

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

INMAR BRAND SOLUTIONS, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 23-994 (JFM)
	)	
QUOTIENT TECHNOLOGY INC.,	)	JURY TRIAL DEMANDED
	)	
Defendant.	)	

**DEFENDANT QUOTIENT TECHNOLOGY, INC.'S
RESPONSIVE CLAIM CONSTRUCTION BRIEF**

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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	DISPUTED CONSTRUCTIONS	1
a.	“scan” / “scanning” / “scanned”	1
b.	“retail store” / “retail business”	3
c.	“validating” / “validated” / “validation” / “validate”	6
d.	“real time”	10
e.	“remote” / “located remotely” / “location that is remote”	12
f.	“point-of-sale terminal” / “POS terminal” / “terminal”	12
g.	“the apparatus” / “apparatus (preamble)”	14
h.	“the processor” / “processor (preamble)”	17
i.	“where the unique account identifier was scanned at the first point-of-sale terminal” / “the first coupon or incentive related information having been input to a terminal in the retail business” / “where the promotion request message is scanned at the POS terminal located at a retail store”	19
j.	Order of steps	21
III.	CONCLUSION.....	23

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Baldwin Graphic Sys., Inc. v. Siebert, Inc.</i> , 512 F.3d 1338 (Fed. Cir. 2008).....	16
<i>C.W. Zumbiel Co., Inc. v. Kappos</i> , 702 F.3d 1371 (Fed. Cir. 2012).....	14
<i>Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.</i> , 289 F.3d 801 (Fed. Cir. 2002).....	14
<i>Convolve, Inc. v. Compaq Computer Corp.</i> , 812 F.3d 1313 (Fed. Cir. 2016).....	17, 18
<i>David Netzer Consulting Eng’r LLC v. Shell Oil Co.</i> , 824 F.3d 989 (Fed. Cir. 2016).....	4
<i>Digi Portal LLC v. WebMD LLC</i> , C.A. No. 20-1435-MN, D.I. 37 (D. Del. Jan 7, 2022)	9
<i>Eaton Corp. v. Rockwell Int’l Corp.</i> , 323 F.3d 1332 (Fed. Cir. 2003).....	14, 15
<i>Eon Corp. IP Holdings v. Silver Springs Network</i> , 815 F.3d 1314 (Fed. Cir. 2016).....	3
<i>Finjan LLC v. SonicWall, Inc.</i> , 84 F.4th 963 (Fed. Cir. 2023)	16, 17, 18
<i>In re Fought</i> , 941 F.3d 1175 (Fed. Cir. 2019).....	15
<i>Function Media, LLC v. Google, Inc.</i> , 708 F.3d 1310 (Fed. Cir. 2013).....	23
<i>IPXL Holdings, L.L.C. v. Amazon.com, Inc.</i> , 430 F.3d 1377 (Fed. Cir. 2005).....	19, 20
<i>Microprocessor Enhancement Corp. v. Texas Instr., Inc.</i> , 520 F.3d 1367 (Fed. Cir. 2008).....	9
<i>Nystrom v. TREX Co., Inc.</i> , 424 F.3d 1136 (Fed. Cir. 2005).....	3
<i>Salazar v. AT&T Mobility LLC</i> , 64 F.4th 1311 (Fed. Cir. 2023)	16, 17

<i>Sequoia Tech., LLC v. Dell, Inc.</i> , 66 F.4th 1317 (Fed. Cir. 2023)	6
<i>SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.</i> , 983 F.3d 1367 (Fed. Cir. 2021).....	15, 17
<i>TiVo, Inc. v. EchoStar Commc'ns Corp.</i> , 516 F.3d 1290 (Fed. Cir. 2008).....	16
<i>Traxcell Techs., LLC v. Nokia Sols. & Networks Oy</i> , 15 F.4th 1136 (Fed. Cir. 2021)	16, 18
<i>Univ. of Mass. v. L'Oreal S.A.</i> , 36 F.4th 1374 (Fed. Cir. 2022)	5
<i>V-Formation, Inc. v. Benetton Group SpA</i> , 401 F.3d 1307 (Fed. Cir. 2005).....	7
<i>Vizio, Inc. v. Int'l Trade Comm'n</i> , 605 F.3d 1330 (Fed. Cir. 2010).....	14, 15, 17
Other Authorities	
Point of Sale (POS), Microsoft Computer Dictionary (5th ed. 2002)	14
Point of Sale Terminal, Newton's Telecom Dictionary (25th ed. 2009).....	13
Point-of-sale terminal, The Chambers Dictionary (12th ed. 2011)	13
<i>Real time</i> , Dictionary.com, https://dictionary.cambridge.org/dictionary/english/real-time (last visited on Jan. 17, 2025).....	11
<i>Real time</i> , Merriam-Webster.com, https://www.merriam-webster.com/dictionary/real%20time (last visited on Jan. 17, 2025).....	11

I. INTRODUCTION

Quotient’s proposed constructions capture the meaning of the disputed claim terms as used in the asserted claims and as described in the patent disclosures. In contrast, Inmar—who refused to articulate what it believed was the “plain and ordinary meaning” of the terms during the exchange process (*see* D.I. 85 at n.2)—now seeks to expand the scope of the claims beyond what is recited and disclosed, or seeks to obscure from the jury industry-standard meanings that are adopted in the patents and would be known to one of ordinary skill in the art, but would be unknown to a lay juror. Accordingly, and for the reasons set forth below, Quotient’s proposed constructions should be adopted.

II. DISPUTED CONSTRUCTIONS

a. “scan” / “scanning” / “scanned”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 1, 11, 17, 25, 30, 33 ’855 Patent: 1, 32, 49, 51, 53, 54, 57	“optically [scan / scanning /scanned] using a barcode reader” Alternative proposal: “optically [scan / scanning /scanned]”	No construction necessary.

As used in the claims and specifications of the ’133 and ’855 Patents, the terms “scan,” “scanning,” and “scanned” refer to optically scanning information using a barcode reader. Alternatively, Quotient proposes “optically [scan / scanning /scanned],” which focuses on the core dispute—whether “scanning” in the patents requires optical technology. It does.

The specifications use the words “scan,” “scanning,” “scannable,” and “scanned” exclusively to refer to optical scanning—usually of a bar code, although in some instances of biometrics, such as a fingerprint. *See, e.g.*, ’133 Patent at 5:23–24 (“*optically scannable* bar codes”); *id.* at 5:28–29 (“in a biometric identification embodiment, a fingerprint scanning pad”

may be used); *id.* at 6:39 (“**barcode** information from a **scanned** product”); *id.* at 7:15–16 (“**barcodes** being **scanned** by a scanner”); *id.* at 7:50–51 (referring to extended barcodes, “the extended portion of the **code** may not even be read when **scanned**”); *id.* at 11:30 (“biometrics scanning”); ’855 Patent, 7:60–62; 8:36–38; 13:10–13 (“the **UPC bar code** of a product being purchased is **scanned**”).¹ Moreover, the claims at issue require scanning information found in a bar code—and hence requiring use of a barcode reader—rather than biometrics. Specifically, the claims of the ’133 Patent require scanning a “unique account identifier,” and those of the ’855 Patent require “scanning” a “coupon or incentive related information including universal product code information.”

By contrast, the patents use other, broader words (such as “read”) when discussing “non-optically readable technology”—not “scanning.” *See, e.g.*, ’133 Patent at 1:45–59; *id.* at 9:57–61 (“non-optical **reading** of a coupon card”). The patents expressly differentiate between optical barcode scanning and other means of obtaining information, and use different words to describe capturing the information. For example, the ’133 Patent distinguishes between “non-optically readable technology,” such as a coupon card with a swipe strip or radio frequency identification (RFID) technology, and “optically readable technology,” including “**optically scannable** bar codes.” ’133 Patent, 5:14–32. The ’855 Patent makes a similar distinction. *See* ’855 Patent, 6:36–49. The patents use the word “scan” only when discussing the optical technology, and use different terms (such as “reading,” “swiping,” or “sliding”) when discussing non-optical data recognition. *See, e.g.*, ’133 Patent, 4:31–34; *id.* at 6:10–12; ’855 Patent, 6:36–38, 7:32–34. Thus, contrary to Inmar’s suggestion that Quotient’s proposal wrongly “excludes the preferred embodiment”

¹ The ’855 Patent also discusses that “**an image** containing the consumer’s cell phone number ... may be scanned by the cashier,” which also indicates optical scanning. ’855 Patent at 14:36–37.

(Inmar’s Opening Claim Construction Brief (“Br.”) at 2), the patentee chose specific words to claim particular embodiments disclosed in the patents. The applicant easily could have used broader terminology, such as “read,” but did not.

Quotient’s proposed construction of the “scan” terms thus reflects how they are used in the patents and the claims. Inmar is “not entitled to a claim construction divorced from the context of the written description and prosecution history.” *Eon Corp. IP Holdings v. Silver Springs Network*, 815 F.3d 1314, 1320 (Fed. Cir. 2016) (quoting *Nystrom v. TREX Co., Inc.*, 424 F.3d 1136, 1144-45 (Fed. Cir. 2005)).

b. “retail store” / “retail business”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 1, 11, 17, 25, 30, 33 ’855 Patent: 1, 32, 49, 51, 53, 54, 57 ’729 Patent: 1, 10, 16	“a brick-and-mortar retail [store / business]”	No construction necessary.

In the context of the asserted patents, a “retail store” or “retail business” is a brick-and-mortar store or business, and does not include online stores. Inmar’s attempt to broaden the terms to include online retail shopping is not supported by any of the patents and should be rejected.

The claim language itself makes clear that the recited “retail store” or “business” is a brick-and-mortar physical location. Contrary to Inmar’s argument, none of the claims recites just a “point-of-sale device”—which Inmar argues is disclosed as encompassing “a computer performing an on-line purchase.” Br. at 3. Instead, the claims of the ’133 Patent, for example, recite a “point-of-sale *terminal which is located at a retail store.*” ’133 Patent, cl. 1. The claims of the ’855 Patent similarly require a POS terminal “*located at a retail store.*” ’855 Patent, cl. 1. The claims of the ’729 Patent use the term “retail business,” and like the ’133 and ’855 Patent claims, their

language makes clear that the “retail business” is a physical location. For example, claim 10 requires “the first coupon or incentive related information having been input to *a terminal in the retail business.*” ’729 Patent, cl. 10.

Other aspects of the claim language further establish that a “retail store” or “retail business” is a particular physical location distinct from other physical locations. For example, claim 1 of the ’133 Patent recites that “the first point-of-sale terminal . . . is located at a retail store and . . . the coupon processing server is at a location that is remote from the retail store.” The other claims include the same or similar language. *See* ’133 Patent cls. 11, 17, 25, 30, 33; ’855 Patent cls. 1, 32, 49, 51, 53, 54, 57; ’729 Patent cls. 1, 10, 16.

The specifications also confirm that the terms “retail store” and “retail business” are physical, brick-and-mortar locations. *See David Netzer Consulting Eng’r LLC v. Shell Oil Co.*, 824 F.3d 989, 993–94 (Fed. Cir. 2016) (“Because a patent is a fully integrated written instrument, we have long emphasized the importance of the specification in claim construction.”). The patents discuss a “retail store” as a physical location where a physical “coupon card may be read by a card reader.” ’133 Patent, 3:22–24 (“a coupon card may be read by a card reader 102 *at a retail store* or other establishment.”); ’855 Patent, 4:43–44; ’729 Patent, 6:63–64; *see also* ’729 Patent, 39:55–57 (“scanning, at a POS terminal located at a retail store, coupon information of a coupon”). The specifications of the ’855 and ’729 Patents also identify a “retail store” as a physical location which may include a network comprising “*the cabling within* a single retail store that connects all the POS terminals to the POS controller of the store,” ’855 Patent, 20:17–19; ’729 Patent, 22:53–55. The ’729 Patent further identifies a “retail store” as an example of a “single location.” ’729 Patent, 41:30–31 (“located in *a single location* 2828 (*such as in a retail store*).”). And the ’855 Patent

expressly distinguishes between a “retailer site” and a “web site.” ’855 Patent, 1:45–46 (“whether at a retailer site or through a web site.”).

The prosecution history confirms the invention is directed to brick-and-mortar retail stores. In distinguishing its patent from the prior art, the patentee explained that, unlike the prior art that involved multiple cash registers, its invention did not require any “additional *in-store, in-the-lane* hardware,” and instead allowed for data transfer between the cash register and the coupon processing server. Ex. 1 (June 28, 2011, ’133 Patent Remarks) at 14. The applicant’s discussion of in-store registers confirms the limitations of its claims. *See Univ. of Mass. v. L’Oreal S.A.*, 36 F.4th 1374, 1379 (Fed. Cir. 2022) (explaining “[t]he prosecution history, in particular, ‘may be critical in interpreting disputed claim terms,’” and using prosecution history to interpret claim limitation) (citation omitted).

Inmar’s argument about the ’729 Patent’s references to “on-line” purchases is also unavailing because the ’729 Patent is a continuation-in-part which discusses online transactions only in the new matter added, but Inmar seeks to claim an earlier priority date for its patents.² There is simply no support in the earlier patents for Inmar’s argument that the claims cover on-line stores in addition to brick-and-mortar ones. Moreover, as set forth in the relevant applications, the purpose of the invention was to improve the brick-and-mortar coupon experience, both for consumers who “clip[] and organiz[e] coupons” and manufacturers and retailers who have to “manual[ly] clear” coupons and deal with “[m]istakes in printing of coupons.” ’133 Patent, 1:21–30. The problem the inventor sought to solve—a problem arising in physical stores—supports

² Inmar contends that the priority date for the ’729 Patent is September 9, 2008. Ex. 11 (Inmar’s 2nd Supplemental R&Os to Interrogatory No. 2) at 7. Moreover, the “on-line” references in the ’729 Patent are not found anywhere in the earlier ’855 and ’133 Patents, thereby confirming that it is new matter that was added at the time of the filing of the ’729 Patent application in 2018.

Quotient’s interpretation of the claims here. *See Sequoia Tech., LLC v. Dell, Inc.*, 66 F.4th 1317, 1326 (Fed. Cir. 2023) (“We have explained that a patent’s express purpose of the invention ‘informs the proper construction of claim terms.’”).

c. “validating” / “validated” / “validation” / “validate”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 11 ’855 Patent: 1, 32, 33, 49, 51, 53, 54, 57 ’729 Patent: 1, 10, 16	“[Determining / determined / determination of / determine] whether the purchase requirements of the [coupon/incentive/etc.] have been met”	No construction necessary.

Validating a coupon, or coupon “validation,” is a term of art in coupon processing that involves determining whether the purchase requirements of a coupon have been met so that a customer can then redeem a coupon. *See, e.g.*, Ex. 2 (North American Coupon Application Guideline Using GS1 DataBar Expanded Symbols) at 23; Ex. 3 (Digital Coupon Management Standard Specification, Issue 1.0, June 2012) at 26; Ex. 4 (An Integrated Service Solution for Digital Discount Coupons Processing) at 400. For example, a coupon that is specifically for a Coca-Cola can only be redeemed for a Coca-Cola—and therefore it cannot be validated for the purchase of a Pepsi. A customer trying to buy a Pepsi would not be able to use a Coca-Cola coupon because it would be rejected during the coupon validation process as not meeting the purchase requirements (*i.e.*, purchasing a Coca-Cola). Coupon validation can be accomplished by comparing the universal product codes (“UPCs”) of the items the customer is purchasing to the eligible UPCs for the coupon. Ex. 5 (GS1-128 Info, UPC Coupon Barcodes).

The claims reflect that in order to validate the coupon or incentive, it is necessary to know what is being purchased so that the system can determine whether the purchase requirements are met. For example, claim 1 of the ’855 Patent requires that “the ICN server is configured to validate

the first coupon or incentive related information for redemption *based at least in part on the universal product codes* of items to be purchased.” ’855 Patent, cls. 1, 32, 49, 51, 53, 54, 57; *see also* ’729 Patent, cls. 1, 10, 16.

The patent specifications further support Quotient’s construction. The patents rely on industry terminology in claiming inventions that relate “to a network based system and method for *validating* and redeeming coupons.” ’133 Patent, 1:5–7; *see also* ’855 Patent, 1:14–17; ’729 Patent, 1:19–24. The specifications disclose “*normal* validation” of coupon codes and “*standard* coupon validation routines.” ’133 Patent, 6:20–24, 7:25–27; ’855 Patent, 7:42–45, 8:47–49; ’729 Patent, 10:1–5, 11:6–8. Thus, a person of skill would understand that there is a “normal” and “standard” coupon validation routine in the industry, and the patents rely on that meaning. The patents also contain numerous examples of coupon validation routines that compare coupon information with product information to determine whether the coupon requirements are met. For example, the ’133 Patent discloses that “the POS terminal may begin a *validation process* to validate each coupon code against *products purchased by the consumer*.” ’133 Patent, 4:46–48; *see also* ’133 Patent, 8:48–50 (“The software application at the POS terminal initiates a *validation process* of each coupon code received against the *product(s) purchased*.”); ’855 Patent, 18:2–17; ’729 Patent, 34:39–45.

The patents also reference industry standards relevant to coupon validation:

Coupons provide benefits to manufacturers and consumers. ... Consumers benefit because coupons are universally accepted, *follow GS1 (including Uniform Commercial Code) guidelines*, are easily understood by consumers, and require no prior notification to a retailer.

See, e.g., ’133 Patent, 1:11–20 (emphasis added); *see V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1311 (Fed. Cir. 2005) (“This court has established that ‘prior art cited in a patent or cited in the prosecution history of the patent constitutes intrinsic evidence.’”) (citation

omitted). GS1 provides a “Digital Coupon Management” “Standard Specification” that provides an overview of the eleven steps of the “Digital Coupon Management Process.” Ex. 3 (Digital Coupon Management Standard Specification, Issue 1.0, June 2012) at 13-34. Step 7 is titled “Validate Coupon” and is defined as: “The Offer Awarder validates whether the digital coupon is authentic and *whether the purchase meets the agreed business rules for the digital coupon.*” *Id.* at 26. The description of Step 7 is headed with a graphic titled “*Validation* and Redemption” and then notes that “up-to-date redemption information *to check whether the presented coupon complies with the redemption rules*” and “access to the related *purchase transaction information*” is required to validate a coupon. *Id.*

Inmar’s opposition appears to be based at least in part on a misunderstanding of Quotient’s claim construction request. Quotient is not seeking to construe the root word “valid.” Br. at 4–5. The terms Quotient seeks to construe all refer to the industry standard step of coupon *validation*, which can be identified easily in the claims. For example, claim 11 of the ’133 Patent requires “the point of sale terminal completing the purchase transaction by *validation* of the at least one valid coupon *against the purchased transaction.*” ’133 Patent, cl. 11. These words make plain that the process of “validation” recited in the claim involves determining whether the purchase requirements have been met, because validation is done “against the purchased transaction.”

Nor does the fact that the word “valid” is used elsewhere in the claims undermine Quotient’s proposed construction for “validating,” “validated,” “validation,” or “validate,” as Inmar wrongly argues. Br. at 5. That claim 11 recites “a *valid coupon*” where “a valid coupon is a coupon that has been validated by the coupon processing server” merely indicates that there may be other requirements to label a coupon “valid”—it does not negate the required step of “validation . . . against the purchased transaction.” Quotient is not seeking to construe the term

“valid coupon,” but instead the distinct concept of **validation** that involves determining whether the purchase requirements of a coupon have been met. Indeed, this is precisely why Quotient did not include claims 25 and 33 of the ’133 Patent in its claim construction chart—these claims only recite the first concept of a valid coupon. *See* ’133 Patent, cls. 25 & 33.

Moreover, Inmar insists that no construction is necessary, but does not explain what actually happens during coupon “validation” or what “normal validation” or “standard coupon validation routines” include. Br. at 4. That is insufficient. *Digi Portal LLC v. WebMD LLC*, C.A. No. 20-1435-MN, D.I. 37 (D. Del. Jan 7, 2022) (“Plaintiff shall articulate what it contends is the plain and ordinary meaning . . . where Plaintiff indicates no construction is necessary”). Inmar’s argument that “[a]ny juror will understand that valid means ‘not invalid’” is spurious both because “valid” is not the term Quotient seeks to construe, and because “not invalid” also has no clear meaning to a jury in this context. Br. at 4. Quotient puts forth a construction that is reasoned, supported by the specification and the industry standards to which the specification expressly refers, and takes into account the full context of the claim language.

Nor is Quotient’s proposed construction a “selective application,” as Inmar wrongly contends. Br. at 4. The fact that the term “valid” is used in one part of the claim and other terms with the same root are used differently elsewhere in the claim is reflective of the fact that these words have different meanings—it does not foreclose Quotient’s claim construction. *See Microprocessor Enhancement Corp. v. Texas Instruments, Inc.*, 520 F.3d 1367, 1375–77 (Fed. Cir. 2008) (allowing meaning of claim term to be understood based on its context within the claims because “the appropriate meaning of [the claim term] is readily apparent from each occurrence in context” and noting that the “nonsensical reading under a uniform construction of [the claim term]

is indicative of the ease of determining the appropriate meaning of each use of the term from its context”).

d. “real time”

Claims	Quotient’s Proposal	Inmar’s Proposal
’855 Patent: 11, 35 ’729 Patent: 3	“during or immediately after completion of a purchase without delay and not on a scheduled basis”	No construction necessary.

The ’855 and ’729 Patents are directed to instantaneous coupon processing with the means of providing valuable information from the transactions to manufacturers as the transactions occur, using electronic communication technology. *See* ’729 Patent, 1:57–62; ’855 Patent, 4:11–15. Quotient’s construction is consistent with the purpose of the patents and the ordinary meaning of providing information in “real time.” In contrast, Inmar seeks to impermissibly broaden the claim scope to cover the very thing the patents sought to improve upon, by improperly attempting to include in the meaning of “real time” providing transaction information at scheduled intervals (the opposite of “real time”).

Although “real time” is not specifically defined in the patents, the specifications make clear that “real time” communications occur during or immediately after a purchase transaction. The patents explain that prior art systems were “a slow, labor intensive process potentially prone to fraud and misuse.” ’729 Patent, 1:38–56; *see also* ’855 Patent, 1:21–46 (“[T]he manual clearing of coupons is labor intensive and may not provide vital market intelligence for weeks or months.”). The alleged invention attempted to resolve these issues by “validating and processing paper coupons quickly, eliminating potential fraud, and providing an auditable and comprehensive financial settlement process.” ’729 Patent, 1:57–62; ’855 Patent, 10:17–20. The specification states that an advantage to having “real time” capabilities is that the coupon information is

“available *immediately*” as opposed to having to “wait weeks until the redeemed coupon has completed the long journey through the manual coupon clearing process.” ’729 Patent, 11:30–40; ’855 Patent, 9:4–14. Further, the real-time capability allows the invention to “provide *immediate* alerts to the appropriate store personnel” if there is a fraud. ’729 Patent, 45:16–27; ’855 Patent, 8:12–16. Only Quotient’s construction fits these descriptions. Indeed, Inmar’s position contradicts the patents, which distinguish between “real time” and “batch” communications. ’855 Patent, 15:10–16:1 (“In this embodiment of the invention, the retailer, manufacturer, or media company can transmit in *real time or batch* the consumer opt-in information to the ICN database.”).

Inmar’s citations support Quotient’s construction. Specifically, Inmar pointed out that “[e]mbodiments of the invention can offer *detailed real-time redemption data that can be available 24 hours per day, 7 days per week.*” Br. at 6 (quoting ’855 Patent, 22:34–44; ’729 Patent, 25:4–15). Only data that is communicated during or immediately after a transaction would allow for detailed reports to be available 24 hours a day.

Extrinsic evidence also supports Quotient’s construction. Specifically, dictionary definitions of real-time include “the actual time during which something takes place” and “communicated, shown, presented, etc. at the same time as events actually happen.” *Real time*, Merriam-Webster.com, <https://www.merriam-webster.com/dictionary/real%20time> (last visited on Jan. 17, 2025); *Real time*, Dictionary.com, <https://dictionary.cambridge.org/dictionary/english/real-time> (last visited on Jan. 17, 2025). Inmar’s contrary position that “real time” can include communicating information at “scheduled” times is the opposite of “real time,” as reflected in both the patents themselves and the dictionary definition of “real time.”

e. “remote” / “located remotely” / “location that is remote”

Claims	Quotient’s Revised Proposal	Inmar’s Proposal
’133 Patent: 1, 11, 17, 25, 30, 33 ’855 Patent: 1, 32, 49, 51, 53, 54, 57 ’729 Patent: 1, 10, 16	“in a different location connected via a network”	Not indefinite.

In an effort to narrow the disputes before the Court, Quotient informed Inmar that Quotient would withdraw its indefiniteness position on this term and agree to Inmar’s suggestion in its brief that the term “remote” means “in a different location connected via a network.” *See* Br. at 8 (“These disclosures . . . would allow one skilled in the art to understand that ‘remote’ means in a different location connected via a network.”)). Yet despite suggesting the definition in its own brief, Inmar would not agree to it as the construction in this case. Quotient requests that the Court hold Inmar to its word and construe “remote” to mean “in a different location connected via a network.”

f. “point-of-sale terminal” / “POS terminal” / “terminal”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 1, 11, 17, 25, 30, 33 ’855 Patent: 1, 32, 49, 51, 53, 54, 57 ’729 Patent: 1, 10, 16	“a terminal installed at a checkout location in a brick-and-mortar retail store or business that is used to complete in-store purchase transactions”	No construction necessary.

The point-of-sale “terminal” terms refer to a specific terminal installed at a checkout location in a brick-and-mortar retail store. As with the “retail store” term, Inmar attempts to expand the scope of its claims beyond the ordinary meaning of the term and what the patent disclosure supports.

The patents' discussion of point-of-sale "terminals" makes clear that when the patents refer to a point-of-sale "terminal," they are referring to a terminal located in a brick-and-mortar store. The specifications demonstrate that a POS terminal is physically located at the retailer, including by explaining the physical interactions the customer has with the retailer. *See, e.g.*, '133 Patent, 6:10–16 ("At the POS, the consumer may swipe his/her coupon card through a card reader . . ."); *id.* at 7:32–38. The patents further explain how the cashier at the retail store interacts with the POS terminal. *See, e.g.*, '133 Patent, 4:31–40 ("[D]uring checkout, the cashier presses a coupon card function key on the POS terminal...."); *id.* at 8:22–24 ("The cashier may select the coupon card function key on the POS terminal keyboard."); '855 Patent, 5:53–62, 9:44–46, 14:33–41, 17:47–51. Indeed, the patents never refer to POS terminals in connection with online transactions. Only the '729 Patent discusses the concept of a "point of sale" for online purchases, and there, it expressly uses different terminology to encompass a broader range of devices: "point-of-sale (POS) *devices*," not terminals. '729 Patent, 41:34–44; *see also id.*, 47:24–26, 48:56–58, 50:25–27, 51:60–62.³

The plain meaning of the term point-of-sale terminal refers to a specific structure used in retail stores. Newton's Telecom Dictionary defines "point of sale terminal" as "[a] special type of computer terminal which is used to collect and store retail sales data. This terminal may be connected to a bar code reader and it may query a central computer for the current price of that item. It may also contain a device for getting authorizations on credit cards." Ex. 6 (Point of Sale Terminal, Newton's Telecom Dictionary (25th ed. 2009)) at 870. Similarly, Chambers defines "point-of-sale terminal" as "an electronic terminal used at retail outlets (eg [sic] supermarket

³ The patents also clearly distinguish between a "point of sale" or POS terminal, which is discussed exclusively in connection with a transaction at a retail store, and "other terminal[s]," which may be used "when shopping from home." *See* '855 Patent, 16:31–39.

checkouts) which records, and processes esp[ecially] for stock-control purposes, sales-transaction information.” Ex. 7 (Point-of-sale terminal, The Chambers Dictionary (12th ed. 2011)) at 1197. Other dictionaries confirm that a point-of-sale terminal refers to a particular physical location, namely a store. For example, the Microsoft Computer Dictionary defines “point-of-sale” as “*[t]he place in a store* at which goods are paid for. Computerized transaction systems, such as those in use at automated supermarkets, use scanners for reading tags and bar codes, electronic cash registers, and other special devices to record purchases at this point.” Ex. 8 (Point of Sale (POS), Microsoft Computer Dictionary (5th ed. 2002)) at 411, 414.

Inmar’s attempt to broaden the meaning of these terms to encompass online shopping transactions should also be rejected because that concept appears only in the continuation-in-part application that issued as the ’729 Patent (using the broader terminology “point-of-sale *device*”), whereas Inmar seeks to claim an earlier priority date for the asserted patents. *See supra*, 2 n.2.

g. “the apparatus” / “apparatus (preamble)”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 17, 25, 30, 33	“[the] single device that is at a centralized location” (preamble is limiting)	No construction necessary; preamble is not limiting.

“[A] preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality to the claim.’” *Vizio, Inc. v. Int’l Trade Comm’n*, 605 F.3d 1330, 1340 (Fed. Cir. 2010). A preamble is also limiting “when the claim(s) depend on it for antecedent basis.” *C.W. Zumbiel Co., Inc. v. Kappos*, 702 F.3d 1371, 1385 (Fed. Cir. 2012) (citing *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002)); *see also Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (“[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects. . . . When

limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.”) (citation and quotation marks omitted). The “apparatus” preamble of claims 17, 25, 30, and 33 of the ’133 Patent is limiting for both reasons.

Here, the preambles are limiting because the body of the claims rely upon and derive antecedent basis from them. Specifically, the preambles recite “[a]n apparatus,” which provides an antecedent basis for “the apparatus” in the body of the claims. The Federal Circuit has “repeatedly held a preamble limiting when it serves as antecedent basis for a term appearing in the body of a claim.” *SIMO Holdings Inc. v. Hong Kong uCloudlink Network Tech. Ltd.*, 983 F.3d 1367, 1375 (Fed. Cir. 2021) (quoting *In re Fought*, 941 F.3d 1175, 1178 (Fed. Cir. 2019)). Because the claim limitations refer back to and derive antecedent basis from the preamble’s recitation of “[a]n apparatus,” the preamble is limiting. *See Eaton Corp.*, 323 F.3d at 1339.

In addition, the preambles of claims 17 and 25 are limiting because they do not simply state a purpose or intended use of the invention (Br. at 11); rather, they recite essential structure or steps of the claims. *See Vizio, Inc.*, 605 F.3d at 1340. The Federal Circuit has held that a preamble is limiting “where the body identifies nothing but functional properties of the claimed apparatus,” and “the preamble language supplies ‘essential structure.’” *SIMO Holdings*, 983 F.3d at 1375. Here, the preamble provides essential information about the structure of the invention that the body of the claim does not, including that it comprises an apparatus with a “processor” and “memory storing software,” that the processor “execut[es] to “cause the apparatus to perform operations.” The subsequent claim limitations identify those functional operations (“scan[ning],” “transmit[ting],” “receiv[ing],” etc.), but absent the structure and meaning provided by the preamble, those limitations lose their context. *See Vizio, Inc.*, 605 F.3d at 1340.

The claim language also supports Quotient’s construction of “apparatus” as a singular device at a centralized location capable of performing all of the claimed limitations. Inmar’s position is premised entirely on the general rule that “a” means one or more, but “[t]he general rule does not apply when the context clearly evidences that the usage is limited to the singular.” *TiVo, Inc. v. EchoStar Commc’ns Corp.*, 516 F.3d 1290, 1303 (Fed. Cir. 2008) (citing *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1344 (Fed. Cir. 2008)). In any event, whether “a” means one or more in the claims is not dispositive. Whether indefinite articles in a claim mean one or more “is a separate issue from whether the claims require the same component to perform multiple functions or satisfy multiple limitations of a claim.” *Finjan LLC v. SonicWall, Inc.*, 84 F.4th 963, 974 (Fed. Cir. 2023) (citing *Salazar v. AT&T Mobility LLC*, 64 F.4th 1311, 1318 (Fed. Cir. 2023)). As the Federal Circuit has held, even if an indefinite article in the claim is interpreted to refer to “one or more” devices, the claim language may still require that at least one of those devices be capable of performing all the functions listed in the claims. *Id.* at 974–75 (holding that patent reciting “‘a computer’—subsequently referred to as ‘the computer’” required “that the same computer perform each of the claimed steps”); see *Traxcell Techs., LLC v. Nokia Sols. & Networks Oy*, 15 F.4th 1136, 1143–44 (Fed. Cir. 2021) (“[R]eciting ‘a computer’ . . . that performs a function, and then further reciting that ‘the computer’ . . . performs multiple additional functions, suggests that such ‘computer’ must be tied to all those functions.”).

Here, it is clear from the claim language that the claimed “apparatus” was intended to be limited to a single centralized device capable of performing all the claimed operations, as opposed to remote, scattered components, each performing different operations. After the introduction of “[a]n apparatus” in the preamble, all of the limitations refer back to “the apparatus.” The claims each recite that “the apparatus” performs the operations listed in the subsequent limitations. Thus,

while there could be multiple apparatuses capable of performing these operations, the claims require that at least one singular apparatus is capable of performing all of them. *Accord Salazar*, 64 F.4th at 1317 (“[W]hile the claim term ‘a microprocessor’ does not require there be only one microprocessor, the subsequent limitations referring back to ‘said microprocessor’ require that at least one microprocessor be capable of performing each of the claimed functions.”).

h. “the processor” / “processor (preamble)”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 17, 25 ’855 Patent: 49, 51, 53 ’729 Patent: 10	“[the] single processor” (preamble is limiting)	No construction necessary; preamble is not limiting.

For the same reasons explained in Section II(g), *supra*, the preambles of claims 17 and 25 of the ’133 Patent, claim 49 of the ’855 Patent, and claim 10 of the ’729 Patent are also limiting. The bodies of these claims provide solely functional properties of the claimed apparatus (e.g., “receiving,” “interpreting,” “validating”)—the preamble is necessary to provide essential structure (e.g., “processor,” “software,” “computer code,” “network,” “memory”) and to give life, meaning, and vitality to the claims. *See SIMO Holdings Inc.*, 983 F.3d at 1375; *Vizio, Inc.*, 605 F.3d at 1340. Accordingly, the preambles should be treated as limiting.

In addition, the claim language at issue here further demonstrates that a singular claimed component (processor) is required by the claims to satisfy multiple limitations. *See Finjan LLC*, 84 F.4th at 974. “[T]he language and structure” of the claims—such as the use of the definite article “the” following the use of indefinite articles—supports a conclusion that a singular processor must be capable of satisfying several limitations. *See Convolve, Inc. v. Compaq Comput. Corp.*, 812 F.3d 1313, 1321 (Fed. Cir. 2016) (holding claim reciting a “[u]ser interface that “operatively work[ed] with a processor,” and “means for causing the processor” to perform certain

claimed functions “require[d] the user interface to work with a single processor in performing all of the claim steps.”).

It is clear from the claim language that while a system may contain multiple processors, there must be at least one single processor that performs all of the claimed limitations. The claims all recite “a processor” and subsequently refer to it as “the processor,” (e.g., ’729 Patent cl. 10 (“An ICN server comprising **a** processor; and a memory including computer program code, the memory and the computer program code configured to, with **the** processor . . .”) (emphasis added)), suggesting that the same processor must perform the same functions. *See Finjan LLC*, 84 F.4th at 974–75. For example, claim 51 of the ’855 Patent, which claims a “point of sale (POS) terminal,” first recites “a processor” in the third limitation and subsequently, in the sixth limitation, recites:

the processor configured to receive information comprising product code information of an item to be purchased and the coupon related information from the first interface; to transmit the information through the second interface to the coupon or incentive processing server, where the coupon or incentive processing server is at a location that is remote from the retail store; in response to the coupon or incentive related information being validated at the coupon or incentive processing server based at least in part on the product code information, to receive the promotion request message; and to execute the point of sale bridge software.

’855 Patent cl. 51 (emphasis added). “This reference to ‘the processor,’ referring back to the ‘a processor’ . . . supports a conclusion that the recited [POS terminal] is ‘operatively working with’ the same processor to perform all of the recited steps.” *Convolve, Inc.*, 812 F.3d at 1321; *see also Traxcell Techs., LLC*, 15 F.4th at 1143–44.

- i. “where the unique account identifier was scanned at the first point-of-sale terminal” / “the first coupon or incentive related information having been input to a terminal in the retail business” / “where the promotion request message is scanned at the POS terminal located at a retail store”

Claims	Quotient’s Proposal	Inmar’s Proposal
’133 Patent: 1, 17, 30	Indefinite under <i>IPXL</i> .	Not indefinite.
’855 Patent: 49, 53		
’729 Patent: 10, 16		

If a claim “recites both a system and the method for using that system, it does not apprise a person of ordinary skill in the art of its scope, and it is invalid under section 112, paragraph 2.” *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005). All three patents asserted by Inmar contain independent claims reciting computer-readable mediums (CRM) and/or apparatuses that improperly include a method step requiring scanning or inputting of certain data to occur. Under *IPXL*, these claims and their dependent claims are indefinite. *Id.*

Three of the independent claims of the ’133 Patent include a limitation requiring a user to scan a unique account identifier at a point-of-sale terminal: “where the unique account identifier was scanned at the first point-of-sale terminal.” ’133 Patent, cls. 1, 17, 30. The ’855 Patent similarly contains two independent claims with comparable limitations requiring a user to scan data at a point-of-sale terminal: “where the [first coupon or incentive related information / promotion request message] is scanned at the [POS] terminal located at a retail store.” ’855 Patent, cls. 49, 53. Finally, the ’729 Patent also contains two independent claims that include a similar limitation: “the first coupon or incentive related information having been input to a terminal in the retail business.” ’729 Patent, cls. 10, 16.

The presence of these method steps in non-method claims is exactly what the Federal Circuit proscribed in *IPXL*. The limitations are written in past and/or present tense (“was scanned,”

“having been input,”) suggesting that the data must be input into and/or scanned at the point-of-sale terminal as a necessary step for infringement to occur; yet the claims specify that they cover “apparatus[es]” and “computer-readable medium[s],” not methods. Because of this, “it is unclear whether infringement of [the asserted patents] occurs when one creates a[n] [apparatus/CRM] that allows the user to [scan and/or input data into the point-of-sale terminal], or whether infringement occurs when the user actually [scans and/or inputs data into the point-of-sale-terminal].” *IPXL Holdings*, 430 F.3d at 1384.

Inmar’s arguments to the contrary are unavailing. First, Inmar incorrectly claims that “claim 1 of the ’133 Patent . . . is a method claim,” and makes arguments relevant thereto. Br. at 12. But claim 1 of the ’133 Patent is “computer-readable medium” claim, not a method claim. Second, contrary to Inmar’s assertions, the actual claims presenting an indefiniteness issue do not merely recite an apparatus/CRM that “is configured to receive certain information.” Br. at 13. Rather, the claim language requires that the information is in fact input and/or scanned at a point-of-sale terminal that is at a location remote from the coupon processing server.

Indeed, the claims requiring an actual transaction (rather than just a configuration or capability) were crucial to getting the patents-in-suit granted in the first place: during prosecution, the examiner noted that “the prior art does not disclose a situation in which the coupon information of a pending transaction ***is transmitted*** to a server that is remote from the retail store” Ex. 9 (May 23, 2014, Office Action) at 12 (emphasis added).

Because simply having a processor configured to receive certain information does not satisfy the claims, but rather the claims require a method step wherein the information is actually “scanned” or “input” at a point-of-sale terminal, claims 1, 17, and 30 of the ’133 Patent, claims 49 and 53 of the ’855 Patent, and claims 10 and 16 of the ’729 Patent are invalid as indefinite.

j. Order of steps

Claims	Quotient's Proposal	Inmar's Proposal
'133 Patent: All claims '855 Patent: All claims '729 Patent: All claims	The steps and/or operations of the claimed apparatus/systems must occur or be performed in the sequence that they are presented in the claims. Nonlimiting examples: '133 Patent Claim 1: 1[c] [scanning] 1[a] [receiving] 1[e] [determining] 1[f] [transmitting] 1[g][a] [updating] 1[g][b] [transmitting] '855 Patent Claim 1: 1[e] [scan] then [transmit] 1[f] [transmit] 1[g] [validate] then [transmit] '855 Patent Claim 32: 32[a] [scanning] 32[b] [transmitting] 32[c] [validating] then [receiving] '729 Patent Claim 1: 1[a] [input] then [receiving] 1[b] [validating] 1[c] [transmitting] 1[d] [redemption] then [receiving] 1[e] determining 1[f] storing '729 Patent Claim 10: 10[a] [input] then [receive] 10[b] [validate] 10[c] [transmit] 10[d] [redemption] then [receive] then [determine] 10[e] [store]	The order of steps is not limiting.

The patents allegedly offer a “fast, convenient way for processing coupons and quickly providing comprehensive market intelligence to retailers and manufacturers.” ’133 Patent, 1:31–34. The claims are directed to point-of-sale terminals and coupon processing servers that interact with each other to allow customers at retail stores to redeem coupons immediately during checkout. That ability depends on a sequence of events and communications between the point-of-sale terminal and coupon processing server during customer checkout at a retail store.

In addition, the alleged patentability of the asserted claims depends on the requirement that the steps recited in the claims be performed in the claimed order. During prosecution, the applicant argued that the alleged invention was an “ordered combination” to overcome a § 101 rejection. Specifically, the patentee argued that “viewing the claim elements as an ordered combination, the steps recited above for [the claims] improve the technology of processing coupons across a network.” Ex. 10 (Apr. 9, 2015 ’133 Patent Remarks) at 17. In addition, the patentee claimed an improvement over “the prior art coupon systems where all the components are located at the retail store require the digital coupons (e.g., the coupon definitions) to be pre-loaded in every single store location and to be validated locally at the retail store location.” *Id.* at 14. Further, “the digital coupons can be defined, edited, and/or corrected in real time in a centralized database at the remote processing server so that each retail store has instant access, e.g., corrected coupon coding errors can be instantly accessed by each retail store that is connected to the remote coupon processing server.” *Id.* at 15. Thus, the claims must be construed consistently with the prosecution history and require the logical sequence of coupon data transfer between the POS terminal and coupon processing server. To allow the steps to be performed in other orders would implicate the prior art the patentee distinguished—for example, use of a pre-loaded coupon database.

Inmar ignores that the claims have a readily apparent logical sequence, regardless of whether some claims are structured such that descriptions of events that must take place earlier appear later in the claim language. For example, the unique account identifier must be scanned before it can be received by the coupon processing server, although the scanning limitation appears later in the claim. *See, e.g.*, '855 Patent, cl. 54. Similarly, some claim elements do not contain steps that need to be ordered (such as the limitations describing the location of the retail store). *See, e.g.*, '133 Patent, cls. 1, 11, 17, 25, 30, 33.

Inmar is also incorrect that non-method claims cannot be subject to an order of steps construction. *See, e.g., Function Media, LLC v. Google, Inc.*, 708 F.3d 1310, 1319–20 (Fed. Cir. 2013) (affirming the district court's claim construction and holding that a system claim that recited "processing" an "electronic advertisement" necessarily required "the creation of the ad must happen before the processing begins"). Here, the purpose of the claimed invention must be accomplished by a specific sequence of steps initiated by a customer initiating a purchase, thus the apparatus and system claims must be directed to inventions that operate in the logical sequence to accomplish the purpose of the invention.

III. CONCLUSION

For the foregoing reasons, Quotient's proposed claim constructions should be adopted.

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