

Claim Construction Hearing

***Web Tracking Solutions, LLC
and Daniel Wexler***

v.

Google Inc.

**Claim Construction Presentation of
Defendant Google Inc.**

U.S. District Court for the Eastern District of New York
Case No. 1:08-cv-03139(RRM)(RER)

April 29, 2010

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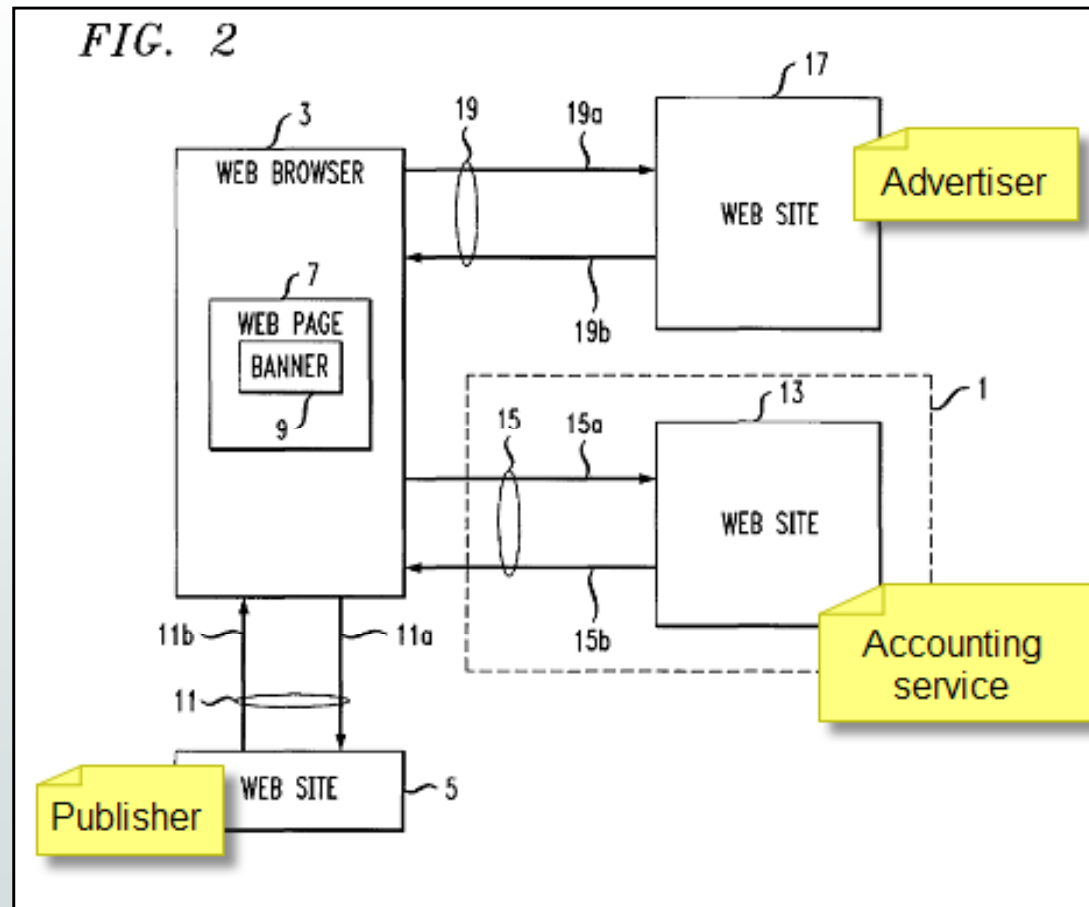
'409 Patent: Background

Summary of the '409 Patent

- The patent was filed in October 1996.
- The patent contains eleven claims:
 - Three independent claims (1, 7, and 9)
 - Eight dependent claims (2-6, 8, 10-11)
- Plaintiffs are currently asserting every claim in the '409 patent.

Summary of the '409 Patent

- The patent illustrates the interaction between these parties.



Summary of the '409 Patent

- In Claim 1, the accounting service is represented as the “fourth Web site.”

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish advertising for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the first uniform resource locator, in response to the receipt of the first uniform resource locator;

redirecting, at the fourth Web site, the first user's Web browser to the third Web site in response to the receipt of the first uniform resource locator;

receiving, at the fourth Web site, a second uniform resource locator from a second user's Web browser, wherein the second uniform resource locator is obtained by the second user's Web browser from the second Web site and wherein the second uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the second uniform resource locator, in response to receiving the second uniform resource locator; and

redirecting, at the fourth Web site, the second user's Web browser to the third Web site in response to the receipt of the second uniform resource locator.

Party	Reference in Claim
Accounting Service	Fourth Web Site

Summary of the '409 Patent

- In Claim 1, the advertiser is represented as the “third Web site.”

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish advertising for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the first uniform resource locator, in response to the receipt of the first uniform resource locator;

redirecting, at the fourth Web site, the first user's Web browser to the third Web site in response to the receipt of the first uniform resource locator;

receiving, at the fourth Web site, a second uniform resource locator from a second user's Web browser, wherein the second uniform resource locator is obtained by the second user's Web browser from the second Web site and wherein the second uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the second uniform resource locator, in response to receiving the second uniform resource locator; and

redirecting, at the fourth Web site, the second user's Web browser to the third Web site in response to the receipt of the second uniform resource locator.

Party	Reference in Claim
Accounting Service	Fourth Web Site
Advertiser	Third Web Site

Summary of the '409 Patent

- In Claim 1, the two publishers are represented as the “first Web site” and the “second Web site.”

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish advertising for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the first uniform resource locator, in response to the receipt of the first uniform resource locator;

redirecting, at the fourth Web site, the first user's Web browser to the third Web site in response to the receipt of the first uniform resource locator;

receiving, at the fourth Web site, a second uniform resource locator from a second user's Web browser, wherein the second uniform resource locator is obtained by the second user's Web browser from the second Web site and wherein the second uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the second uniform resource locator, in response to receiving the second uniform resource locator; and

redirecting, at the fourth Web site, the second user's Web browser to the third Web site in response to the receipt of the second uniform resource locator.

Party	Reference in Claim
Accounting Service	Fourth Web Site
Advertiser	Third Web Site
Publishers	First Web Site
	Second Web Site

The '409 Patent Used Existing Technologies

- The '409 Patent did not disclose any new technology. It used existing technologies to carry out a “new” business method.
- For example, before the '409 Patent, the Internet had already been invented and was already widely used.

Until as recently as five years ago, the Internet was used primarily by the scientific and technical community and was relatively unknown outside of such circles. And now, five years hence, knowledge of the Internet, and its use, are ubiquitous.

'409 Patent, Col. 1, Ln. 9-13

The '409 Patent Used Existing Technologies

- Network protocols, Web server software, and details about network connections were already well-known before the patent.

Servers, which are programs that provide Internet resources (e.g, a Web page), and clients, which are programs that access those resources on a user's behalf (e.g., a Web browser), are resident on such computers. Details concerning such computers and software, and the process of establishing communication links are known to those skilled in the art and will not be described herein except as appropriate for an understanding of the present invention.

'409 Patent, Col. 3, Ln. 15-21

The '409 Patent Used Existing Technologies

- Internet advertising was already widespread when the patent was filed.

Businesses have recognized the benefits of establishing a presence on the Internet, and, more particularly, on the World Wide Web (Web). One benefit is that it is a convenient way for both the buyer and the seller to do business; products and services can be ordered on-line. Another benefit to a business is that for the money spent, its advertising can reach a lot of prospective customers.

'409 Patent, Col. 1, Ln. 14-20

The '409 Patent Used Existing Technologies

- Before the '409 Patent, advertisers and publishers already knew how to track “clicks” on Internet advertisements.

Regardless of the fee basis, both the advertiser and the administrator of the banner-publishing site will typically have an interest in knowing certain statistics pertaining to advertising effectiveness. For example, if the fee for the advertising is based on the number of clicks on the banner, then both parties will want this statistic. The advertiser can obtain this information by interrogating an access log maintained by the advertiser Web site. This information, however, is not directly available to the banner-publishing site. While it can be obtained from the advertiser, the publishing-site administrator would presumably prefer receiving the relevant statistics from an unbiased source.

'409 Patent, Col. 2, Ln. 7-18

The '409 Patent Used Existing Technologies

- The only change between the prior art and the patent is the use of a “third party” to track clicks.

FIG. 1
PRIOR ART

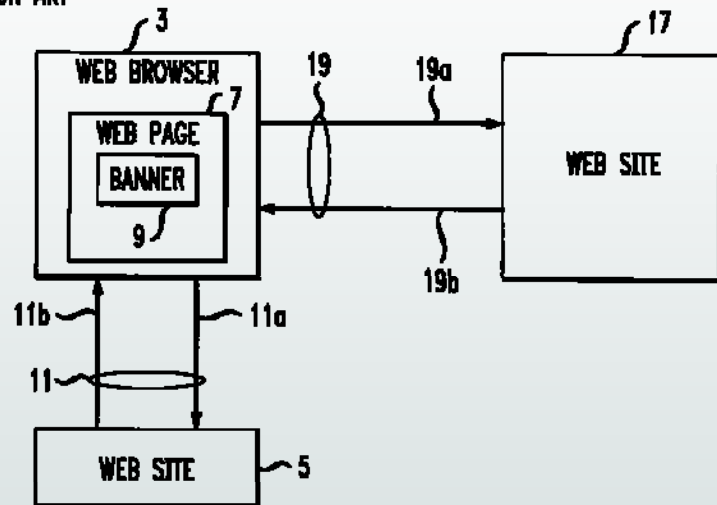
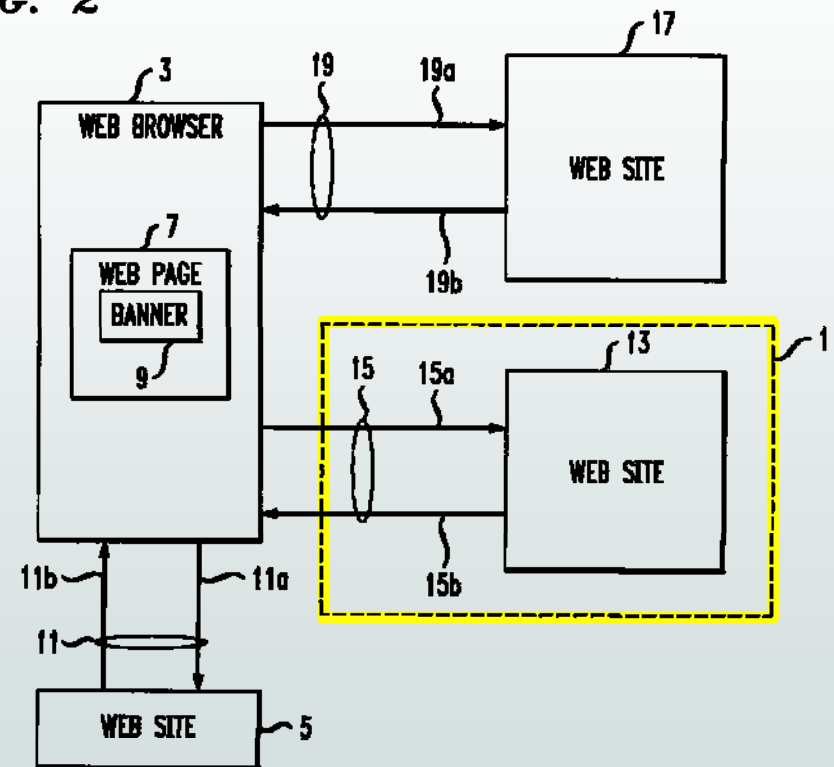
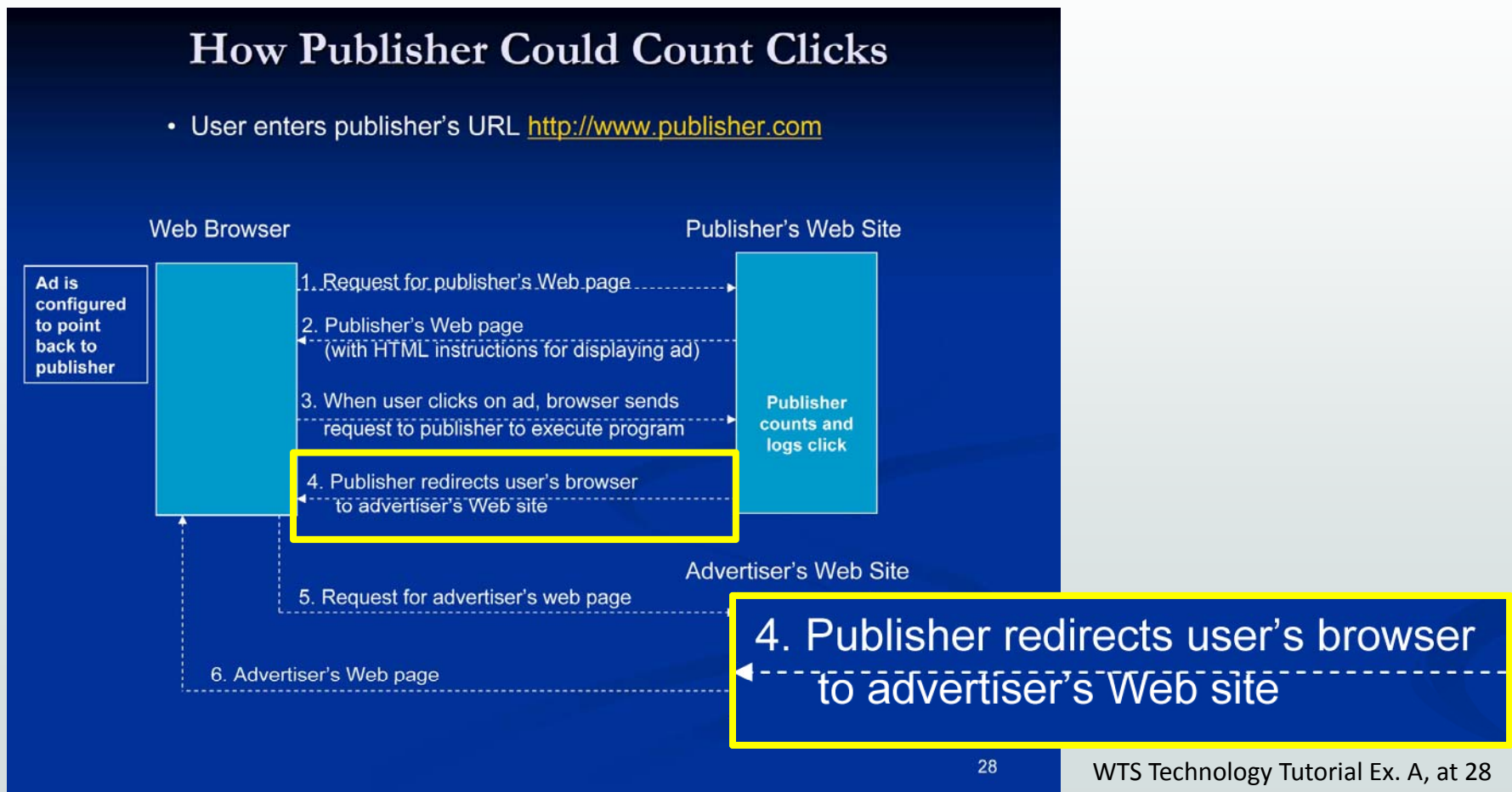


FIG. 2



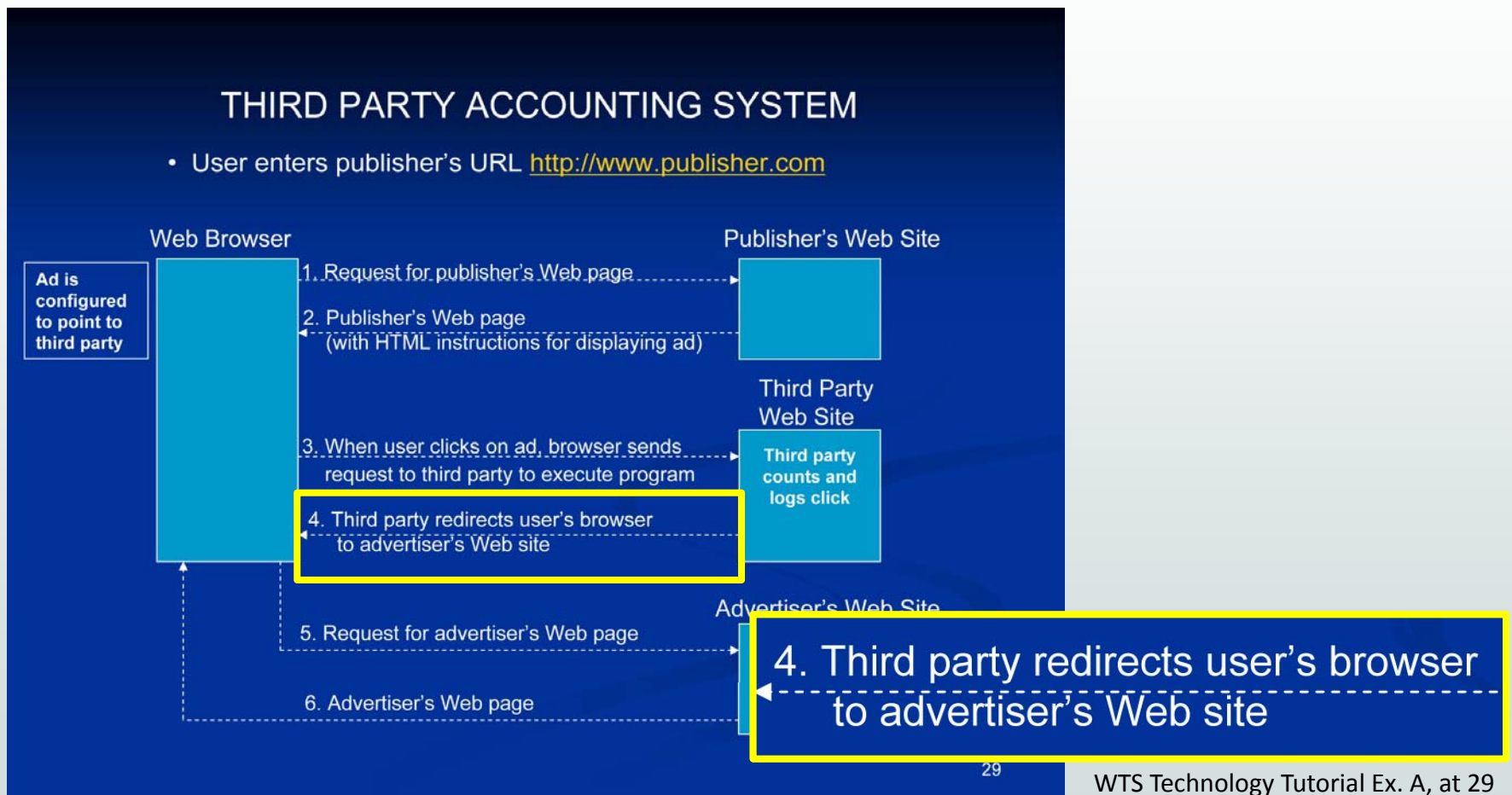
The '409 Patent Used Existing Technologies

- WTS admits that before the patent, publishers were using redirect response messages to count clicks.



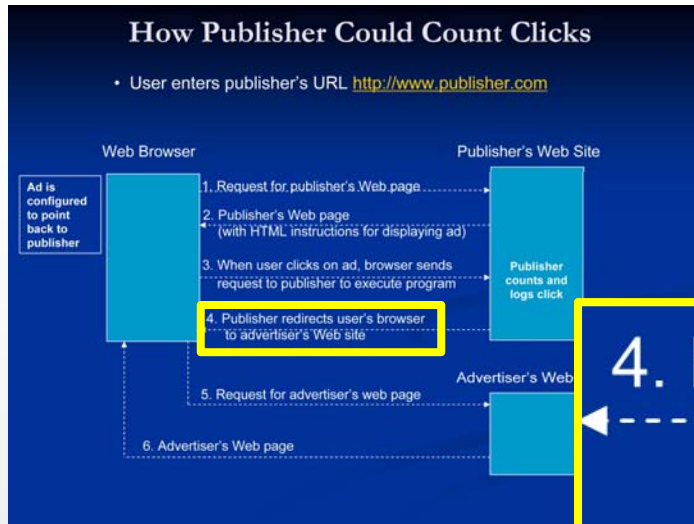
The '409 Patent Used Existing Technologies

- WTS admits that the patent uses redirect response messages in the same manner as the prior art.

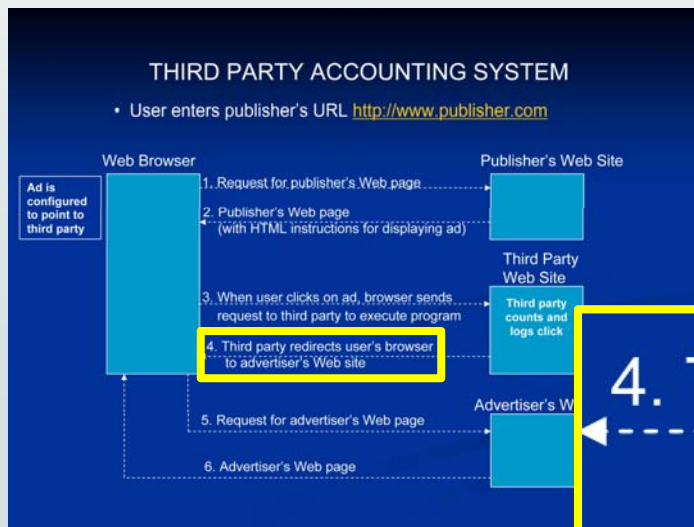


The '409 Patent Used Existing Technologies

- The technical steps in the prior art and in the patent are identical.



4. Publisher redirects user's browser to advertiser's Web site



4. Third party redirects user's browser to advertiser's Web site

The Sole Point of Novelty Alleged in the '409 Patent Is a Business Method

[57]

ABSTRACT

A system and method for providing on-line third party accounting and statistical information is disclosed.

'409 Patent, Abstract

In view of the value of such statistics, and the relative inconvenience in obtaining such information, a need presently exists for an unbiased, readily available source of statistical/accounting information for Internet advertisers and advertising publishers.

'409 Patent, Col. 2, Ln. 31-35

The Sole Point of Novelty Alleged in the '409 Patent Is a Business Method

- The patentability of business methods is currently under review by the United States Supreme Court in *Bilski v. Kappos*, No. 08-964 (argued November 9, 2009).

No. 08-964

IN THE
Supreme Court of the United States

BERNARD L. BILSKI AND RAMI A. WARMAN,
Petitioners,

v.

JOHN J. DOLL, ACTING UNDER SECRETARY OF
COMMERCE FOR INTELLECTUAL PROPERTY AND ACTING
DIRECTOR OF THE UNITED STATES PATENT AND
TRADEMARK OFFICE,
Respondent.

On Writ of Certiorari to the
United States Court of Appeals
for the Federal Circuit

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Claim Construction Guidelines

Law of Claim Construction

“Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically, the court looks to those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean. Those sources include the **words of the claims** themselves, the remainder of **the specification**, the **prosecution history**, and **extrinsic evidence** concerning relevant scientific principles, the meaning of technical terms, and the state of the art.”

Phillips v. AWH Corp.,

415 F.3d 1303, 1314 (Fed. Cir. 2005) (internal citations omitted)

Claims of a Patent Define the Invention

- It is undisputed that “it is a ‘bedrock principle’ of patent law that the claims of a patent define the invention [and] the words of a claim are generally given their ordinary and customary meaning.”

Phillips v. AWH Corp.,

415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (internal quotes omitted)(See Pl. Opp. Br. at 1)

- “[T]he ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.”

Phillips v. AWH Corp.,

at 415 F.3d at 1321 (Fed. Cir. 2005)

Intrinsic Evidence: The Specification Is the ‘Single Best Guide’ to a Claim’s Meaning

- “[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the **single best guide** to the meaning of a disputed term.”

Phillips v. AWH Corp.,

415 F.3d 1303, 1315 (Fed. Cir. 2005) (internal citations omitted)

- “The **best source for understanding a technical term is the specification** from which it arose, informed, as needed, by the prosecution history.”

Id.

Claims Are Appropriately Limited to the Only Disclosed Embodiment in the Patent

- “The district court correctly observed that the only host interface described in the specification is a direct parallel bus interface.... Although claims need not be limited to the preferred embodiment when the invention is more broadly described, neither do the claims enlarge what is patented beyond what the inventor has described as his invention.”

Inpro II Licensing, S.A.R.L. v. T-Mobile, Inc.,
450 F.3d 1350, 1354-57 (Fed. Cir. 2006)

- “The specification shows only a structure whereby the restriction ring is ‘part of’ the cover, in permanent attachment. This is not simply the preferred embodiment; it is the only embodiment.”

Toro Co. v. White Consol. Indus., Inc.,
199 F.3d 1295, 1301 (Fed. Cir. 1999)

- “The only embodiment described in the ’669 patent specification is the character-based protocol, and the claims were correctly interpreted as limited thereto.”

Wang Labs., Inc. v. Am. Online, Inc.,
197 F.3d 1377, 1382-83 (Fed. Cir. 1999)

The Inventor May Limit Scope of Claim During Prosecution

“[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, **making the claim scope narrower than it would otherwise be.**”

Phillips v. AWH Corp.,

415 F.3d 1303, 1317 (Fed. Cir. 2005) (internal citations omitted)

Characterization of the “Present Invention” Limits the Claim Terms

- “When a patent thus **describes the features of the ‘present invention’** as a whole, this description **limits the scope of the invention.**”

Verizon Servs. Corp. v. Vonage Holdings Corp.,
503 F.3d 1295, 1308 (Fed. Cir. 2007)

Characterization of the “Present Invention” Limits the Claim Terms

- The Federal Circuit routinely holds that claim terms are limited by the patentee’s characterization of the “present invention.”
- *Honeywell Intern., Inc. v. ITT Industries, Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006) (construing a term to include fuel filter because “[o]n at least four occasions, the written description refers to the fuel filter as **‘this invention’ or ‘the present invention’**”).
- *SciMed Life Sys. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001) (“[T]he **characterization** of the coaxial configuration **as part of the ‘present invention’** is strong evidence that the claims should not be read to encompass the opposite structure.”).

Patentee Cannot Reclaim Subject Matter Given Up to Obtain the Patent Claims

- “The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.”

Omega Eng'g, Inc. v. Raytek Corp.,
334 F.3d 1314, 1323 (Fed. Cir. 2003)

- “A patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement. The prosecution history constitutes a public record of the patentee’s representations concerning the scope and the meaning of the claims, and competitors are entitled to rely on those representations when ascertaining the degree of lawful conduct.”

Springs Window Fashions LP v. Novo Indus., L.P.,
323 F.3d 989, 995 (Fed. Cir. 2003) (internal citations omitted)

Extrinsic Evidence: Dictionaries and Expert Testimony Are of Secondary Importance

“[W]hile extrinsic evidence can shed useful light on the relevant art, we have explained that it is less significant than the intrinsic record in determining the legally operative meaning of claim language.”

Phillips v. AWH Corp.,

415 F.3d 1303, 1317 (Fed. Cir. 2005) (internal citations omitted)

Extrinsic Evidence Is Less Reliable, Less Relevant, and Subject to Bias

“[E]xtrinsic evidence by definition is not part of the patent and **does not have the specification’s virtue of being created at the time of patent prosecution for the purpose of explaining the patent’s scope and meaning.** Second, while claims are construed as they would be understood by a hypothetical person of skill in the art, extrinsic publications may not be written by or for skilled artisans and therefore **may not reflect the understanding of a skilled artisan in the field of the patent.**”

Phillips v. AWH Corp.,

415 F.3d 1303, 1318 (Fed. Cir. 2005) (internal citations omitted) (emphasis added)

Plaintiffs Assert Improper Claim Construction Standards

- Plaintiffs employ a claim construction methodology that the Federal Circuit has rejected
- Plaintiffs cite a broad dictionary definition of a claim term, conclude that the specification contains no express disavowal of that definition, and then asserts that the broad dictionary definition is the correct construction
- The Federal Circuit emphatically rejected this approach in its *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005)

Phillips Rejected Texas Digital

“While the [*Texas Digital*] court noted that the specification must be consulted in every case, it suggested a methodology for claim interpretation in which the specification should be consulted only after a determination is made, whether based on a dictionary, treatise, or other source, as to the ordinary meaning or meanings of the claim term in dispute. Even then, recourse to the specification is limited to determining whether the specification excludes one of the meanings derived from the dictionary, whether the presumption in favor of the dictionary definition of the claim term has been overcome by an ‘explicit definition of the term different from its ordinary meaning,’ or whether the inventor ‘has disavowed or disclaimed scope of coverage by using words or expressing a manifest exclusion or restriction, representing a clear disavowal of claim scope.’”

Phillips v. AWH Corp.,
415 F.3d at 1320 (Fed. Cir. 2005)

Phillips Rejected Texas Digital

“In effect, the *Texas Digital* approach limits the role of the specification in claim construction to serving as a check on the dictionary meaning of a claim term if the specification requires the court to conclude that fewer than all the dictionary definitions apply, or if the specification contains a sufficiently specific alternative definition or disavowal.... That approach, in our view, improperly restricts the role of the specification in claim construction.”

Phillips v. AWH Corp.,
415 F.3d at 1320 (Fed. Cir. 2005)

***Phillips* Rejected Heavy Reliance on Dictionaries, Divorced From Intrinsic Evidence**

“The main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent. Properly viewed, the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent. Yet heavy reliance on its dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the claim term in the abstract, out of its particular context, which is the specification.”

Phillips v. AWH Corp.,
415 F.3d at 1321 (Fed. Cir. 2005)

Problem With Plaintiffs' Claim Construction Approach

“The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive.”

Phillips v. AWH Corp.,
415 F.3d at 1321 (Fed. Cir. 2005)

Plaintiffs Assert Improper Claim Construction Standards

- Plaintiffs also assert that the prosecution history must contain “clear and express disavowal” in order to be relevant for interpretation of claims
- This is contrary to the law
 - The prosecution history should be considered because it can “inform the meaning of the claim language by demonstrating how the inventor understood the invention.”

Phillips v. AWH Corp.,

415 F.3d at 1317 (Fed. Cir. 2005) (citation and quotations omitted)

- “[A] court should also consider the patent’s prosecution history,” which can “inform the meaning of the claim by demonstrating how the inventor understood the invention” and aid the court in excluding “any interpretation that was disclaimed during prosecution.”

Id.

The Inventor's Statements Against Interest Are Relevant to Claim Construction

- It is not proper to rely on **self-serving** testimony by an inventor during claim construction
 - *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.* 132 F.3d 701, 706 (Fed. Cir. 1997) (self-serving inventor testimony is dangerous because it may be an “after-the-fact attempt to state what should have been part” of the patent application)
- Here, however, Mr. Wexler's testimony contains statements against interest and is therefore relevant
 - *Evans Med. Ltd. v. American CynamidCo.*, 11 F.Supp.2d 338, 350 (S.D.N.Y. 1998), *aff'd* 215 F.3d 1347 (Fed. Cir. 1999) (allowing defendant to use inventor's deposition testimony where it was a “clear” and “positive” statement “that the position advanced by defendants as to the meaning of..the claims of his patents is absolutely correct, and that the construction for which plaintiffs contend is plainly wrong.”)
 - *Bristol-Myers Squibb Co. v. Teva Pharmaceuticals USA, Inc.*, 288 F. Supp. 2d 562, 586 (S.D.N.Y. 2003) (“Testimony against a patentee's own interest, however, is perhaps the ‘most persuasive extrinsic evidence.’”)

Disputed Terms in the '409 Patent

Summary of the Issues

- 1) The third-party accounting service must be an unbiased source of statistics (*i.e.*, its revenues do not depend on its accounting figures).
- 2) The browser must obtain the “first uniform resource locator” from the publisher’s Web site.
- 3) The accounting service redirects the user’s Web browser to the advertiser’s Web site.
- 4) A “banner” ad is an image ad, not a text ad.

How “Independent” Is the Accounting Service?

The Accounting Service Must Be Financially Independent

- Google's and WTS's constructions use similar language, but they have markedly different meanings.

Google position: the accounting service is financially independent

WTS position: the accounting service is separately owned and operated

The Accounting Service Must Be Financially Independent

- WTS agrees that the accounting service must be a “third-party” that is “independent.”

Google’s Construction	Plaintiffs’ Construction
<p>Fourth Web site: A Web site owned and operated independently from the first, second, and third Web sites, and that performs the function of an unbiased third- party accounting and statistical service</p>	<p>Fourth Web site: A Web site that is owned and operated by an entity that is independent from the entity(s) that own and operate the first, second, and third Web sites, and that performs the function of a third-party accounting and statistical service</p>

According to the Specification, the Accounting Service Must Be Financially Independent

- The patent specification expressly requires a “third party” accounting service.

[57]

ABSTRACT

A system and method for providing on-line third party accounting and statistical information is disclosed. A third party accounting service receives a download request signal ultimately intended for an advertiser Web site. The download request signal is generated when a user clicks on a banner displayed on a Web page of a frequently-visited Web site. The banner is published by the frequently-visited Web site for the benefit of the advertiser. The third party receives the download request since, rather than pointing to the advertiser Web site, the banner is configured to point to the third party Web site. The third party Web site maintains a count of all received download request signals generated by clicking on the banner. Since an advertiser banner may be displayed at more than one frequently-visited Web site, the third party Web site further maintains a log containing the address of the frequently-visited Web site that displayed the banner that generated the click, as well as other information provided by the user Web browser. The third party sends a redirect signal to the user Web browser causing it to send a download request to the advertiser Web site. The advertiser Web site then downloads the information originally sought by the user to his Web browser. The third party accumulates and tabulates statistical information including the number of clicks on the advertiser banner, and data indicative of the effectiveness of the banner-publisher frequently-visited Web site as an advertising medium. Such information is provided to the advertiser and/or the banner publisher.

According to the Specification, the Accounting Service Must Be Financially Independent

- The patent admits that advertisers and publishers already knew how to track “clicks” by October 1996.
- The supposed invention was a method for “unbiased” accounting – *i.e.*, accounting by a party with no financial interest in the statistics.

Regardless of the fee basis, both the advertiser and the administrator of the banner-publishing site will typically have an interest in knowing certain statistics pertaining to advertising effectiveness. For example, if the fee for the advertising is based on the number of clicks on the banner, then both parties will want this statistic. The advertiser can obtain this information by interrogating an access log maintained by the advertiser Web site. This information, however, is not directly available to the banner-publishing site. While it can be obtained from the advertiser, the publishing-site administrator would presumably prefer receiving the relevant statistics from an unbiased source.

According to the Specification, the Accounting Service Must Be Financially Independent

- The patent states that it addresses the need for an “unbiased” source of statistical and accounting information.

In view of the value of such statistics, and the relative inconvenience in obtaining such information, a need presently exists for an **unbiased**, readily available source of statistical/accounting information for Internet advertisers and advertising publishers.

'409 Patent, Col. 2, Ln. 31-35

According to the Prosecution History, the Accounting Service Must Be Financially Independent

- Mr. Wexler filed his patent application on October 11, 1996.
- The Patent Office rejected all claims in that application on July 13, 1998.
- The patent examiner found that the claims were “clearly anticipated by any single one” of several prior art references that disclosed a “third party which logs specific data concerning the path which a user took to get to that location, and a redirection operation which sends the user to their preferred location based on the advertisement which they ‘clicked’ in the first place.”

Office action dated July 13, 1998 at 3 (WTS000040)

According to the Prosecution History, the Accounting Service Must Be Financially Independent

- On November 18, 1998, Mr. Wexler argued that the prior art did not disclose an “independent” accounting site.

After studying the references, the claims have been amended to clarify the distinction between the present invention and the prior art. In light of these amendments, however, the applicant respectfully submits that the claims are now allowable.

Amendment dated November 18, 1998 at 5 (WTS000050)

- These arguments characterized “the present invention.”

According to the Prosecution History, the Accounting Service Must Be Financially Independent

- Mr. Wexler argued that the prior art only disclosed financially interested accounting – not financially independent accounting.

Second, the present invention enables the accounting site to be owned and operated by an independent entity — one that is not associated with either the publisher or the advertiser. A disadvantage with Internet accounting systems in the prior art is that the accounting is performed by either the publisher or by the advertiser. And because the amount of money paid by the advertiser to the publisher is dependent on the accounting statistics collected, there is, or is perceived to be, the temptation by the one doing the accounting to bias the statistics in its favor. In other words, advertisers don't completely trust publishers to be honest and publishers don't completely trust advertisers either.

Amendment dated November 18, 1998 at 6 (WTS000051)

- The “present invention” was a financially independent accounting service.

According to the Prosecution History, the Accounting Service Must Be Financially Independent

- Mr. Wexler compared his financially independent accounting service to the Nielsen Ratings Company.

The situation is analogous to that in television advertising. **Because television advertising fees are based on ratings, television stations don't trust advertisers to tally the ratings and advertisers don't trust television stations.** Therefore, the need existed for an independent entity to tally television ratings, which has been filled by the well-known A.C. Nielson Company.

In the same way that television advertising needed an independent entity to tally ratings, the Internet needs an independent entity to account for the referrals from publishers to advertisers. **The present invention** enables that independent entity.

Amendment dated November 18, 1998 at 6-7 (WTS000051-52)

- Mr. Wexler characterized this financially-independent accounting service as “the present invention.”

According to the Prosecution History, the Accounting Service Must Be Financially Independent

- On February 9, 1999, the Patent Office rejected the claims for a second time.
- On April 9, 1999, Mr. Wexler meet with the patent examiner to object to the examiner's characterization of the claims and the prior art.
- On May 3, 1999, Mr. Wexler submitted a second amendment and a summary of the April 9 meeting.

The applicant wishes to thank Examiner Stamber for the interview at the USPTO last Thursday and includes the following remarks, which summarize the discussion at the interview. Therefore, reconsideration is respectfully requested in light of the above amendments and the following remarks.

Amendment dated May 3, 1999, at 2 (WTS000068)

According to the Prosecution History, the Accounting Service Must Be Financially Independent

- Mr. Wexler again emphasized that the “present invention” was a financially independent accounting service.

Second, **the present invention** enables the accounting site to be owned and operated by an independent entity — one that is not associated with either the publisher or the advertiser. A disadvantage with Internet accounting systems in the prior art is that the accounting is performed by either the publisher or by the advertiser. And **because the amount of money paid by the advertiser to the publisher is dependent on the accounting statistics collected, there is, or is perceived to be, the temptation by the one doing the accounting to bias the statistics in its favor.** In other words, advertisers don't completely trust publishers to be honest and publishers don't completely trust advertisers either.

For example, it is contemplated that the system of Kirsch is to be operated by a publisher (e.g., In/Touch, Yahoo, etc.) and the system of Greber I, Greber II and Greber III is to be operated by the advertiser (e.g., Amazon.com, ebay.com, etc.), but the present invention can be operated by an independent entity that is neither the publisher nor the advertiser.

The situation is analogous to that in television advertising. **Because television advertising fees are based on ratings, television stations don't trust advertisers to tally the ratings and advertisers don't trust television stations.** Therefore, the need existed for an independent entity to tally television ratings, which has been filled by the well-known A.C. Nielsen Company.

In the same way that television advertising needed an independent entity to tally ratings, the Internet needs an independent entity to account for the referrals from publishers to advertisers. **The present invention** enables that independent entity.

Characterizations of the “Present Invention” Limit the Claim Terms

- “When a patent thus describes the features of the ‘present invention’ as a whole, **this description limits the scope of the invention.**”

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503 F.3d 1295, 1308 (Fed. Cir. 2007)

- “[C]haracterization...as part of the ‘present invention’ is strong evidence that the claims should not be read to encompass the opposite structure.”

SciMed Life Sys. v. Advanced Cardiovascular Sys., Inc.,
242 F.3d 1337, 1343 (Fed. Cir. 2001)

Statements Made During Prosecution Limit the Scope of the Claims

- “[B]y distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover.”

Ekchian v. Home Depot, Inc.,

104 F.3d 1299, 1304 (Fed. Cir. 1997)

- “Claims should not be construed one way in order to obtain their allowance and in a different way against accused infringers.”

Computer Docking Station Corp. v. Dell, Inc.,

519 F.3d 1366, 1374 (Fed. Cir. 2008)

Mr. Wexler Admits Google's Construction Is Correct

- Mr. Wexler confirmed during his deposition that his alleged invention was an independent, unbiased third-party service with no financial interest in the statistics it would collect.

Q. Right. For example, you wanted to make sure that the numbers – the click-through numbers were as accurate as possible, correct?

A. Yes.

Q. And one way to do that was to make sure that parties that had an interest in the number being higher, for example, like the advertiser, were not actually doing the tracking; is that right?

A. Yes.

* * *

Q. But, on the other hand, it is like having an independent accounting firm or the Nielsen ratings, you want to make sure that it is an unbiased source, so that not even an issue; is that fair?

A. Yes.

Mr. Wexler Admits Google's Construction Is Correct

- In his deposition, Mr. Wexler admitted that the third-party accounting site he considered his invention was not paid based on the number of clicks it recorded:

Q. And just as Nielsen presumably didn't have a financial interest in the data that it was reporting, neither did your third-party site?

A. **My company was not**, you know, **paid by the click** and we had no motivation to report things that wouldn't be true.

Wexler Deposition, 287:9-18 (objection omitted)

Mr. Wexler Admits Google's Construction Is Correct

- Mr. Wexler also admitted that “third-party” accounting requires an unbiased, trusted source of statistical information:

Q. When you use the term “third party,” what are you referring to?

A. In my opinion, a third party is a party who is believable by two sides, who has credibility, and is trusted, basically they have confidence, party A and party B has confidence in party C that they are going to be truthful and give accurate statistics.

Wexler Deposition, 8:25-9:11 (objection omitted)

Mr. Wexler Admits Google's Construction Is Correct

- Mr. Wexler's statements against interest are relevant to claim construction.
 - *Evans Med. Ltd. v. American Cyanamid Co.*, 11 F.Supp.2d 338, 350 (S.D.N.Y. 1998), *aff'd* 215 F.3d 1347 (Fed. Cir. 1999) (allowing defendant to use inventor's deposition testimony where it was a "clear" and "positive" statement "that the position advanced by defendants as to the meaning of...the claims of his patents is absolutely correct, and that the construction for which plaintiffs contend is plainly wrong.")
 - *Bristol-Myers Squibb Co. v. Teva Pharmaceuticals USA, Inc.*, 288 F. Supp. 2d 562, 586 (S.D.N.Y. 2003) ("Testimony against a patentee's own interest, however, is perhaps the 'most persuasive extrinsic evidence.'")

WTS Admits Google's Construction Is Correct

- WTS admits the “focus” of the “independent third party” is the “perception” of bias created “because the amount of money paid by the advertiser to the publisher is *dependent on the accounting statistics collected.*”

Moreover, Wexler does not purport to preclude every potential for bias. Rather, the focus is on the *perception* of bias if either the publisher or the advertiser is the source of the accounting statistics. As stated in the prosecution history:

And because the amount of money paid by the advertiser to the publisher is dependent on the accounting statistics collected, there is, *or is perceived to be*, the temptation by the one doing the accounting to bias the statistics in its favor. In other words, advertisers don't completely trust publishers to be honest and publishers don't completely trust advertisers either.

WTS Markman Br. at 18

- Accordingly, the third party in the '409 patent cannot receive money that is dependant on the accounting statistics collected.

WTS Admits Google's Construction Is Correct

- WTS admits that the third party accounting service must **also** be “trustworthy” and “reliable.”

Wexler reduces this perception

by disclosing a third party accounting service that both the publisher and advertiser consider to be **reliable**. As such, Wexler discloses a method that precludes the need for the advertiser and publisher **to trust or rely** on each other to provide accurate statistical information.

WTS Markman Br. at 18

- Plainly, a biased third party would not be considered trustworthy or reliable.

WTS Admits Google's Construction Is Correct

Problem: Disparity In Click Statistics

- Advertiser's statistics did not match with publisher's statistics
- Technical failures
 - Connectivity failures, browser crashes, server crashes
- Inherent distrust between advertiser and publisher when either one of them doing the counting
 - Publisher counting double clicks or invalid clicks

- Inherent distrust between advertiser and publisher when either one of them doing the counting
 - Publisher counting double clicks or invalid clicks
 - Publisher overstating number of clicks
 - Advertiser understating statistics

WTS Technology Tutorial Ex. A, at 6

- WTS admits there is “inherent distrust” when financially-interested parties are “doing the counting.”

WTS Admits Google's Construction Is Correct

- WTS even claims that the primary difference between Google's construction and WTS's construction – the word “unbiased” – would be “**redundant.**”

Plaintiffs' construction addresses the concern of bias by requiring that the fourth Web site be owned and operated by an entity that is neither the publisher nor the advertiser. To insert the term “unbiased” into this definition is redundant. Such redundancy injects significant potential for jury confusion, in that it may suggest that something more is required.

WTS Markman Br. at 19

- If merely “redundant,” then the claim should be construed to clearly exclude third parties whose revenue depends upon the statistics they collect.

WTS Is Trying to Avoid the Issue of Financial Bias

- In light of these admissions, *why is this term still **disputed**?*
- WTS apparently plans to argue to the jury that a financially-biased accounting service is covered by the claims.
- In its response brief, WTS contends that an accounting service not owned by the publisher or the advertiser meets the “fourth Web site” limitation even if its revenues **depend on** the number of click-throughs recorded.

WTS Response Br. at 3

WTS Is Trying to Avoid the Issue of Financial Bias

- But the unbiased third-party accounting service is the **entire invention** – everything else was already disclosed in the prior art.

FIG. 1

PRIOR ART

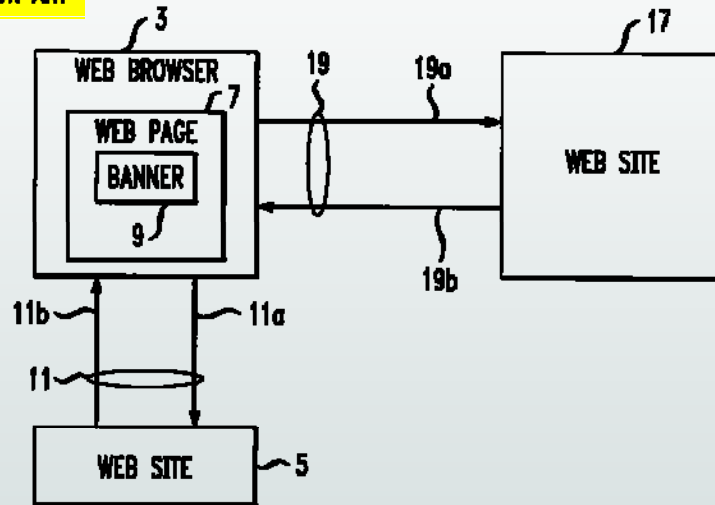
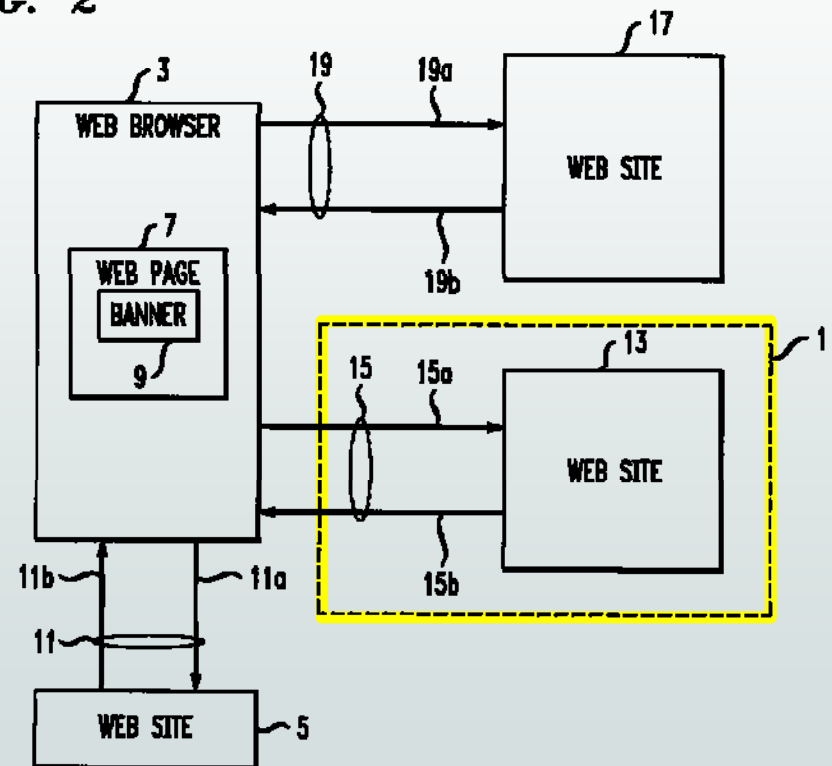


FIG. 2



WTS Is Trying to Avoid the Issue of Financial Bias

- In a footnote, WTS's response brief **concedes** that the claims require more than separate ownership.

Google further misstates Plaintiffs' position as requiring only that the Web sites be owned by different legal entities. That is not Plaintiffs' position at all. To the contrary, Plaintiffs' construction requires that the third party accounting Web site be "owned *and operated*" by an entity that is independent from the entity that "owns *and operates*" the other Web sites. **This construction does not limit the required independence to mere ownership of the Web sites by different legal entities.**

WTS Response Br. at 7 n.5

- But WTS does not explain what, other than ownership, it would require.
- WTS tries to appear in line with the prosecution history – but actually is at odds with that record.

WTS Is Trying to Avoid the Issue of Financial Bias

- WTS's opening brief selectively parses and quotes the prosecution history to support their construction (WTS Br. at 15-16).

Cited by Plaintiffs

Second, the present invention enables the accounting site to be owned and operated by an independent entity — one that is not associated with either the publisher or the advertiser. A disadvantage with Internet accounting systems in the prior art is that the accounting is performed by either the publisher or by the advertiser. And because the amount of money paid by the advertiser to the publisher is dependent on the accounting statistics collected, there is, or is perceived to be, the temptation by the one doing the accounting to bias the statistics in its favor. In other words, advertisers don't completely trust publishers to be honest and publishers don't completely trust advertisers either.

For example, it is contemplated that the system of Kirsch is to be operated by a publisher (e.g., Infoseek, Yahoo, etc.) and the system of Graber I, Graber II and Graber III is to be operated by the advertiser (e.g., Amazon.com, ebay.com, etc.), but the present invention can be operated by an independent entity that is neither the publisher nor the advertiser.

The situation is analogous to that in television advertising. Because television advertising fees are based on ratings, television stations don't trust advertisers to tally the ratings and advertisers don't trust television stations. Therefore, the need existed for an independent entity to tally television ratings, which has been filled by the well-known A.C. Nielson Company.

In the same way that television advertising needed an independent entity to tally ratings, the Internet needs an independent entity to account for the referrals from publishers to advertisers. The present invention enables that independent entity.

Ignored by Plaintiffs

WTS Is Trying to Avoid the Issue of Financial Bias

- But Mr. Wexler argued that the “present invention” – the independent third-party accounting service – was different than the prior art because it was financially independent.

Second, the present invention enables the accounting site to be owned and operated by an independent entity — one that is not associated with either the publisher or the advertiser. A disadvantage with Internet accounting systems in the prior art is that the accounting is performed by either the publisher or by the advertiser. And because the amount of money paid by the advertiser to the publisher is dependent on the accounting statistics collected, there is, or is perceived to be, the temptation by the one doing the accounting to bias the statistics in its favor. In other words, advertisers don't completely trust publishers to be honest and publishers don't completely trust advertisers either.

WTS000051

- WTS cannot rewrite history to erase the allegedly novel aspect of the patent.

WTS Is Trying to Avoid the Issue of Financial Bias

- WTS's response brief only addresses these statements concerning the Nielsen ratings company in a **footnote**.

The analogy to Nielsen was without regard for who pays Nielsen or the manner in which Nielsen's compensation is calculated.

WTS Response Br. at 5 n.4

- To the contrary, Mr. Wexler's statements to the Patent Office **directly addressed** payment methods.

The situation is analogous to that in television advertising. **Because television advertising fees are based on ratings, television stations don't trust advertisers to tally the ratings and advertisers don't trust television stations.** Therefore, the need existed for an independent entity to tally television ratings, which has been filled by the well-known A.C. Nielson Company.

In the same way that television advertising needed an independent entity to tally ratings, the Internet needs an independent entity to account for the referrals from publishers to advertisers. **The present invention** enables that independent entity.

Amendment dated November 18, 1998 at 6-7 (WTS000051-52)

The Claims Require More Than an Agreement Between the Publisher and Advertiser

- According to WTS, any accounting service that the publisher and the advertiser agree to use is unbiased.

As discussed below, by agreeing upon an independent third party to be the provider of the accounting and statistical information, both the publisher and advertiser express their belief that the third party is credible and trustworthy, and that it will be truthful and will provide accurate statistics.

WTS Response Br. at 8

The Claims Require More Than an Agreement Between the Publisher and Advertiser

- But in the prior art, the publisher and advertiser agreed upon a party to provide accounting statistics.
 - This agreement did not express a belief that the party keeping the statistics was credible and trustworthy.
 - WTS admits that this agreement actually came with “inherent distrust.”

WTS Response Br. at 3

- Contrary to WTS’s argument, an agreement to use a financially-interested party for the accounting is **an agreement not to use the patent.**

How Is the “First Uniform Resource Locator” Obtained?

The First URL Is Downloaded From The First Web Site

- The dispute relates to the “first uniform resource locator” – *i.e.*, the target address of the advertisement – mentioned in Claim 1.

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish advertising for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with advertising for the advertiser;

'409 Patent, Col. 6, Ln. 30-39

The First URL Is Downloaded From The First Web Site

Google's Construction

The first uniform resource locator is part of the Web page generated by the first Web site and downloaded from the first Web site to the first user's Web browser.

Plaintiffs' Construction

The first uniform resource locator is acquired as a result of interaction between the first user's Web browser and the first Web site (for example, as a result of downloading a Web page from the first Web site or as a result of clicking on a link or an advertisement on the first publisher's Web page as displayed in the first user's browser).

According to the Plain Claim Language, the First URL Is Downloaded From the First Web Site

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish advertising for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with advertising for the advertiser;

'409 Patent, Col. 6, Ln. 30-39

The First URL Is Downloaded From the First Web Site

- The “starting point for any claim construction must be the claims themselves.”

Pitney Bowes, Inc. v. Hewlett-Packard Co.,
182 F.3d 1298, 1305 (Fed. Cir. 1999)

- “[C]ourts may not redraft claims,” as this would “interfere with the function of claims in putting competitors on notice of the scope of the claimed invention.”

Lucent Tech. Inc. v. Gateway, Inc.,
525 F.3d 1200, 1215 (Fed. Cir. 2008)

- “Where the plain import of the language is clear, the court will not engage in speculative interpretation.”

AngeloMongiello’s Children, LLC v. Pizza Hut, Inc.,
70 F.Supp.2d 196, 203 (E.D.N.Y. 1999)

According to the Specification, the First URL Is Downloaded From the First Web Site

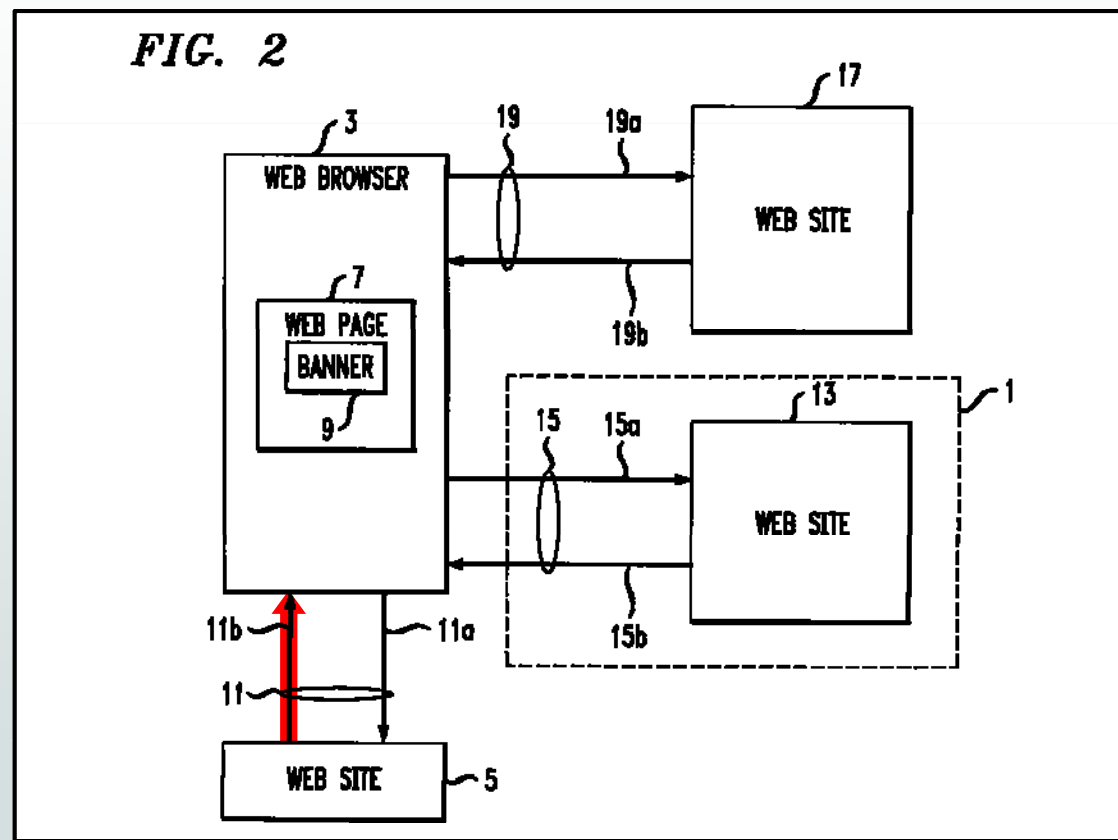
- The specification says that when the user requests the publisher's Web site, the user's Web browser downloads the publisher's Web page.

As described above for conventional systems, the link 11 to the Web site 5 is established by entering the URL of the Web site 5 into the Web browser 3. Once the link 11 is established, the Web browser 3 sends a download request signal 11a to the Web site 5. In response, the Web site 5 downloads information, indicated by the reference numeral 11b, to the user's Web browser 3. The downloaded information includes a copy of the requested hypertext source file operable to generate a Web page 7 having a banner 9.

'409 Patent, Col. 4, Ln. 28-36

According to the Specification, the First URL Is Downloaded From the First Web Site

- This download process is illustrated in Figure 2.



According to the Specification, the First URL Is Downloaded From the First Web Site

- The specification states that this Web page, downloaded from the first Web site, “includes the URL.”

According to operation block 101, the hypertext file that generates the Web page 7 and the banner 9 is edited or originally coded so that the banner 9 is operable, in conjunction with the user's Web browser 3, to form a hypertext link to the third party Web site 13 when clicked upon. The aforementioned coding includes the URL pointing to the third party site 13.

'409 Patent, Col. 4, Ln. 47-53

Plaintiffs Rewrite the Claim Language

- The claim says the first URL comes “from the first Web site.”
- Plaintiffs say the first URL may come “from any source, including a Web site other than the publisher’s Web site.”

WTS Br. at 21

receiving, at a fourth Web site, a first uniform resource locator from a first user’s Web browser, wherein the first uniform resource locator is obtained by the first user’s Web browser ~~from the first Web site~~ and wherein the first uniform resource locator is associated with advertising for the advertiser;

WTS Ignores the Patent Specification

- WTS claims that “There is no explicit teaching that the hypertext source file that is downloaded to the user’s browser must include the actual advertisement or URL.”

WTS Response Br. at 16

- To the contrary, the specification expressly says the HTML file “*includes the URL* pointing to the third party site 13.”

'409 Patent, Col. 4, Ln. 52-53

- **No other method of URL delivery is disclosed.**

WTS Ignores the Prosecution History

- In the initial patent application, Claim 1 only required a “download request signal” that was “ultimately intended for the advertiser’s Web site”

Application Filed October 11, 1996 (WTS000027)

- After the claim was rejected, Mr. Wexler narrowed the claim to require a “first uniform resource locator” that was “obtained by the first user’s Web browser from the first Web site”

Amendment Dated November 18, 1998 (WTS000046)

WTS Ignores the Prosecution History

- WTS says this amendment was only for “clarity,” not to limit the claim.

Wexler amended Claim 1 to provide for multiple publishers, multiple users and multiple URLs, rather than a single publisher, single user and single URL. Ex. B, at WTS 46-47. Once the claim was amended to provide for multiple publishers, users and URLs, it only made sense, for purposes of clarity, to specify each Web site from which each user obtained each URL. Thus, the amendment was made to clarify the invention, not to limit it, and nothing in the prosecution history indicates otherwise.

WTS Ignores the Prosecution History

- But the prosecution history says this amendment was made “to clarify the distinction between the present invention and the prior art.”

Claims 1-9 were examined and rejected under 35 U.S.C. 103. Claims 1-9 have been amended to clarify the distinction between the present invention and the prior art and claims 10 and 11 have been added. Therefore, reconsideration is respectfully requested in light of the above amendments and the following remarks.

Amendment Dated November 18, 1998 (WTS000050)

- This is the **definition** of a narrowing amendment.

WTS Improperly Relies on Extrinsic Evidence

- WTS ignores the intrinsic evidence.
- Instead, it focuses on two dictionary definitions from 1989 for the words “obtain” and “download.”

obtain (əb'teɪn), *v.* Forms: 5-6 ob-, op-, -teyne, -teyne, -teigne, -teygne, (5 optyne), 6 obtaigne, opteine, (*Sc.* obtene, obtine, optene), 6-7 obteine, -taine, (optain(e), 7 *Sc.* obtean), 6- obtain. [ME. *obtaine*, -teyne, -tene, a. F. *obten-ir* (14th c. in Littré), ad. L. *obtinēre*, f. *ob-* (OB- 1 b) + *tenēre* to hold, keep. Cf. CONTAIN.]

1. *trans.* To come into the possession or enjoyment of (something) by an individual or by request; to obtain something in itself, of purpose and effort; hence, generally, to acquire.

download (-daʊnləʊd), *sb.* *Computing.* [f. DOWN *adv.* + LOAD *sb.*] The action or process of downloading.

1977 *Sci. Amer.* Sept. 160/1 Changes at this stage are readily achieved by a simple process of re-edit, assemble and download. 1985 *Personal Computer World* Feb. 122/1 The feature which will appeal to most telecommunications people... is the download and upload routine.

download (-daʊn'ləʊd, 'daʊn-), *v.* *Computing.* [f. DOWN *adv.* + LOAD *v.*] *trans.* To transfer (esp. software) from a remote stage of a larger system to that of a smaller one.

WTS Br. Ex. C

WTS Improperly Relies on Extrinsic Evidence

- These definitions are irrelevant.
- The specification explains how the URL is obtained.
- Extrinsic evidence cannot overcome that intrinsic evidence.

Philips,
415 F.3d at 1318-19

WTS Improperly Relies on Extrinsic Evidence

- WTS's dictionary definitions are outdated.
- They date from **1989**, but the patent was filed in **1996**.
- According to the patent, Internet-related concepts were relatively unknown **before 1991**.

Until as recently as five years ago, the Internet was used primarily by the scientific and technical community and was relatively unknown outside of such circles. And now, five years hence, knowledge of the Internet, and its use, are ubiquitous.

'409 Patent, Col. 1, Ln. 9-13

How the Accounting Service Redirects the User's Web Browser to the Advertiser

The Redirect Message Is the Response Message Sent on Receipt of the Click

- The dispute relates to two terms in two claims that describe how the accounting service redirects the user's Web browser to the advertiser's Web site.

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish advertising for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the first uniform resource locator, in response to the receipt of the first uniform resource locator;

redirecting, at the fourth Web site, the first user's Web browser to the third Web site in response to the receipt of the first uniform resource locator;

receiving, at the fourth Web site, a second uniform resource locator from a second user's Web browser, wherein the second uniform resource locator is obtained by the second user's Web browser from the second Web site and wherein the second uniform resource locator is associated with advertising for the advertiser;

logging, at the fourth Web site, the receipt of the second uniform resource locator, in response to receiving the second uniform resource locator; and

redirecting, at the fourth Web site, the second user's Web browser to the third Web site in response to the receipt of the second uniform resource locator.

'409 Patent, Col. 6, Ln. 30-59

9. A method comprising:

receiving a first uniform resource locator from a first browser, wherein the first uniform resource locator is obtained by the first browser from a first Web site that publishes advertising for an advertiser;

logging, in response to the receipt of the first uniform resource locator, the receipt of the first uniform resource locator;

transmitting, in response to the receipt of the first uniform resource locator, a second uniform resource locator to the first browser, wherein the second uniform resource locator is associated with a second Web site that is associated with the advertiser;

receiving a third uniform resource locator from a second browser, wherein the third uniform resource locator is obtained by the second browser from a third Web site that publishes advertising for the advertiser;

logging, in response to the receipt of the third uniform resource locator, the receipt of third uniform resource locator; and

transmitting a fourth uniform resource locator to the second browser, wherein the fourth uniform resource locator is associated with the second Web site.

'409 Patent, Col. 9, Ln. 3-25

The Redirect Message Is the Response Message Sent on Receipt of the Click

Google's Construction	Plaintiffs' Construction
<p>Redirecting to the third Web site as the response to the first browser's request containing the first uniform resource locator</p>	<p>Either needs no construction, or should be construed according to the plain and ordinary meaning of claim language subject to the term "redirecting"</p>
<p>Transmitting, as the response to the first browser's request that contains the first uniform resource locator, a second uniform resource locator to the first browser</p>	<p>Needs no construction, and if it is to be construed, should be construed as its "plain and ordinary meaning"</p>

The Patent Specification Supports Google

- The patent incorporates various standard protocols for network communication.
- These protocols were known to those of skill in the art.

The present invention can be implemented over a network such as the Internet. It is understood that such a network is comprised of many computers linked over telecommunication lines and communicating using various standard protocols. Servers, which are programs that provide Internet resources (e.g, a Web page), and clients, which are programs that access those resources on a user's behalf (e.g., a Web browser), are resident on such computers. Details concerning such computers and software, and the process of establishing communication links are known to those skilled in the art and will not be described herein except as appropriate for an understanding of the present invention.

The Patent Specification Supports Google

- These protocols include the Hypertext Transfer Protocol (HTTP), the computer language underlying the Internet.

In one embodiment, operation blocks 105 and 107 can be accomplished as follows. A **Hypertext Transfer Protocol (HTTP)** server program at the third party's site 13 is configured to issue a "302" redirect response when a specific URL is requested. Such configuration involves editing a configuration file for the HTTP server program. When the specific URL is requested, the request itself and Web browser 3 information is recorded, and the redirect to the intended URL, i.e., the advertiser's Web site, is issued. In this manner, the user is transparently redirected to the advertiser's Web site 17.

'409 Patent, Col. 5, Ln. 13-23

The Patent Specification Supports Google

- The specification references HTTP redirect response messages.

In one embodiment, operation blocks 105 and 107 can be accomplished as follows. A Hypertext Transfer Protocol (HTTP) server program at the third party's site 13 is configured to issue a "302" redirect response when a specific URL is requested. Such configuration involves editing a configuration file for the HTTP server program. When the specific URL is requested, the request itself and Web browser 3 information is recorded, and the redirect to the intended URL, i.e., the advertiser's Web site, is issued. In this manner, the user is transparently redirected to the advertiser's Web site 17.

'409 Patent, Col. 5, Ln. 13-23

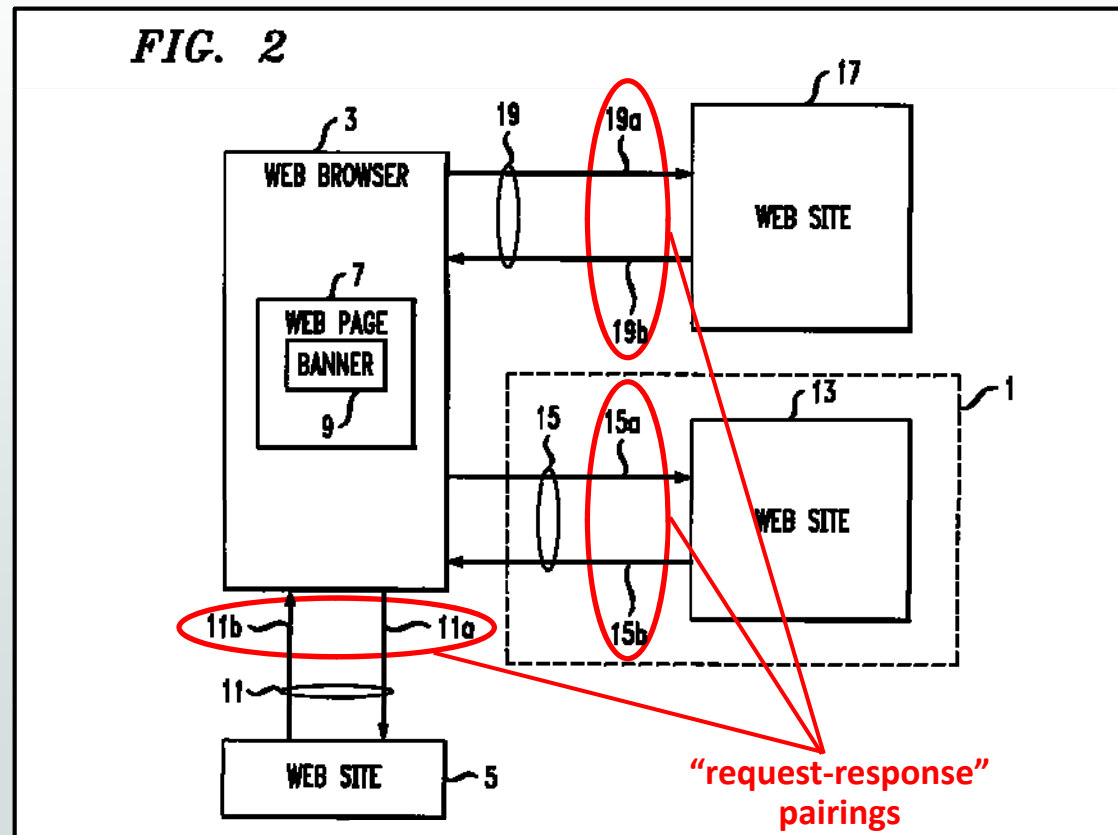
The Patent Specification Supports Google

- The HTTP protocol includes several different types of redirect response messages:
 - 301 redirect response
 - 302 redirect response
 - 303 redirect response
 - 307 redirect response

See HTTP1.1 Specification, www.w3.org/Protocols/rfc2616/rfc2616.html

According to the Patent Figures, the Redirect Message Is the Response Message Sent on Receipt of the Click

- All HTTP messages occur in “request-response” pairs.
- The “request” message and the “response” message are two halves of a single exchange.



WTS Admits HTTP Is a “Request-Response” Language

- “[T]he HTTP protocol is an example of a client-server protocol, in which the client (the Web browser) sends requests to the server (the Web server), which responds to client requests.”

WTS Tutorial at 11

- “[T]he Web browser and Web server communicate in the HTTP protocol through multiple request and response messages.”

WTS Tutorial at 15

- “[T]he HTTP protocol [] utilizes a request-response pairing format.”

WTS Response Br. at 19

- **“There is no dispute that the HTTP protocol utilizes request-response pairings.”**

WTS Response Br. at 20

The Redirect Message Is the Response Message Sent on Receipt of the Click

- One of ordinary skill would read the words “request” and “response” in the claims to mean the paired “request” and “response” messages discussed in the specification.
- “[A]bsent some particular reason to do otherwise, the claim terms must be interpreted as would one of ordinary skill in the art.”

Medrad, Inc. v. MRI Devices Corp.,

401 F.3d 1313, 1319 (Fed. Cir. 2005)

WTS's Argument That the Redirect Response Is Not Paired to the Request for the First URL Is Meritless

- WTS argues for a very broad construction of this term, under the guise of “plain and ordinary meaning.”

Any process that ultimately redirects the first user's Web browser to the advertiser's Web site, following receipt of the first URL at the fourth Web site/third party accounting service, meets this claim element.

WTS Br. at 25

- WTS's proposed construction places **no limits** on the meaning of the term.
- Any process can qualify, as long as the user ends up at the advertiser's Web site.

WTS's Claim Differentiation Arguments Are Factually Incorrect

- According to WTS, the differences between Claim 1 and Claim 5 support their construction under the doctrine of claim differentiation.
- WTS confuses two separate issues:
 - The **type** of redirect response messages
 - The **number** of redirect response messages

WTS's Claim Differentiation Arguments Are Factually Incorrect

- The HTTP protocol includes multiple different redirect response message **types**:
 - 301 redirect response
 - 302 redirect response
 - 303 redirect response
 - 307 redirect response
- Claim 1 can be **any type** of redirect response: 301, 302, 303, 307, or some other non-HTTP redirect response message.
- Claim 5 must be a 302 redirect response.

WTS's Claim Differentiation Arguments Are Factually Incorrect

- Nothing in Claim 5 addresses the **number** of redirect messages.
 - Claim 5 picks a type of redirect response message – the 302 redirect response message type
 - Claim 5 does not say that there can be “multiple intermediate redirects”
- With respect to the **number** of redirect messages used, Claim 1 and Claim 5 have the same scope.
 - In both, there is only a single redirect in response to the receipt of the first uniform resource locator.

WTS Br. at 28

The Patent Does Not Contemplate “Intermediate Redirects”

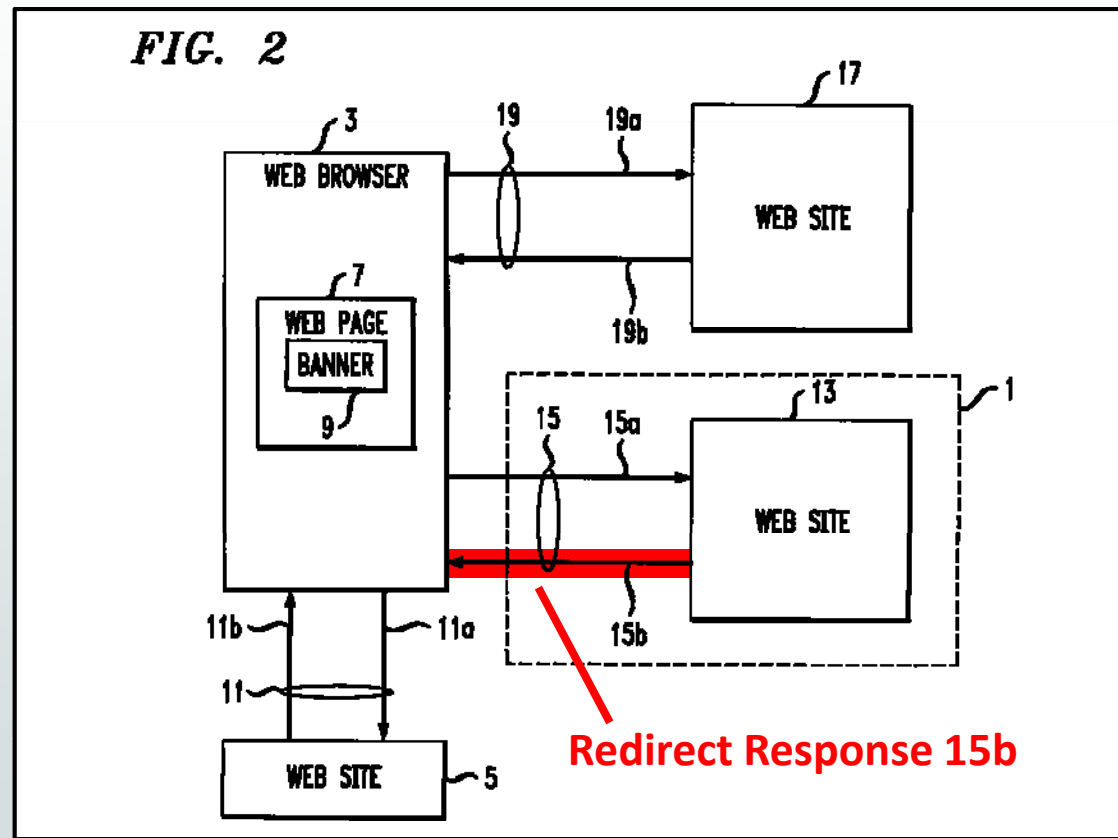
- WTS claims that “Google’s construction would thereby **preclude embodiments** of the claimed invention whereby, upon receipt of the URL, the third party site issues intermediate redirects before redirecting the user’s browser to the advertiser’s Web site.”

WTS Response Br. at 20

- But WTS cites no such embodiments.

The Patent Does Not Contemplate “Intermediate Redirects”

- In fact, there is only one embodiment, with one redirect.



The Patent Does Not Contemplate “Intermediate Redirects”

- The portion of the specification WTS cites (Response Br. at 21) addresses logging – not intermediate redirects.

The third party service 13 accepts the download request signal 15a and increments a counter that keeps track of the number of received request signals, as indicated in operation block 105. Additionally, the third party service 13 logs a variety of information available from the user's Web browser 3. Such information can include the origin of the user, the address of the banner publisher, and so forth. In this manner, the third party service 13 accumulates statistical information useful to the banner publisher and the advertiser.

'409 Patent, Col. 4, Ln. 58-67

The Patent Does Not Contemplate “Intermediate Redirects”

- In its response brief, WTS points to the word “comprising” to support its construction. (WTS Response Br. at 22.)
- “Comprising” claims cover methods that perform all claimed steps, and also perform **additional** steps.
 - The word “comprising” does not alter the elements **already** in the claim.
 - If claim elements are not satisfied, “comprising” language is irrelevant.
- *Spectrum Int’l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1379-80 (Fed. Cir. 1998) (affirming summary judgment of non-infringement; “[c]omprising’ is not a weasel word with which to abrogate claim limitations”).

The Patent Does Not Contemplate “Intermediate Redirects”

- The concept of intermediate redirects is inconsistent with the agreed construction of “redirecting.”
 - **Redirecting:** “transferring or pointing from one place to another, for example from one Web site to another Web site or from one node to another node.”
- The claim language expressly requires a redirect from “the fourth Web site” to “the third Web site in response to the receipt of the first uniform resource locator.”

redirecting, at the fourth Web site, the first user’s Web browser to the third Web site in response to the receipt of the first uniform resource locator;

- To permit multiple, undisclosed “intermediate redirects” would rewrite the claim language.

How “Banner” Advertising Is Different Than Other Advertising

Banner Advertisements Are Image Advertisements

Google's Construction	Plaintiffs' Construction
<p>An area of a Web page used to display logos or other graphical images</p>	<p>An area of a Web page that can be used to display logos, advertisements, or other content to potentially entice a user to obtain further information pertaining to the banner or to connect to an advertiser's Web site</p>

According to the Specification, Banner Advertisements Are Image Advertisements

- The specification repeatedly and consistently describes a “banner” as an area used to display graphics, such as a company’s logo.

The banner describes an area of a Web page that can be used to display logos, etc., that will hopefully entice the reader to obtain further information pertaining to the banner.

'409 Patent, Col. 1, Ln. 49-51

The banner 9 is an area of the Web page 7 that can be used to display logos, etc., that will hopefully entice a user reading the banner to obtain further information pertaining to the banner.

'409 Patent, Col. 3, Ln. 54-58

According to Claim Differentiation Principles, Banner Advertisements Are Image Advertisements

1. A method for accounting, wherein a first publisher having a first Web site and a second publisher having a second Web site each publish **advertising** for an advertiser having a third Web site, the method comprising:

receiving, at a fourth Web site, a first uniform resource locator from a first user's Web browser, wherein the first uniform resource locator is obtained by the first user's Web browser from the first Web site and wherein the first uniform resource locator is associated with **advertising** for the advertiser;

'409 Patent, Claim 1

2. The method of claim 1 wherein the advertising published by the first publisher is a first **banner** that is associated with the first uniform resource locator and the advertising published by the second publisher is a second **banner** that is associated with the second uniform resource locator.

'409 Patent, Claim 2

According to Claim Differentiation Principles, Banner Advertisements Are Image Advertisements

- “Banner” narrows Claims 1, 7, and 9 by limiting them to image advertisements.
 - “[D]ependent claims are presumed to be of narrower scope than the independent claims from which they depend.”

AK Stell Corp. v. Sollac and Ugine,
344 F.3d 1234, 1242 (Fed. Cir. 2003)

WTS's Definition Is Inconsistent With Claim Differentiation Principles

- WTS's construction of "banner" captures any online advertising, and does not limit Claim 1, Claim 7, or Claim 9 in any way.
- This violates the claim differentiation principles WTS itself asks this Court to apply.
 - "The principle of claim differentiation...provides that a dependent claim further limits the claim scope of the independent claim from which it depends. The claim scope of the independent claim, therefore, is necessarily broader than the scope of the dependent claim that directly or indirectly depends from the independent claim.

Acumed LLC v. Stryker Corp.,
483 F.3d 800, 806 (Fed. Cir. 2007); (WTS Br. at 27)

WTS's Construction Would Lead to Absurd Results

- Google explained in its opening brief that WTS's construction would cover the text of a news story:

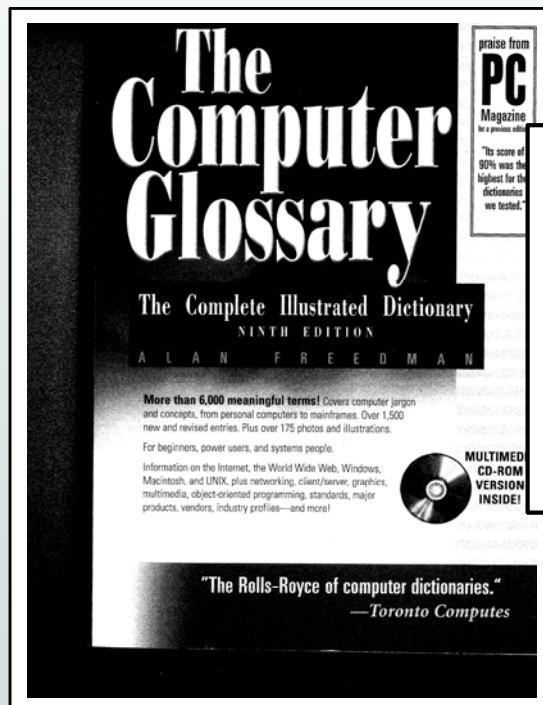
The text of the story is “content” displayed on the newspaper’s Web page, and the text could “potentially entice” the reader to “obtain further information pertaining to the [text].”

Google Br. at 35

- WTS **does not dispute this fact** in their response brief.

According to the Ordinary Meaning, Banner Advertisements Are Image Advertisements

- In 1996, and through at least 2001, “banner” referred to image advertisements – not other non-graphical types of advertising.



banner ad

A graphic image used on a Web site to advertise a product or service. Banner ads (ad banners) are typically 460 pixels wide by 60 pixels high.

The Computer Glossary: The Complete Illustrated Dictionary (9th Ed. 2001) at 26

According to Mr. Wexler's Testimony, Banner Advertisements Are Image Advertisements

- Mr. Wexler admitted that he understood “banner” to mean “image” in 1996.

Q. And what's a banner?

A. In my understanding?

Q. Yes.

A. My understanding of the banner was **the graphic, the JIF file**, that was part of the advertisement.

Ex. C, Wexler Dep. Tr. 242:22-243:3

The Inventor's Statements Against Interest Are Relevant to Claim Construction

- Mr. Wexler's testimony contains statements against interest and is therefore relevant
 - *Evans Med. Ltd. v. American Cyanamid Co.*, 11 F.Supp.2d 338, 350 (S.D.N.Y. 1998), *aff'd* 215 F.3d 1347 (Fed. Cir. 1999) (allowing defendant to use inventor's deposition testimony where it was a "clear" and "positive" statement "that the position advanced by defendants as to the meaning of...the claims of his patents is absolutely correct, and that the construction for which plaintiffs contend is plainly wrong.")
 - *Bristol-Myers Squibb Co. v. Teva Pharmaceuticals USA, Inc.*, 288 F. Supp. 2d 562, 586 (S.D.N.Y. 2003) ("Testimony against a patentee's own interest, however, is perhaps the 'most persuasive extrinsic evidence.'")

The Inventor's Statements Regarding Ordinary Meaning Are Relevant to Claim Construction

- In claim construction, “the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.”

Markman v. Westview Instruments, Inc.,

52 F.3d 967, 986 (Fed. Cir. 1995)

- Unless WTS contends Mr. Wexler lacks ordinary skill in the art, WTS admits that one of ordinary skill in the art at the time of the invention would have understood “banner” to mean a “graphic.”