded as part of

26   the psychographic profile of a user. ('396, 2:18-23) (emphasis added).

27 As the emphasized text makes abundantly clear, preferences regarding format (*e.g.,*

28 color schemes, text size, shapes) are, in fact, part of the psychographic profile.

13

1 ValueClick's attempt to selectively quote around this key section of the patent must

2 fail, and its definition should accordingly be rejected in its entirety.

3 *Second,* as discussed above, ValueClick attempts to rewrite the patent by

4 incorrectly describing: (a) Ad Series Object 33c as holding the "psychographic

5 profile," but lacking "any display or format of the given ad;" and (b) a different ad

6 object, Ad Object 33d, as holding an indication of display or format of the given ad.

7 Based on these erroneous characterizations, ValueClick concludes that psychographic

8 profile does not include format preferences. VC Brief, at 15.

9 As explained above, Ad Series Object 33c holds sponsor specified

10 psychographic/demographic *criteria*, not the psychographic *profile*. *See* '396, 12:23-

11 33. In other words, the "psychographic *criteria*" in Ad Series Object 33c (used to

12 identify the ideal audience for an ad) is not in any way pertinent to the generation of a

13 "psychographic *profile*" of a user. And although it is true that Ad Object 33d holds

14 "display characteristics" and "graphic references," *See* Fig. 5D, these terms pertain to

15 the "daily start time" and "daily end time" for displaying the ad, and to the graphical

16 or multimedia portions of the advertisement, respectively. ('396, 12:48-52). They do

17 not, as ValueClick brazenly asserts, refer to "color, format, location on the page."

18 Accordingly, this Court should reject ValueClick's argument that anything pertaining

19 to the discussion of Ad Objects indicates that the term "psychographic profile" does

20 not include format preferences.

21   **c.   Prosecution History also buttresses RSI's definition**

22 ValueClick's attempt to draw support from the prosecution history is equally

23 unavailing. ValueClick argues that the prosecution history supports its definition of

24 psychographic profile as not including format preferences, because ValueClick's

25 definition matches that of the prior art patent Wilkins, and the patentee "never

26 indicated that his definition of psychographic profile was any different from that used

27 by Wilkins." VC Brief, at 15.

28 ValueClick is in error. The patentee clearly differentiated the psychographic

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1   profile disclosed in Wilkins from that disclosed in the patents-in-suit. In response to

2   Office Action rejecting all claims as anticipated by prior art reference, the applicant

3   stated:

4   ***Preferences with respect to color schemes, text size, shapes and the like are***

5   ***recorded as part of the psychographic profile of a user.*** In turn, the

6   psychographic profile defined and generated by the tracking and profiling

7   member enables the data assembly to customize future presentation (format) of

8   agate information, per user**,** for display to the user." '396 F.H., RSI00001189

9   (emphasis added).

10   Further, the examiner stated as his reason for allowance: "each user profile

11   providing an indication of categories of interest to the user ***and display preferences***

12   for each category," which reason was not objected to by the applicant. '396 F.H.,

13   RSI00001194 (emphasis added).

14   In sum, the prosecution history also contradicts ValueClick's definition, but

15   supports RSI's definition.

d.   ValueClick's Reliance on Dictionary Definitions Is Misplaced

16

17   ValueClick cites Wikipedia, Dictionary.com and the American Heritage

18   Dictionary as support for the "ordinary meaning" of the term.   VC Brief, at 12-13.

19   ValueClick's reliance on extrinsic evidence is entirely unwarranted, since the

20   intrinsic evidence provides unambiguous meaning to the phrase "psychographic

21   profile of a (each) user." *See Vitronics Corp. v. Conceptronic, Inc.,* 90 F.3d 1576,

22   1582 (Fed. Cir. 1996) ("[If] an analysis of the intrinsic evidence alone will resolve

23   any ambiguity in a disputed claim term . . . it is improper to rely on extrinsic

24   evidence.").

25   In any event, ValueClick's reliance on Wikipedia and Dictionary.com is

26   gravely misplaced. Wikipedia and Dictionary.com are unreliable sources, because

27   anyone can edit the content of these online sources. Moreover, there is absolutely no

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1   evidence that either the Wikipedia or Dictionary.com definitions were available at the

2   time of filing of the patents-in-suit in 1996, and that is the only appropriate time

3   period from which extrinsic evidence – if any can be properly relied upon at all –

4   may be used. For all these reasons, the Court should not consider ValueClick's

5   extrinsic evidence in construing this term.

6   In sum, the Court should accept RSI's definition of "psychographic profile of a

7   (each) user" as: **"**Presentation format preferences and content preferences of a

8   uniquely identifiable individual person (*i.e.,* the user), based on that person's

9   responses to prompts regarding that person's preferences and lifestyle and modified

10 by that person's viewing and selection history."

**3.   agate information / agate data [all asserted claims] AND
advertisement ['396:5, 7; '735:5, 8, and 18]**

11

12   The parties agree that the definition of agate information must include "Time-

13 sensitive reference information that is not read linearly," but apparently disagree

14 about whether there is any distinction between "agate information" and "sponsor

15 provided advertisements." Because the patentee chose to carve out "sponsor

16 provided advertisements" from the scope of agate information, *See* RSI's Opening

17 Brief, RSI's definition provides further clarification that agate information is "distinct

18 from sponsor provided advertisements." For the same reason, RSI proposes that

19 "advertisement" in the context of the patents-in-suit be construed as "Sponsor

20 provided advertisement, distinct from agate data." ValueClick, on the other hand,

21 seeks to blur the distinction between two, perhaps hoping to sow confusion where

22 none should exist. The portion of the specification that ValueClick cites in support of

23 its position that no distinction should be drawn between these concepts – *i.e.,*

24 "advertisements . . . which may be integrated into the agate data" at '396, 7:30-31

25 (VC Brief, at 17) - actually reinforces RSI's point that advertisements and agate are

26 distinct terms. Roman Decl. ¶ 72. Time and again, the patentee draws a distinction

27 in the specification between sponsor-provide advertisements, on the one hand, and

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1   the agate data to be displayed on the other. RSI's definition of "advertisement"

2   merely seeks to capture the line drawn by the patentee, so that the jury will

3   understand how and where the two terms differ from one another.

4   ValueClick attacks RSI's definition of "agate information" on the grounds that

5   RSI seeks an "infringement comparison, not a construction" and that this is

6   "improper at this stage." VC Brief, at 16. ValueClick also argues that "RSI

7   construction overlooks that an advertisement is a type of agate information." VC

8   Brief, at 26. Both of these arguments are unfounded.

9   First of all, RSI's definition is merely seeking clarity regarding the boundary

10 between two claim terms – a boundary that the patentee himself created and repeated.

11 This is the very purpose of the claim construction process, and ValueClick's assertion

12 that this is somehow "improper" at this stage is utterly baseless. Second, RSI's

13 position does not in any way overlook the fact that a *classified* advertisement can be a

14 type of agate data. As disclosed in the patents, the patentee expressly included

15 "classified advertisements" in his definition of agate, but chose to carve out sponsor

16 provided advertisements from agate data. RSI's definition remains faithful to this

17 patent disclosure.

18   Finally, ValueClick disputes RSI's definition on the grounds that it is

19 "circular," *i.e.,* the definition includes the term being defined ("advertisement"). VC

20 Brief, at 26. This borders on the frivolous. The parties are not disputing what the

21 term "advertisement" means in general, but rather how the patent uses this term.

22 When read in the context of the patent, the term "advertisement" means a particular

23 type of advertisement, which is captured by RSI's construction.

24   By contrast, ValueClick's construction of "advertisement" ignores the patent

25 disclosure, instead relying completely on dictionary evidence. ValueClick's

26 definition should be rejected and RSI's definition adopted.

27   **4.   screen view ['735:1, 5, 8, 15 and 18]**

28   RSI proposes that this term be construed as the "Entire page displayed on an

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1   end user's network client program (*e.g.,* web browser)."

2   Both parties agree that a screen view is a page. The dispute is whether "screen

3   view" means the <u>entire</u> page as RSI proposes, or some fragment of a page, per

4   ValueClick. ValueClick argues that the "intrinsic record does not support" RSI's

5   construction, "which is itself unclear insofar as an 'entire page' is a concept foreign

6   to the intrinsic record." VC Brief, at 18.

7   ValueClick is simply wrong. The specification consistently explains that in

8   generating a page, the program queries Page Display Objects 35a, b, and c. See, *e.g.,*

9   '396, 14:53-57. Page Display Object 35a holds agate or other data. Page Display

10   Object 35c provides the outline for screen views, such as a home page, and a

11   financial page. Page Display Object 35a cross-references with User Object 37c

12   which holds the category and display preferences of the user. Thus, in putting

13   together a page, the program does not simply query 35c for a page outline and

14   display the outline to the user, or only query 35b and display only agate data, without

15   the outline to the user. Instead, the specification discloses that *the entire page*—

16   outline and agate data customized to the user's psychographic profile – is displayed

17   as the screen view to the user. Roman Decl. ¶¶ 54-58.

18   In contrast, ValueClick points to little support for its construction. The only

19   intrinsic evidence ValueClick cites for its construction is the patent disclosure that

20   "the term 'page' is used synonymously with screen view." VC Brief, at 18 (citing

21   '735, 20:64-65). This disclosure, however, supports RSI's proposal. A page means

22   an *entire page*, not part of a page. Similarly, a screen view means the entire page, not

23   part of the page.

24   The only other support that ValueClick points to is alleged expert opinion

25   testimony that a "screen view was known to encompass (potentially) less than the

26   complete viewable portion of a web page." VC Brief, at 18-19. Yet, there is

27   absolutely no support for this proposition in the patent or prosecution history. *See*

28   *Phillips,* 415 F.3d at 1318 ("conclusory, unsupported assertions by experts as to the

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1   definition of a claim term are not useful to a court. Similarly, a court should discount

2   any expert testimony 'that is clearly at odds with the claim construction mandated by

3   the claims themselves, the written description, and the prosecution history, in other

4   words, with the written record of the patent.'"). Accordingly, the Court should reject

5   ValueClick's definition and adopt RSI's construction.

5.   demographic profile [no asserted claims]

7   The Court should not construe this term since it is not in any of the asserted

8   claims, and construing it is akin to offering an advisory opinion. According to

9   ValueClick, the Court should construe the term because it is included in RSI's

10 definition of target profile. *See* VC Brief, at 20. This argument has no merit. If the

11 Court were to follow ValueClick's logic, this Court would be buried under an endless

12 task of defining all of the definitions. ValueClick also argues that it will be helpful

13 for the jury to have "demographic profile" in mind while it considers issues related to

14 psychographic profile. VC Brief, at 20. Again, to the extent it will be helpful to

15 provide context to the patents-in-suit, RSI's definitions provide that context by giving

16 a clear definition for the relevant claim terms in dispute.

17   ValueClick further argues that construction of the term would be relevant,

18 insofar as ValueClick decides to assert additional claims later. VC Brief, at 20. The

19 same thing could be said of any term in any unasserted claims at any time during a

20 patent case. ValueClick should be in a position to assess from publicly available

21 information and documents produced by RSI whether it has sufficient basis to assert

22 infringement of the remaining claims. Because ValueClick has chosen not to assert

23 claims containing the term "demographic profile," ValueClick should not be

24 permitted to seek an "advisory" construction of this claim term.

6.   "computer apparatus" ['396:1, 5, 8; and '735:14]

26   RSI proposes that "computer apparatus" should be construed as: "A computer

27 program (*i.e.,* set of statements or computer instructions) and the server hardware at a

28 single network site for running or executing it, the server hardware distinct and

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1 separate from end user digital processors."

2 RSI's definition focuses on the simple fact that the patent discloses that the

3 invention is a program operating at a single network site. By contrast, ValueClick's

4 expansive definition, "a computer, or a multiplicity of computers, connected on a

5 network such as the Internet" literally includes any computer or computers connected

6 to the Internet. *See* VC Brief, at 20. As support for the multiplicity concept,

7 ValueClick cites to the '396 specification at 3:54-67. The specification, however,

8 supports RSI's position. The specification discloses several "loosely coupled"

9 networks of computers, with each network including several "loosely coupled"

10 personal computers and a single server, and the invention is described as "software

11 program 31 operated on and connected through a server 27 to the Internet for

12 communication among the various networks." Thus, the specification suggests a

13 computer apparatus is *a server at a single network site* that is connected to other

14 networks—a concept that is captured by RSI's definition. *See* Roman Response ¶¶

15 25-27.

16 ValueClick further argues that RSI's construction has limitations that find no

17 support in the intrinsic record. VC Brief, at 21. ValueClick is wrong. RSI's

18 construction takes into account the patentee's choice to include in his claims

19 references to more than one type of computer, but to only claim one of them. For

20 example, claim 1 of the '396 patent uses two different terms to describe a computer--

21 "computer apparatus" and "digital processor." The digital processor must be

22 different from the computer apparatus; for otherwise, the term "digital processor"

23 would be rendered superfluous. *See, e.g., Ethicon Endo-Surgery v. United States*

24 *Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996) ("If the terms 'pusher assembly'

25 and 'pusher bar' described a single element, one would expect the claim to

26 consistently refer to this element as *either* a 'pusher bar' or a 'pusher assembly,' but

27 not both, especially not within the same clause. Therefore, in our view, the plain

28 meaning of the claim will not bear a reading that 'pusher assembly' and 'pusher bar'

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are synonyms."). RSI's construction captures this self-engineered limitation chosen by the patentee. In contrast, ValueClick's definition ignores the distinctions drawn by the patentee, instead proposing a broad definition that could include "digital processor" and "multiplicity of computers." RSI's proper construction should be adopted.

7.   "a computer program embodied on a computer readable medium" ['735:1, 5, and 8]

This term should be construed as: "Set of statements (computer instructions) stored on a single piece of storage material for execution on the hardware of a server at a single network site, the server hardware distinct and separate from the end user digital processors."

ValueClick proposes a broad definition: "the physical manifestation of a computer algorithm (or set of algorithms), without limitation as to the form on which it might reside." VC Brief, at 21. ValueClick argues that this definition "recognizes that object-oriented programs (like the ones described in the Gerace patents) were known to be an aggregation of multiple self-contained subprograms." *Id.* VC's argument is nonsensical. The objects in an object oriented program are not "self-contained subprograms." Rather, the objects are all compiled together into a single, interdependent computer program. Roman Responsive Decl. ¶ 29.

ValueClick also contends that RSI's definition adds unrecited limitations that find no support in intrinsic record. VC Brief, at 21. As explained previously in RSI's Opening Brief, RSI's construction is fully supported by intrinsic record. For all these reasons, this Court should accept RSI's proposed construction.

8.   "Physical Activity" [all asserted claims] AND "User Response" [all asserted claims]

RSI proposes that "physical activity" means "Inputs (mouse and keyboard) to the user's computer," and that "user response" means "Information provided by a user in response to a prompt for the user's presentation format preferences and content preferences."

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DEFENDANT REVENUE SCIENCE, INC.'S RESPONSIVE
MARKMAN BRIEF   CASE NO. CV-07-2052 MMM (JCX)

1   RSI's definitions take into consideration the basic canon of claim construction

2   that two separate terms must each have separate meaning. *Bancorp Servs., L.L.C. v.*

3   *Hartford Life Ins. Co.*, 359 F.3d 1367, 1373 (Fed. Cir. 2004) ("the use of [two] terms

4   in close proximity in the same claim gives rise to an inference that a different

5   meaning should be assigned to each"). Accordingly, "Physical Activity" and "User

6   Response" must have different meanings since both terms are found in the same

7   claim. For example, claim 1 of the '396 patent provides that a computer apparatus

8   (or program) records both "physical activity" and "user response" to create a

9   psychographic profile. If "physical activity" means mouse clicks and keyboard

10   inputs, then "user response" must mean something more. *See, e.g., Primos, Inc. v.*

11   *Hunter's Specialties, Inc.*, 451 F.3d 841, 848 (Fed. Cir. 2006) ("the terms 'engaging'

12   and 'sealing' are both expressly recited in the claim and therefore 'engaging' cannot

13   mean the same thing as 'sealing'; if it did, one of the terms would be superfluous.").

14   The only logical thing it could mean, as supported by the intrinsic evidence, is

15   information provided by a user in response to a prompt for the user's preferences.

16   *See* RSI's Opening Brief. By contrast, ValueClick's identical definitions for these

17   terms renders one of the terms superfluous, thereby violating a basic canon of claim

18   construction that each term must have a separate meaning.

19   Regarding the term "physical activity," ValueClick argues that input cannot be

20   limited to mouse and keyboard inputs. VC Brief, at 23. ValueClick , however,

21   points to no support in the patent for any other kind of input. Thus, when the claim

22   term is read in the context of the specification, physical activity should be limited to

23   mouse and keyboard input, as RSI proposes. *Phillips*, 415 F.3d at 1315 ("the best

24   source for understanding a technical term is the specification from which it arose,

25   informed, as needed by the prosecution history." (internal quotations omitted).

26   **9.   target profile of desired users to whom to display the**
             advertisement / target audience profile of each advertisement
27   **['396:5, 7; '735:5, and 8]**

28   This term should be construed as: "Information associated with each

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1   advertisement that identifies the characteristics of the audience to whom the

2   advertiser wants the advertisement displayed, distinct from demographic or

3   psychographic profile of a user." RSI's construction properly captures the fact that

4   "target profile" is distinct from a psychographic or a demographic profile. If this

5   were not the case, claim 6 of the '396 patent, which discloses target profile,

6   psychographic profile and demographic profile would be nonsensical—the term

7   "target profile" would be rendered superfluous by "psychographic profile."

8   ValueClick, nonetheless, argues that claim 6 indicates that the target profile

9   can include demographic or psychographic profiles of desired users for a given ad.

10 VC Brief, at 25. However, ValueClick's proposal would convert the "can" to

11 "must," making the pertinent terms refer to precisely the same thing. In other words,

12 a "target profile" will be the same thing as a "demographic" and/or "psychographic"

13 profile" of a user, if ValueClick's definition were adopted.

14   In any event, the claim language of, for example, unasserted claim 6 of the

15 '396 patent, requires that the target profile be "substantially matching" with the

16 psychographic profile or demographic profile in order to serve an ad. As such, the

17 target profile must be a different component. Otherwise, the claim would be calling

18 for the target profile to be compared to itself. For all these reasons, ValueClick's

19 definition equating "target profile" with a "demographic and/or psychographic

20 profile" of a user should be rejected and RSI's definition adopted.

21   **B.   112(6) claim terms**

22   **1.   RSI's Position that the 112(6) Elements Disclose Insufficient
         Structure is correct and appropriate at this stage**

23

24   The parties do not dispute that means-plus-function terms at issue in this case

25 are computer implemented or that the corresponding structure is an algorithm. *See*

26 *Harris Corp. v. Ericsson, Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005). The dispute

27 arises over whether the specification discloses adequate corresponding structure. RSI

28 believes that no algorithm is disclosed, thus rendering the claims fatally indefinite

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and thus, invalid. ValueClick argues otherwise.

It is well-established law that the algorithm must be <u>disclosed in the specification</u>, not in sources outside of the specification, such as the knowledge of a person of ordinary skill in the art. *See* 35 U.S.C. 112, 6 (means-plus-function "claim shall be construed to cover the corresponding structure, material, or acts described *in the specification* and equivalents thereof.") (emphasis added). Whether the specification adequately discloses that corresponding structure must be measured from the knowledge of the person of ordinary skill in the art. *Med. Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1211 (Fed. Cir. 2003). However, this does not relieve the patentee of the duty of fully describing the corresponding structure. The testimony of one skilled in the art as to what the structure *could* be cannot be substituted for the "total absence of structure from the specification." *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A.*, 412 F.3d 1291, 1302 (Fed. Cir. 2005).

Thus, the proper question is whether "one of skill in the art would have understood that [patent] disclosure to encompass software for [the disclosed function] and been able to implement such a program, not simply whether one of skill in the art would have been able to write such a software program." *Med. Instrumentation*, 344 F.3d at 1212.

Putting it in the context of this case, the question is twofold: first, whether one of ordinary skill in the art would have understood the disclosure in the patents-in-suit to encompass the algorithm for the following claim terms: "(agate) data assembly;" "Tracking and profiling member/ user profiling member;" "advertising component;" and "program controller" to perform their respective functions; and second, whether one of ordinary skill in the art would have been able to implement <u>the disclosed algorithm</u>, not whether one of ordinary skill in the art would have been able to develop her own algorithm and then write a software program based upon it.

1

a.   A Person Of Ordinary Skill In The Art Would Not Have Understood The Patents-In-Suit To Encompass An Algorithm For Each Of The Claim Terms

2

3   A skilled artisan would not have understood that the patent discloses algorithm

4   for at least four reasons. *First*, the patents-in-suit do not include a single flow chart or

5   listing of source code. By contrast, in *Allvoice Computing PLC v. Nuance*

6   *Communications, Inc.*, , the case relied upon by ValueClick, nine out of the fifteen

7   figures in the patent were flow charts disclosing the relevant algorithm(s). No. 2006-

8   1440, 2007 WL 2963933 (Fed. Cir. Oct. 12, 2007).

9   In *Allvoice*, the issue was whether sufficient algorithmic structure was disclosed

10   "for determining positions of the recognized words" and "for updating word positions

11   after edits." *Id*. at *5. The Court concluded that "the disclosure at Col. 7 l.7 *et seq.* of

12   the '273 patent, along with Figures 4 and 8A of the patent," constituted sufficient

13   algorithmic structure. *Id*. at *6. Notably, Fig. 8A was a complete flow chart with

14   several boxes and arrows. ValueClick, nonetheless, conveniently ignores this fact,

15   instead arguing erroneously that "the only 'structure' disclosure for the function of

16   'determining the position of recognized words' was a box in a flowchart that stated

17   'DETERMINE WORD LOCATION IN TEXT.'" VC Brief, at 27-28. Thus, it was the

18   entire flow chart, coupled with other disclosures, that resulted in the Court finding

19   adequate disclosure of algorithm, *not* a single box. Moreover, the described function

20   employed "well-known features of windows operating system (messages, operating

21   system function calls, and hooking." *Allvoice*, 2007 WL 2963933, at *6. This was a

22   straightforward programming task using low-level routines. Roman Decl. ¶ 89. In

23   contrast, the higher level functions claimed in ValueClick's patents are complex and

24   not so easily reducable, thereby demanding a greater level of explanation, *i.e.,* a

25   complete and detailed disclosure of the algorithm. *Id*.

26   *Second*, not a single routine or method is identified for each of the several

27   objects that correspond to the claimed functions. In object oriented programming,

28   "Each object is formed of data and subroutines (methods) for acting on the data."

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1 ('396, 5:43-45). Figures 3-5 of the patents disclose what appears to be "data" for

2 each of the several Objects. However, not a single routine is disclosed. In a typical

3 case, an Object would not only include "data" but also routines that act on the data.

4 Thus, for example, User Interface Object 37c in Fig. 3D would not only be identified

5 by the data, *i.e.,* User Computer ID, Categories, and Category display, but would also

6 include, for example, a Return value. *See* Roman Response ¶¶ 78, 81. In the

7 absence of such information, a person of ordinary skill in the art would not

8 understand which methods act on the data, because there are hundreds of routines

9 that can act on such a complex data set. Roman Decl. ¶¶ 84-88, 90. Thus, a person

10 of ordinary skill in the art would not understand the patents-in-suit to have adequately

11 disclosed the algorithm(s) corresponding to the claimed functions.

12   *Third*, ValueClick's own expert acknowledges the brevity of disclosure in the

13 patent and struggles to fill in the holes. Regarding "data assembly," Mr. Kent states

14 that the "patent discloses that Page Object 35a <u>cross-references</u> User Interface Object

15 37c, which specifies which Page Display Object 35c and which agate information is

16 appropriate for the current user." Kent Decl. ¶ 18. Mr. Kent continues: "The "cross-

17 referencing" mentioned above would be accomplished with <u>some sort of main</u>

18 <u>routine</u>, which "dips into" the data assembly to "grab" items for display.

19 Programming techniques to accomplish these algorithms would have been trivial."

20 *Id.*(emphasis added). Mr. Kent's phrase "some sort of main routine" exemplifies the

21 utter lack of detail in the patent. This is akin to a person who cannot write a sentence

22 of code stating that his invention is "fetching a webpage" and then providing, as the

23 only description, "that some sort of main routine X" fetches a webpage from a web

24 server by "dipping" into the data in the web server and "grabbing items for display."

25 There is simply no disclosure of an implementable algorithm in that statement.

26 Roman Decl. ¶¶ 75-111.

27   *Fourth*, the patents are remarkably silent as to *how* the different functions are

28 accomplished, even though the patents provide information on what function is

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1 purportedly performed by the different components of the invention. Specifically,

2 the patents completely fail to disclose how the tracking and profiling member or the

3 user profiling member records user's activity. Likewise, the patents do not provide

4 what are surely several steps that the Program Controller must take in order to

5 perform the complex function of obtaining preference information and generating the

6 appropriate content and format for display to the user. Similarly, four different

7 objects perform the function of the advertising module 75, and three distinct objects

8 perform the function of agate data assembly 71. Yet remarkably, the way in which

9 these different objects coordinate to perform their functions is simply undisclosed.

10 *See* Roman Decl. ¶¶ 91-97.

11   In light of the above, a person of ordinary skill in the art would not have

12 understood the patents to disclose an algorithm corresponding to each of the

13 functional limitations of the claims.

> **b.   Even if the General Information in the Specification Could Somehow be Deemed an Algorithm, A Person Of Ordinary Skill In The Art Would Not Have Been Able To Implement Such An Algorithm**

14
15
16   Assuming *arguendo* that the general information provided in the patent

17 specification constitutes an algorithm (which it does not), a person of ordinary skill in

18 the art would not be able to *implement* such an algorithm. For example, there is no

19 disclosure as to how the user profiling member records user activities during viewing

20 and correlates those with items within screen views that are being displayed and,

21 therefore, being viewed. Roman Decl. ¶¶ 98-111. Thus, even if the artisan of

22 ordinary skill is asked to implement the "algorithm" by using object oriented

23 programming, she would not know how to implement the step of recording user

24 activities with respect to screen views during display. More specifically, a person of

25 ordinary skill in the art would not be able to implement the methods to act on the data

26 in the Objects because there are hundreds of routines that can act on this kind of

27 complex data. Roman Decl. ¶ 87.

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1   In sum, one of ordinary skill in the art: (1) would not have understood

2 disclosure in the patents-in-suit to encompass algorithm for "(agate) data assembly,"

3 "Tracking and profiling member/user profiling member," "advertising component,"

4 and "program controller" to perform their respective functions; or (2) been able to

5 implement such an algorithm.

c.   Due To the Lack of Corresponding Structure RSI Must Raise the Invalidity of the Patents Now

7   In light of the complete absence of structure disclosing how the relevant

8 functions are performed, RSI is left with no choice but to point to the Court that the

9 patent fails to provide adequate structure. *Atmel Corp. v. Info. Storage Devices, Inc.*,

10 198 F.3d 1374, 1379 (Fed. Cir. 1999) ("We have previously observed that an analysis

11 under § 112, P.2 is inextricably intertwined with claim construction and that in the §

12 112, P.6 context, a court's determination of the structure that corresponds to a

13 particular means-plus-function limitation is indeed a matter of claim construction.")

14 (internal citation omitted) . Thus, while RSI does not at this time move for a

15 determination that the means-plus-function claim terms are indefinite under 35

16 U.S.C. § 112, if RSI failed to notify the Court that the lack of structure should

17 ultimately render the patents invalid, RSI would be doing the Court a disservice.

18 Accordingly, RSI's presentation of the fact that the patents disclose insufficient

19 corresponding structure is appropriate at this stage.

2.   Specific 112(6) Claim Terms

a.   "data assembly for providing and supporting display of agate information to users of the computer network" ['396:1, 5, 7 and '735:14] AND "agate data assembly for providing agate information for display to users" ['735:1, 5, and 8]

24   RSI submits that the terms "data assembly" and "agate data assembly" should

25 be defined as means-plus-function terms because they recite a function to be

26 performed rather than the structure used to perform the function. ValueClick,

27 however, contends that "a 'data assembly' is terminology evocative of structure –

28 namely, an assembly of data" and because the terms do not include "means," the two

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1   terms are presumptively not governed by 112(6). VC Brief, at 22.

2   ValueClick misinterprets the law. The presumption that 112(6) does not apply

3   to a term not using "means" is rebutted if "the claim term fails to recite sufficiently

4   definite structure or else recites a function without reciting sufficient structure for

5   performing the function." *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d

6   1311,1320 (Fed. Cir. 2004). The issue is not whether a claim term generally evokes

7   structure, but rather whether the claim term recites "<u>sufficiently definite </u>structure" or

8   where a claim phrase recites a function, does the claim phrase also recite "<u>sufficient</u>

9   <u>structure for performing the function</u>." These claim terms neither recite "sufficiently

10   definite structure," nor do they recite "sufficient structure for performing the

11   function" of these claim elements.

12   That the claim terms do not recite "sufficiently definite structure" is shown by

13   ValueClick's own expert's declaration. Mr. Kent suggests two separate meanings for

14   data assembly "relational databases" and "flat-file text databases," *See* Kent Decl. ¶

15   11 neither of which are referenced by the patents-in-suit. Rather, the patent discloses

16   the data assembly as Page Display Objects and such Objects are entirely different

17   from relational and textual databases. *See* Roman Decl. ¶¶ 16-19. Thus, the term

18   "data assembly" encompasses a variety of possible structures and accordingly does

19   not recite a sufficiently definite structure for one of ordinary skill in the art to

20   understand what is being claimed.

21   Even when the term "data assembly" is read together with the rest of the

22   disputed phrases, the term still does not recite "sufficient structure for performing the

23   function." Mr. Kent avers that the term "data assembly" in 1996 "connoted an

24   arrangement for holding computer data." Kent Decl. ¶ 11. "Holding data" is not the

25   same as "providing agate information for display to users" or "providing and

26   supporting display of agate information to users of the computer network."

27   Accordingly, "an arrangement for holding computer data" discloses no structure that

28   could perform the functions demanded by the claims. Rather, the term "data

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assembly" has no identifiable structure, but takes on an identity co-extensive with its function.   Accordingly, "data assembly" should be construed as a mean plus function element.

> **b.   "a program controller responsive to user commands of a user for generating screen views to the user, the program controller (i) obtaining information from the agate data portion and user profiling member, including creating and obtaining the psychographic profile of the user and (ii) generating and displaying appropriate screen views to the user based on the created psychographic profile of the user" ['735:1, 5, and 8]**

RSI contends that the term a "program controller" is a means-plus-function claim term because it recites neither "<u>sufficiently definite</u> structure" nor "<u>sufficient structure for performing the function</u>." ValueClick argues that the term "program controller" is not a 112(6) term for reasons similar to those it set forth for "data assembly." Specifically, ValueClick contends that "'program controller' is terminology evocative of structure – namely a controller of a program (*e.g.,* a computer CPU)." VC Brief, at 25.

ValueClick's argument that "program controller" evokes the structure "controller of program" underscores the utter lack of definiteness of structure for this term.[6] By ValueClick's own assessment, the term "program controller" could literally mean any number of possibilities, with the reader's imagination being the only limit. Clearly, the term "program controller" has no "sufficiently definite structure." *See* Roman Decl. ¶¶ 112-117.

Even when read in the context of its function recited by the claim, the term

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[6] ValueClick cites *Honeywell Int'l, Inc. v. Universal Avionics Sys. Corp.*, a Delaware district court case, in support of its argument that "controller" should not be construed as a means-plus-function. VC Brief, at 25. However, a claim element must be construed in light of the specific claims at issue, not because other courts have construed a similar term in a particular manner. Indeed, the Federal Circuit reached the opposite conclusion on the term "control mechanism" after the *Honeywell* case. *See Toro Co. v. Deere Co.*, 355 F.3d 1313, 1325 (Fed. Cir. 2004). (holding that "control mechanism" is governed by 112(6) even though "means" is not used, because the claim "discloses a function for a 'control mechanism' but does not provide sufficient structural description of this mechanism.")

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"program controller" fails to recite "sufficient structure for performing the function."

The function of "program controller" as claimed is not "controlling a program," but

"generating screen views to the user . . . (i) obtaining information from the agate data

portion and user profiling member, including creating and obtaining the

psychographic profile of the user and (ii) generating and displaying appropriate

screen views to the user based on the created psychographic profile of the user."

Accordingly, "program controller" fails to recite sufficient structure for performing

its defined function.

V.   CONCLUSION

Based on the arguments and evidence provided above, RSI respectfully

requests that the Court adopt the RSI' proposed claim constructions.

Dated: November 19, 2007   HELLER EHRMAN LLP

By /s/Nitin Subhedar
                Nitin Subhedar

Attorneys for Defendant Revenue Science, Inc.

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