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3 **UNITED STATES DISTRICT COURT**

4 **NORTHERN DISTRICT OF CALIFORNIA**

5 **SAN JOSE DIVISION**

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7 RICHARD A. WILLIAMSON,   Case No. 15-cv-00966-BLF

8   Plaintiff,

9   v.   **ORDER CONSTRUING CLAIMS**

10 GOOGLE INC.,

11   Defendant.

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13   Plaintiff Richard Williamson ("Williamson"), Trustee of At Home Bondholders'

14 Liquidating Trust, brings this patent infringement lawsuit against Defendant Google Inc.

15 ("Google"). The complaint alleges Google's AdSense and other products infringe two patents:

16 U.S. Patent No. 6,014,698 (the "'698 patent"), directed at using first banner request that cannot be

17 blocked from reaching a server for accurately counting displays of banners on network terminals,

18 and U.S. Patent No. 6,286,045 (the "'045 patent"), directed at information storage and delivery

19 over a computer network using centralized intelligence to monitor and control the information

20 being delivered. Compl., ECF 1; Exs. A and B to Compl. The Court held a tutorial on June 8,

21 2017, and a *Markman* hearing on June 16, 2017, for the purpose construing eight disputed terms

22 that are in the asserted claims of the '045 and the '698 patents.

23 **I.   BACKGROUND ON THE '045 AND THE '698 PATENTS**

24   The '698 patent is a continuation-in-part of the '045 patent and Williamson admits that the

25 specifications are almost identical. Revised Opening Claim Constr. Br. ("Opening Br.") 8, ECF

26 139. As such, the discussion of the '045 patent applies equally to the '698 patent unless otherwise

27 noted.

28   The '045 patent relates to serving information over a network, such as an advertisement, to

1   a client device, such as a personal computer, and accurately counting the number of times an

2   advertisement is displayed. '045 patent at 3:34-41, Ex. B to Compl., ECF 1-2. According to the

3   '045 patent, the prior art method did not allow for accurate counting of the display due to

4   "caching." *Id*. at 6:36-7:7; 12:56-66. "Caching" pertains to the process of storing previously

5   requested information on a user's computer or a proxy server and providing the stored copy in

6   response to a request, instead of obtaining the requested information from the server. *Id*. at 6:36-

7   7:7; 12:56-13:2. While caching increases the speed at which information is displayed and reduces

8   the traffic on the network, it prevents accurate counting of the display and interferes with the

9   ability to select the precise advertisement to be displayed. *Id*. at 13:46-14:32.

10   The '045 patent attempts to solve this problem by requiring a mandatory initial request to

11   be transmitted each time banner information is requested. *Id*. at 14:33-40; 14: 57-15:3;

12   19:63:20:14. After the initial request is sent, there would be an opportunity to select the specific

13   content to be displayed, if desired, prior to responding to that initial request. *Id*. at 15:8-22. That

14   response can then either provide the location information of the content to be displayed or other

15   identifying information of the content. *Id*. at 15:34-44. If the content is already cached, the

16   content will be displayed. *Id*. at 15:48-56. If it is not, a second request will be transmitted to

17   obtain the content from a server. *Id*. at 15:56-60. According to the '045 patent, the invention thus

18   allows for accurate counting of the content display due to the mandatory initial request while at the

19   same time imposing very little burden on the network traffic. *Id*. at 19:63-20:36.

20   **A.   Claim Terms at Issue**

21   The Patent Local Rules allow the parties to identify up to 10 terms "whose construction

22   will be most significant to the resolution of the case." Patent L.R. 4-3(c). The parties agreed on

23   the construction of the following claim phrase:

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Claim Phrase	Agreed Construction
"content general request"	"content request that does not specify particular content"

27   In accordance with the parties' joint claim construction chart, the following disputed terms

28   and phrases are identified for construction:

	Claim Phrase(s)	Patent(s) / Claim(s)
1	"banner"	• '045 patent: 20, 34, 64, 66, 70, 71, 72, 73, 75, 78 • '698 patent: 17, 18-20, 24-28, 39, 42, 44
2	"content specific request"	• '045 patent: 5 • '698 patent: 7, 20
3	"location signal" (and variants)	• '045 patent: 1, 20, 34, 64, 72, 75 • '698 patent: 1, 17, 39, 44
4	"counting each display of said specified banner on the client device" (and variants)	• '045 patent: 19, 71, 73 • '698 patent: 2, 3, 17, 24, 25, 39

Additionally, the following disputed phrases are identified by Google to be indefinite:

	Claim Phrase(s)	Patent(s) / Claim(s)
5	"best suited"	• '045 patent: 7
6	"intended to prevent said first request signal from being blocked" (and variants)	• '045 patent: 1, 20, 34, 64, 72, 75
7	"selecting the composition of said second portion of information"	• '045 patent: 14
8	"said specified banner"	• '045 patent: 20

Joint Claim Constr. Chart, ECF 135-1.

II. LEGAL STANDARD

A. General Principles

Claim construction is a matter of law. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 387 (1996). "It is a 'bedrock principle' of patent law that 'the claims of a patent 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) (internal citation omitted), and, as such, "[t]he appropriate starting point . . . is always with the language of the asserted claim itself," *Comark Commc'ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998).

Claim terms "are generally given their ordinary and customary meaning," defined as "the meaning . . . the term would have to a person of ordinary skill in the art in question . . . as of the effective filing date of the patent application." *Phillips*, 415 F.3d at 1313 (internal citation omitted). The court reads claims in light of the specification, which is "the single best guide to the meaning of a disputed term." *Id.* at 1315; *see also Lighting Ballast Control LLC v. Philips Elecs.*

1 *N. Am. Corp.*, 744 F.3d 1272, 1284-85 (Fed. Cir. 2014) (en banc). Furthermore, "the

2 interpretation to be given a term can only be determined and confirmed with a full understanding

3 of what the inventors actually invented and intended to envelop with the claim." *Phillips*, 415

4 F.3d at 1316 (quoting *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed.

5 Cir. 1998)). The words of the claims must therefore be understood as the inventor used them, as

6 such understanding is revealed by the patent and prosecution history. *Id.* The claim language,

7 written description, and patent prosecution history thus form the intrinsic record that is most

8 significant when determining the proper meaning of a disputed claim limitation. *Phillips*, 415

9 F.3d at 1315-17; *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir.

10 1996).

11   Evidence external to the patent is less significant than the intrinsic record, but the court

12 may also consider such extrinsic evidence as expert and inventor testimony, dictionaries, and

13 learned treatises "if the court deems it helpful in determining 'the true meaning of language used

14 in the patent claims.'" *Philips,* 415 F.3d at 1318 (quoting *Markman*, 52 F.3d at 980). However,

15 extrinsic evidence may not be used to contradict or change the meaning of claims "in derogation

16 of the 'indisputable public records consisting of the claims, the specification and the prosecution

17 history,' thereby undermining the public notice function of patents." *Id.* at 1319 (quoting

18 *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995)).

19   **B.**   **Indefiniteness**

20   "The Patent Act requires that a patent specification conclude with one or more claims

21 particularly pointing out and distinctly claiming the subject matter which the applicant regards as

22 the invention." *Nautilus v. Biosig Instruments*, 134 S. Ct. 2120, 2124 (2014). "A patent is invalid

23 for indefiniteness if its claims, read in light of the specification delineating the patent, and the

24 prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the

25 scope of the invention." *Id.* While the scope of the claims must be clear enough to "apprise the

26 public of what is still open to them," *Markman*, 517 U.S. at 373, "the definiteness requirement

27 must take into account the inherent limitations of language. Some modicum of uncertainty . . . is

28 the price of ensuring the appropriate incentives for innovation." *Nautilus*, 134 S. Ct. at 2128

1   (internal citations omitted). Thus, "the certainty which the law requires in patents is not greater

2   than is reasonable, having regard to their subject-matter." *Id.* at 2129 (quoting *Minerals*

3   *Separation v. Hyde*, 242 U.S. 261, 270 (1916)).

4   **III.   CONSTRUCTION OF DISPUTED TERMS AND PHRASES**

5   **A.   "banner"**

Williamson's Proposal	Google's Proposal	Court's Construction
"information displayed in conjunction with a web page"	"information displayed in conjunction with a web page wherein the information is not part of the same file as the web page"	"information displayed in conjunction with a web page"

The disputed term "banner" appears in asserted independent claims 20, 34, 64, 72, 75 of

the '045 patent and independent claims 17, 39, 44 of the '698 patent. Claim 20 of the '045 patent

is set forth below as an example of how the term is used:

> 20. A method for distributing a **banner** over a computer network to a device when the **banner** is referenced or linked to in a document served to the device, wherein the **banner** is stored in one or more servers, comprising:
>
> receiving a first **banner** request signal from a device at a first server requesting that a **banner** be served to the device, wherein said first **banner** request signal includes information intended to prevent said first **banner** request signal from being blocked from reaching said first server by the device despite previous caching of said specified **banner** in the device;
>
> sending a **banner** location signal from said first server to the device, wherein said **banner** location signal includes location information for a specified **banner** stored on a second server; and
>
> receiving a second **banner** request signal from the device at said second server requesting that the second server serve said specified **banner** to the device.

'045 patent at 28:38-55 (emphasis added).

While the parties agree that "banner" refers to information displayed in conjunction with a

web page, they disagree whether it must be separate from the web page file. Williamson argues

that requiring it to be separate from the web page file is contrary to the specification's express

disclosures. Opening Br. 9. Google claims that its proposed construction actually comports with

the patentee's chosen lexicography in defining "banner," and is also consistent with Williamson's

own representation during the inter partes review ("IPR") proceedings. Resp. Br. 2-3, ECF 137.

Google concludes that "banner" thus should be defined based on the express definition in the specification.

The Court agrees with Williamson and finds that the evidence does not support Google's proposed construction. The patents expressly define "banner" as follows:

> For purposes of the present invention, the term "banner" is meant to be construed very broadly and includes any information displayed in conjunction with a web page wherein the information is not part of the same file as the web page. That is, a banner includes anything that is displayed or used in conjunction with a web page, but which *can* exist separately from the web page or which can be used in conjunction with many web pages.

'045 patent at 2:27-35 (italics added). Based on this definition, "banner" is defined to *include* an embodiment "wherein the information is not part of the same file as the web page," without excluding a situation where the information is part of the same file. The broader construction advocated by Williamson is further supported by the disclosure describing the invention in context of one of the figures:

> The banner information may be served with the web page or, more commonly, the banner information may reside in separate files which will need to be requested by the user's terminal 36 before the banner information can be displayed on the user's terminal 36 along with the requested web page.

Id. at 10:22-27. This disclosure is consistent with the construction that "banner" could encompass information "served with the web page," as well as those that "reside in separate files." *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed. Cir. 2008) ("We normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification.").

Citing *Allergan, Inc. v. Apotex Inc.* and *Sinorgchem Co., Shandong v. Int'l Trade Comm'n.*, Google argues that the use of quotation marks and the use of "includes" signal a patentee's choice to act as its own lexicographer, and that a proper construction should exclude the embodiment contrary to that lexicography. Resp. Br. 3 (citing 754 F.3d 952, 957 (Fed. Cir. 2014); 511 F.3d 1132, 1138 (Fed. Cir. 2007)). However, those cases are inapposite and do not compel a different conclusion. The court in *Sinorgchem* held that embodiments are excluded from the definition of a term if "those embodiments are inconsistent with unambiguous language in the patent's specification or prosecution history." 511 F.3d at 1138. The *Sinorgchem* court, however,

did not consider the use of the term "includes," in a manner similar to how "banner" is defined here. Unlike this case, the patent in *Sinorgchem* had "express definitional language" that excluded certain embodiments. *Id.* at 1136, 1138 (noting that the definition was provided in the patent as: "[a] 'controlled amount' of protic material is an amount up to that which inhibits the reaction of aniline with nitrobenzene, e.g., up to about 4% H_2O based on the volume of the reaction mixture when aniline is utilized as the solvent"). As such, *Sinorgchem* is not analogous to the situation here. *Allergan* is similarly inapplicable and also fails to support Google's arguments. The *Allergan* court noted that the use of "includes" means that the patentee intended to define a term to include a list of items that is to follow. 754 F.3d at 957. But the court did not find that the definition of the phrase should be circumscribed only to that list. *Id.* at 958. Rather, the holding hinged on the interpretation of the conjunctive "and" in the definition, which is not at issue here. *Id.* at 957. Notably, the *Allergan* court resorted to "numerous examples in the patent" to arrive at its construction of the term. *Id.* at 958. In the same way, considering the embodiments set forth in the '045 patent specification leads this Court to construe the term to encompass an embodiment where the "banner information may be served with the web page." As to Williamson's representation during IPR with regard to this term, the construction advocated by Williamson during the IPR proceeding did not exclude this embodiment, either.

Accordingly, the Court adopts Williamson's construction because the definition introduced by the use of "includes" does not exclude an embodiment where the "banner information may be served with the web page."

B. "content specific request"

Williamson's Proposal	Google's Proposal	Court's Construction
"A content request that does specify particular content and/or location thereof"	"a request that specifies the location of particular content"	"A content request that does specify particular content and/or location thereof"

The disputed phrase "content specific request" appears in asserted dependent claim 5 of the '045 patent, and dependent claims 7 and 20 of the '698 patent. Claim 5 of the '045 patent ultimately depends on claim 1 and is set forth below as an example of how the phrase is used:

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> 5.   The method of claim 4, wherein said second request signal is a **content specific request** signal.

'045 patent at 27:61-62 (emphasis added).

Williamson first contends that a construction beginning with "a content request," as opposed to "a request," more accurately reflects the character of the request, namely, a request for content. Opening Br. 10. Williasom also avers that a construction beginning with "a content request" would be consistent with the agreed-upon construction for "content general request." *Id.* It next argues that Google's construction is overly limiting by requiring that the request always specifies the location of a particular content. *Id.* at 11; Reply 3, ECF 140. Responding to Williamson's first point, Google notes the difference between "a content request" and "a request" to be immaterial and does not believe that to be the crux of the dispute. Resp. Br. 4 n.2. Rather, the issue is whether "a request" always specifies the location of a particular content. Google argues that the specification supports the requirement that a content-specific request always contains the location. *Id.* at 5. Google also claims that Williamson's construction renders the term indefinite because it fails to distinguish specifying particular content from specifying location thereof. *Id.*

The Court does not agree with Google that the claim scope should be narrowed based on a limitation from the specification that is not incorporated into the claim itself, and thus adopts Williamson's construction. Although understanding of this phrase may be aided by the written description, which explains that a content specific request can contain URL or IP addresses, "it is important not to import into a claim limitations that are not a part of the claim." *Resonate Inc. v. Alteon Websystems, Inc.*, 338 F.3d 1360, 1364 (Fed. Cir. 2003). The disputed phrase – "content specific request" – specifies nothing regarding what the request must contain and contains no language regarding whether it must contain a URL address, IP address, or other types of location information. Based on the plain language of the disputed phrase, if a piece of information other than location can be used to specify a particular content, the phrase would encompass that.

The parties rely on various sections of the specification in support of their respective arguments. Although those sections of the specification often refer to URL or IP addresses as a means to specify a particular content, there is no need to narrow the term to require the "location"

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limitation. The patentee is not required to set forth in the claim language the specific detail of how

the request specifies the particular content. Nor does the Court need to narrow the scope of the

claim based on examples in the specification that have been omitted from a claim. *See K-2 Corp.*

v. Salomon S.A., 191 F.3d 1356, 1364 (Fed. Cir. 1999) ("Courts do not rewrite claims; instead, we

give effect to the terms chosen by the patentee."); *Autogiro Co. of Am. v. United States*, 384 F.2d

391, 396 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee

something different than what he has set forth.").

The Court also does not find persuasive Google's argument that Williamson's construction

is indefinite. Google contends that the patent contains no disclosures concerning the selection of

particular content other than referencing a server or an address. Resp. Br. 5. As such, Google

concludes it is thus unclear how "specifying particular content" could be different from

"specifying location." However, not having adequate disclosure in support of a claim does not

render a claim invalid for indefiniteness. Rather, a claim is indefinite when it "fail[s] to inform,

with reasonable certainty, those skilled in the art about the scope of the invention." *See Nautilus*,

134 S. Ct. at 2124. The Court thus does not find Williamson's proposed construction unclear

because it sufficiently delineates the scope of the claim.

Therefore, in light of the specification and the claim language, the Court finds no

persuasive evidence that the request must contain location information and adopts Williamson's

proposed construction.

C. **"location signal" (and variants)**

Williamson's Proposal	Google's Proposal	Court's Construction
No construction necessary.	"header referencing an address"	No construction necessary.

The disputed phrase "location signal" appears in asserted independent claims 1, 20, 34, 64,

72 and 75 of the '045 patent, and independent claims 1, 17, 39, and 44 of the '698 patent. Claim 1

of the '045 patent is representative of how the phrase is used in the claim language:

1. A method for storing information on a primary server and one or more secondary servers
   and on computer sites connected to a computer network, wherein information delivered
   over the computer network to a terminal or a group of terminals may contain references to
   other information to be delivered to the terminal, comprising:

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serving a first portion of information to a terminal, wherein said first portion of
information contains a reference to a second portion of information;

causing a first request signal to be transmitted from the terminal to a primary server
requesting a location address for said second portion of information from which said
second portion of information can be served to the terminal, wherein said first request
signal includes information intended to prevent said first request signal from being
blocked from reaching said primary server by either the terminal or any intermediary
device located topologically between the terminal and the primary server as a result of
previous caching of said first portion of information or said second portion of
information in the terminal or said intermediary device;

sending a **location signal** from the primary server to the terminal providing said
location address of said second portion of information;
causing a second request signal to be transmitted from the terminal containing said
location address of said second portion of information and requesting said second
portion of information be served to the terminal; and

serving said second portion of information to the terminal.

'045 patent at 27:24-54 (emphasis added).

Williamson argues that no construction is needed for "location signal" because it is a
readily understood phrase. According to Williamson, the specification places no restrictions
relating to the formatting of the signal or any other limitations. Opening Br. 13. Google,
however, urges this Court to construe the term in accordance with its proposal because the phrase
is by itself ill-defined and does not have a specialized technical meaning. Resp. Br. 6. Google
further argues construction is necessary in order to differentiate "location signal" from "location
address," another phrase used in the claims.

The Court does not find "location signal" to be ill-defined or vague so to require a
construction. Construing a claim term or phrase is only required "when the meaning or scope of
technical terms and words of art is unclear and in dispute and requires resolution to determine the
issue before the court." *Eli Lilly and Co. v. Aradigm Corp.*, 376 F.3d 1352, 1360 (Fed. Cir. 2004).
Where "the ordinary meaning of claim language as understood by a person of skill in the art may
be readily apparent even to lay judges, claim construction in such cases involves little more than
the application of the widely accepted meaning of commonly understood words." *Phillips*, 415
F.3d at 1314.

1   "Location signal" is neither a technical term nor word of art but instead has a plain and

2   ordinary meaning in light of the specification and in context of the claims. Google's expert, Dr.

3   Freedman opines that "the term 'location signal' did not have a standard meaning to one of skill in

4   the art in 1997" or even now in 2017. Freedman Decl. ¶ 17, ECF 137-4. He also states that

5   "location signal" is "not a term of art." *Id.* Further, Williamson's expert, Dr. Almeroth, agrees

6   with this opinion that "location signal" did not have a standard meaning in 1997, and that a person

7   of ordinary skill in the art would readily understand this phrase in light of the specification.

8   Almeroth Decl. ¶¶ 22-23, ECF 138-3. These expert opinions on the lack of a "standard" meaning

9   do not persuade the Court that a construction is necessary. Rather, the Court finds these expert

10 opinions to be consistent with the conclusion that "location signal" is not a technical term or word

11 of art but would be understood based on its plain and ordinary meaning. Google further argues

12 that construction is necessary to differentiate "location signal" from "location address." However,

13 Google does not explain why the plain and ordinary meaning of those terms would be insufficient

14 to impart different meanings. [1]

15 Lastly, Google proposes "header referencing an address" as a construction by cobbling

16 together various disclosures in the specification and in a draft specification for HTTP/1.1. Resp.

17 Br. 7-8; App. B to Freedman Decl., ECF 137-6. However, Google provides no valid reason why

18 the term needs to be limited by the disclosure in the specification or in the HTTP/1.1 draft

19 specification. Notably, "header referencing an address" does not appear anywhere in the patents-

20 in-suit. In addition, even though Google points to embodiments in the specification showing that

21 location signal is an HTTP response containing a header referencing an address, claim terms

22 normally should not be limited to embodiments in the specification. *See Phillips*, 415 F.3d at

23 1323 ("[A]lthough the specification often describes very specific embodiments of the invention,

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25 [1] Additionally, Google was adamant at the hearing that the claim phrase "location signal" must be

26 construed to "grapple" with serious problems that are forthcoming, including issues relating to
    "distinguish[ing] the invention from the prior art." June 16, 2017 H'rg Tr. 37:23-38:2. This

27 generic statement, however, fails to elucidate for the Court the relevance of these alleged problems
    to claim construction. Further, as explained below, because the Court does not find Google's

28 proposed construction to be proper under the governing case law, the Court declines to adopt
    Google's proposed construction.

we have repeatedly warned against confining the claims to those embodiments."). Exceptional

circumstances are not present here to compel this Court to steer away from this general principle.

D. "counting each display of said specified banner on the client device" (and variants)

Williamson's Proposal	Google's Proposal	Court's Construction
No construction necessary.	"counting on the server [each | at least one] request of [said specified banner | said second portion of the information | the banner]"	No construction necessary (except for terms appearing within the phrase already construed by the Court)

The disputed phrase "counting each display of said specified banner on the client device"

appears in asserted dependent claims 71 and 73 of the '045 patent, and independent claims 17 and

39 and dependent claims 2, 3, 24, and 25 of the '698 patent. Claim 71 of the '045 patent

ultimately depends on independent claim 64 and is set forth below as an example of how the

phrase is used:

> 71. The method of claim 70, including **counting at least one display of said specified banner on the client device**.

'045 patent at 32:21-22 (emphasis added).

Williamson argues that no construction is needed for "counting at least one display of said

specified banner on the client device" because the plain and ordinary meaning is clear. Opening

Br. 14. According to Williamson, Google's proposed construction requiring counting to occur at

the server and counting requests instead of displays is inconsistent with the claim language and the

specification. *Id.*

Google contends that the purported invention counts requests at the server, which is

acknowledged by Williamson when discussing relevant portions of the specification. Resp. Br. 9-

10. In order for the claim construction to be consistent with the specification, Google argues that

"counting displays" should be construed as "counting requests." *Id.* at 10. Google also avers that

without construction, the literal language could only cover counting the actual display on the client

device and not requests at the server. Google then concludes that its proposed construction is

appropriate to "preserve [the claims'] validity" in light of the written description and enablement

issues. *Id.* at 10-11.

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1   At the claims construction hearing, the Court ordered the parties to file supplemental briefs

2   to further aid this Court in construing this phrase. Williamson reiterates the position that the

3   phrase should not be limited to an embodiment disclosed in the specification. Pl. Supp. Br. 2,

4   ECF 147. It also highlights that a dependent claim, claim 24 of the '698 patent, further limits the

5   claim scope of independent claim 17 by specifying that the counting is "done by said server." *Id.*

6   According to Williamson, in light of such a dependent claim, limiting independent claims

7   containing the "counting" phrase to "counting at the server" would be contrary to principles of

8   claim construction. *Id.* (citing *Phillips*, 415 F.3d at 13). Google maintains its disagreement with

9   Williamson, and in its supplemental brief, provides specific variations of its proposed construction

10   for the asserted claims. Def. Supp. Br. 2, ECF 148. Google argues that its proposed construction

11   does not limit the claims to a preferred embodiment but merely clarifies that "display" is

12   shorthand for ensuring that "an ad request could always be counted by the primary server." *Id.* at

13   2.

14   The Court's comments made during the claims construction hearing might have suggested

15   that at the time of the hearing, the Court was evaluating whether the "counting" phrase requires

16   construction. In an attempt to explore all sides of the parties' argument, the Court suggested that

17   "display" may not have "a common meaning" and thus the phrase might require a construction.

18   Now with the benefit of an in-depth discussion on the record and further review of the parties'

19   supplemental submissions, the Court determines that the "counting" phrase need not be construed.

20   This is because its plain and ordinary meaning can be readily understood by a person of ordinary

21   skill in the art. While Google insists that the claimed invention counts requests at the server and

22   does not count displays, it also acknowledges that the specification discloses a system that

23   provides "for accurate monitoring and counting of the information and banners displayed to a user

24   or served to a terminal." Resp. Br. 10 (citing '045 patent at 3:21-28). The Court finds that such

25   disclosure supports the plain and ordinary meaning of this phrase. In an attempt to circumvent this

26   inconvenient disclosure in the specification, Google claims that the counting requests sent to the

27   server is a surrogate for counting the display at the terminal. Resp. Br. 10; Def. Supp. Br. 2.

28   However, this proposed "surrogate" construction is not apparent from the claim language itself

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and Google offers no reason why a specific counting means disclosed in the embodiment –

counting requests at the server – must substitute for counting displays. Notably, dependent claim

24 of the '698 patent requires in addition to the independent claim, "wherein said counting each

display of said specified banner on the client device is done by said server." '698 patent at 29:48-

50. The inclusion of this limitation of counting being "done by said server" makes it likely that

the patentee did not contemplate that "counting" as recited in the independent claim already

contained that limitation. *See Phillips*, 415 F.3d at 1324 (concluding that an independent claim

should be given broader scope than a dependent claim to avoid rendering the dependent claim

redundant) (citing *Dow Chem. Co. v. United States*, 226 F.3d 1334, 1341-42 (Fed. Cir. 2000)).

Regardless, the specification discloses a computer terminal that displays a banner by

sending a request to a server, which responds by sending a banner location signal to the terminal,

which then responds by sending a second banner request, and which then receives and displays the

banner. The "counting" phrase could encompass counting banner display directly or indirectly by

counting any of these signal relays. Even if one or more of these counting means might be

imprecisely correlated with actual displays under certain circumstances, not enabled, or not

adequately supported by written description, these are not issues before the Court here. Rather,

the inquiry here is whether the plain and ordinary meaning of the phrase conveys what the phrase

would mean to a person of ordinary skill in the art in the context of the claim, and in light of the

specification and prosecution history. The Court concludes that the "counting" phrase is readily

understood by its plain and ordinary meaning and no construction is necessary.

IV. INDEFINITENESS

A. "best suited"

Williamson's Proposal	Google's Proposal	Court's Construction
No construction necessary.	Indefinite.	No construction necessary.

The disputed phrase "best suited" appears in asserted dependent claim 7 of the '045 patent.

Claim 7 of the '045 patent is set forth below:

> 7. The method of claim 1, wherein after the primary server receives the first request signal
> from the terminal, further including determining which server connected to the computer
> network is **best suited** for serving said second portion of information to the terminal.

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1 '526 Patent at 9:19-34 (emphasis added).

2 Williamson contends that claim 7 containing the phrase "best suited" is not indefinite

3 because the specification and claim language adequately inform persons of ordinary skill in the art

4 about the scope of the claimed invention. Opening Br. 16. Williamson further argues that the

5 phrase is not "vague or boundless" because the claim requires that the server be "best suited" to

6 perform a particular task of serving the requested information. Reply 7, ECF 140. Google

7 counters that the examples in the specification fail to render the claim definite because there

8 remains a limitless list of qualities one could consider to determine which server is "best suited."

9 Resp. Br. 13.

10 "A patent is invalid for indefiniteness if its claims, read in light of the specification

11 delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those

12 skilled in the art about the scope of the invention." *Nautilus*, 134 S. Ct. at 2124. Proof of

13 indefiniteness requires an accused infringer to show "by clear and convincing evidence that a

14 skilled artisan could not discern the boundaries of the claim based on the claim language, the

15 specification, and the prosecution history, as well as her knowledge of the relevant art area."

16 *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1249-50 (Fed. Cir. 2008).

17 Here, Google has not met its burden to show by clear and convincing evidence that claim 7

18 is indefinite. First, the specification provides guidance on how to select a server that is "best

19 suited" for serving the requested information to a terminal. Criteria for determining a server that

20 is "best suited" includes shortest period of response time, network topological distance,

21 geographical distance, bandwidth of the server, and round trip times. *See* '045 patent at 20:61-

22 21:7; 24:32-47. Although the claim is not limited to a particular factor or numerical limit, one of

23 ordinary skill in art could use these various factors to determine a server that is "best suited" for

24 serving the requested information. *See C-Cation Techs., LLC v. Time Warner Cable, Inc.*, No. 14-

25 0059-JRG-RSP, 2015 WL 1849014, at *11 (E.D. Tex. Apr. 20, 2015) (finding no indefiniteness

26 with the phrase "determining whether a different and suitable signalling [sic] data channel is

27 available" because one skilled in the art would recognize various factors that could be used to

28 determine suitability).

1   Second, contrary to Google's argument, case law does not mandate a patentee to set forth

2   in the claim specific means or metric for what constitutes "best suited" to meet the definiteness

3   requirement, as the Supreme Court noted, "[s]ome modicum of uncertainty [] is the 'price of

4   ensuring the appropriate incentives for innovation.'" *Nautilus*, 134 S. Ct. at 2128 (citation

5   omitted); *see also Sonix Tech. Co. v. Pubs. Int'l, Ltd.*, 844 F.3d 1370, 1377 (Fed. Cir. 2017)

6   (holding that "a patentee need not define his invention with mathematical precision in order to

7   comply with the definiteness requirement."); *id.* at 1379 (noting that "requirements for the

8   graphical indicators being negligible to human eyes" render the claim definite). Moreover, claim

9   7 only requires that a determination is made, and does not require that the selected server must

10   meet various criteria with mathematical precision. *See, e.g.*, *Vstream Techs., LLC v. PLR*

11   *Holdings, LLC*, No. 15-974-JRG-JDL, 2016 WL 6211550, at *13 (E.D. Tex. Sept. 27, 2016)

12   (finding not indefinite the phrase "based upon which pipeline is more suitable for processing the

13   component" and noting that "the fact that the pipe analyzer performs the suitability analysis is the

14   important issue, not necessarily the outcome of that analysis"). Accordingly, that there are

15   numerous ways to meet this claim limitation, as argued by Google, does not alone make claim 7

16   indefinite.

17   Additionally, claim 7 does not simply require identifying a server that is best suited

18   without further qualifications. Rather, it requires "determining which server connected to the

19   computer network is best suited" for a specific purpose – "serving said second portion of

20   information to the terminal." *See* Reply 7. Given the requirement that the server must be best

21   suited for "serving said second portion of information to the terminal," the claim language viewed

22   in light of the specification adequately informs a person of ordinary skill in the art the scope of the

23   claim with reasonable certainty. *See Nautilus*, 134 S. Ct. at 2129 (holding that the test for

24   definiteness is whether the "patent's claims, viewed in light of the specification and prosecution

25   history, inform those skilled in the art about the scope of the invention with reasonable certainty").

26   The Court recognizes that merely providing examples in the specification does not always

27   render a claim definite, especially when the examples fail to inform a person of ordinary skill the

28   scope of the claims. *E.g.*, *Prolifiq Software Inc. v. Veeva Sys. Inc.*, No. 13-03644-SI, 2014 WL

3870016, at *6 (N.D. Cal. Aug. 6, 2014) (finding the term "differently versioned" rendered the claims indefinite because specification "only provides information about when something is a differently versioned digital content element, but it does not provide information about when something is not a differently versioned digital content element"). However, aside from conclusory assertions that one of ordinary skill in the art cannot discern the scope of the claim without specific selection criteria, Resp. Br. 13-14, Google has not presented clear and convincing evidence showing why these examples would be inadequate or why specific selection criteria would be necessary. For example, Google has not presented any expert opinions on whether one of ordinary skill in the art would be able to determine the scope or meaning of claim 7. Without evidence on this point, Google cannot meet its burden of showing indefiniteness by the clear and convincing standard.

B.   "intended to prevent said first request signal from being blocked" (and variants)

Williamson's Proposal	Google's Proposal	Court's Construction
No construction necessary.	Indefinite.	No construction necessary.

The disputed phrase "intended to prevent said first request signal from being blocked" appears in asserted independent claims 1, 20, 34, 64, 72, 75 of the '045 patent. Claim 1 of the '045 patent is representative:

1. A method for storing information on a primary server and one or more secondary servers and on computer sites connected to a computer network, wherein information delivered over the computer network to a terminal or a group of terminals may contain references to other information to be delivered to the terminal, comprising:

    serving a first portion of information to a terminal, wherein said first portion of information contains a reference to a second portion of information;

    causing a first request signal to be transmitted from the terminal to a primary server requesting a location address for said second portion of information from which said second portion of information can be served to the terminal, wherein said first request signal includes information **intended to prevent said first request signal from being blocked** from reaching said primary server by either the terminal or any intermediary device located topologically between the terminal and the primary server as a result of previous caching of said first portion of information or said second portion of information in the terminal or said intermediary device;

    sending a location signal from the primary server to the terminal providing said

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location address of said second portion of information;
causing a second request signal to be transmitted from the terminal containing said location address of said second portion of information and requesting said second portion of information be served to the terminal; and

serving said second portion of information to the terminal.

'045 patent at 27:24-54 (emphasis added).

Williamson argues that the claims in light of the specification and prosecution history properly inform a person of ordinary skill in the art about the scope of the invention. Opening Br. 18. According to Williamson, the use of the word "intended" does not introduce a subjective intent, but instead aims to convey that the signal "is designed in a way such that it will not be blocked or prevented from reaching the primary server." *Id.* at 18-19. Further, Williamson argues that this phrase was the result of a claim amendment during prosecution where the patent examiner found the prior claim requiring that the "signal cannot be blocked" as not enabled. *Id.* at 19-20. Williamson concludes that the examiner's eventual approval of the current claim language shows that the claim is not indefinite.

Contrary to Williamson's contention, Google avers that the claims require a subjective intent, which would render the claims indefinite. Resp. Br. 14. Google highlights that the examples disclosed in the specification, such as the use of "cgi-bin" and "?," could have different purposes, one to prevent the request from being blocked from reaching a server and another to maintain session state across requests. *Id.* at 14-15. According to Google, only by weighing the subjective intent of the designer would one be able to determine whether there is infringement. *Id.* at 15. Google then concludes that such consideration of subjective intent renders the claims indefinite. *Id.*

Google has not met its burden to show by clear and convincing evidence that claims containing the phrase at issue are indefinite. Based on plain and ordinary meaning, information "intended to prevent said first request signal from being blocked" simply refers to information that is configured to prevent the request signal from being blocked. Further, when read in light of the specification and the prosecution history, the requirement that the claims implicate subjective intent is nowhere to be found. *Nautilus*, 134 S. Ct. at 2124. Although the Court does not defer to

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1   the patent examiner's findings that the claims are valid (separate from the general presumption of

2   patent validity), the prosecution history remains informative. *See Quad Envtl. Techs. Corp. v.*

3   *Union Sanitary Dist.*, 946 F.2d 870, 876 (Fed. Cir. 1991) ("although courts may take cognizance

4   of, and benefit from, the proceedings before the patent examiner, the question is ultimately for the

5   courts to decide, without deference to the rulings of the patent examiner."). The prosecution

6   history shows that the claim amendment incorporating the phrase containing "intended" was not to

7   introduce subjective intent, but to overcome an enablement issue.

8   The Court further finds that the use of the word "intended" on its own does not introduce

9   subjective intent in the context of the claims and the specification. Rather, the word "intended" is

10   often used to introduce a functional limitation to a claim, which is exactly the case here. In *Caron*

11   *v. QuicKutz, Inc.*, the court did not find ambiguous the use of the phrase "intended to be used for,"

12   and actually construed "embellishing template" as "a die having features intended to be used for

13   cutting, embossing, and/or stenciling on sheet media." No. 09-02600, 2012 WL 5053232, at *2

14   (D. Ariz. Oct. 16, 2012). The motion for reconsideration of the claim construction order on the

15   basis of indefiniteness was denied. *Id.* In denying the motion for reconsideration, the court held

16   that the phrase "intended to be used for" did not render the claims ambiguous. *Id.* It further

17   reasoned that it was not necessary to decide who exhibited the intent and that it "can be

18   determined objectively whether a person skilled in the art would conclude that a die has an

19   opening or projection that will cut, emboss, and/or stencil in an intended shape or pattern." *Id.*

20   Similarly here, the use of the word "intended" introduces a functional limitation in connection

21   with "information," as recited in the claims and introduces no ambiguity. *See, e.g.*, *SourceOne*

22   *Global Partners, LLC v. KGK Synergize, Inc.*, 2010 WL 2232944, at *9 (N.D. Ill. June 3, 2010)

23   (construing the phrase "for treating breast cancer" to mean "intended to prevent or inhibit breast

24   cancer"); *see also Ricoh Co., Ltd. v. Quanta Computer, Inc.*, 571 F. Supp. 2d 929, 937-38 (W.D.

25   Wis. 2007) (construing the phrase "to be accessed" to mean "intended for access in the future").

26   In fact, Williamson represented to the Court at the hearing that the word "intended" could be

27   substituted with "designed" or "configured" without altering the meaning of the claims. These

28   means of reciting "intended," "designed," or "configured" to introduce a functional limitation do

1   not by themselves render the claims indefinite. Indeed, functional language may even promote

2   "definiteness because it helps bound the scope of the claims by specifying the operations" that the

3   claimed invention must undertake. *Cox Commc'ns, Inc. v. Sprint Commc'n Co. LP*, 838 F.3d

4   1224, 1232 (Fed. Cir. 2016); *cf. Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371-72

5   (Fed. Cir. 2014) (finding the claims containing the phrase "in an unobtrusive manner that does not

6   distract a user" indefinite because the phrase is "purely subjective" and the specification provides

7   no clarity).

8   Although the Court concludes that the plain and ordinary meaning of the disputed phrase

9   correctly conveys the meaning of the claims, substituting "intended" with "configured" would be

10   equally acceptable. In the event the parties find that replacing "intended" with "configured"

11   would be a proper construction and can assist the jury's understanding of the disputed phrase, the

12   Court invites the parties to make that request.

13   **C.   "selecting the composition of said second portion of information"**

Williamson's Proposal	Google's Proposal	Court's Construction
No construction necessary.	Indefinite.	No construction necessary.

16   The disputed phrase "selecting the composition of said second portion of information"

17   appears in asserted dependent claim 14 of the '045 patent. Claim 14 of the '045 patent ultimately

18   depends on claim 1 and is set forth below.

19   14. The method of claim 4, including **selecting the composition of said second portion
       of information**.

20   '045 patent at 28:22-23 (emphasis added).

21   Williamson contends that the claim 14 is not indefinite because the PTAB in a prior IPR

22   proceeding did not find it indefinite in the context of comparing the claim to the prior art.

23   Opening Br. 20-21. Williamson further argues that the patent specification adequately informs a

24   person of ordinary skill in the art. *Id.* at 21. Williamson notes that the patent explains that a

25   server may select the banner to be served and that the composition of the banner may be based on

26   demographics or other information about the user. *Id.*

27   Google urges this Court to find the claim indefinite because it is unclear which step of the

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claimed method "select[s] the composition of said second portion of information." Resp. Br. 17.

According to Google, the confusion stems from the direct dependence of claim 14 on claim 4,

referencing "a first request signal . . . ," even though Williamson's proffered support from the

specification referring to a different step that does not involve "a first request signal . . . ." *Id.*

Google also argues that the claim is indefinite on the additional ground that the specification

makes no mention of "the composition" of the banner. *Id.* at 17-18.

First, with respect to Google's alleged confusion based on the dependence of claim 14 on

claim 4, there is no authority requiring a step recited in a dependent claim to be performed by the

step of an immediate parent claim. In other words, while claim 14 directly depends on claim 4 and

ultimately depends on claim 1, the "selecting" step in claim 14 does not have to necessarily occur

at the same step as claim 4. Claim 4 does not even recite a method step but only specifies that the

"first request signal is a content general request signal," further undercutting Google's argument.

Second, as to whether the specification makes a mention of "the composition," there is no

authority, and Google has provided none, requiring that the recited word or phrase must appear in

the specification as a condition for definiteness. *Cf. Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598

F.3d 1336, 1352 (Fed. Cir. 2010) (noting that the "description requirement does not demand any

particular form of disclosure, or that the specification recite the claimed invention *in haec verba*")

(citation omitted). Accordingly, Google fails to meet the burden of showing by clear and

convincing evidence that claim 14 is indefinite.

D.   "said specified banner" (and variants)

Williamson's Proposal	Google's Proposal	Court's Construction
No construction necessary.	Indefinite.	"said banner"

The disputed phrase "said specified banner" appears in asserted independent claim 20 of

the '045 patent. Claim 20 of the '045 patent is set forth below.

> 20. A method for distributing a banner over a computer network to a device when the
> banner is referenced or linked to in a document served to the device, wherein the
> banner is stored in one or more servers, comprising:
>
>   receiving a first banner request signal from a device at a first server requesting that
>   a banner be served to the device, wherein said first banner request signal includes

information intended to prevent said first banner request signal from being blocked from reaching said first server by the device despite previous caching of **said specified banner** in the device;

sending a banner location signal from said first server to the device, wherein said banner location signal includes location information for a specified banner stored on a second server; and

receiving a second banner request signal from the device at said second server requesting that the second server serve said specified banner to the device.

'045 patent at 28:38-55 (emphasis added).

Even though Williamson does not dispute that "said specified banner" lacks explicit antecedent basis, it argues that a person of ordinary skill in the art could still ascertain the scope of the invention based on the patent. Opening Br. 21-22. Further, Williamson points out that the prior recitation of "a banner" provides the antecedent basis at least by implication. *Id.* at 22. Williamson argues that the specification provides further support that "said specified banner" refers to the previously recited "a banner." *Id.*

Google counters that the portion of the specification relied upon by Williamson shows that the meaning of this phrase is uncertain. Resp. Br. 18. Specifically, the specification states that the initial banner request signal "either request[s] that unspecified banner be served to the terminal or that a specified banner be served to the terminal." *Id.* (citing '045 patent at 4:4-10). Because it is unclear which of these two options, one for unspecified banner and another for specified banner, the phrase refers to, Google concludes that the claim is indefinite.

The Court agrees with Williamson and finds that claim 20 is not indefinite because of the phrase "said specified banner." The lack of an explicit antecedent basis is but a minor drafting error in the claim, and the construction of this phrase is not subject to reasonable debate. Reading the claim in light of the specification, and considering the claim as a whole, one of skilled in the art would understand with reasonable certainty that the phrase "said specified banner" refers to the previously recited "a banner." Google argues that alternatively, the initial recitation of "a banner" could be amended to "a specified banner," and having this plausible alternative choice renders the claim indefinite. However, this alternative amendment is not supported by the specification and is inconsistent with other claims. The specification discloses that an initial banner request signal can

request either a specified or unspecified banner be served. '045 patent at 4:4-10. This shows that

the scope of the invention could encompass either specified or unspecified banner and does not

support the narrower amendment of "a specified banner." Moreover, claim 24, a dependent claim

of claim 20, requires that the first banner request signal be "a content general banner request

signal." '045 patent at 28:66-67. Amending claim 20 from "a banner" to "a specified banner"

would conflict with claim 24, and would not be a proper amendment. *See, e.g.*, *Phillips*, 415 F.3d

at 1315 ("the presence of a dependent claim that adds a particular limitation gives rise to a

presumption that the limitation in question is not present in the independent claim"). As such,

Google has not provided clear and convincing evidence that claim 20 is indefinite.

Having found no indefiniteness, the Court turns to whether the first instance of the phrase

"said specified banner" should be amended to "said banner." A court may correct an error in a

claim "only if (1) the correction is not subject to reasonable debate based on consideration of the

claim language and the specification and (2) the prosecution history does not suggest a different

interpretation of the claims." *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1354 (Fed.

Cir. 2003).   As discussed above, the correction here is not subject to reasonable debate based on

the claim language and the specification. The parties also do not argue that the prosecution history

suggests a different interpretation. One of ordinary skill in the art would also interpret this phrase

to be "said banner." Accordingly, the Court construes the phrase to be "said banner" and the

corrected claim 20 is set forth below:

> 20. A method for distributing a banner over a computer network to a device when the banner is referenced or linked to in a document served to the device, wherein the banner is stored in one or more servers, comprising:
>
> receiving a first banner request signal from a device at a first server requesting that a banner be served to the device, wherein said first banner request signal includes information intended to prevent said first banner request signal from being blocked from reaching said first server by the device despite previous caching of **said** ~~specified~~ **banner** in the device;
>
> sending a banner location signal from said first server to the device, wherein said banner location signal includes location information for a specified banner stored on a second server; and
>
> receiving a second banner request signal from the device at said second server

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requesting that the second server serve said specified banner to the device.

'045 patent at 28:38-55 (emphasis added with alteration).

V. ORDER
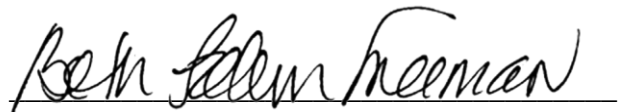
For the foregoing set forth above, the terms and phrases are construed as follows:

Claim Term	Court's Construction
"content general request"	"content request that does not specify particular content"
"banner"	"information displayed in conjunction with a web page"
"content specific request"	"A content request that does specify particular content and/or location thereof"
"location signal" (and variants)	No construction necessary.
"counting each display of said specified banner on the client device" (and variants)	No construction necessary (except for terms appearing within the phrase already construed by the Court).
"best suited"	No construction necessary; not indefinite.
"intended to prevent said first request signal from being blocked" (and variants)	No construction necessary; not indefinite.
"selecting the composition of said second portion of information"	No construction necessary; not indefinite.
The first instance of "said specified banner" in claim 20 of the '045 patent	"said banner"

IT IS SO ORDERED.

Dated: July 27, 2017

BETH LABSON FREEMAN
United States District Judge