**IN THE UNITED STATES DISTRICT COURT**
**FOR THE WESTERN DISTRICT OF TEXAS**
**WACO DIVISION**

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|---|---|---|
| **ALMONDNET, INC., INTENT IQ, LLC,**<br>***Plaintiff,***<br><br>**-v-**<br><br>**MICROSOFT CORPORATION,**<br>***Defendant.*** | §<br>§<br>§<br>§<br>§<br>§<br>§<br>§<br>§ | **6:21-CV-00897-ADA** |
| **ALMONDNET, INC., INTENT IQ, LLC,**<br>***Plaintiff,***<br><br>**-v-**<br><br>**AMAZON.COM, INC., AMAZON.COM SERVICES LLC, AMAZON WEB SERVICES, INC.,**<br>***Defendants.*** | §<br>§<br>§<br>§<br>§<br>§<br>§<br>§<br>§<br>§<br>§ | **6:21-CV-00898-ADA** |

**CLAIM CONSTRUCTION ORDER AND MEMORANDUM IN SUPPORT THEREOF**

Before the Court are the Parties' claim construction briefs: Defendants' Microsoft Corporation's and Amazon.com, Inc., Amazon.com Services LLC, and Amazon Web Services, Inc.'s ("Amazon") Opening and Reply briefs (6:21-cv-00897 ECF Nos. 29 and 32, respectively; 6:21-cv-00898 ECF No. 33 and 40, respectively) and Plaintiffs AlmondNet, Inc. and Intent IQ, LLC's Response and Sur-Reply briefs (6:21-cv-00897 ECF Nos. 30 and 34, respectively; 6:21-cv-00898 ECF No. 34 and 42, respectively). The Court provided preliminary constructions for the disputed terms one day before the hearing. The Court held the *Markman* hearing on November 30, 2022. 6:21-cv-00897 ECF No. 69, 6:21-cv-00898 ECF No. 50. During that hearing, the Court informed the Parties of the final constructions for the disputed terms. *Id.* This Order does not alter any of those constructions.

## I. DESCRIPTION OF THE ASSERTED PATENTS

Plaintiff asserts U.S. Patent Nos. 7,822,639, 8,244,582, 8,244,586, 8,671,139, 8,677,398, 9,830,615. All six patents are generally directed towards targeted advertising, which the parties divide into four groups.

### A. Group 1: '582 Patent

In the first group, which Defendants call the "Profiling Matching" patent, is the '582 Patent. The specification and claims of the '582 Patent describes gathering profile information about a user, adding that information to an already maintained profile for the user, and then using that information to target advertising. '582 Patent at 3:62–4:38; '582 Patent, Claims 1, 11.

### B. Group 2: '639 and '586 Patents

In the second group, which Defendants call the "Advertising Saturation" patents, are the '639 and '586 Patents. The specifications of these patents describe targeting advertising for when a media property, *e.g.*, a website, becomes "saturated" (*i.e.*, cannot accept any more advertising) by using a third party to place additional targeted advertising on another media property. '639 Patent at 2:51–58, '586 Patent at 2:51–60.

### C. Group 3: '139 and '615 Patents

In the third group, which Defendants call the "Targeted Advertising" patents, are the '139 and '615 Patents. These patents describe "an automatic system" to "facilitate selection of media properties on which to display an advertisement, responsive to a profile collected on a first media property[.]" '139 Patent at 6:12–18; '822 Patent at 6:12–35

### D. Group 4: '398 Patent

In the fourth group, which Defendants call the "Viewer Targeting" patent, is the '398 Patent. The specification describes that the inventor sought to solve a specific problem, namely,

how to "avoid the use of PII"—or "personally identifiable information," such as a user's name, birth date, or account numbers—when targeting users on one electronic device medium "based on activity in another." '398 Patent at 7:13–22. The '398 Patent describes "[u]sing user profile information derived from online activity from one of the online access IP addresses, a television advertisement is selected, such as by using behavioral targeting or demographic information, and automatically directed to the set-top box indicated by the set-top IP address associated with that online access IP address." '398 Patent at 7:66–8:11

## II. LEGAL STANDARD

### A. General principles

The general rule is that claim terms are generally given their plain-and-ordinary meaning. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*); *Azure Networks, LLC v. CSR PLC*, 771 F.3d 1336, 1347 (Fed. Cir. 2014), *vacated on other grounds*, 575 U.S. 959, 959 (2015) ("There is a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time.") (internal quotation omitted). The plain-and-ordinary meaning of a term is the "meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips*, 415 F.3d at 1313.

The "only two exceptions to [the] general rule" that claim terms are construed according to their plain-and-ordinary meaning are when the patentee (1) acts as his/her own lexicographer or (2) disavows the full scope of the claim term either in the specification or during prosecution. *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). The Federal Circuit has counseled that "[t]he standards for finding lexicography and disavowal are exacting." *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014). To act as his/her

own lexicographer, the patentee must "clearly set forth a definition of the disputed claim term" and "'clearly express an intent' to [define] the term." *Thorner,* 669 F.3d at 1365.

"Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent." *Phillips*, 415 F.3d at 1317. "[D]istinguishing the claimed invention over the prior art, an applicant is indicating what a claim does not cover." *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1379 (Fed. Cir. 1998). The doctrine of prosecution disclaimer precludes a patentee from recapturing a specific meaning that was previously disclaimed during prosecution. *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003). "[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable." *Id.* at 1325–26. Accordingly, when "an applicant's statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable." *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013).

A construction of "plain and ordinary meaning" may be inadequate when a term has more than one "ordinary" meaning or when reliance on a term's "ordinary" meaning does not resolve the parties' dispute. *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008). In that case, the Court must describe what the plain-and-ordinary meaning is. *Id.*

"Although the specification may aid the court in interpreting the meaning of disputed claim language . . ., particular embodiments and examples appearing in the specification will not generally be read into the claims." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir. 1988). "[I]t is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in

the intrinsic record that the patentee intended the claims to be so limited." *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004).

Although extrinsic evidence can be useful, it is "less significant than the intrinsic record in determining 'the legally operative meaning of claim language.'" *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004)). Technical dictionaries may be helpful, but they may also provide definitions that are too broad or not indicative of how the term is used in the patent. *Id.* at 1318. Expert testimony may also be helpful, but an expert's conclusory or unsupported assertions as to the meaning of a term are not. *Id.*

**B. Indefiniteness**

"[I]ndefiniteness is a question of law and in effect part of claim construction." *ePlus, Inc. v. Lawson Software, Inc.*, 700 F.3d 509, 517 (Fed. Cir. 2012). Patent claims must particularly point out and distinctly claim the subject matter regarded as the invention. 35 U.S.C. § 112, ¶ 2. A claim, when viewed in light of the intrinsic evidence, must "inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 910 (2014). If it does not, the claim fails § 112, ¶ 2 and is therefore invalid as indefinite. *Id.* at 901. Whether a claim is indefinite is determined from the perspective of one of ordinary skill in the art as of the time the application was filed. *Id.* at 911.

## III. LEGAL ANALYSIS

### A. Term #1: "tag"

| Term | Plaintiffs' Proposed Construction | Amazon's Proposed Construction |
|---|---|---|
| #1: "tag"<br><br>U.S. Patent No. 7,822,639, Claims 24, 40, 44; U.S. Patent No. 8,244,586, Claims 1, 2, 7, 8, 11, 19, 20; U.S. Patent No. 8,671,139, Claims 3, 46, 47, 50, 51, 53; U.S. Patent No. 8,959,146, Claims 10, 11, 23, 24; U.S. Patent No. 9,830,615, Claim 9; U.S. Patent No. 10,321,198, Claims 22, 23; U.S. Patent No. 8,200,822, Claims 37, 43, 44, 47, 49, 50, 51<br><br>Proposed by Amazon | No construction necessary; plain and ordinary meaning | Identifier<br><br>Alternatively, an identifier or information indicating that its bearer has been marked |

Amazon contends that the Court should construe this term to aid the jury. Opening at 5. Amazon contends that, "in the context of the alleged inventions, the term 'tag' simply refers to an 'identifier.'" *Id.* at 5–6 (quoting '639 Patent at 5:29–32, 5:23–32; '586 Patent at 5:20–29; '139 Patent at 3:22–26; '615 Patent at 3:32–36; '822 Patent at 3:22–26; '198 Patent at 10:1–12, 10:22–25). Amazon contends that their proposed construction is consistent with contemporary dictionary definitions. *Id.* at 6.

In their response, Plaintiffs contend that "tag" does not need construction as it is a commonly used English word to "refer to the result of the action of tagging," *e.g.*, like a name tag is an item that someone tags themselves with. Response at 4, 5 (citing '586 Patent at 6:41–45, 20:23–24). Plaintiffs contend that the '586 Patent recites that a "tag simply identifies that its bearer

was so marked." *Id.* at 5 (citing '586 Patent at 5:20–29). Plaintiffs contend that extrinsic evidence supports their proposed construction. *Id.* at 5–6 (citing dictionary definitions).

With respect to Amazon's proposed construction, Plaintiffs first contend that Amazon's alleged need to construe the term—jury confusion—is hypothetical as Amazon has not provided evidence that a jury might be confused. *Id.* at 6.

Plaintiffs contend that Amazon's proposed construction is incorrect because the specification recites that the "tag" does not need to contain any information that identifies the visit. *Id.* (citing '586 Patent at 5:20–29). Plaintiffs contend that the intrinsic record "further emphasizes" the distinction between "tag" and "identifier." *Id.* at 7 (quoting '198 Patent at 22:64–67 ("[e]xamples of extra identifiers could include . . . a tag."), Claim 11 ("the first set-top box identifier includes a tag or a cookie on the first set-top box.").

Plaintiffs contend that extrinsic evidence confirms that a "tag" need not "identify" the visitor. *Id.* at 6–7 (citing dictionaries).

In their reply, Amazon contends that the parties are closer than expected, but that Plaintiffs are asking the Court to kick the can down the road. Reply at 1. To avoid that, Amazon contends that the Court should just construe the term at this stage in the case as "the Court will likely reach the same conclusion it can reach right now—a tag is simply an identifier or information indicating that its bearer has been marked." *Id.*

In their sur-reply, Plaintiffs contend that Amazon do not allege lexicography to justify their construction. Sur-Reply at 1. Plaintiffs contend that Amazon's proposed construction could require that the entity being tagged store the tag, but that would be inconsistent with the specification which describes that a "tag does not have to be placed on the user's device." *Id.* (quoting '146 Patent at 4:24; '586 Patent at 10:45–50). Plaintiffs contend that Amazon does not

provide evidence that this term would be difficult for a POSITA or a lay jury to understand. *Id.* at 1–2.

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347. ***Second***, Defendant does not expressly allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning. *Thorner*, 669 F.3d at 1365. ***Third***, Defendants do not provide evidence that this term would be difficult for a POSITA or a lay jury to understand, nor does the Court believe that a POSITA or a lay jury would not understand the meaning of this term.

Therefore, for the reasons described above, the Court finds that "tag" should be construed according to its plain-and-ordinary meaning.

**B. Term #2: "delivery to visitor computers visiting a second, different Internet site of advertisements sold, for a first price, for placement on visitor computers that have visited the first Internet site" / "direction of at least one off-site advertisement to visitor computers visiting a second Internet site . . . which off-site advertisement concerns at least one offering of a third-party advertiser that has paid to display said advertisement on visitor computers that have visited the first Internet site"**

| Term | Plaintiffs' Proposed Construction | Amazon's Proposed Construction |
|---|---|---|
| #2: "delivery to visitor computers visiting a second, different Internet site of advertisements sold, for a first price, for placement on visitor computers that have visited the first Internet site" / "direction of at least one off-site advertisement to visitor computers visiting a second Internet site . . . which off-site advertisement concerns at least one offering of a third-party advertiser that has paid to display said advertisement on visitor computers that have visited the first Internet site"<br><br>U.S. Patent No. 7,822,639, Claim 24; U.S. Patent No. 8,244,586, Claims 1, 11<br><br>Proposed by Amazon | No construction necessary; plain and ordinary meaning | <u>'639 patent, claim 24; '586 patent, claim 11:</u><br>delivery to visitor computers <u>currently</u> visiting a second, different Internet site of advertisements <u>that were</u> sold, for a first price, for placement on visitor computers that have visited the first Internet site<br><br><u>'586 patent, claim 1:</u><br>direction of at least one off-site advertisement to visitor computers <u>currently</u> visiting a second Internet site . . . which off-site advertisement concerns at least one offering of a third-party advertiser that has <u>previously</u> paid to display said advertisement on visitor computers that have visited the first Internet site |

**<u>The Parties' Positions:</u>**

The parties have two disputes: (1) the "direction/delivery of an advertisement to visitor computers visiting a second Internet site," and (2) the timing of the "sale" or "payment" for that advertisement. Response at 8.

Amazon contends that its proposed constructions "***clarify*** that the transaction must occur prior to the display of the advertisement on the second Internet site[.]" Opening at 8 (emphasis in Defendants' brief). Amazon contends that the sole embodiment in the specification describes that when space for advertisement is sold out for a first Internet site, space for that advertisement may be sold on a second Internet site. *Id.* (citing '639 Patent at 13:10–23, 13:24–33).

Amazon also contends that the patentee "confirmed during prosecution that, in the claimed invention, the advertisements are first sold for displaying to visitors on a first Internet site, and then are displayed to the visitors when they arrive at a second Internet site." *Id.* at 9. More specifically, Amazon contends that "[t]he patentee replaced then-recited 'selling placements of advertisements on a multitude of computers that visit the first site' to 'refer[] ... to advertisements sold for placement on computers visiting the first site." *Id.* (some internal quotations marks omitted). Amazon contends that Examiner accepted Applicant's amendment and characterization, and indicated that the basis for patentability was because prior art did not disclose that the (1) user's computer was "currently visiting a second site" and (2) "advertisements that were sold for placement to visitors of the first site are directed to the second site[.]" *Id.* at 9–10 (quoting Opening, Ex. 6 at 3–4, 4–5).

In its response, with respect to the first issue, Plaintiffs do not dispute that the advertisement must be delivered at/on the second sites, but Plaintiffs contend that Amazon's construction would "seemingly allow the claim to be satisfied by delivering the ad to the visitor at the first site, because at the time the advertisement is delivered, the visitor would be 'currently visiting a second, different Internet site.'" Response at 8. Based on this, Plaintiffs contend that Amazon's proposed construction incorrectly focuses on timing of the advertisement delivery, rather than the location of its delivery. *Id.* Plaintiffs contend that Examiner's Notice of Allowance "cannot give rise to

narrowing disclaimer." *Id.* at 9 (quoting *Salazar v. Procter & Gamble Co.*, 414 F.3d at 1345; *3M Innovative Props.*, 350 F.3d at 1374).

With respect to the second issue, Plaintiffs contend that the intrinsic evidence indicates that the payment occurs at some time and not necessarily prior to delivery. *Id.* More specifically, Plaintiffs contend that the intrinsic evidence does not specify when the payment takes place. *Id.* (quoting '639 Patent at 6:58–7:26, 7:44; citing '639 Patent 7:53–54, 7:60–61, 8:2–4, 8:55–59, 11:18–21, 11:26–67, 12:18–19, 12:29–30, 12:36–37, 12:45–47).

Plaintiffs contend that Defendants' proposed construction incorrectly requires that the advertisement must have been previously sold for display on the first Internet site. *Id.* But Plaintiffs contend that the passage Defendants cite ('639 Patent at 12:9–14) does not describe paying for an advertisement on a first Internet site, but rather only describes inserting an advertisement into an "offsite media," *i.e.*, the second Internet site. *Id.* at 10. Plaintiffs contend that nothing in this embodiment or any other passages Defendants cite to, "implies, much less requires, that the same advertisement is presented at both the first site and the second site." *Id.*

Plaintiffs contend that "Amazon similarly provides no support in the file history for its proposed construction (and certainly nothing that would give rise to the "exacting" standard for disclaimer)." *Id.* at 10–11. More specifically, Plaintiffs contend that nothing in Applicant's prosecution statements "clearly distinguishes the prior art on the basis of the *timing* of the sale or payment[.]" *Id.* at 11 (quoting Response, Ex. 3 at 12 ("any ads in Oliver shown on Site 2 are not from advertisers who 'paid to display said advertisements on visitor computers that have visited the first Internet site.'"), 12 ("Neither Oliver nor Adshare Concepts disclose any site getting revenue from advertisements that were sold for display on computers that visited a different site.")) (emphasis in original).

In their reply, Amazon contends that their proposed construction clarifies that advertisements are delivered to visitor computers visiting the second Internet site "***after*** the transaction related to advertisements on 'visitor computers that have visited the first Internet site.'" Reply at 2 (emphasis in original).

With respect to Plaintiffs' argument that Applicant's prosecution statements were not directed towards the timing of the sale or payment, Amazon contends that Plaintiffs are incorrect. *Id.* More specifically, Amazon contends that Applicant stated that the advertisement on the second Internet site "arises from the advertiser having 'paid to display said advertisement on visitor computers that have visited the first Internet site.'" *Id.* at 2–3 (quoting Opening, Ex. 3 at 12 (emphasis added by Amazon)). Amazon contends that in order to "arise from," the advertisement on the second Internet site must occur after the transaction of displaying advertisements on visitor computers that have visited the first Internet site. *Id.* at 3. Amazon further contends that Examiner's statements indicate that the Examiner understood Applicant's statements in that way as well. *Id.*

With respect to whether the claims require that an advertisement be previously sold for display on the first Internet site, Amazon contends that the claimed invention is premised on the situation whether the first Internet site becomes "saturated" with advertisements, thus forcing advertisements that were sold for display on the first Internet site to instead be displayed on the second site. *Id.* at 4.

In its sur-reply, Plaintiffs contend that Amazon's proposed construction (1) incorrectly requires that the advertisement be sold for placement on the first Internet site and (2) improperly emphasizes the timing of the advertisement's delivery rather than the location. Sur-Reply at 2. With respect to the former, Plaintiffs contend that "Amazon does not dispute that none of the

contracts referenced in the specification involve payment for display of an advertisement on the first site." *Id.* at 4. Plaintiffs contend that Amazon improperly assumes that that the advertisement was sold to be displayed on the first Internet site, but was unable to do displayed due to "saturation" on the first Internet site. *Id.* at 4.

With respect to the latter, Plaintiffs contend that Amazon's proposed construction deviates from the plain meaning and that Amazon does not allege lexicography and that the prosecution statements Amazon points to do not meet the "exacting" standard required for disavowal. *Id.* at 3. More specifically, Plaintiffs contend that Amazon does not consider that "arise from" includes when "the payment is agreed by the parties, but is only later finalized and delivered after the advertisement is displayed." *Id.* at 2–3. Plaintiffs contend that the prosecution history's discussion of "advertisements that were sold for placement" is not a disclaimer because the claims do not use the words "that were." *Id.* at 3.

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is plain-and-ordinary meaning.

With respect to the first dispute (*i.e.*, the "direction/delivery of an advertisement to visitor computers visiting a second Internet site"), the Court agrees with Plaintiffs for the reasons that follow. ***First***, the Court agrees with Plaintiffs that Amazon's proposed construction appears to incorrectly focus on the timing of the delivery of the advertisement, rather than where the advertisement is supposed to be delivered to. More specifically, the claim language recites "delivery to visitor computers visiting a second, different Internet site," but Amazon's proposed

construction—" delivery to visitor computers currently visiting a second, different Internet site"—improperly adds in the word "currently" into the claim.

***Second***, the Court agrees with Plaintiff that Applicant did not make a narrowing amendment during prosecution. More specifically, an Examiner's Notice of Allowance "cannot give rise to narrowing disclaimer." *Salazar*, 414 F.3d 1342, 1345 (Fed. Cir. 2005) ("[A]n applicant's silence regarding statements made by the examiner during prosecution, without more, cannot amount to a 'clear and unmistakable disavowal' of claim scope. After all, the applicant has disavowed nothing." (internal citations omitted)).

***Third***, with respect to Amazon's argument that the claimed invention is premised on the situation whether the first Internet site becomes "saturated" with advertisements, the Court disagrees. The claims do not require that the first Internet site is saturated with advertisements. Furthermore, there is no logical reason why an advertiser must pay for the same advertisements to be shown on the first Internet site, when it is ultimately shown on the second Internet site.

With respect to the second dispute (*i.e.*, if the advertisement must have been previously sold), the Court concludes that Applicant's statement do not meet the "exacting" standard required for a prosecution disclaimer. *Hill-Rom Servs.*, 755 F.3d at 1371. In particular, the statement relies on "the off-site advertisement arises from the advertiser having 'paid to display said advertisement on visitor computers that have visited the first Internet site.'" Opening, Ex. 3 at 12. While "arises from" could mean that the advertisement on the second Internet site must occur after the transaction of displaying advertisements that have visited the first Internet site as Amazon contends, it could also mean "starting from." As such, because there are two reasonable interpretations to Applicant's statement, Applicant's statement is not "clear and unambiguous." *3M Innovative Props.*, 725 F.3d at 1326.

Furthermore, the plain language of this statement does not describe that payment must occur prior to the placement of the advertisement at the second Internet site. By contrast, payment could be made, for example, at the end of the month.

***Fourth***, the Court notes that co-defendant Microsoft did not assert that this term needed to be construed, which confirms that no construction is necessary.

The "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347. Amazon does not allege lexicography and as described above, there is no disclaimer. As such, this claim term does not fall into either of the two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning. *Thorner*, 669 F.3d at 1365.

Therefore, for the reasons described above, the Court finds that this term should be construed according to its plain-and-ordinary meaning.

### C. Term #3: "second Internet site" / "second, different Internet site"

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #3: "second Internet site" / "second, different Internet site"<br><br>U.S. Patent No. 7,822,639, Claims 24, 40; U.S. Patent No. 8,244,586, Claims 1, 5, 6, 7, 8, 9, 11, 14, 17, 19, 20<br><br>Proposed by Defendants | "Internet site operated for the benefit of a different (and not commonly owned) entity than an entity for which the first Internet site is operated for the benefit of." | Internet site owned by and operated for the benefit of proprietor(s) that are different from (not commonly owned by) proprietors of the first Internet site<br><br>Alternatively, Internet site operated for the benefit of proprietor(s) that are different from (not commonly owned by) proprietors of the first Internet site |

**<u>The Parties' Positions:</u>**

Defendants contend that Applicant expressly distinguished "first Internet site" and "second Internet site" during prosecution. Opening at 10. Defendants contend that even though the prosecution statements were made during the prosecution for the direct parent of the '586 Patent, which shares the same specification, the statements made during prosecution of a parent patent also apply to the child patent. *Id.* (citing *Iridescent Networks v. AT&T Mobility*, 933 F.3d 1345, 1350 (Fed. Cir. 2019)).

In their response, Plaintiffs concedes that Applicant distinguished prior art on the basis that a "'second Internet site' is an Internet site operated for the benefit of a different (and not commonly owned) entity than an entity for which the first Internet site is operated for the benefit of." Response at 12. Plaintiffs contend that "the applicant made clear that by 'proprietor,' the applicant referred to the entity benefitting from operation of a site, not the owner or operator of the site." *Id.* Plaintiffs contend that Defendants' proposed construction deviates from Applicant's prosecution

statements first by "refer[ring] to the ownership of a site, not who benefits from operation of the site." *Id.*

Plaintiffs contend that Defendants' proposed construction "is also confusing because it introduces the concept that the second site must be 'not commonly owned by[] proprietors of the first Internet site,' a concept that is not implied by the applicant's prosecution statements." *Id.* at 13.

In their reply, Defendants contend that Plaintiffs' proposed construction incorrectly substitutes "entity" for "proprietor," as it is inconsistent with the intrinsic record. Reply at 5. Defendants also concede that they are willing to drop "owned by and" as shown in their alternate proposed construction. *Id.*

In their sur-reply, Plaintiffs contend that the prosecution history describes that the intended beneficiary of the second Internet site are "entities" and not the owner or operator of the site. Sur-Reply at 5 (quoting Opening, Ex. 8 at 14 ("The usage described herein is consistent with the patent specification, which describes sites throughout in terms of the entities benefitting from them…")).

**<u>The Court's Analysis:</u>**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is "Internet site operated for the benefit of a different (and not commonly owned) entity than an entity for which the first Internet site is operated for the benefit of." Plaintiffs' proposed construction and Defendants' alternate proposed construction differs only in one respect, namely whether the proper construction should use the word "entity" (Plaintiffs' position) or "proprietor" (Defendants' position). Applicant's prosecution statement uses the word "proprietor" in the prosecution statement, but it also expressly

describes that "proprietors" is subsumed within "entities." Opening, Ex. 8, at 14 ("The references in the claims to 'first site' and 'second site,' therefore, refer to sites operated for the benefit of different (and not commonly owned) proprietors. The usage described here is consistent with the patent specification, which describes sites throughout in terms of the entities benefitting from them and do not mention URLs, domain names, or IP addresses.") (emphasis added). Therefore, the Court will use the word "entity."

Therefore, for the reasons described above, the Court finds that "second Internet site" / "second, different Internet site" should be construed as "Internet site operated for the benefit of a different (and not commonly owned) entity than an entity for which the first Internet site is operated for the benefit of."

**D. Term #4: "unaffiliated third parties" / "unaffiliated third party"**

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #4: "unaffiliated third parties" / "unaffiliated third party"<br><br>U.S. Patent No. 8,244,582, Claims 1, 5, 11, 15<br><br>Proposed by Defendants | a party not having common ownership with the party or parties that control said programmed computer system | "unaffiliated third party"/ "unaffiliated third parties": indefinite, lacks reasonable certainty as to its scope<br>***<br>"third party" / "third parties": a party not having common ownership with the party or parties that own said programmed computer system |

**The Parties' Positions:**

Defendants contend that this term is indefinite because the term lacks discernible meaning given the difference between a "third-party" and an "unaffiliated third-party" is unclear. Opening at 16. Defendants contend that the parties "largely agree on the construction of 'third party,' with

a one-word difference[,]" namely whether it is "a party not having common ownership with the party or parties that control said programmed computer system" (Plaintiff) versus "a party not having common ownership with the party or parties that own said programmed computer system" (Defendant). *Id.* at 18 (emphasis added). Defendants contend that while "own" in their proposed construction stems from the "common ownership" language in both proposed constructions, "control" in Plaintiffs' proposed construction is a "new and amorphous" concept, which is confusing and unhelpful to a jury. *Id.*

With respect to "unaffiliated," Defendants contend that it does not have a plain-and-ordinary meaning in the art, and that the intrinsic evidence and claims does not provide any guidance as to how it modifies the meaning of "third-party." *Id.* at 17. Defendants contend that dictionary definitions of "unaffiliated" are similarly unhelpful. *Id.*

Defendants contend that whether two parties are "unaffiliated" is subjective and could range from having no formal contractual or legal relationship to being strangers with no discernable connections or prior communications, or something in between. *Id.* at 17–18.

In their response, Plaintiffs contend that Defendants' proposed construction for another term ("third-party server computer") recognizes that a "third-party" requires that a "party be distinct from the parties primarily involved in a situation." Reply at 17. Plaintiffs contend that "[b]ecause the parties agree that the term as a whole requires common ownership, but there is no evidence that 'third party' itself imposes such a requirement, the lack of common ownership limitation flows from the term 'unaffiliated,' consistent with Plaintiffs' construction." *Id.* Plaintiffs contend that this interpretation is Defendants' dictionary definitions and with original co-defendant Samsung's usage of the word "affiliate" in its terms of service. *Id.* at 17–18.

With respect to whether third-parties "control" (Plaintiffs' position) or "own" (Defendants' position) the programmed computer system, Plaintiffs contend that the claims support its position. *Id.* at 18. More specifically, Plaintiffs contend that Claim 1 and 11 recite that a "'programmed computer system' receives a partial profile from a 'server ***controlled by*** one of a plurality of unaffiliated third parties.'" *Id.* (emphasis in Plaintiffs' brief). Based on that, Plaintiffs contend that the "relevant inquiry is who ***controls*** the server of who is an 'unaffiliated third party.'" *Id.* (emphasis in Plaintiffs' brief). Plaintiffs contend that, similarly, the same standard should apply to who controls the "programmed computer system." *Id.*

Plaintiffs contend that Defendants' proposed construction "would cause the claim to depend on whether the party that ***owns*** the 'programmed computer system' is commonly owned with the party that ***controls*** the server, would lead to results contrary to the patentee's intent." *Id.* (emphasis in Plaintiffs' brief). Plaintiffs provide an example of this contrary intent, namely, a company that uses another entity's cloud server would be a "third party" even though it controls all the relevant hardware. *Id.* at 18–19.

With respect to Defendants' proposed construction, Plaintiffs contend that even if the parties agree that "<u>unaffiliated third parties</u>" are not commonly owned, it does not necessarily follow that "<u>programmed computer system</u>" also are not commonly owned. *Id.* at 19. With respect to Defendants' argument that "control" is a "new and amorphous" concept, Plaintiffs contend that the claims already recite "control." *Id.*

Plaintiffs contend that Defendants do not provide any evidence that a POSITA would have believed that "third party" implicated a common ownership standard or that a POSITA would be confused whether two parties were sufficiently non-connected to qualify as "unaffiliated." *Id.* at 20, 21. In particular, Plaintiffs contend that original co-defendant Samsung's own terms of service

recite "affiliates" which provides evidence that at least one of the original co-defendants understand what "affiliated" and "unaffiliated" mean. Plaintiffs also contend that Defendants do not cite any authority for the proposition that a claim is invalid based on "some arguably overlapping verbiage." *Id.*

In its reply, Defendants again contend that while the parties agree that "third party" means "a party not having common ownership," but because "determining whether two third-parties are sufficiently non-connected to be 'unaffiliated' becomes subject to the 'unpredictable vagaries of any one person's opinion,' and thus is indefinite." Reply at 8 (citing *Interval Licensing v. AOL*, 766 F.3d 1364, 1371 (Fed. Cir. 2014)). Defendants contend that Plaintiffs' argument regarding original co-defendant Samsung's terms-of-service is a "meritless 'gotcha'," as the documents use the word "affiliates"—not "unaffiliated." *Id.* at 8–9.

Defendants contend that Plaintiffs' do not offer any evidence that "third parties" refers to distinct entities without regard to ownership. *Id.* at 9. Defendants contend that, by contrast, Applicant characterized a third-party media property as "not under common ownership." Therefore, Defendants contend that the lack of common ownership comes from "third party" and not "unaffiliated." *Id.*

Defendants contend that the parties agree that a "third party" means "a party not having common ownership with the party or parties that **owns** said programmed computer system," but Plaintiffs do not provide any explanation for replacing "owns" with "controls" in its proposed construction. *Id.* at 9–10.

In their sur-reply, Plaintiffs contend that Defendants provide no evidence that "unaffiliated" is indefinite, let alone provide clear and convincing evidence. Sur-Reply at 8.

Plaintiffs contend that, by contrast, it has provided evidence as to the meaning of "unaffiliated," and that Defendants' extrinsic evidence supports that Plaintiffs' interpretation. *Id.*

Plaintiffs contend that Defendants are incorrect to assert that "third party" requires a lack of common ownership for at least two reasons. *Id.* at 9. Plaintiffs first contend that the only evidence Defendants provide is from the file history of an unrelated patent. *Id.* Plaintiffs also contend that even if "unaffiliated" is redundant with "third party," that does not render the term to be indefinite. *Id.* (*Alacritech, Inc. v. CenturyLink Commc'ns LLC*, 271 F. Supp. 3d. 850, 878-79 (E.D. Tex. Sept. 21, 2017) ("The Court is not persuaded that this term renders any claim indefinite simply because it may be redundant.")).

With respect to the competing "owns" versus "controls" language in the two parties' proposed constructions, Plaintiffs contend that the claims "explicitly depend on whether hardware is 'controlled by' the unaffiliated third parties, and not on whether the hardware is 'owned by' those third parties." *Id.* at 10. Plaintiffs contend that "Defendants implicitly concede the relevance of this 'control' standard recited in the claims by failing to address it (other than to pretend that it simply does not exist)" and that Defendants do not dispute that their construction "would lead to results contrary to the patentee's intent" as Plaintiffs argued in its response. *Id.*

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs that because Defendant has not provided clear and convincing evidence that a POSITA would not understand the scope of this term with "reasonable certainty," the term is not indefinite and that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the Court agrees with Plaintiffs that even if "unaffiliated" is redundant with "third

party," that does not render the term to be indefinite. *Alacritech, Inc. v. CenturyLink Commc'ns LLC*, 271 F. Supp. 3d. 850, 878–79 (E.D. Tex. Sept. 21, 2017) ("The Court is not persuaded that this term renders any claim indefinite simply because it may be redundant.")). Rather, by definition, if a POSITA understands that a word in the claim term is redundant, the POSITA understands, with at least "reasonable certainty," the scope of claim term. Defendants have not provided any authority that describes that redundant words in a claim term requires that a court conclude that the term is indefinite. Rather, the cases that Defendants cite merely stand for the proposition that "[a] claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so[,]" but not that a redundant claim term is necessarily indefinite. *Merck*, 395 F.3d at 1372. Furthermore, in neither case Defendants cited did the Federal Circuit find that the claim term was indefinite. *Merck*, 395 F.3d at 1372 ("We thus hold that the term 'about' should be given its ordinary and accepted meaning of 'approximately.'"); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1364 (Fed. Cir. 1991) (affirming district court's conclusion of noninfringement).

***Second***, Defendants do not appear to provide any reason or authority why the Court should limit the meaning of "third party" based on an alleged disclaimer in an unrelated patent.

***Third***, the Court disagrees that Applicant made a disclaimer during prosecution of the '822 Patent, and that "third party" should have its plain-and-ordinary meaning. Apart from alleging that the parties "largely agree" on the construction of this term—which Plaintiffs appear to dispute—Defendants have not provided any reason why "third party" should not be construed according to its plain-and-ordinary meaning. Opening at 18; Response at 17. Because Defendants' indefiniteness construction is premised on an alleged redundancy between "unaffiliated" and "third party," based on a particular construction of "third party," a plain-and-ordinary construction for

"third party" eliminates any redundancy between "unaffiliated" and "third party," thus undermining Defendants' indefiniteness position.

***Fourth***, with respect to "unaffiliated," Defendants only appear to contend that "unaffiliated" does not a particular meaning in the art. Opening at 17. While the Court agrees that that assertion, the Court disagrees that a POSITA would not understand that the claim language, in light of the specification, uses "unaffiliated" according to its plain English meaning. Defendants do not appear to contend that "unaffiliated" does not have a plain English meaning (Defendants contend that "unaffiliated" means "not a branch organization"), but only rather that that plain English meaning is "unhelpful" in resolving the alleged redundancy between "unaffiliated" and "third party." However, the Court does not believe a jury will not understand the meaning of "unaffiliated."

Therefore, for the reasons described above, the Court concludes that Defendants have not provided clear and convincing evidence that "unaffiliated third part[y/ies]" is indefinite.

***Construction***: Because the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning and because Defendant does not allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning, the Court concludes that the term should be construed as having its plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347; *Thorner*, 669 F.3d at 1365.

Therefore, for the reasons described above, the Court finds that the term is not indefinite and should be construed according to its plain-and-ordinary meaning.

### E. Term #5: "partial profile"

| Term | Plaintiffs' Proposed Construction | Defendant's Proposed Construction |
|---|---|---|
| #5: "partial profile"<br><br>U.S. Patent No. 8,244,582, Claims 1, 3, 4, 6, 11, 13, 14, 16<br><br>Proposed by Defendants | Not indefinite. No construction necessary; plain and ordinary meaning. | Indefinite, lacks reasonable certainty as to its scope. |

**<u>The Parties' Positions:</u>**

Defendants contend that "partial" is a term of degree and because the intrinsic evidence does not provide guidance on the scope of the term, the term is indefinite. Opening at 19. Defendants contend that the claims recite both "partial profile" and "maintained profile," but the claims do not provide further guidance as to the scope of this term. *Id.* Defendants contend that the specification describes that all profiles are "by definition, partial." *Id.* Based on that, Defendants contend that "partial" is superfluous, and there is no guidance as to how to differentiate between a "partial profile" and a "profile." *Id.*

In their response, Plaintiffs contend that the patentee expressly defined "profile" as "[a] collection of attributes that describe a person, or an organization or any other entity that can be describe[d] by a combination of data." Response at 22 (citing '582 Patent at 2:26–57). Plaintiffs contend that the specification describes that "all profiles are, by definition, partial" because it "is impossible to have complete information about any of these entities." *Id.* at 22–23 ('582 Patent at 7:43–49). Plaintiffs contend that because there is no such thing as a non-partial profile, there is "zero room for any uncertainty about the scope of the term 'partial profile' or the word 'profile" in the context of this patent." *Id.* at 23.

Plaintiffs further contend that the specification describes adding received partial profiles to a databank of previously received partial profiles, which are then stored and become "maintained." *Id.* at 23–25 (citing '582 Patent at Figure 2, 3:30–36, 5:4–26, 6:33–41). Based on that, Plaintiffs contend that Defendants are incorrect to assert that "'maintained profiles' are not some sort of non-partial profile or even contrasted with partial profiles[.]" *Id.* at 23.

With respect to Defendants' argument that "partial" is superfluous, Plaintiffs contend that the claims usage of "partial" simply "reiterates a feature that the patent says is true 'by definition' of all 'profiles.'" *Id.* at 25.

In their reply, Defendants contend that based on Plaintiffs' contention that "there is no such thing as a non-partial (*i.e.*, totally complete) profile," "partial" is superfluous and there is nothing to distinguish a "partial profile" from the other profiles (*e.g.*, "maintained profile"). Reply at 10.

Defendants contend that the passages Plaintiffs cite from the specification and the claims do not provide guidance as to the scope of this term. *Id.* In particular, Defendants contend that Figure 2 does not refer to profiles and that 3:30–36, 5:4–26, 6:33–41 do not state what is in a partial profile. *Id.*

In their sur-reply, Plaintiffs contend that a POSITA would understand the difference between a "partial profile" and a "complete profile," as the latter is unattainable. Sur-Reply at 11. Plaintiffs contend that Defendants do not meaningfully respond to Plaintiffs' explanation regarding "partial profiles" and "maintained profiles." *Id.*

**<u>The Court's Analysis:</u>**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs that because Defendant has not provided clear and convincing evidence that a

POSITA would not understand the scope of this term with "reasonable certainty," the term is not indefinite and that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, Defendants do not contend that "profile" is indefinite, but rather than "partial profile" is superfluous—and thus indefinite—in light of the specification's disclosure that a complete profile is unattainable. '582 Patent at 7:43–49. But merely because a complete profile is unattainable in practice does not mean that a POSITA would not understand what it is.

And if a POSITA is able to understand what a complete profile is, a POSITA should be able to understand, with at least reasonable certainty, what a "partial profile" is. More specifically, the plain-and-ordinary meaning of "partial" simply means a "part of," which may range from just about 0% to just under 100%. The specification's descriptions of "partial profile" are consistent with this understanding. For example, the specification describes that a partial profile is a combination of attributes, *e.g.*, name, address, income, age, education, details of product purchase transaction over the Internet, credit rating, *etc.*, aggregated together. *Id.* at 7:24–29. Similarly, the specification also describes that a partial profile "will often itself contain ***certain*** predetermined identified commercial attributes, demographic attributes, or behavioral attributes or combinations thereof or the like." *Id.* at 11:7–10 (emphasis added). The specification describes that two partial profiles may contain different subsets of demographic information. *Id.* at 14:54–59 ("the first partial profile contains the name of Joe Blue, the information that he is male, and the information that he lives in Mississippi. However, the corresponding second partial profile associated with Joe Blue contains the information that he is a she (real name Josephine) and that she lives in Mississippi.").

***Second***, with respect to Defendants' argument that "partial" is a term of degree, the Court agrees that it is a term of degree, but disagrees that it is indefinite. At most, Defendants confuse

breadth with indefiniteness, but merely because "partial" may cover a broad range (e.g., more than 0% to less than 100%) does not mean that a POSITA would not understand with reasonable certainty what "partial" means. *BASF Corp. v. Johnson Matthey Inc.*, 875 F.3d 1360, 1367 (Fed. Cir. 2017) ("Breadth is not indefiniteness.").

***Construction***: Because the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning and because Defendant does not allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning, the Court concludes that the term should be construed as having its plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347; *Thorner*, 669 F.3d at 1365.

Therefore, for the reasons described above, the Court finds that "partial profile" is not indefinite and should be construed according to its plain-and-ordinary meaning.

**F. Term #6: "available"**

| Term | Plaintiffs' Proposed Construction | Defendant's Proposed Construction |
|---|---|---|
| #6: "available"<br><br>U.S. Patent No. 8,244,582, Claims 1, 11<br><br>Proposed by Defendants | No construction necessary; plain and ordinary meaning | electronically accessible |

**<u>The Parties' Positions:</u>**

Defendants contend that "available" with respect to a "partial profile" does not appear in the specification. Opening at 20. Defendants contend that Plaintiffs do not explain what the plain-

and-ordinary meaning is. *Id.* Defendants contend that Plaintiffs' infringement contentions specify how this claim term is met, which indicates that Plaintiffs seek to read this term out of the claim. *Id.* Defendants contend that this term has no meaning "imprecise, unclear, and potentially confusing" in an electronic context. *Id.*

Defendants contend that their proposed construction is "consistent with the "plain and ordinary meaning of 'available'" and is based on dictionary definitions. *Id.* Defendants also contend that because the claim language contains "electronically," that should also be included in the Court's final construction. *Id.* at 21.

In their response, Plaintiffs contend that "available" does not require construction as even a lay juror understands its meaning. Response at 26. Plaintiffs contend that Defendant do not contend that "available" is a coined term, or that the patentee acted as his/her own lexicographer and/or made a disclaimer. *Id.* As such, Plaintiffs contend that this term does not fall into either of the exceptions that justify adopting a non-plain-and-ordinary meaning construction. *Id.*

Plaintiffs contend that Defendants have not shown that "available" is imprecise in an electronic context. *Id.* Plaintiffs further contends that Defendants' argument that because the claim language includes "electronically," the Court should not include that word as it is redundant with the surrounding claim language. *Id.* at 26–27.

In their reply, Defendants again contend that "available" means "electronically accessible" in an electronic context. Reply at 11. Defendants contend that Plaintiffs provide no explanation as to why Defendants' proposed construction fails to capture the meaning of the term "*in that context*." *Id.* (emphasis in Defendants' brief).

In their sur-reply, Plaintiffs contend that purpose of claim construction is provide clarity, but Defendants' proposed construction does not provide that. Sur-Reply at 12. Plaintiffs contend

that Defendants do not explain the "specifics" of the electronics "context," nor explain why a plain English word—that they do not even allege is limited by a disclaimer—needs to be construed. *Id.*

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347. ***Second***, Defendant does not expressly allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning. *Thorner*, 669 F.3d at 1365.

***Third***, Defendants do not explain why "available" has a particular definition in the electronic context. The fact that Defendants based their proposed construction on general purpose dictionaries (Merriam-Webster's Collegiate Dictionary and Webster's II New College Dictionary)—and not technical dictionaries tends to undermine their argument that "available" has a particular definition in the electronic context. Furthermore, Defendants' proposed construction simply combines the definition from a general purpose dictionary ("accessible") and adds "electronically." It is unclear whether that particular construction is the correct meaning in the electronic context.

***Fourth***, Defendant's proposed construction appears to otherwise simply paraphrase the claim language, which the Court declines to do. *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858, 863 (Fed. Cir. 2004) (agreeing that "merely rephrasing or paraphrasing the plain

language of a claim by substituting synonyms does not represent genuine claim construction") (internal quotations omitted).

Therefore, for the reasons described above, the Court's final construction for "available" is plain-and-ordinary meaning.

### G. Term #7: "automatically with the computer system" / "automatically" / "automatic"

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #7: "automatically with the computer system" / "automatically" / "automatic"<br><br>U.S. Patent No. 8,244,582, Claims 1, 5, 6, 9, 10, 11, 14, 15, 16, 19, 20; U.S. Patent No. 8,244,586, Claims 1, 2; U.S. Patent No. 8,671,139, Claim 37; U.S. Patent No. 8,959,146, Claims 1, 21; U.S. Patent No. 9,830,615, Claims 9, 10, 11; U.S. Patent No. 10,321,198, Claims 1, 18; U.S. Patent No. 8,566,164, Claims 1, 3, 16, 22; U.S. Patent No. 10,715,878, Claims 13, 17, 18, 20; U.S. Patent No. 8,200,822, Claim 35<br><br>Proposed by Defendants | No construction necessary; plain and ordinary meaning | not manually |

**<u>The Parties' Positions:</u>**

Defendants contend that Applicant stated that "***the undersigned agreed that the term 'automatic' was used in the sense opposed to 'manual,'*** *and that the* ***Examiner should interpret***

***the term automatic in such fashion***." *Id.* (quoting Opening, Ex. 14 at 17-18 (emphasis in Defendants' brief)).

In their response, Plaintiffs contend that "available" does not require construction and that Defendants' proposed construction is simply the plain-and-ordinary meaning of the term. Response at 27. Plaintiffs contend, however, that if the Court construes this term, it "does not disagree in substance with Defendants' proposal." *Id.*

In their reply, Defendants contend that given that Plaintiffs do not disagree with Defendants' proposal, and because the inventor stated that "automatically" means "not manually," the Court should adopt Defendants' proposed construction. Reply at 12.

In their sur-reply, Plaintiffs contend that Defendants fail to provide a "compelling justification for artificially constraining the scope of readily understood claim language." Sur-Reply at 12–13.

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347. ***Second***, the Court disagrees that Applicant acted as his own lexicographer during prosecution. Applicant described that "the undersigned agreed that the term 'automatic' was used ***in a sense*** as opposed to 'manual[.]'" Opening, Ex. 14 at 18. The Court concludes that "in a sense" is not a definitional statement, but rather akin to describing that "automatic" is "similar to" "the opposite of manual." As such, the use of such a phrase indicates that Applicant did not intend to define "automatic." *Hill-Rom Servs.,*

*Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014) (to act as its own lexicographer, a patentee must "clearly express an intent to redefine the term")).

Because the Applicant did not act as his own lexicographer and because Defendants do not appear to allege disclaimer, the Court concludes that plain-and-ordinary meaning is the proper construction. *Thorner*, 669 F.3d at 1365.

**H. Term #8: "URL redirection"**

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #8: "URL redirection"<br><br>U.S. Patent No. 8,244,582, Claims 1, 10, 11, 20<br><br>Proposed by Defendants | obtaining certain information for at least a portion of an accessed page / site from a different location | obtaining a requested webpage from a different location |

**<u>The Parties' Positions:</u>**

The dispute between the parties appears to be whether the complete webpage needs to be obtained (Defendants' position) or whether only "certain information," *i.e.*, some information, needs to be obtained from the requested webpage (Plaintiffs' position). *See, e.g.*, Response at 28.

Defendants contend that the intrinsic evidence demonstrates that their position is correct. Opening at 23. More specifically, Defendants contend that Applicant told Examiner that Examiner "misapprehend[ed] the meaning of 'redirection'," so Applicant provided a dictionary definition for "redirection." *Id.* Then, pursuant to a request from Examiner, Applicant amended the claims to add "URL redirection." *Id.* Defendants contend that Plaintiffs' definition of "URL redirection" is binding and Defendants' proposed construction adopts that definition as their proposed

construction. *Id.* at 24 (quoting *Iridescent Networks*, 933 F.3d at 1350; citing *E.I. du Pont De Nemours & Co. v. Unifrax I*, 921 F.3d 1060, 1070-71 (Fed. Cir. 2019)).

Defendants contend that Plaintiffs' proposed construction improperly broadens the claim to recapture claim scope it expressly disclaimed during prosecution to overcome a prior art rejection. *Id.* (citing cases).

In their response, Plaintiffs contend that the claims expressly state that the URL direction is from a portion of the webpage. Response at 28 (citing '582 Patent, Claim , Limitation [b] ("wherein receiving the partial profile is achieved as a result of ***automatic electronic URL redirection from a portion of a page of the website*** accessed by the user computer") (emphasis added)). Plaintiffs contend that some of the disclosed embodiments state that the URL direction is from a portion of the webpage. *Id.* (citing '582 Patent at 4:2–8, 12:2–4). Plaintiffs contend that Defendants have not "cited any patent specification examples showing that the *entirety* of the requested webpage must be obtained." *Id.* Plaintiffs contend that even if there was such an embodiment, it would be improper to import limitations from that embodiment into the claim term. *Id.*

Plaintiffs contend that Applicant's prosecution statements indicate that there is no intent to change the meaning of this term. *Id.* at 29 (quoting Opening, Ex. 15 at 7 ("Assignee submitted several computer dictionaries defining 'redirection' ***in the sense*** used in the specification.) (emphasis added)). Plaintiffs contend that the proffered definition is consistent with its ordinary usage in the field. *Id.*

Plaintiffs contend that "[t]o the extent disclaimer applies, it only encompasses the patentee's distinction over prior art like Acxiom, which 'discloses something akin to one party

sending another party an electronic disk or other storage device containing email addresses obtained via the first party's website.'" *Id.* (quoting Opening, Ex. 15 at 6)).

In their reply, Defendants contend that the claim language Plaintiffs cite is "irrelevant to the issue at hand[.]" Reply at 12. Defendants contend that the issue at hand is: "***where*** URL redirection occurs ***from*** is irrelevant to ***what*** is being obtained by URL redirection." *Id.* (emphasis in Defendants' brief). Defendants contend that the specification is "equally irrelevant" as the claim language as it also focuses on "where redirection can occur from, but do not explain what is obtained through redirection." *Id.* at 12–13 (citing '582 Patent at 4:2–8, 12:2–4).

Defendant again contends that in order to obtain allowance, "the patentee explained *what* is being obtained by URL redirection[,]" namely, that URL redirection means "'when a web server tells a client browser to obtain a certain requested page from a different location,' *i.e.* the page itself, and not any portion of it." *Id.* at 13 (quoting Opening, Ex. 16 at 6–7 (emphasis in Defendants' brief).

In their sur-reply, Plaintiffs contend that the parties agree that the claims "merely recite the location from where the URL redirection occurs." Sur-Reply at 13. Plaintiffs further contend that the "file history also does not disclose Defendants' interpretation of the claims," for at least two reasons. *Id.* (quoting *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013)). Plaintiffs first contend that "Defendants do not dispute that the disclaimer over the prior art emphasized that the prior art at issue disclosed no redirection at all," so disclaimer does not apply. *Id.* (citing *SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 882 (Fed. Cir. 2004)).

Plaintiffs next contend that Applicant "offered dictionaries merely as an 'example" of how the term "redirection" was used in the specification and understood by persons of ordinary skill in

the art at the time of the invention. *Id.* (citing Opening, Ex. 15 at 6–7). Plaintiffs contend that Applicant also said that the dictionary definitions did not narrow the scope of the invention. *Id.* at 13–14. Plaintiffs contend that Defendants do not point to any "no portion of the file history which establishes—unambiguously or otherwise—that [the dictionary definitions] were *coextensive* with the specification." *Id.* at 14 (citing *Tech. Properties Ltd. LLC v. Huawei Techs. Co.*, 849 F.3d 1349, 1358 (Fed. Cir. 2017) (emphasis in Plaintiffs' brief).

Finally, Plaintiffs disagree with Defendants that the specification is "irrelevant." *Id.* Plaintiffs contend that the specification describes "redirecting a ***portion*** of the visitor page to the server." *Id.* (quoting '582 Patent at 4:6–8, 12:2–4 (emphasis in Plaintiffs' brief)). Based on that, Plaintiffs contend that Defendants' proposed construction would improperly read out an embodiment. *Id.* (citing *Epos Techs. Ltd. v. Pegasus Techs. Ltd.*, 766 F.3d 1338, 1347 (Fed. Cir. 2014)).

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347.

***Second***, the Court disagrees that Applicant acted as his own lexicographer during prosecution. When discussing the alleged definition, Applicant prefaced that definition with "[f]or example," which indicates that Applicant did not have the intent to define "URL redirection." *Hill-Rom Servs.*, 755 F.3d at 1371 (to act as its own lexicographer, a patentee must "clearly express an intent to redefine the term")). Furthermore, Applicant stated that amending the claims to include

"URL redirection" was meant only to "clarify" the claim scope and was not intended to "narrow" the claim scope. Opening, Ex. 15 at 6–7. The use of "clarify" and "not thought to narrow" tends to indicates that Applicant did not have the intent to define the term and was not providing a particular definition for this claim term that would narrow the scope.

***Third***, the Court disagrees that Applicant made a disclaimer during prosecution. Applicant wrote that "Acxiom clearly fails to disclose any 'redirection' in the sense used in this specification[,]" but rather "Acxiom reference discloses something akin to one party sending another party an electronic disk or other storage device containing email addresses obtained via the first party's website." *Id.* at 6. Therefore, Applicant did not amend the claims to include "URL redirection" in order to distinguish the claimed invention from the Acxiom prior art reference. As such, there was no "clear and unmistakable" disclaimer. *SuperGuide*, Inc., 358 F.3d at 882.

Because the Applicant did not act as his own lexicographer and or disclaim claim scope during prosecution, the Court concludes that plain-and-ordinary meaning is the proper construction. *Thorner*, 669 F.3d at 1365.

### I. Term #9: "indicia of instructions" / "indicia of a condition" / "indicia"

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #9: "indicia of instructions" / "indicia of a condition" / "indicia"<br><br>U.S. Patent No. 8,244,582, Claims 11, 15, 16, 19, 20; U.S. Patent No. 8,671,139, Claims 1, 37<br><br>Proposed by Defendants | Not indefinite. No construction necessary; plain and ordinary meaning | Indefinite, lacks reasonable certainty as to its scope |

**The Parties' Positions:**

Defendants first contend that the specification of the '582 Patent does not contain any reference to "indicia of instructions" or "indicia of a condition" and that the specifications of the '139, '146, and '582 Patents do not use the word "indicia." Opening at 25. Defendants contend that this term is indefinite for at least two reasons. First, Defendants contend that it is unclear what type of information can satisfy an "indicia of instructions" or an "indicia of a condition" beyond the instructions or condition itself. *Id.* Second, Defendants contend that it is unclear how an "indicia of instructions" or an "indicia of a condition" is sufficient to trigger specific actions. *Id.* at 26. More specifically, Defendants contend that there is no guidance in the specifications. *Id.*

In their response, Plaintiffs note that Defendants do not allege that "instructions," "conditions," or "indicia" are indefinite. Response at 30. Plaintiffs contend that Defendants' description that all "electronic data represents an indicia of information" provides at least reasonable certainty for a POSITA to understand the scope of "indicia." *Id.* at 31–32.

With respect to Defendants' first reason, Plaintiffs contend that the claims provide additional guidance and examples of the indicia. *Id.* More specifically, Plaintiffs contend that claims describe that:

> (i.) the indicia [is] of a condition for a display of an advertisement (claim 1); (ii.) that the condition "relates specifically to an electronic visitor" (also claim 1); and (iii.) that the condition is "that a price charged by the second media property is less than a profile-attribute-dependent price" (claim 2).

*Id.* Plaintiffs contend that for an "indicia of instructions," the specifications describes an embodiment that includes a "computer useable program, *i.e.*¸ *a software product, which allows the exchange of descriptive profiles between users, databanks, and/or other computers*." *Id.* at 32 (quoting '582 Patent at 16:35–40, 6:4–8) (emphasis in Plaintiffs' brief).

With respect to Defendants' second reason, Plaintiffs contend that this issue is directed towards written description or enablement, and not indefiniteness. *Id.* at 32–33. Plaintiffs again cite '582 Patent at 16:35–40 and contends that "[a]n indicia of an instruction need not be the actual computer software instruction itself, but can also be the exchange of the other electronic data used in the examples in the patent specification, such as through higher-level program 'code' or the exchange of descriptive electronic profiles or the like." *Id.* at 33.

Plaintiffs finally contend that Defendants use the same or similar language in their own patents. *Id*. (citing U.S. Patent No. 10,268,841, Claim 2 (Amazon Patent)).

In their reply, with respect to Plaintiffs' argument that an "indicia of an instruction" could be higher-level program code, Defendants contend that there are not such examples in the specification. Reply at 13. Defendants contend that the passage Plaintiffs cite in support of that argument ('582 Patent at 16:35–40) "does not purport to describe 'indicia of instructions,' let alone suggest that it can be something beyond the instructions themselves." *Id.* at 13–14. Defendants contend that, by contrast, the passage describes that the software product "allows the exchange of descriptive profiles between users, databanks, and/or computers" in the passage "is simply a description of a function of the software product[,]" and does not describe the instructions that make up the software product. *Id.* at 14.

Defendants contend that if "indicia of instructions" are not instructions, then it is unclear what causes a processor to perform the claimed method steps. *Id.* Defendants contend that that lack of clarity along with the specification's silence indicate that the term is indefinite. *Id.*

In their sur-reply, Plaintiffs again contend that Defendants do not dispute that "instructions," "conditions," or "indicia" are indefinite, and thus combinations of those words are also not indefinite. Sur-Reply at 15. With respect to whether an "indicia of an instruction" could

be higher-level program code, Plaintiffs contend that it could be either lower-level instructions (*i.e.*, machine-level code), higher-level code, or "other descriptions of software functionality that are used (directly or indirectly) to instruct the processor." *Id.*

Plaintiffs contend that Defendants improperly seek to shift the burden to Plaintiffs to explain the meaning of the term (to demonstrate that it is not indefinite), but that is Defendants' burden to show that the term is indefinite. *Id.*

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs that because Defendant has not provided clear and convincing evidence that a POSITA would not understand the scope of this term with "reasonable certainty," the term is not indefinite and that the proper construction is plain-and-ordinary meaning. With respect to Defendants' contention that the specification does not provide guidance as to how an "indicia of instructions" or an "indicia of a condition" is sufficient to trigger specific actions, the Court agrees with Plaintiffs that that is more properly a § 112, ¶1 argument than a § 112, ¶2 dispute.

With respect to Defendants' argument that it is unclear what type of information can satisfy an "indicia of instructions" or an "indicia of a condition" beyond the instructions or condition itself, the Court disagrees for the reasons that follow. ***First***, because Defendants do not allege that "instructions," "conditions," or "indicia" are indefinite, this provides evidence that the combination of those words is also not indefinite. ***Second***, Defendants use the same or similar language in their own patents. *See, e.g.*, U.S. Patent No. 10,268,841, Claim 2. This provides further evidence that a POSITA would understand the scope of this term with at least "reasonable certainty."

***Third***, the Court agrees with Plaintiffs that the claims provide additional guidance and examples of the indicia. For example, dependent Claim 2 of the '139 Patent recites "wherein the condition for display of the advertisement is that a price charged by the second media property is less than a profile-attribute-dependent price that an advertiser is willing to pay for display of the advertisement." This limitation describes that the condition for displaying the advertisement is if the price for displaying the advertisement on the second media property is lower than what the advertiser is willing to pay. In this context, an "indicia of the condition" appears to only require an indicator of that condition. This additional guidance and examples provides further evidence that a POSITA would understand the scope of this term with at least "reasonable certainty."

***Fourth***, the Court agrees with Plaintiffs that a POSITA might understand that an "instructions" is a broad enough term to include both machine-level instructions (*i.e.*, assembly code) to higher-level code. On the other hand, the Court is not convinced that a POSITA would understand that "instructions" also includes "other descriptions of software functionality that are used (directly or indirectly) to instruct the processor" as Plaintiffs assert.

Therefore, for the reasons described above, the Court concludes that Defendants have not provided clear and convincing evidence that this term is indefinite.

***Construction***: Because the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning and because Defendant does not allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning, the Court concludes that the term should be construed as having its plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347; *Thorner*, 669 F.3d at 1365.

Therefore, for the reasons described above, the Court finds that the term is not indefinite and should be construed according to its plain-and-ordinary meaning.

### J. Term #10: "third-party server computer"

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #10: "third-party server computer"<br><br>U.S. Patent No. 8,671,139, Claims 1, 37; U.S. Patent No. 8,959,146, Claims 1, 21<br><br>Proposed by Defendants | No construction necessary; plain and ordinary meaning | server other than first media property, second media property, or the server performing the claimed process |

**<u>The Parties' Positions:</u>**

Defendants contend that the dispute is what differentiates a "third party" server computer from other server computers. Opening at 28. Defendants contend that their proposed constructions gives meaning to the term "third party" in the claimed system. *Id.* at 29. Defendants contend that Applicant distinguished "third-party server computer" from "media property" server. *Id.* at 29–30 (quoting Opening, Ex. 16 at 2 ("[T]he way the clarified claim language now uses the term 'media property' is as the web site, ad network's site, or TV program, etc. (or their site servers or the like), and not the servers controlling advertising space in them (if separate), which are now being called explicitly 'server computers[s] controlling' the ad space."). Defendants finally contend that their proposed construction is consistent with dictionary definitions of 'third party." *Id.* at 30.

In their response, Plaintiffs contend, as it did with respect to Term #7, that a "third party" is simply a distinct party from the parties primarily involved in a situation. Response at 37. Based on that, Plaintiffs contend that "any server computer that is not part of the 'computer system' or

'one or more computers' is a "third-party server computer." *Id.* Plaintiffs contend that no construction is necessary given that a lay jury will understand that a server computer cannot be a third-party server computer to itself. *Id.*

Plaintiffs contend that there are "several reasons" why Defendants' proposed construction is incorrect. *Id.* With respect "server computer," Plaintiffs contend that Defendants improperly construe it as "server." *Id.*

With respect to "first media property," Plaintiffs contend that Defendants' proposed construction confusingly excludes "first media property," which is incorrect as "media properties" are not "computers." *Id.* Plaintiffs contend that a "first media property" is "not necessarily involved in the situation" of "directing third-party server computer" as required by the claims. *Id.* at 37–38. Plaintiffs contend that Defendants' exclusion of "first media property" is inconsistent with the specification. *Id.* at 38. More specifically, Plaintiffs contend that the specification "makes clear that the behavioral targeting or "BT" company (i.e., the company directing the indicia of the condition 15) can be a publisher (i.e., the party controlling the first media property)." *Id.* (citing '139 Patent at 2:14–22).

With respect to "second media property," Plaintiffs contend that Defendants do not provide any support for excluding this from their proposed construction. *Id.* Plaintiffs contend that "Defendants' proposal, which requires a distinction between the 'third-party server computer' and the 'second media property,' makes little sense in light of the claims themselves reciting that the third-party server computer controls at least a portion of the second media property." *Id.* (citing'139 Patent at 12:66–67, 14:44–46, 16:40–42).

In their reply, Defendants contend that the parties appear to agree that the "third-party computer server" must be "something ***other than*** the server performing the claimed process."

Reply at 16. With respect "server computer," Defendants recite they are amenable to changing their construction from "server" to "server computer." *Id.* at 18.

With respect to "first media property," Defendants contend that the claim language describes that third-party server computer "cannot be the same as the "first media property." *Id.* at 16. More specifically, Defendants contend that because Claim 37 of the '139 Patent recites "for each of a multitude of different electronic visitors to a first media property: (a) automatically directing, to a third-party server computer," this claim language "would not make sense if the 'third party server computer' and the 'first media property' were the same because the claim would contemplate "directing" information to the same place they are already visiting." *Id.*

With respect to Plaintiffs' argument that the BT company can itself be a publisher, Defendants contend that the specification "at best discloses alternatives in which the BT company may or may not be a third party with respect to the publisher. But this does not mean that the claims must cover both embodiments." *Id.* at 17 (quoting *Pacing Techs. v. Garmin Int'l*, 778 F.3d 1021, 1026 (Fed. Cir. 2015)). Defendants contend that "[b]y requiring that the server computer be a 'third-party' server computer with respect to the first media property, the applicants sought to capture the primary embodiment in which the two are not the same." *Id.*

With respect to "second media property," Defendants contend that the plain language of the claims recites "a third-party server computer controlling advertising space on a second media property." *Id.* (quoting '139 Patent, Claim 37). Defendants contend that if the third-party server computer and second media property were not different, then the third-party server computer can control advertising space on itself, thus rendering "third-party" to be superfluous. *Id.*

In their sur-reply, with respect to "first media property," Plaintiffs contend that "Defendants do not explain why, for example, it would not make sense for a server—associated

with a website that a user is visiting—to receive information regarding that visitor." Sur-Reply at 18. With respect to "second media property," Plaintiffs contend that the parties have agreed that the "third-party server computer" is "distinct from the server computer performing the claimed process," which means, contrary to Defendants' assertion, that "third-party" is not superfluous. *Id.*

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347. ***Second***, Defendant does not expressly allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning. *Thorner*, 669 F.3d at 1365.

***Third***, with respect to "first media property," because "media properties" are not "computers," the Court agrees with Plaintiffs that, Defendants' proposed construction excluding "first media property" is confusing. ***Fourth***, the Court concludes that Defendants improperly exclude an embodiment. More specifically, Defendants assert that the specification discloses "discloses alternatives in which the BT company may or may not be a third party with respect to the publisher," but that the patentee chose to only claim one embodiment. To exclude an embodiment requires probative evidence to the contrary. *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed. Cir. 2008) ("We normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification. . . . where claims can reasonably be interpreted to

include a specific embodiment, it is incorrect to construe the claims to exclude that embodiment, absent probative evidence to the contrary."). As Defendants have not provided any such evidence, the Court concludes Defendants' proposed construction improperly excludes an embodiment. ***Fifth***, the Court agrees with Plaintiffs that Defendants have not explained why it would not make sense for a server—associated with a website that a user is visiting—to receive information regarding that visitor.

***Sixth***, with respect to "second media property," the Court agrees with Plaintiffs that Defendants' distinction between the "third-party server computer" and the "second media property," makes little sense in light of the claims themselves reciting that the third-party server computer controls at least a portion of the second media property." '139 Patent, Claims 1, 19, 37. ***Seventh***, the Court agrees with Plaintiffs that because the parties agrees that "third-party server computer" is different from the server computer performing the claimed process, that does not render "third-party" to be superfluous.

Therefore, for the reasons described above, the Court finds that "third-party server computer" should be construed according to its plain-and-ordinary meaning.

**K. Term #11: "possibly applicable" / "possible"**

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #11: "possibly applicable" / "possible"<br><br>U.S. Patent No. 8,671,139, Claims 1, 3, 4, 37, 40; U.S. Patent No. 8,959,146, Claims 1, 4, 21; U.S. Patent No. 8,200,822, Claims 35-37<br><br>Proposed by Defendants | Not indefinite. No construction necessary; plain and ordinary meaning | Indefinite, lacks reasonable certainty as to its scope |

**<u>The Parties' Positions:</u>**

Defendants contend that the intrinsic record provides no meaningful guidance what qualities as being "possibly applicable," apart from being actually applicable. Opening at 30. Defendants contend that Plaintiffs do not provide a construction nor explains what separates what is "possibly applicable" from what is impossible. *Id.* Defendants contend that the common specification does not use the words "possibly" or "possible" when describing attributes, nor provide examples. *Id.* at 31. Defendants contend that dictionaries define "possible" as "being something that may or may not occur," which in the context of the asserted patents does inform a POSITA with reasonable certainty what the scope of the claims are. *Id.*

In their response, Plaintiffs first contend that "possible" is a plain English word that "stands in contrast to the bright line of 'impossible.'" Response at 39, 40. Based on that, Plaintiffs contend that this term does not rely on subjective intent. *Id.* at 40. Plaintiffs contend that "possible" is a broad term, but that breadth is not indefiniteness. *Id.* (quoting *BASF Corp.*, 875 F.3d at 1367).

Plaintiffs contend that Defendants' dictionary-related argument, if applied to all patents, would render all patents that use "possible" or "possibly" to be indefinite. *Id.* Plaintiffs contend

that they provided examples of Defendants' patents that use "possibly," which would likewise be indefinite under Defendants' argument. *Id.*

Plaintiffs contend that "'all that is required is some standard' for one of skill in the art to determine the scope of the term with reasonable certainty." *Id.* at 40–41 (quoting *Exmark Mfg. Co., Inc. v. Briggs & Straton Power Prods. Grp. LLC*, 879 F.3d 1332, 1345–47 (Fed. Cir. 2018)).

In their reply, Defendants first contend that Plaintiffs do not cite anything in the "intrinsic record that provides objective boundaries" for this claim term. Reply at 18. Defendants further contend that it is not enough to identify "some standard" to determine the claim scope. *Id.* (citing *Interval Licensing*, 766 F.3d at 1370–71 (Fed. Cir. 2014)).

Defendants contend that "[w]hether an attribute is 'possibly applicable' necessarily depends on subjective decisions made by the system based on the information available to it." *Id.* at 19 (citing '139 Patent, Claim 37). Defendants contend that the specification do not provide any guidance as to when an attribute crosses the line from "possible" to "impossible." *Id.*

Defendants contend that citations to its patents are irrelevant because they are extrinsic evidence and because the specifications of those patents provided objective boundaries as to be the meaning of "possibly." *Id.*

In their sur-reply, Plaintiffs contend that Defendants do not allege that "possible," "possibly," and "applicable" are indefinite in isolation. Sur-Reply at 18. With respect to Defendants' argument that "[w]hether an attribute is 'possibly applicable' necessarily depends on subjective decisions made by the system based on the information available to it," Plaintiffs contend that that is a written description argument, and not an indefiniteness argument. *Id.* at 18–19. Plaintiffs further contend that the claim language provides the "necessary context for evaluating the indefiniteness question." *Id.* at 19 (citing *Cox Commc'ns, Inc. v. Sprint Commc'n*

*Co.*, 838 F.3d 1224, 1231 (Fed. Cir. 2016)). Plaintiffs contend that claims "simply require the existence of a plurality of profile attributes, each of which is 'possibly applicable' to an electronic visitor when the visitor 'visits the first media property.'" *Id.* at 19–20 (citing '139 Patent, Claims 1, 3).

**The Court's Analysis:**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs that because Defendant has not provided clear and convincing evidence that a POSITA would not understand the scope of this term with "reasonable certainty," the term is not indefinite and that the proper construction is plain-and-ordinary meaning for the reasons that follow. ***First***, the Court agrees with Plaintiffs that "possible" and "possibly" are broad terms, but that their breadth can be determined, *i.e.*, what is not impossible. *BASF Corp.*, 875 F.3d at 1367 ("Breadth is not indefiniteness.").

***Second***, the Court concludes that a POSITA would understand with reasonable certainty what the scope of this term is. More specifically, the parties do not appear to dispute what the meaning of "attributes" is, *e.g.* characteristics of an electronic visitor. *Id.*, Claim 37, Limitation [c]. The specifications describe that the claimed inventions are implemented using computers. *See, e.g.*, '139 Patent at Figure 3. Based on those two facts, the Court concludes that not only would a POSITA understand that the "possible" attributes are those that are not impossible, they also are sufficiently definite such that a POSITA could implement them in software.

Therefore, for the reasons described above, the Court concludes that Defendants have not provided clear and convincing evidence that this term is indefinite.

***Construction***: Because the "heavy presumption" is that terms should be construed according to their plain-and-ordinary meaning and because Defendant does not allege lexicography or disclaimer, which are the only two exceptions to the general rule that a term should be construed as having its plain-and-ordinary meaning, the Court concludes that the term should be construed as having its plain-and-ordinary meaning. *Azure Networks*, 771 F.3d at 1347; *Thorner*, 669 F.3d at 1365.

Therefore, for the reasons described above, the Court finds that the term is not indefinite and should be construed according to its plain-and-ordinary meaning.

**L. Term #12: "BT company"**

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction |
|---|---|---|
| #12: "BT company"<br><br>U.S. Patent No. 9,830,615, Claims 9, 11<br><br>Proposed by Microsoft | an entity that targets ads based on observed behavior of sites' visitors | The preamble is limiting.<br><br>An entity that targets ads for placement in advertising space controlled by another party based on observed behavior of website visitors by arranging for placement of cookies |

**<u>The Parties' Positions:</u>**

The parties' proposed constructions initially differed in two respects: (1) whether the BT company places ads in space "controlled by another party," and (2) the use of cookies. Reply at 21. With respect to the latter dispute, Microsoft says that it is willing to replace "cookies" with Plaintiffs' suggested "identifiers." *Id.*

With respect to the former dispute, Microsoft contends that the claim language "teaches that the BT company has a cap on the price it will pay for allowing delivery of an advertisement,

implying that the ad has to be delivered or placed on some other media property." Opening at 34 (citing '615 Patent, Claim 9, Limitation [c]). Microsoft further contends that the specification confirms this understanding. *Id.* More specifically, Microsoft contends that the specification teaches that the "BT company places ads on [s]ites that can be either a site that uses the BT company's software or a site where the BT company has bought media—either way, those are another party's websites." *Id.* at 34–35 ('615 Patent at 2:17–19; 3:45–48, 9:54–56; 7:4–6, and 8:48–50).

In their response, Plaintiffs contend that adding "controlled by another party" is unnecessary because the "claims already specify the entity controlling the advertising space, there is no basis for Microsoft to read a similar limitation into the definition of 'BT company.'" Response at 44.

In its reply, Microsoft contends that the claim language and specification confirm its reading. Reply at 21 (citing '615 Patent, Claim 9, Limitations [c], [d]; '615 Patent at 2:17–19; 3:45–48, 9:54–56). Microsoft further contends that the term requires "clarif[ication]."

In their sur-reply, Plaintiffs contend that Microsoft does not dispute that the claims "are already explicit about what entity controls what advertising space (i.e., the 'third party computer system')[.]" Sur-Reply at 21. Plaintiffs also contend that "hypothetical 'other disputes'…are not intrinsic or extrinsic evidence justifying the extraneous limitation Microsoft seeks to import here." *Id.*

**<u>The Court's Analysis:</u>**

After reviewing the parties' arguments and considering the applicable law, the Court agrees with Plaintiffs and finds that the proper construction is "an entity that targets ads based on observed

behavior of sites' visitors" for the reasons that follow. ***First***, the '615 Patent describes BT companies as companies who "specialize in targeting ads based on observed behavior of sites' visitors." '615 Patent at 2:5–8. This description does not include "third party computer system." Therefore, in the absence of a disclaimer or additional lexicography, the Court concludes that this is the proper construction.

***Second***, the Court agrees with Plaintiffs that including "third party computer system" is incorrect. The Court agrees with Plaintiff—and Microsoft does not appear to disagree—that the claim language recites that the BT company places ads on "media property advertising space controlled by the third party computer system." '615 Patent, Claim 9, Limitation [c]. Because the claim language already recites "third party computer system," it would be incorrect to include it in the Court's final construction as that would render some of the claim language to be superfluous. Furthermore, the fact that the claim language includes this term indicates that "third party computer system" is outside the meaning of this term.

***Third***, none of the passages that Microsoft cites ('615 Patent at 2:17–19; 3:45–48, 9:54–56; 7:4–6, and 8:48–50) appears to rises to the level of a "clear and unmistakable" disclaimer. *Liebel-Flarsheim*, 358 F.3d at 900. Rather, theses passage appear to describe an aspect of different embodiments. But absent a clear indication in the intrinsic record that the patentee intended to limit the claims to a particular embodiment, it is improper for the Court to do so. *Id.* at 913 ("[I]t is improper to read limitations from a preferred embodiment described in the specification—even if it is the only embodiment—into the claims absent a clear indication in the intrinsic record that the patentee intended the claims to be so limited.").

Therefore, for the reasons described above, the Court finds that "BT company" is one that "specialize[s] in targeting ads based on observed behavior of sites' visitors."

## IV. CONCLUSION

In conclusion, for the reasons described herein, the Court adopts the below constructions as its final constructions.

**SIGNED** this 19th day of June, 2023.

ALAN D ALBRIGHT
UNITED STATES DISTRICT JUDGE

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #1: "tag"<br><br>U.S. Patent No. 7,822,639, Claims 24, 40, 44; U.S. Patent No. 8,244,586, Claims 1, 2, 7, 8, 11, 19, 20; U.S. Patent No. 8,671,139, Claims 3, 46, 47, 50, 51, 53; U.S. Patent No. 8,959,146, Claims 10, 11, 23, 24; U.S. Patent No. 9,830,615, Claim 9; U.S. Patent No. 10,321,198, Claims 22, 23; U.S. Patent No. 8,200,822, Claims 37, 43, 44, 47, 49, 50, 51<br><br>Proposed by Amazon | No construction necessary; plain and ordinary meaning | Identifier<br><br>Alternatively, an identifier or information indicating that its bearer has been marked | Plain-and-ordinary meaning |

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #2: "delivery to visitor computers visiting a second, different Internet site of advertisements sold, for a first price, for placement on visitor computers that have visited the first Internet site" / "direction of at least one off-site advertisement to visitor computers visiting a second Internet site . . . which off-site advertisement concerns at least one offering of a third-party advertiser that has paid to display said advertisement on visitor computers that have visited the first Internet site"<br><br>U.S. Patent No. 7,822,639, Claim 24; U.S. Patent No. 8,244,586, Claims 1, 11<br><br>Proposed by Amazon | No construction necessary; plain and ordinary meaning | <u>'639 patent, claim 24; '586 patent, claim 11:</u><br>delivery to visitor computers <u>currently</u> visiting a second, different Internet site of advertisements <u>that were</u> sold, for a first price, for placement on visitor computers that have visited the first Internet site<br><br><u>'586 patent, claim 1:</u><br>direction of at least one off-site advertisement to visitor computers <u>currently</u> visiting a second Internet site . . . which off-site advertisement concerns at least one offering of a third-party advertiser that has <u>previously</u> paid to display said advertisement on visitor computers that have visited the first Internet site | Plain-and-ordinary meaning |

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #3: "second Internet site" / "second, different Internet site"<br><br>U.S. Patent No. 7,822,639, Claims 24, 40; U.S. Patent No. 8,244,586, Claims 1, 5, 6, 7, 8, 9, 11, 14, 17, 19, 20<br><br>Proposed by Defendants | "Internet site operated for the benefit of a different (and not commonly owned) entity than an entity for which the first Internet site is operated for the benefit of." | Internet site owned by and operated for the benefit of proprietor(s) that are different from (not commonly owned by) proprietors of the first Internet site<br><br>Alternatively, Internet site operated for the benefit of proprietor(s) that are different from (not commonly owned by) proprietors of the first Internet site | "Internet site operated for the benefit of a different (and not commonly owned) entity than an entity for which the first Internet site is operated for the benefit of." |

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #4: "unaffiliated third parties" / "unaffiliated third party"<br><br>U.S. Patent No. 8,244,582, Claims 1, 5, 11, 15<br><br>Proposed by Defendants | a party not having common ownership with the party or parties that control said programmed computer system | "unaffiliated third party"/ "unaffiliated third parties": indefinite, lacks reasonable certainty as to its scope<br>***<br>"third party" / "third parties": a party not having common ownership with the party or parties that own said programmed computer system | Not indefinite. Plain-and-ordinary meaning |
| #5: "partial profile"<br><br>U.S. Patent No. 8,244,582, Claims 1, 3, 4, 6, 11, 13, 14, 16<br><br>Proposed by Defendants | Not indefinite. No construction necessary; plain and ordinary meaning. | Indefinite, lacks reasonable certainty as to its scope. | Not indefinite. Plain-and-ordinary meaning. |
| #6: "available"<br><br>U.S. Patent No. 8,244,582, Claims 1, 11<br><br>Proposed by Defendants | No construction necessary; plain and ordinary meaning | electronically accessible | Plain-and-ordinary meaning |

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #7: "automatically with the computer system" / "automatically" / "automatic"<br><br>U.S. Patent No. 8,244,582, Claims 1, 5, 6, 9, 10, 11, 14, 15, 16, 19, 20; U.S. Patent No. 8,244,586, Claims 1, 2; U.S. Patent No. 8,671,139, Claim 37; U.S. Patent No. 8,959,146, Claims 1, 21; U.S. Patent No. 9,830,615, Claims 9, 10, 11; U.S. Patent No. 10,321,198, Claims 1, 18; U.S. Patent No. 8,566,164, Claims 1, 3, 16, 22; U.S. Patent No. 10,715,878, Claims 13, 17, 18, 20; U.S. Patent No. 8,200,822, Claim 35<br><br>Proposed by Defendants | No construction necessary; plain and ordinary meaning | not manually | Plain-and-ordinary meaning |

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #8: "URL redirection"<br><br>U.S. Patent No. 8,244,582, Claims 1, 10, 11, 20<br><br>Proposed by Defendants | obtaining certain information for at least a portion of an accessed page / site from a different location | obtaining a requested webpage from a different location | Plain-and-ordinary meaning |
| #9: "indicia of instructions" / "indicia of a condition" / "indicia"<br><br>U.S. Patent No. 8,244,582, Claims 11, 15, 16, 19, 20; U.S. Patent No. 8,671,139, Claims 1, 37<br><br>Proposed by Defendants | Not indefinite. No construction necessary; plain and ordinary meaning | Indefinite, lacks reasonable certainty as to its scope | Not indefinite. Plain-and-ordinary meaning. |

| Term | Plaintiffs' Proposed Construction | Defendants' Proposed Construction | Court's Final Construction |
|---|---|---|---|
| #10: "third-party server computer"<br><br>U.S. Patent No. 8,671,139, Claims 1, 37; U.S. Patent No. 8,959,146, Claims 1, 21<br><br>Proposed by Defendants | No construction necessary; plain and ordinary meaning | server other than first media property, second media property, or the server performing the claimed process | Plain-and-ordinary meaning |
| #11: "possibly applicable" / "possible"<br><br>U.S. Patent No. 8,671,139, Claims 1, 3, 4, 37, 40; U.S. Patent No. 8,959,146, Claims 1, 4, 21; U.S. Patent No. 8,200,822, Claims 35-37<br><br>Proposed by Defendants | Not indefinite. No construction necessary; plain and ordinary meaning | Indefinite, lacks reasonable certainty as to its scope | Not indefinite. Plain-and-ordinary meaning. |
| #12: "BT company"<br><br>U.S. Patent No. 9,830,615, Claims 9, 11<br><br>Proposed by Microsoft | an entity that targets ads based on observed behavior of sites' visitors | The preamble is limiting.<br><br>An entity that targets ads for placement in advertising space controlled by another party based on observed behavior of website visitors by arranging for placement of cookies | "an entity that targets ads based on observed behavior of sites' visitors" |



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