

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SurgeTech, LLC,

Plaintiff,

v.

Uber Technologies, Inc.,

Defendant.

C.A. No. 22-cv-882-GBW

JURY TRIAL DEMANDED

**DEFENDANT UBER TECHNOLOGIES, INC.'S
RESPONSIVE CLAIM CONSTRUCTION BRIEF**

Date: May 12, 2023

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TABLE OF ABBREVIATIONS

Abbreviation	Meaning
SurgeTech	Plaintiff SurgeTech, LLC
Uber	Defendant Uber Technologies, Inc.
'598 patent (or '598)	U.S. Patent No. 11,334,598
'999 patent (or '999)	U.S. Patent No. 11,360,999
'047 patent (or '047)	U.S. Patent No. 11,475,047
Br.	SurgeTech LLC's Opening Claim Construction Brief
Ex.	Exhibits to Declaration of Robert Vincent
Kursh Decl.	Declaration of Steven R. Kursh, Ph.D., CSDP, CLP
JCCC	Joint Claim Construction Chart (D.I. 63)
Australian Priority Application	Australian Provisional Patent Application 2006902685

I. INTRODUCTION

Uber’s proposed constructions follow well-established principles of claim construction—particularly, they “stay[] true to the claim language and most naturally align[] with the patent’s description of the invention.” *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998). SurgeTech, by contrast, commits several fatal errors. It ignores the claims’ context. It ignores unhelpful passages in selectively citing the specification. It favors extrinsic evidence over intrinsic. It rejects simplicity in favor of complexity. And for means-plus-function terms, it cites a broad swath of the specification that is not clearly linked to the function, or merely restates the function without disclosing actual structure. Uber respectfully requests that the Court reject SurgeTech’s deficient proposals and adopt Uber’s constructions.

II. DISPUTED NON MEANS-PLUS-FUNCTION TERMS

A. “inventory” (JCCC, 2)

Uber’s Construction	SurgeTech’s Construction
“any item, whether tangible or intangible, that is capable of being transferred or distributed from one party, entity, apparatus, or consumption source to another and in respect of which it may be required to control and monitor quantity, rate of consumption, and other parameters”	“one or more items, whether tangible or intangible, capable of being transferred or distributed from one party, entity, apparatus, or consumption source to another, and not limited to items that are sold”

The parties agree that the specification provides a definition of “inventory.” Br. at 1–2. But SurgeTech seeks to (1) eliminate part of this express definition, and (2) add language that contradicts the claims.

SurgeTech argues against something that Uber’s construction does not do—namely, transform a “*permissive example*” from the specification into a *requirement* of the claims. Br. at

2.¹ Uber’s construction does not import any “examples”—permissive or otherwise—from the specification. *Id.* To the contrary, it retains the verbatim definition of “inventory” crafted by the patentee—including that “it may be required to control and monitor quantity, rate of consumption and other parameters.” ’598 at 39:1–5.

SurgeTech cites irrelevant case law in which—unlike here—the patentee did *not* act as its own lexicographer, and the court thus declined to limit the claims to particular embodiments. *Id.* at 2–3 (citations omitted). But, as SurgeTech admits (Br. at 1–3), the patentee here *did* act as its own lexicographer. Where such a “lexicographic definition” includes “non-limiting terms” like “can” or “may” to inform the understanding of the term, they should be included. *Shire Dev. LLC v. Teva Pharms. USA, Inc.*, 2019 WL 969638, at *10 (D. Del. Feb. 28, 2019).

There is, however, a restraint on verbatim adoption of language in the specification—that language must always yield to the language of the *claims*. *Elektia Instrument S.A. v. O.U.R. Sci. Int’l, Inc.*, 214 F.3d 1302, 1308 (Fed. Cir. 2000) (“[T]he unambiguous language of the . . . claim controls over any contradictory language in the written description.”). While the specification states that “inventory,” in the abstract, may “not [be] limited to items that are sold” (’598 at 39:6), the asserted claims *are* limited to inventory items that are sold—all of the asserted claims recite receipt and processing of “sale data” related to the inventory and the adjustment of its “price.” *See* ’598, cls. 1, 9, 17, 21, 23; ’999, cls. 1, 9, 10; ’047, cls. 1, 4, 7, 10. While the patentee could have drafted claims to encompass types of inventory that are *not* sold, it did not do so for the asserted claims here.² “Proper claim construction . . . demands interpretation of the entire claim in context,

¹ All emphases are added unless otherwise noted.

² The Federal Circuit has recognized that a patentee may draft claims to cover specific embodiments described in the specification. *See Intamin Ltd. v. Magnetar Techs., Corp.*, 483 F.3d 1328, 1337 (Fed. Cir. 2007) (“[T]his court has acknowledged that a claim need not cover all embodiments. . . . A patentee may draft different claims to cover different embodiments.”).

not a single element in isolation.” *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999). SurgeTech’s attempt to add limitations that are inconsistent with the claims as a whole should be rejected.

B. “distribution channel[s]” (JCCC, 3)

Uber’s Construction	SurgeTech’s Construction
“reseller that distributes inventory to consumers”	“portals, outlets, channels and other distribution agents that are configured for the distribution of inventory to consumers or sources of consumption”

SurgeTech argues that it merely adopts the definition of “distribution channel” provided by the specification. Br. at 3. But SurgeTech ignores that the specification provides *multiple* definitions of “distribution channel.” The Australian Priority Application—incorporated by reference into the specification (*see* ’598 at 1:13–15)³—expressly defines “distribution channel” as “[a]t least one *reseller* of goods or services, where the goods or services are subjected to a particular selling procedure, such as through an agent, where commission is payable, where the characteristics of that procedure are unique to the distribution channel.” Ex. A (Australian Priority Application) at 3. Uber’s construction—unlike SurgeTech’s—accounts for and harmonizes these definitions, consistent with the claims and specification.

Following these express definitions, the patents invariably associate the term “distribution channel” with “reseller”:

- “The problem is a result of the manner in which such inventory is allocated to various *re-sellers, referred to as distribution channels (‘Channels’)*, which can be ad hoc and thus inefficient.” ’598 at 1:32–35.

³ The Australian Priority Application is “effectively part of the host [specification] as if it were explicitly contained therein.” *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001) (citations omitted).

- “A primary reason for this is that the traveling public is now able to book and pay online for practically all of its travel and accommodation needs via various online travel/accommodation **reseller portals and agencies, which can be regarded as Channels**. The online **reseller** market is particularly large in this field and the various Channels have the potential to be extremely successful.” *Id.* at 3:66–4:6.⁴
- “In FIG. 1, reference numeral 10 broadly illustrates an exemplary embodiment of a system for managing inventory allocated to respective **re-sellers**.” *Id.* at 4:7–9.
- “The computer 12 is programmed or configured [] to receive data relating to accommodation allotments **allocated to respective re-sellers stored on servers that are referred to as distribution channels or channels**, indicated schematically at 18, via the World Wide Web 14.” *Id.* at 4:24–28.
- “The computer 12 is configured to store data representing inventory that is required to be sold on line by **third party on line resellers using the channels** 18. The system 10 allows a vendor of the inventory, in the form of a member or subscriber, indicated at 20, to place all or part of their inventory required to be sold online in a database 22 of the computer 12.” *Id.* at 4:38–44
- “Reference numeral 32 indicates any **channel 18 associated with a user-selected third party re-seller** that stocks real-time inventory availabilities or allocations that are represented by values in database fields of computers associated with the channels 18.” *Id.* at 5:44–48.
- “For each **channel**, the number of Rooms sold is recorded and a total is calculated in the final column. In order to obtain a measure of how well a **re-seller** is performing in the market, a ratio between the Rooms sold per **Channel** and the total number of Rooms sold at each time point is calculated to provide a suitable indicator. This provides a measure of how well a **channel** is selling the Rooms for a predetermined time period.” *Id.* at 9:33–41.
- “The invention is intended to cover an embodiment in which rather than using the number of Rooms sold to evaluate how a particular **re-seller** compares to its competitors, the total revenue generated out of the total amount of revenue for that time period is considered.” *Id.* at 14:7–11
- “The schematic flowchart 100 represents an embodiment of a software product in the form of instructions stored on a non-transitory computer-readable medium executable by a computer and a method for managing inventory allocated to respective **re-sellers**.” *Id.* at 29:22–26.

⁴ SurgeTech argues this language—“can be understood as”—somehow transforms a definitional feature into an “optional” one. Br. at 4. But just as humans “can be regarded as” mammals, “distribution channels” can be regarded as “resellers.” This passage, like the rest of the specification, describes being a reseller as a defining—not optional—feature of a distribution channel.

These are not merely a “narrow example” from the specification. Br. at 3. To the contrary, the patents *never* envision a “distribution channel” that does *not* correspond to a “reseller”—exactly as defined in the Australian Priority Application incorporated into the specification.

Contrary to SurgeTech’s argument (Br. at 4), Uber’s construction does not “contradict” dependent claim 8. It does not logically follow that because “computing devices” can be configured as the “distribution channels” (’598, cl. 8), those channels must be “broader” than resellers. Br. at 4. To the contrary, as explained in the specification, those computing devices are the *reseller’s* computing devices. ’598 at 4:24–28 (computing devices such as “servers” can be configured as the “distribution channels” for inventory “allocated to respective re-sellers”). The use of “computing devices” does not alter the defining characteristic of a “distribution channel”—*i.e.*, a “reseller” or “agent” for distributing inventory to consumers. Even in the passage SurgeTech relies on, “distribution channels” are not just any type of “portals,” “outlets,” or “channels” in the abstract; rather, these are all examples of “distribution *agents*.” ’598 at 39:22–24. That is precisely what a “reseller” is—“a person or business authorized to act on another’s behalf,” in this case, an entity that resells a vendor’s inventory. *See* Ex. B (<https://www.collinsdictionary.com/us/dictionary/english/agent>); ’598 at 1:32–38, 3:57–62, 4:38–44 (discussing “resellers” selling inventory on behalf of vendors).

Moreover, SurgeTech’s attempt to achieve a “broader” definition not limited to “resellers” is inconsistent with its own reliance on the Australian Application for priority in this case.⁵ If the asserted patents properly claim priority to the Australian Patent Application, as SurgeTech asserts, they cannot claim a “broader” scope than disclosed in that priority application. *Anascope, Ltd. v.*

⁵ SurgeTech has taken the position both in its Infringement Contentions and in its interrogatory responses that the alleged inventions claim priority to no later than May 18, 2006, the filing date of the Australian Priority Application.

Nintendo of Am. Inc., 601 F.3d 1333, 1338–39 (Fed. Cir. 2010) (broadening claim terms would constitute “new matter” not entitled to the priority date of the prior application).

Uber’s proposed construction is easy to understand and accounts for the entirety of the intrinsic record. SurgeTech’s proposal narrowly focuses on three lines of the specification to the exclusion of the rest. Uber respectfully requests that the Court adopt Uber’s construction.

C. “performance rating” (JCCC, 4)

Uber’s Construction	SurgeTech’s Construction
“indicator for how well inventory items are being sold/have been sold through a particular distribution channel”	“indicator of performance”

As with other disputed terms, SurgeTech seeks to divorce the term “performance rating” from the claims’ context. SurgeTech argues that Uber’s proposal “unduly narrows this term to indicate sales performance.” Br. at 5. In fact, the *claims* make clear that “performance rating” is an indicator of the sales performance of the distribution channels. Claim 1 of the ’598 patent, for example, expressly states that a “performance rating” for each distribution channel is calculated by processing “sale data” from each channel, and, based on a comparison of these performance ratings, inventory can be reallocated or sold at a different “price.” SurgeTech does not explain how the “performance rating” in the context of the asserted claims could be anything other than an “indicator for how well inventory items are being sold/have been sold through a particular distribution channel.”

In addition to the claims, the specification describes the performance indicator exactly as Uber proposes:

In order to obtain a measure of *how well a re-seller is performing in the market*, a ratio between the Rooms *sold* per Channel and the total number of Rooms *sold* at each time point is calculated to provide a suitable *indicator*. This provides a measure of *how well a channel is selling the Rooms for a predetermined time period*. This is then used to ascertain any price adjustments that should be made for the associated channel.

'598 patent at 9:34–41. SurgeTech is correct that the specification states that “the performance rating can be in the form of a number of parameters.” Br. at 5 (quoting '598 at 6:65–66). As the very next sentence states, “it could be related to a surplus or deficit percentage related to supply and demand of particular inventory items.” '598 at 6:66–7:1. Of course the actual indicator could take several forms “related” to supply and demand, and the patent provides some examples. *See id.* at 9:42–44, 11:21–31, 14:35, 31:17–31. But whatever form it takes, it must be an indicator of the channel’s sales performance. The claims envision nothing else.

D. “in real time” (JCCC, 5)

Uber’s Construction	SurgeTech’s Construction
“provided automatically to indicate the most recent data”	“in which the input or processing of data occurs concurrently with an external activity and in time to affect that activity”

SurgeTech’s argument begins by citing a complicated dictionary definition that is anything but “plain,” followed by citations to the specification to “support” its extrinsic construction. Br. at 5–7. SurgeTech’s approach is exactly backwards. Claim construction begins with the intrinsic record, only resorting to extrinsic evidence when necessary and always “considered in the context of the intrinsic evidence.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005) (en banc).

The intrinsic evidence supports Uber’s construction. SurgeTech admits that “[t]he specification contrasts ‘real-time’ updates, which are described as being . . . sent to a database (e.g., in anticipation of polling by a subroutine 24), with ‘request-based’ schemes which withhold updates from the database until a request is made.”⁶ Br. at 6 (citing '598 at 7:34–38); *see also* '598 at 7:20–33, 7:38–51, 33:34–42, 36:8–37:12. Using language from the specification, Uber’s

⁶ Contrary to SurgeTech’s arguments (Br. at 6), the patents never state that “real time” updates are sent “continuously.” To the contrary, as discussed below, the patents state that “real time” updates are sent “regular[ly]” or “periodically.” '598 at 8:3–6, 36:38–40.

construction observes this distinction, making clear that “real time” updates are provided “automatically” by the distribution channels, instead of being provided only after a request from the server:

- “Processes 238 and 240 are for cases in which the central server is configured to wait for *automatic* responses from the distributed servers 206 that send the contingent values at times.” ’598 at 36:14–17.
- “When process 236 executes, then, at 242, the central server selects a distributed server. At 244, a check is performed to determine if that distributed server 208 needs to be prompted for receiving the contingent values or if the distributed server 208 is configured *automatically* to send the contingent values to the central server 200.” *Id.* at 36:20–25.
- “Process 238 is for controlling the case when a distributed server is configured to send the contingent values to the central server *periodically and automatically*.” *Id.* at 36:38–40.

“In real time” can be construed simply by reference to the intrinsic record, as Uber proposes.

Ignoring these disclosures, SurgeTech pivots to cited prior art.⁷ Br. at 6. Again, SurgeTech gets it backwards by citing unrelated patents to contradict the specification. *See, e.g., Trs. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1368 (Fed. Cir. 2016) (holding that “fleeting references” to a prior art reference “cannot overcome the overwhelming evidence in the specification and the prosecution history,” particularly when “the specification did not even refer with any detailed particularity to the passages” of the prior art reference) (citation omitted). For example, SurgeTech cites an unrelated patent to distinguish data sent “in real time” from data sent in a “periodic” manner. Br. at 6 (quoting U.S. Patent No. 7,613,628). This evidence is directly contrary to the patents, which expressly teach that “real time” data may be sent “periodically.”

⁷ SurgeTech erroneously claims that these patents are intrinsic evidence of “similar value as the specification.” Br. at 6 n.7. Unlike in *Arthur A. Collins, Inc. v. Northern Telecom Ltd.*, 216 F.3d 1042 (Fed. Cir. 2000), on which SurgeTech relies, these patents are never discussed in the specification or file histories *at all*, let alone in the context of “real time” to “indicate . . . that the patentee intended to adopt that meaning.” *Id.* at 1045.

'598 at 36:38–40; *see also id.* at 8:3–6 (“real-time” data is sent “on a regular basis”), 5:35–38, 35:42–45 (data is received and processed “recurrently”).

SurgeTech’s deemphasis of the specification leads it to erroneously argue that Uber’s construction leads to “absurd” results. Br. at 7. SurgeTech complains that there is no “temporal limit” on real-time updates under Uber’s construction (*id.*), but the patent expressly states that “real time” data can be sent *periodically*, whether hourly ('598 patent at 5:35–38, 7:23–25), daily (*id.* at 14:51–52, 32:46–48), weekly (*id.* at 14:15–18), or at some other interval appropriate for the particular type of inventory. This flexibility is a feature of the alleged invention, not an error in Uber’s construction. SurgeTech’s second alleged “absurd” result (Br. at 7) is a misreading of Uber’s construction, which simply requires that the distribution channel send the “most recent data” available at that point in time. That the distribution channel may later update the data after it is sent is irrelevant.

The intrinsic record is clear, and SurgeTech’s attempt to use extrinsic evidence to contradict the intrinsic meaning should be rejected.

III. INDEFINITE TERMS⁸

A. “in near real time” (JCCC, 5)

As SurgeTech admits, “in near real time” is not used in the specification. Br. at 7. Rather, the specification, along with all of the independent claims save one, disclose receiving data “in real time,” as discussed above. *See* Section II.D, *supra*. Claim 1 of the '999 patent, by contrast, recites “receiving sale data cyclically, in *near* real time, from respective distribution channels” The patent provides no guidance as to what constitutes “in *near* real time,” especially as

⁸ Uber also asserts that means-plus-function terms of the '047 patent are indefinite for failing to identify corresponding structure. Uber addresses those terms in Section IV, below.

contrasted to “in real time,” thus rendering the term indefinite.⁹ *See* Kursh Decl. ¶¶ 40–53.

As discussed above, the parties agree that the specification discloses two different ways of receiving data from distribution channels—either the channels provide data “in real time,” or the distribution channels employ a “‘request-based’ scheme[] which withhold[s] updates from the database until a request is made.” Br. at 6; *see also* ’598 at 33:34–37 (disclosing the “two methods in which data can be received from respective Channels [that] have been conceived,” namely, “‘real time’ and ‘request-based’ (also known as polling) methods”).

The patents do not explain, however, what it means for data to be sent “in *near* real time.” While it may encompass data received “in real time,” the patents provide no guidance to one of ordinary skill as to the outer boundaries of what constitutes “near” real time. The patents present a binary choice for how data is received—either data is sent automatically, without waiting for a request (*i.e.* in real time), or it is sent only after a request is made. *Id.* For the former, while the patents explain that “real time” data may be sent, *e.g.*, on a “regular basis,” they do not explain how quickly data must be sent for it to qualify as “*near*” real time. Thus, whether data is sent in “near” real time is impossible to determine in the context of the asserted patents.

Under SurgeTech’s construction of “in real time,” “in *near* real time” is still indefinite, because “near” remains a term of degree, and the claim language and specification provide no “objective boundaries for those of skill in the art.” *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1371 (Fed. Cir. 2014). Where, as here, a term is “highly subjective and, on its face, provides little guidance to one of skill in the art” and the specification provides no helpful guidance, the term is indefinite. *Id.* at 1371–72. In fact, the specification provides no guidance at all as to just

⁹ Contrary to SurgeTech’s misrepresentation of the parties’ meet-and-confers (Br. at 8), Uber did explain to SurgeTech—twice—how “in near real time” is indefinite.

how “near” to “real time” data must be received to fall within the scope of the claims.

SurgeTech argues that because “near real time” appears in some dictionaries, that means the term is definite. Br. at 7–8. First, these definitions, like those for “real time,” are untethered to the intrinsic record’s use of these terms. Moreover, these definitions simply repeat the vague claim language (or substitute an equally vague term). *Id.* Saying that “in near real time” means “not quite” in real time, but “nearly so,” or within a “short time period,” still offers no objective boundaries by which one of ordinary skill can understand the scope of the claim, rendering it indefinite. *Interval Licensing*, 766 F.3d at 1371–72; *see also* Kursh Decl. ¶¶ 40–53.

B. “adjusting . . . a price of the items in the transportation services inventory allocated to each of the linked online distribution channels” (’598, cls. 1, 9, 17) (JCCC, 6)

“adjusting a price of inventory items allocated to each of the respective distribution channels” (’999, cls. 1, 9, 10) (JCCC, 6)

While the ’598 and ’999 patents cover adjusting a price of inventory items,¹⁰ their claims have three different formulations of this limitation:

’598 cls. 1, 9, 17	’598 cls. 21, 23	’999 cls. 1, 9, 10
“adjust[ing] . . . a price of <i>the items in the transportation services inventory</i> allocated to <i>each of the</i> linked online distribution channels”	“adjusting . . . a price of <i>said one or more of the items</i> allocated to <i>the corresponding</i> linked online distribution channel”	“adjusting a price of <i>inventory items</i> allocated to <i>each of the respective</i> distribution channels”

SurgeTech appears to argue each of these phrases requires adjusting only “one or more” prices of “one or more” items in “one or more” distribution channels. Br. at 8. This reading is consistent with claims 21 and 23 of the ’598 patent (which Uber is not arguing are indefinite), in which sale data for “one or more” of the items is received and processed, after which a price of “said one or

¹⁰ The ’047 patent also claims adjusting a price of inventory, but that patent is not the subject of Uber’s indefiniteness argument.

more items” allocated to “the” corresponding “channel” may be adjusted. These claims are clearly satisfied by a single price adjustment of a single inventory item in a single channel, as SurgeTech contends.

But the other claims are not so clear. Claims 1, 9, and 17 of the ’598 patent require “adjust[ing] . . . a price of *the items* [plural] in the transportation services inventory allocated to *each of the* linked online distribution *channels* [plural].” While SurgeTech contends that these claims also require only a single price adjustment, these claims could be reasonably read to require adjusting a price of “*the items*”—*i.e.*, the *multiple* items in the transportation services inventory—in the *multiple* distribution channels. In fact, given the contrasting language of these claims compared to the others, it is probable that the patentee intended a different claim scope. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008) (“[D]ifferent claim terms are presumed to have different meanings.”) (citation omitted). The ’999 patent presents yet another formulation, requiring “adjusting a price of inventory items [plural] allocated to each of the respective distribution channels [plural].” Again, it is not clear how many inventory items (in how many distribution channels) must undergo a price adjustment.

Because these claims “might mean several different things and no informed and confident choice is available among the contending definitions,” they are indefinite. *HZNP Meds. LLC v. Actavis Lab’ys UT, Inc.*, 940 F.3d 680, 698 (Fed. Cir. 2019) (quotation omitted). As SurgeTech’s brief demonstrates, the specification provides no clarification. Br. at 8–9. While SurgeTech is correct that the specification certainly contemplates a single price change (*id.*), it also contemplates a situation in which a price of the inventory items in *all* channels is adjusted. *See, e.g.*, ’598 at 5:27–31 (“It follows that if a shortage of supply should occur, a price of inventory in all the channels 18 will increase.”); *see also id.* at 5:7–11 (setting a minimum price for all items).

Uber does not dispute that SurgeTech’s reading is a reasonable one. What renders these phrases indefinite is not that they cannot be given *any* meaning, but that there are *multiple* reasonable interpretations of these phrases—each resulting in a different claim scope—and the intrinsic record fails to inform those skilled in the art “with reasonable certainty” as to which should control. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014).

IV. MEANS-PLUS-FUNCTION TERMS

The parties agree on all of the recited functions for the means-plus-function terms.¹¹ *See* JCCC at 6–17. And, for the terms for which Uber proposes corresponding structure (*i.e.*, the terms that are not indefinite), the parties agree that Uber’s proposals should be included in the corresponding structure. *Id.* (SurgeTech’s proposed structure includes all citations identified by Uber).

As SurgeTech correctly states (Br. at 10), the parties have three categories of disagreements: (1) for the terms the parties agree are definite, whether SurgeTech’s additional citations are corresponding structure clearly linked to the claimed function; (2) for the terms Uber contends are indefinite, whether SurgeTech has identified *any* corresponding structure, or instead identified passages that—at best—merely restate the claimed function; and (3) whether two “means” terms are means-plus-function terms at all.

SurgeTech barely attempts to support its proposed structure. *See* Br. at 12–17. SurgeTech’s “argument” comprises two charts with truncated identifications of the agreed function, followed by a string cite of specification passages.¹² *Id.* Other than a single parenthetical

¹¹ The agreed functions are also provided in the table at the beginning of this brief for the Court’s convenience.

¹² Frustratingly, although these charts are meant to “identify the linking language for the additional structure [SurgeTech] identified in the JCCC” (Br. at 16), SurgeTech’s brief cites new passages and omits other passages SurgeTech cited in the JCCC, leaving Uber and the Court no way to

quoting the first citation—with no analysis of how it is clearly linked to the function—SurgeTech presents no argument at all. *Id.* SurgeTech’s meager attempt to support its ambiguous proposals should be rejected.

A. Means-plus-function terms the parties agree are definite

SurgeTech’s proposed structures are contrary to established Federal Circuit law. The parties agree that structure disclosed in the specification is “corresponding” structure under Section 112 ¶ 6 only if it “clearly link[s] or associate[s] [that] structure to the claimed function.” Br. at 16 (quoting *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1377 (Fed. Cir. 2001)). “A court may not import into the claim features that are unnecessary to perform the claimed function.” *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1352 (Fed. Cir. 2003) (“Features that do not perform the recited function do not constitute corresponding structure and thus do not serve as claim limitations.”) (citations omitted). That a structure is “capable” of performing the recited function, while necessary, is insufficient; rather, the inquiry is whether the structure is “clearly linked or associated with the function.” *Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1311 (Fed. Cir. 2001).

Moreover, computer-implemented means-plus-function terms must disclose an algorithm for performing the claimed function. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008). “[T]he structure disclosed in the specification [must] be more than simply a general purpose computer or microprocessor.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1352 (Fed. Cir. 2015). While the algorithm may be expressed in “any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that

decipher SurgeTech’s actual position. *Compare* Br. at 12–14, 16–17 with JCCC at 6–17. Uber reserves the right to respond to the extent SurgeTech presents a clear position on these terms.

provides sufficient structure,” it “cannot merely restate the function recited in the claim.” *Augme Techns., Inc. v. Yahoo! Inc.*, 755 F.3d 1326, 1337 (Fed. Cir. 2014) (quotations omitted). Rather, “an algorithm is . . . a step-by-step procedure for accomplishing a given result.” *Ergo Licensing, LLC v. CareFusion 303, Inc.*, 673 F.3d 1361, 1365 (Fed. Cir. 2012).

Merely stating that that information is “processed” is insufficient; the specification must disclose *how* the function is performed. *Pi-Net Int’l Inc. v. J.P. Morgan Chase & Co.*, 2014 WL 1997039, at *13 (D. Del. May 14, 2014); *see also Uniloc USA, Inc. v. Samsung Elecs. Am., Inc.*, 2018 WL 5296046, at *19 (E.D. Tex. Oct. 25, 2018) (recitation of “mak[ing] an additional calculation of the incline” and “verifying the calculation of the incline” do not describe an algorithm or impart sufficient structure); *Atser Rsch. Techs., Inc. v. Raba-Kistner Consultants Inc.*, 2009 WL 691118, at *15–16 (W.D. Tex. Mar. 2, 2009) (recitation of “appropriate engineering calculation[s]” is insufficient corresponding structure).

Moreover, the proposed structure must perform the “*entire* function,” not merely a portion thereof. *Touchcom, Inc. v. Dresser, Inc.*, 427 F. Supp. 2d 730, 736 (E.D. Tex. 2005).

SurgeTech’s proposed structures possess these infirmities: (1) they simply disclose a generic computer, (2) they merely restate (part of) the function, (3) they fail to perform the entire function, and (4) they do not provide a “step-by-step” procedure for “how” the function is performed.

1. “means for linking . . .” (’598, cls. 21, 23; JCCC, 6–7)

Agreed function: linking, via a computerized network, each of a plurality of items in the transportation services inventory with one of a plurality of online distribution channels, thereafter each being a linked online distribution channel in a plurality of linked online distribution channels, by allocating each of the plurality of items to the corresponding linked online distribution channel.

The lone parenthetical provided by SurgeTech states, “The system 10 allows a vendor . . . to place all or part of their inventory required to be sold online in a database 22 of the computer

12.” Br. at 16 (citing 598 patent at 4:38–50). This passage makes no mention of linking *each* inventory item with a particular channel by allocating each item to a specific channel, as required by the agreed function. Thus, this structure is neither clearly linked to nor capable¹³ of performing the claimed function.

2. “means for receiving . . .” (’598, cls. 21, 23; JCCC, 7–8)

Agreed function: receiving, from each of the plurality of linked online distribution channels in real time via the computerized network, sale data pertaining to the one or more online bookings for one or more of the items in the plurality of items allocated to the corresponding linked online distribution channel.

The lone parenthetical provided by SurgeTech states, “The computer 12 is programmed or configured with *to receive* data relating to accommodation allotments to . . . distribution channels . . . via the World Wide Web 14.” Br. at 16 (citing ’598 patent at 4:24–28) (emphasis in original). This passage merely states that a “computer” is “configured” to perform a small portion of the claimed function (“receive data”), but does not provide any algorithmic structure for receiving “in real time via the computerized network, sale data pertaining to the one or more online bookings.” A reference to a generic computer is insufficient structure, and it does not disclose the entire function.

3. “means for processing . . .” (’598, cls. 21, 23; JCCC, 8)

Agreed function: processing the sale data by carrying out calculations to obtain a performance rating for each of the plurality of linked online distribution channels.

SurgeTech’s lone parenthetical for this term states, “The computer 12 is configured to *process the data to obtain data relating to sales performance* in each channel . . .” Br. at 16–17

¹³ SurgeTech is incorrect that “Uber is not arguing that the disputed structure is incapable of performing the recited function.” Br. at 16 n.12. One of the many flaws in SurgeTech’s proposals is that it argues that “any” of its long string cites is “sufficient” structure to perform the claimed function. See JCCC at 6–17. But several of its cited “structures” are not, on their own, capable of performing the claimed function.

(citing '598 patent at 4:29–32) (emphasis in original). But this passage merely restates part of the function (“processing the data”), makes no mention of a “performance rating,” and discloses only a generic computer “configured” to perform (part of) the restated function. This is insufficient.

4. “means for determining . . .” ('598, cls. 21, 23; JCCC, 9)¹⁴

Agreed function: determining that the performance rating of at least one of the plurality of linked online distribution channels is better than the performance rating of other linked online distribution channels in the plurality of linked online distribution channels.

Agreed function: determining that the performance rating of at least one of the plurality of linked online distribution channels is worse than the performance rating of other linked online distribution channels in the plurality of linked online distribution channels.

SurgeTech’s sole parenthetical states, “[T]he computer increases the price in channels with a *relatively high outward transfer rate and high costs ... when compared with other channels*” Br. at 17 (citing '598 at 5:1–24). Unlike Uber’s proposed structure, this passage does not discuss performance ratings, and is alone insufficient to perform the claimed function.

5. “means for adjusting . . .” (598, cls. 21, 23; JCCC, 10)

Agreed function: adjusting, via the computerized network, a price of said one or more of the items allocated to the corresponding linked online distribution channel.

SurgeTech’s sole parenthetical states, “[T]he computer is configured to *adjust characteristics or parameters* relating to inventory allocated to respective channels 18 depending on the performance data” Br. at 17 (citing '598 at 4:17–37) (emphasis in original). This passage discloses only a generic computer “configured” to perform (part of) the restated function, not *how* the entire function is performed.

¹⁴ These terms are identical, except that the first involves determining that the performance rating for one distribution channel is *better* than the rating of other channels, and the second involves determining that the performance rating for one distribution channel is *worse* than the rating of other channels. But the parties identify the same respective structure for each function. JCCC at 10.

6. “means for modifying . . .” (598, cls. 21, 23; JCCC, 10–11)

Agreed function: modifying, via the computerized network, the linkage of said one or more of the items to the corresponding linked online distribution channel by re-allocating said one or more of the items in the transportation services inventory to or from the corresponding linked online respective distribution channel in the plurality of linked online distribution channels from or to one or more of the other linked online distribution channels in the plurality of linked online distribution channels.

SurgeTech’s sole parenthetical states, “[T]he computer is configured to . . . re-allocate inventory in respective channels 18 to other channels 18.” Br. at 17 (citing ’598 at 4:17–37). Again, this passage discloses only a generic computer “configured” to perform (part of) the restated function. It does not disclose *how* the “linkage” of the inventory items to particular distribution channels is “modified.”

7. “means for linking” (’047, cls. 7, 10; JCCC, 14)¹⁵

Agreed function: linking the one or more active channel records to the channel interface.

Uber agrees that SurgeTech’s sole parenthetical identifies corresponding structure for the “means for linking the one or more active channel records to the channel interface” term of the ’047 patent. Namely, the specification states, “An active ClientChannels table record is a record in a ClientChannels table that **links to an interface** used by a vendor to select a particular channel.” Br. at 13 (emphasis in original) (citing ’047 at 30:60–63). However, SurgeTech has not demonstrated that its remaining structure is clearly linked to the claimed function. For example, several of SurgeTech’s citations do not mention active channel records or a channel interface at all, let alone describe how they are linked. *See, e.g.*, Br. at 13 (citing ’047, 4:18–28, 5:24–37, 9:46–52, 27:43–59, 27:63–28:47, 28:64–67).

For all of the definite means-plus-function terms, the Court should reject SurgeTech’s

¹⁵ Uber originally identified this term as indefinite. *See* JCCC at 14. To narrow the issues in dispute, Uber will agree that the term is definite, with the structure identified above.

attempts to include structure not clearly linked to the claimed function.

B. Indefinite means-plus-function terms

The indefinite means-plus-function terms are, with one exception, found in the '047 patent. As discussed in Uber's § 101 motion, while directed to the same general steps as the '598 and '999 patents, the '047 patent adds technical-sounding words in an attempt to provide superficial substance to the claims. D.I. 65 at 8–9. But these superficially technical terms are either not found in the specification at all, or are mentioned in such a perfunctory way that—at most—the specification simply restates the claimed function. Like the other means-plus-function terms, SurgeTech's proposals simply disclose a generic computer and fail to provide a step-by-step procedure for how the entire function is performed. Because the specification discloses no corresponding structure, these terms are indefinite. *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1382 (Fed. Cir. 1999) (“Fulfillment of the § 112, ¶ 6 trade-off cannot be satisfied when there is a total omission of structure.”).

1. ***“means for establishing . . . a channel connection interface”*** ('598, cls. 22, 24; JCCC, 11)
“means for establishing . . . a channel interface” ('047 patent, JCCC, 12)

Agreed function: establishing, for each of the plurality of linked online distribution channels, a channel connection interface that (i) receives a user input selecting one of the plurality of linked online distribution channels and (ii) sends transportation services inventory data pertaining to said one or more of the items linked to the corresponding linked online distribution channel.

Agreed function: establishing a channel interface that provides bidirectional communication between at least one server computing device and a vendor computing device.

SurgeTech's sole parenthetical for these terms states, “[T]he software product 100 ***provides an interface*** to permit the Property to lock inventory (Rooms) [T]he interface 100 allows the Rooms to be ‘unlocked’.” Br. at 12 (citing '598 at 33:5–11, '047 at 31:54–60) (emphasis in original). This passage merely mentions the existence of an “interface,” not how it is “establish[ed]” for “each” distribution channel, how it receives user input or sends transportation

services inventory data, or how it “provides bidirectional communication” between a server and vendor computing devices.

2. “means for storing, via a channel data structure, a channel record” (’047, cls. 7, 10;; JCCC, 12)

Agreed function: storing, via a channel data structure, a channel record for each of a plurality of distribution channels.

SurgeTech’s sole parenthetical states, “The computer 12 is configured to *store data* representing inventory that is required to be sold on line by third party on line resellers using the channels 18.” Br. at 12 (citing ’047 at 4:18–30) (emphasis in original). There is no mention of a “channel record” or how it is stored “via a channel data structure,” and it discloses only a generic computer “configured” to perform (part of) the restated function.

3. “means for receiving . . . a selection” (’047, cls. 7, 10; JCCC, 13)

Agreed function: receiving, from the vendor computing device through the channel interface, a selection, from the plurality of distribution channels, of one or more participant channels for a transportation service.

SurgeTech’s sole parenthetical states, “An active ClientChannels table record is a record in a ClientChannels table that links to an interface used by a vendor to select a particular channel.” Br. at 12 (citing ’047 at 30:60–64). This passage merely mentions the existence of an “interface,” but does not explain how a “selection” is “receiv[ed] from the vendor computing device through the channel interface.”

**4. “means for establishing . . . one or more active channel records” (’047, cls. 7, 10; JCCC, 13)
“means for establishing . . . one or more inactive channel records” (’047, cls. 7, 10; JCCC, 14)**

Agreed function: establishing, via the channel data structure, one or more active channel records based upon the one or more participant channels for the transportation service.

Agreed function: establishing, via the channel data structure, one or more inactive channel records based upon the one or more participant channels for the transportation service.

SurgeTech’s sole parenthetical states, “In order for the particular record to be *active*, that channel should have been *selected by a vendor to participate* in the reselling of the vendor’s inventory.” Br. at 13 (citing ’047 at 30:64–67). This passage says nothing about the “channel data structure” at all, says nothing about active channel “records” or how they are “establish[ed] via the channel data structure,” and says nothing about “inactive” channels or channel records.

5. “means for receiving” (’047, cls. 7, 10; JCCC, 15)

Agreed function: receiving, in real time for the one or more participant channels corresponding to the one or more active channel records linked to the channel interface, sale data corresponding to at least one or more additional vendor computing devices.

SurgeTech’s sole parenthetical states, “The computer 12 is programmed or configured with *to receive data* relating to accommodation allotments to . . . distribution channels . . . via the World Wide Web 14.” Br. at 13 (citing ’047 at 4:4–8) (emphasis in original). This passage merely states that a “computer” is “configured” to perform a small portion of the claimed function (“receive data”), but does not provide any structure for receiving “in real time” sale data pertaining to the one or more additional vendor computing devices.

6. “means for determining” (’047, cls. 7, 10; JCCC, 15–16)

Agreed function: determining a performance indicator in real time, for each of the one or more participant channels corresponding to the one or more active channel records linked to the channel interface, based at least on the sale data corresponding to said at least one or more additional vendor computing devices.

SurgeTech’s sole parenthetical states, “The computer 12 is configured to process the data to obtain *data relating to sales performance* in each channel . . .” Br. at 13 (citing ’047 at 4:9–17) (emphasis in original). This passage discloses only a generic computer “configured” to perform (part of) the restated function, but does not explain how a performance indicator is determined in real time, for each channel corresponding to the active channel records, nor does it explain how the indicator is determined “based at least on the sale data” other than the data is

“process[ed].”

7. “*means for adjusting*” (’047, cls. 7, 10; JCCC, 16–17)¹⁶

Agreed function: adjusting, via the channel interface, a price of the transportation service by an adjustment factor if the performance indicator indicates a performance that fails to meet a performance threshold.

Agreed function: adjusting, via the channel interface, a price of the transportation service by an adjustment factor if the performance indicator indicates a performance that meets a performance threshold.

SurgeTech’s sole parenthetical states, “[T]he computer is configured to *adjust characteristics or parameters relating to inventory* allocated to respective channels 18 depending on the performance data” Br. at 14 (citing ’047 at 4:12–17) (emphasis in original). This passage discloses only a generic computer “configured” to perform (part of) the restated function, and contains no mention of a “channel interface,” “adjustment factor,” or “performance threshold.”

C. Terms that SurgeTech contends are not means-plus-function

SurgeTech cannot overcome the “presumption” that the “means for processing the sale data” and “means for establishing . . . a channel connection interface” terms are subject to § 112 ¶ 6. *Williamson*, 792 F.3d at 1349 (en banc in relevant part). To do so, it must show that the “claim recites sufficient structure for performing the described functions in their entirety.” *TecSec, Inc. v. Int’l Bus. Mach. Corp.*, 731 F.3d 1336, 1347 (Fed. Cir. 2013) (quotation omitted). In other words, it must show that “the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Williamson*, 792 F.3d at 1348. SurgeTech has failed to do so here.

¹⁶ These terms are identical, except that the first involves adjusting a price if the performance indicator indicates that a performance *fails to meet* a threshold, and the second involves adjusting a price if the performance indicator indicates that a performance *meets* a threshold. But SurgeTech identifies the same respective structure for each function. JCCC at 16–17.

1. “means for processing the sale data by carrying out calculations . . . ” (’598, cls. 21, 23; JCCC, 8)

SurgeTech argues that this term is not subject to § 112 ¶ 6 because the term itself contains an “algorithm”—namely, the “by carrying out calculations . . .” clause. Br. at 14. But, as SurgeTech itself admits, this is part of the function (JCCC at 8), and, thus, cannot itself be an algorithm for *how* the function is performed. *See also Arendi S.A.R.L. v. LG Elecs., Inc.*, 2019 WL 3891150, at *12–14 (D. Del. Aug. 19, 2019) (finding that “means for responding to a user selection *by inserting* . . .” and “means for responding to a user selection *by performing an operation* . . .” were subject to § 112 ¶ 6 and indefinite for failure to disclose an algorithm to perform the entire function, including the “by” clauses). Moreover, merely “carrying out calculations” is not an algorithm for how the function is performed. *See Ergo*, 673 F.3d at 1365.

**2. “means for establishing . . . a channel connection interface” (’598, cls. 22, 24; JCCC, 11)
“means for establishing . . . a channel interface” (’047, cls 7, 10; JCCC, 11)**

For these terms, SurgeTech misunderstands the claimed functions. These terms require means for “establishing” a channel [connection] interface. Merely reciting the existence of the interface (Br. at 15) says nothing about *how* it is established.

SurgeTech’s argument is based on circular reasoning. Br. at 15. These claims require “establishing” a “channel [connection] interface” that performs certain functions. For the ’598 patent, these functions are (i) receiving user input selecting one of the distribution channels and (ii) sending inventory data pertaining to one or more of the inventory items linked to the corresponding channel. ’598, cls. 22, 24. For the ’047 patent, the function is “provid[ing] bidirectional communication between at least one server computing device and a vendor computing device.” ’047, cls. 7, 10. These functions do not *create* the interface; they require the interface to have already been “established.” In the words of SurgeTech’s extrinsic dictionary, the

interface “*enable[s]* two entities to interact.” Br. at 15 (quotation omitted). The interface must already exist to allow the communications to occur; the communications do not cause the interface to somehow spring into existence, as SurgeTech argues. *Id.* To make a simple analogy, a telephone connection (interface) is a *prerequisite* to providing bidirectional communications between telephones. It makes no sense to say that the act of making a phone call is how the interface—that enabled the call in the first place—was “established.”

Because these terms provide no structure for “establishing” the channel [connection] interface, SurgeTech has failed to overcome the presumption that § 112 ¶ 6 applies.

V. CONCLUSION

For the foregoing reasons, Uber respectfully requests that the disputed terms/phrases be construed as proposed by Uber.

Date: May 12, 2023

Respectfully submitted,

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CERTIFICATION OF COMPLIANCE

The foregoing document complies with the type-volume limitation of this Court's Scheduling Order (D.I. 34). The text of this brief, including footnotes, was prepared in Times New Roman, 12 point. According to the word processing system used to prepare it, the brief contains 7,346 words, excluding the case caption, signature block, table of contents and table of authorities.

/s/ Brian E. Farnan

Brian E. Farnan (Bar No. 4089)

Dated: May 12, 2023

CERTIFICATE OF SERVICE

I, Brian E. Farnan, hereby certify that on May 12, 2023, a copy of Defendant Uber Technologies, Inc.'s Responsive Claim Construction Brief was served on the following as indicated:

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