

Term	Claims in IPRs	Docket No.
“associated with a user”	’561 Patent claims: 1, 8 ’942 Patent claims: 1, 10	236
“when the user modifies a content of the file”; “when a content ... is modified by the user”	’561 Patent claims: 1, 8	243
“responsive to the determination that the first electronic device is in communication with the second electronic device”	’942 Patent claims: 1, 10	258
(order of steps)	’561 Patent claims: all; ’942 Patent claims: all;	244
“responsive to the user modifying a content”	’942 Patent claims: 1, 10;	259

03/18/2024	236	ORAL ORDER: The Court, having reviewed the parties' motions for claim construction, (D.I. 87; D.I. 88), the briefing related thereto, (D.I. 138), having held a Markman hearing on September 13, 2023, (D.I. 160 ("Tr.")), and having considered the legal standards related to claim construction, see Vytacera Bio, LLC v. CytomX Therapeutics, Inc., Civil Action No. 20-333-LPS-CJB, 2021 WL 4621866, at *2-3 (D. Del. Oct. 7, 2021), hereby addresses the construction of term 1: "associated with a user." In the briefing, the parties' dispute was about whether there could only be one user associated with the electronic device (Defendant's position) or whether it was possible that multiple users could be associated with one such device (Plaintiff's position). (D.I. 138 at 3-11) As to that issue, the answer seems clear, in that during the hearing, even Defendant's counsel conceded that the patent could in fact allow for more than one user to share a device (in a scenario, for example, where the same "device" was utilized by a small number of people). (Tr. at 146) However, during the hearing, Defendant's counsel indicated that the "real" dispute that the Court needed to resolve as to this term was over whether or not a server (or "things similar to servers") can be a "device" (i.e., the item that, according to the asserted patents' claims, is "associated with a user"). (Id. at 144, 146-47, 149, 152, 157). Defendant does not think this can be so, such that it does not believe that you could have "a situation [as to the patents' use of the term "device"] where you have a user and it could be hundreds or thousands of users accessing a server." (Id. at 145) Plaintiff apparently
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		believes that a "device" can include a server. (Id. at 155) This issue--i.e., about whether a server can be a "device"--was not the focus of the parties' briefing as to this term; indeed, it was only mentioned in passing in the parties' joint brief. (See D.I. 138 at 9, 11 & n.2; see also Tr. at 152-54 (Plaintiffs' counsel noting that Defendant's focus at the hearing on the "Can a server be a device?" issue "seems to be new arguments to us and not really fully briefed")) Moreover, in the Court's view, the answer to this server-related question would be most properly addressed in defining the claim term "device"--not the claim term "associated with a user." (Tr. at 144) For these reasons, as an initial matter, the Court will construe term 1 to mean "associated with a specific user." This construction avoids the use of the word "relationship" in Plaintiff's proposal, which was vague. (D.I. 138 at 8) It also aligns with the patents' indication that the invention is meant to apply to scenarios where the same user is using more than one computing device, (561 patent, col. 1:25-27, 51-60; D.I. 138 at 5; Tr. at 154-55), something both sides agree is the case, (D.I. 138 at 7-8, 10; Tr. at 147-48, 154-55). But this construction does not rule out the possibility that someone other than a device's primary user could occasionally access or make use of that device, a concept that both sides now also agree with. (D.I. 138 at 5, 9; Tr. at 154-55) Additionally, the Court advises the parties that it will not now address their dispute over whether a "device" can be a server. Instead, if the parties cannot resolve this dispute in the future, they should alert the Court to this by way of a joint letter filed no later than 21 days prior to the filing of summary judgment briefing; the letter should advise the Court as to whether the dispute relates to an issue that will be discussed in that briefing. The Court will thereafter decide whether to have the issue briefed as part of the summary judgment process, or otherwise prior to trial. And if the dispute is briefed in the future, it will be taken up as to the meaning of the term "device." Ordered by Judge Christopher J. Burke on 3/18/2024. (dlb) (Entered: 03/18/2024)
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03/27/2024	243	ORAL ORDER: With regard to the parties' motions for claim construction, (D.I. 87; D.I. 88), the Court now addresses the construction of term 2: "when the user modifies a content of the [] file" / "when a content... is modified by the user." For reasons that will be made clear below, the Court will modify the terms to be construed here to be "automatically transferred... when the user modifies a content of the [] file" and "automatically provided... when a content... is modified by the user," as those phrases better capture the entirety of the parties' dispute. (Tr. at 56) By the end of the Markman hearing, both parties agreed that modification of the file by the user was the only triggering event that initiates the start of the file synchronization process. (Tr. at
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	19, 24, 35, 43) The real lingering dispute as to this term is over whether intervening events can occur in between the user modifying the electronic file and when the file synchronization process is complete (Plaintiff's position) or whether there can be no intervening events between the user modifying the file and synchronization being complete (Defendant's position). (Id. at 32-33, 36, 43-45; D.I. 138 at 17, 19-20) Neither of the parties' original constructions really addressed this (difficult to resolve) question. (See Tr. at 45-46, 71) At the Markman hearing, however, the parties provided guidance on possible alternative constructions. (See id. at 48, 65, 72) In line with Plaintiff's revised position, the Court will construe the term to mean "where the automatic synchronization is initiated by the user modifying the content of the file." (Id. at 72) It does so for the following reasons: (1) During prosecution of the 561 patent, the patentee initially sought claims covering automatically transferring a file "subsequent to" the user modifying the file. (D.I. 139, ex. 1 at TOP00001718-22; D.I. 138 at 15; Tr. at 52-53) The claims were rejected as invalid over the prior art. The patentee then amended the claims to change "subsequent to" to "when," such that synchronization is triggered "when" the user modifies the file. (D.I. 139, ex. 1 at TOP00001718-22; D.I. 138 at 15; Tr. at 52-53) Defendant argues that: (a) the way this change came about indicates that the patentee meant to disclose a direct causal action that does not leave room for intervening events; and (b) as part of making the change, the patentee explicitly disclaimed the possibility that the sync operation could happen "an undisclosed amount of time" after the file is modified and/or after another intervening event occurred that led to the operation. (D.I. 138 at 14); (2) In the key portion of the prosecution history, the applicant distinguished its invention over Multer in part by specifically noting that in Multer the files are transferred and received "at predetermined times" via "periodic synchronization" or are synchronized "based on synchronization of another device" or "when logging into or out of a web-portal" or "manually upon press of a sync' button"; the patentee emphasized that in contrast to Multer, its invention accomplishes "automatic transfer of a file when a user modifies the file." (D.I. 139, ex. 1 at TOP00001725 (emphasis omitted); D.I. 138 at 14-17; Tr. at 58-64); (3) At the Markman hearing, Plaintiff argued that in the prosecution history excerpt at issue, the patentee had only been distinguishing Multer with regard to what event must "start the synchronization process" or must be the "initiating event[]" or "initial trigger" for that process--and that the patentee had not meant to signal that no other later-occurring intervening event could occur prior to the completion of the file synchronization process. (Tr. at 37-42, 69-70, 72-73) And in the Court's view, this key excerpt of the prosecution history can be read in the way Plaintiff suggests. In the crucial paragraph, the patentee bolded and italicized the phrases "when a user modifies the file[,]" "when the user modifies the... file" and
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	"when modified by the user[.]" which could suggest that it was intending to distinguish its invention over Multer simply based on the type of event that must trigger the start of the file synchronization process. (D.I. 139, ex. 1 at TOP00001725 (emphasis omitted)) And each of the disclosures in Multer that the patentee distinguishes appear to amount to different ways of initiating file transfer. (Id.); (4) That said, the Court acknowledges that there are ways to read this key prosecution history paragraph that could support Defendant's alternative viewpoint about what was being disclaimed. For example, at one point the patentee states that it was distinguishing Multer based on how Multer discloses "synchronizing"--this might have been meant to reference the synchronizing process writ large, and not just the event that initiates or triggers the start of such a process. (Id. (emphasis omitted)) And in distinguishing Multer, at times the patentee noted that the claim term at issue does not simply relate to what begins the transfer process, but that it also relates to what it means for a file to be "automatically transfer[red]" or "automatic[ally] recei[ved]" to a device "when the user modifies" that file. (D.I. 139, ex. 1 at TOP00001725 ("Applicant respectfully submits that nothing in Multer discloses such automatic receipt of such files when the user modifies the files."); id. (noting that nothing in Multer discloses "automatic transfer of a file when a user modifies the file"); see also 561 patent, col. 10:54-56, 59-61; Defendant's Markman Hearing Presentation, Slides 20, 23; Tr. at 53, 55, 73) So it could be that here, the patentee meant to discuss how the entire automatic transfer/synchronization process works (beginning when a user modifies a file and ending when the file is received, with no intervening events noted as occurring in between)--and not just what is the triggering event that starts that process.; (4) But at the end of the day, in order for prosecution history disclaimer to attach, the import of the alleged disavowing statements needs to be "clear and unmistakable[.]" Aylus Networks, Inc. v. Apple, Inc., 856 F.3d 1353, 1359 (Fed. Cir. 2017). And the Court simply cannot say that Defendant's reading of the prosecution history is "unmistakabl[y]" correct. As a result, and because but for the disclaimer argument, there is no question that Plaintiff's position would control, the Court adopts Plaintiff's construction here.; and (5) At the Markman hearing, an additional dispute arose regarding whether "modifi[cation]" of the file includes saving the file. (Tr. at 22, 50-51) The Court is not in a position to resolve that dispute (if it still exists and if it is actually a material dispute) because the issue was not well briefed by the parties. (Id. at 22, 51). Ordered by Judge Christopher J. Burke on 3/27/2024. (dlb) (Entered: 03/27/2024)
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04/03/2024	244	ORAL ORDER: With regard to the parties' motions for claim construction, (D.I. 87; D.I. 88), the Court now addresses the construction of term 4: (order of steps). The dispute between the parties is whether the steps of the claims must be performed "in the order recited" (Defendant's position) or whether they only must be performed in a specific order "where the claim language and logical sequence necessitate" (Plaintiff's position). (D.I. 138 at 28) The Court hereby ORDERS that the term means that "the actions recited occur in the order recited where the claim language and logical sequence necessitate" (i.e., Plaintiff's proposal). It does so for the following reasons: (1) Both parties agree that there are certain aspects or steps of certain asserted claims that must be performed in a specific order, which is made clear by the wording of those particular claims. (Id. at 29-31, 33-35; see e.g., 561 patent, col. 10:53-56; 607 patent, cols. 10:62-66, 11:15-18) But, as Plaintiff notes, there are many asserted claims here, and simply because certain steps of certain asserted claims require an order, that does not mean that all steps of all of the claims necessarily must be performed in a specific order. (D.I. 138 at 34-35) When the inventors wanted to specify that an ordering of steps was required, they knew how to do so and they did it; where such specific indication is absent from the claims, that is a good clue that the inventors did not mean to require a particular order of steps. (Id.); (2) Plaintiff also points to examples of certain asserted claims where not only is no order specified as to when certain steps must be performed, but it appears as if the order of the steps simply does not matter. (See 561 patent, col. 10:53-61 (cited in D.I. 138 at 29); 607 patent, cols. 10:62-11:18 (cited in D.I. 138 at 34-35)) And indeed, Defendant seemed to acknowledge that as to at least some of Plaintiff's cited examples, Plaintiff was correct (i.e., that no order is required as to those steps). (D.I. 138 at 36 (Defendant noting that Plaintiff has presented "two examples where the order may not matter for two specific claim elements")) Generally, where there is not a clear indication of order from the claims or the specification, it is presumed that the steps recited do not have to be performed in the order recited. See <i>Altiris, Inc. v. Symantec Corp.</i>, 318 F.3d 1363, 1369-70 (Fed. Cir. 2003). In light of this, Defendant's proposal--one that applies a blanket requirement that all steps of all asserted claims must be performed in "the order recited"--is not only contrary to common understanding, but it would not make sense in the context of these particular asserted claims.; and (3) In support of its position, Defendant asserted that during prosecution of the 561 patent, Plaintiff argued to the Examiner that the steps recited in the claims had to be performed in the order recited, "regardless of whether language within the claims requires an order[.]" (D.I. 138 at 31-33) Here, Defendant points to: (a) one general statement by the patentee to the Examiner that "the elements [of the claim] must be arranged as required by the claim[.]" (D.I. 139, ex. 9 at TOP00001654
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		(internal quotation marks, emphasis and citations omitted) (cited in D.I. 138 at 32)); and (b) certain comments the patentee made in distinguishing the prior art, wherein the patentee noted the "specific arrangement referenced [in certain claim recitations,]" (id. at TOP00001657; id., ex. 1 at TOP00001724, -1726 (cited in D.I. 138 at 32-33)). However, it is simply not clear that with these statements, the patentee was stating that certain or all steps recited in each of the relevant claims had to be performed in a particular order. It seems just as likely to the Court (indeed, more likely) that instead the patentee was merely referencing the more general "arrangement" or configuration of the parts of the system that are described in the claims. (D.I. 138 at 36 n.9) If the patentee wished to clearly convey to the Examiner that the claimed steps had to proceed in a particular order, presumably the patentee would have used the word "order" in its comments to the Examiner; it did not do so here. In order to invoke prosecution history disclaimer, Defendant must demonstrate that the patentee clearly and unambiguously disavowed claim scope, and Defendant does not come close to meeting that bar. See <i>Aylus Networks, Inc. v. Apple Inc.</i> , 856 F.3d 1353, 1363 (Fed. Cir. 2017) ("[W]hen a prosecution argument is subject to more than one reasonable interpretation, it cannot rise to the level of a clear and unmistakable disclaimer.") (internal quotation marks and citation omitted). Ordered by Judge Christopher J. Burke on 4/3/2024. (dlb) (Entered: 04/03/2024)
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04/17/2024	258	ORAL ORDER: With regard to the parties' motions for claim construction, (D.I. 87; D.I. 88), the Court now addresses the construction of term 3: "responsive to the determination that the first electronic device is in communication with the second electronic device." The Court concludes that this phrase (and the other "responsive to" phrase in this limitation) should be construed to have its plain and ordinary meaning, and that it does not need the further gloss of some different claim construction. It comes to this conclusion for the following reasons: (1) The sole remaining dispute as to this term by the time of the Markman hearing was over whether the claim allowed there to be other actions or intervening events (in addition to (a) the determination that the first electronic device was in communication with the second electronic device, and (b) receipt of the modified second electronic file copy from the third electronic device, which the Court will refer to herein as the "two claimed triggering events") that could be a part of the process of causing the modified second electronic file copy (hereafter, "second copy") to be sent to the second electronic device. (See, e.g., 942 patent, col. 11:22-28) Defendant says "no," while Plaintiff says that the claim could allow for this. (D.I. 138 at 27; Tr. at 81-82, 89-90, 95) The Court agrees with
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		Plaintiff, using a similar rationale to what it used in resolving the parties' dispute as to term 2.; (2) Although claims 1 and 10 of the 942 patent require that the two claimed triggering events have to happen before the second copy is sent, and that the second copy is sent "responsive to" those two events occurring, the Court does not see how the claim language necessarily precludes an additional action or intervening event from occurring that also might be necessary to prompt the automatic sending of the second copy. (Defendant's Markman Hearing Slides, Slide 25) Nor does it see how (as Defendant claims) coming to this conclusion "reads out" the words "responsive to" from the claims. (Id.) The second copy could still be sent "responsive to" the two claimed triggering events occurring--even in a scenario where a third triggering event also occurs that is relevant to the process of automatically sending the second copy. (Id., Slides 25, 28); (3) Defendant suggests that somehow during prosecution Plaintiff disclaimed this possibility. (Id., Slides 26-27; Tr. at 91-92; D.I. 138 at 24; see D.I. 139, ex. 2 at TOP0000539, -545) But the Court, having read the prosecution history excerpts, does not see how that is so. Surely it was important to the Examiner that the two claimed triggering events would be a part of the claim. But nothing said during prosecution excludes the possibility that, for example, a third triggering event could occur prior to the second file being sent.; and (4) With the Court having resolved this dispute, it does not think there is a need to adopt a construction of the term at issue (in part because the parties' proposals were incomplete or unhelpful, and in part because the claim language itself clearly sets out what is required here). Ordered by Judge Christopher J. Burke on 4/17/2024. (dlb) (Entered: 04/17/2024)
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04/17/2024	259	ORAL ORDER: With regard to the parties' motions for claim construction, (D.I. 87; D.I. 88), the Court now addresses the construction of term 5: "responsive to the user modifying a content." The dispute that the parties are having as to this term is, as the Court understands it, essentially identical to the dispute they were having regarding term 2. That is, Plaintiff asserts that while the "user modifying a content of the first electronic file" must be the initial triggering event that starts the automatic process of transferring a copy of the first file to the second electronic device, the claims' language does not preclude there being some intervening event that is also relevant to that transfer process. (D.I. 138 at 39 ("transfer may not occur until some later point in time after the user modifies the content of the electronic file"); id. at 44 ("So, user modification is the triggering event, after which an automatic process is permitted to transfer the modified file."); Tr. at 87-89, 101-02) And Defendant argues that no such intervening trigger events are possible. (D.I. 138 at
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	40; Tr. at 89-90, 98) The Court again agrees with Plaintiff, and will construe the term largely as Plaintiff proposed: "referring to a condition of the user modifying a content as an initial triggering event for a corresponding recited action." It so concludes for the following reasons: (1) In line with its discussion of term 2, the Court does not view a fair reading of the claim language as excluding the possibility that after the first electronic file is modified by the user (i.e. getting the automatic transfer process under way), there could be some other event required to complete the transfer process.; and (2) Defendant again argues that Plaintiff disclaimed such a possibility during prosecution, pointing for example to the way the patentee distinguished the Mohanty reference to the Examiner. (Defendant's Markman Slides, Slides 30-32; D.I. 138 at 41; see also D.I. 139, ex. 3 at TOP00002361-62) But as it did with term 2, here the Court notes that in order for prosecution history disclaimer to apply, the disclaimer must be clear and unmistakable. And here, it could be that when the patentee was distinguishing the "automated file backup process in Mohanty" that was performed on a "periodic or other timing basis[.]" (D.I. 139, ex. 3 at TOP00002361-62; see also D.I. 138 at 41; Defendant's Markman Slides, Slides 30-32), it was simply doing so on the basis that its invention instead kicks off that transfer process "responsive to the user modifying a content" (and was not suggesting that this is the only event that might ever be a part of the transfer process). Ordered by Judge Christopher J. Burke on 4/17/2024. (dlb) (Entered: 04/17/2024)
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