

United States District Court  
Northern District of California

Augme Technologies, Inc.,  
Plaintiff,  
v.  
Yahoo! Inc.,  
Defendant.

Case No.: [3:09-cv-05386-JCS](#)

**ORDER GRANTING MOTION FOR  
ENTRY OF SEPARATE AND FINAL  
JUDGMENT PURSUANT TO FED. R.  
CIV. P. 54(b) [Dkt. No. 340].**

United States District Court  
Northern District of California

**I. INTRODUCTION**

Before the Court is a Motion filed by Augme Technologies, Inc. (“Augme”) requesting the Court to declare final judgment on Augme’s infringement claims against Yahoo! Inc. (“Yahoo!”) pursuant to Federal Rule of Civil Procedure 54(b). On August 8, 2012, this Court granted summary judgment in favor of Yahoo! on Augme’s claims that Yahoo! infringed two of its patents. Yahoo! has one counterclaim pending before the Court alleging that Augme has infringed one of its own patents, and on this basis, opposes Augme’s Rule 54(b) Motion. This Motion is appropriate for decision without oral argument pursuant to Local Rule 7-1(b). The hearing scheduled for November 2, 2012 at 9:30a.m. is vacated. For the reasons set forth below, the Court GRANTS Augme’s motion for separate and final judgment pursuant to Rule 54(b).<sup>1</sup>

**II. BACKGROUND**

On November 16, 2009, Augme filed a lawsuit against Yahoo! alleging infringement of the Augme’s U.S. Patent Nos. 6,594,691 (“the ‘691 patent”) and 7,269,636 (“the ‘636 patent”) (collectively “the Augme patents”). Dkt. No. 1. On December 21, 2010, Yahoo! filed counterclaims against Augme alleging infringement of Yahoo!’s U.S. Patent Nos. 7,512,622 (“the

---

<sup>1</sup> The parties have consented to the jurisdiction of the undersigned magistrate judge pursuant to 28 U.S.C. § 636(c).

1 '622 patent") and 7,640,320 ("the '320 patent") (collectively "the Yahoo! patents"). Dkt. No. 91.  
2 Litigation of the Augme claims and Yahoo! counterclaims has progressed on different schedules.  
3 The Court held separate claim construction hearings for the Augme patents and the Yahoo!  
4 patents. *See* Dkt. Nos. 185, 216. During the claim construction hearing on the Yahoo! patents,  
5 the Court stated that the claims and counterclaims would be tried separately. Declaration of  
6 Gregory S. Bishop in Support of Augme's Motion for Entry of Judgment Pursuant to Rule 54(b)  
7 ("Bishop Decl.") Ex. 1 (transcript of proceedings) at 86. On January 6, 2012, the Court ordered  
8 separate schedules and separate trials for the Augme and Yahoo! patents. *See* Dkt. No. 220.

9 On August 8, 2012, the Court granted Yahoo!'s motion for summary judgment and denied  
10 Augme's motion for partial summary judgment regarding Augme's claims of infringement. *See*  
11 Dkt. Nos. 333, 335. The infringing instrumentalities of the Augme patents were alleged to be  
12 Yahoo!'s behavioral targeting of advertising on the internet. The Court granted summary  
13 judgment in favor of Yahoo! on the basis that the accused products lack a "service response" (*Id.*  
14 at 11-13) and an "embedded first code module" (*Id.* at 13-20), two claims in Augme's patents.

15 After granting summary judgment on Augme's claims, the parties filed a stipulation,  
16 which the Court granted, to dismiss with prejudice Yahoo!'s counterclaim of infringement of the  
17 '622 patent. *See* Dkt. Nos. 337-38. Yahoo!'s counterclaim of infringement of the '320 patent  
18 remains pending before the Court. The '320 patent is entitled "Method and apparatus for  
19 organizing and playing data" and is generally directed to methods for displaying a media interface  
20 to a user. Dkt. No. 91 at 14. Yahoo!'s motion hearing is set for March 15, 2013, and trial is  
21 scheduled to begin June 17, 2013. *See* Dkt. No. 220.

22 On September 28, 2012, Augme filed the instant Motion requesting the Court to enter  
23 final judgment pursuant to Rule 54(b). Augme intends to appeal this Court's decision and  
24 contends there is "no just reason for delay." Fed.R.Civ.P. 54(b). Yahoo! opposes Augme's  
25 Motion on the basis that its pending counterclaim involves technological issues that overlap with  
26 Augme's claims, and thus, it would be more efficient to allow both of the parties' claims to  
27 ultimately proceed on appeal together.

28 //

1     **III.     DISCUSSION**

2             In general, the Federal Circuit reviews only final orders and decisions of a district court.  
3     *See* 28 U.S.C. § 1295(a)(1). However, Rule 54(b) allows district courts to certify a partial final  
4     judgment for the purpose of appeal by directing entry of final judgment as to one or more, but  
5     fewer than all, of the claims if there is an express determination that there is no just reason for  
6     delay. *See* Fed.R.Civ.P. 54(b). The Supreme Court has established a two-step process for district  
7     courts to determine whether certification of a claim in a multiple claims action under Rule 54(b)  
8     is warranted. *See Curtiss-Wright Corp. v. General Elec. Co.*, 446 U.S. 1, 7-8 (1980). First, the  
9     judgment must be final with respect to one or more claims. *See id.* A district court’s judgment is  
10    final where it “ends the litigation on the merits and leaves nothing for the court to do but execute  
11    the judgment.” *Catlin v. United States*, 324 U.S. 229, 233 (1945). Second, “the district court  
12    must go on to determine whether there is any just reason for delay.” *Curtiss-Wright*, 446 U.S. at  
13    8. This is a discretionary judgment where courts “consider such factors as whether the claims  
14    under review [are] separable from the others remaining to be adjudicated and whether the nature  
15    of the claims already determined was such that no appellate court would have to decide the same  
16    issues more than once.” *W.L. Gore & Assocs. Inc. v. Int’l Med. Prosthetics Research Assocs.,*  
17    *Inc.*, 975 F.2d 858, 862 (Fed. Cir. 1992) (citing *Curtiss-Wright*, 446 U.S. at 8). In addition to  
18    administrative interests, courts consider the equities involved. *Curtiss-Wright*, 446 U.S. at 8.  
19    Where a counterclaim remains pending, its “significance for Rule 54(b) purposes turns on their  
20    interrelationship with the claims on which certification is sought.” *Id.* at 9.

21             Having considered the foregoing factors, the Court finds that certifying Augme’s claims  
22    for appeal to the Federal Circuit under Rule 54(b) is warranted. Granting summary judgment in  
23    favor of Yahoo! was a final judgment with respect to the Augme claims. Moreover, there is no  
24    just reason to delay Augme’s appeal to the Federal Circuit. Yahoo! bases its opposition to  
25    Augme’s Rule 54(b) Motion on its counterclaim, but this Court already decided that Yahoo!’s  
26    counterclaim of infringement of the ‘320 patent is separable from Augme’s claims of  
27    infringement of the ‘691 and ‘636 patents, and severed litigation accordingly. Even if the ‘320  
28    patent and the Augme patents share common technology and products, Yahoo! has not identified

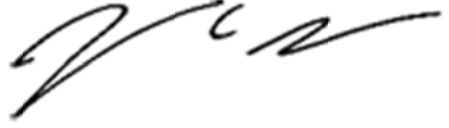
1 one legal or factual issue the Federal Circuit will have to decide more than once. *See W.L. Gore,*  
2 975 F.2d at 862. There are no claims in Yahoo!’s patent which overlap with this Court’s  
3 construction of the relevant claims in the Augme patents, namely, the “service response” and the  
4 “embedded first code module.” Although some courts may deny a Rule 54(b) Motion when one  
5 patent remains pending, this Court finds that the distinct coverage of the patents in this case, as  
6 well as the equities involved, weigh in Augme’s favor to certify Augme’s claims for appeal to the  
7 Federal Circuit.

8 **IV. CONCLUSION**

9 For the foregoing reasons, the Court GRANTS Augme’s Motion for final judgment  
10 pursuant to Rule 54(b).

11 IT IS SO ORDERED.

12 Dated: October 29, 2012



\_\_\_\_\_  
Joseph C. Spero  
United States Magistrate Judge