IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

VIDEOSHARE, LLC, 　　　　　Plaintiff, 　　v. GOOGLE INC., and YOUTUBE LLC 　　　　　Defendants.	Civil Action No. 13-990-GMS
VIDEOSHARE, LLC, 　　　　　Plaintiff, 　　v. VIMEO, LLC, 　　　　　Defendant.	Civil Action No. 13-992-GMS

ORDER CONSTRUING THE TERMS OF U.S. PATENT NOS. 8,438,608 and 8,646,302[1]

After considering the submissions of the parties and hearing oral argument on the matter,

IT IS HEREBY ORDERED, ADJUDGED, and DECREED that, as used in the asserted claims of

U.S. Patent Nos. 8,438,608 ("the '608 patent") and 8,646,302 ("the '302 patent"):

1.　　The terms **"first computer, second computer, third computer, fourth computer,**

fifth computer, sixth computer, seventh computer, eighth computer, ninth

computer" are construed to each consist of one or more computers, each of which

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[1] All docket citations refer to Civil Action No. 13-990-GMS. The abbreviation "Tr." refers to the transcript from the *Markman* Hearing on November 24, 2015, D.I. 78.

may include component parts that overlap with the other enumerated computers, and

each of which may be part of the same computer.[2]

2.   The term "**a receiving computer**" is construed to mean "one or more computers,

other than a second computer, at least one component of which receives a video file

from a user on a second computer."[3]

3.   The term "**a first computer**" is construed to mean "one or more computers, other

than a second computer." [4]

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[2] Defendants argue that these claim terms should be construed as means-plus-function terms under § 112 ¶ 6. To avoid application of § 112 ¶ 6, a term must be "understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015). If the term does not denote structure, the court must then look to the specification to find corresponding structure. "If the patentee fails to disclose adequate corresponding structure, the claim is indefinite." *Id.* at 1352. The defendants argue that 'computer' invokes functional claiming because "a general purpose computer is insufficient structure" to pass an indefiniteness analysis under § 112 ¶ 6. (D.I. 62 at 2.)

The defendants conflate two separate inquiries. Whether a structure is sufficient to survive an indefiniteness analysis is a separate consideration from whether a term denotes a structure at all. The Federal Circuit has not stated that the standards for indefiniteness and the standard for structure are identical. Indeed, a claim can have definite enough structure to avoid the application of § 112 ¶ 6, but still be found indefinite—otherwise, any indefinite claim would necessarily be a means-plus-function claim.

A computer is a tangible and physical structure, well-known to one of ordinary skill in the art. The court therefore finds that 'computer' denotes sufficient structure to avoid the application of § 112 ¶ 6. At this time, the court does not analyze whether the generic computer terms contain sufficient structure to survive an indefiniteness challenge.

[3] During the *Markman* Hearing, the parties agreed with the court's proposed construction for this term as applied to the '608 patent, claim 1. Tr. 32:20–34:24.

The court's construction will also apply to this term as used in the '608 patent, claim 14. 'Receiving computer' appears three times in claim 14 of the '608 patent. Under the defendants' proposed construction, 'receiving computer' would be construed as a means-plus-function term only the third time it appears in this claim, following the "embedding . . . the identification tag" limitation. As discussed in note 2, the court finds that 'computer' has sufficient structure to avoid application of § 112 ¶ 6. Indeed, the inconsistency in treating 'receiving computer' differently within the same claim highlights the problem with the defendants' position that 'computer' is functional, rather than structural, claim language.

[4] The defendants raise two issues regarding this term. First, they argue that there must be a distinction between 'a first computer' and 'a second computer,' as later recited in claim 1 of the '302 patent. The plaintiff does not disagree, and the court amends the plaintiff's proposed construction to reflect this.

Second, the defendants argue that there must be a distinct computer that performs all of the recited steps. Alternatively, if there are a plurality of computers, the defendants argue that this limitation requires

4. The term "**embedding the identification tag . . . into a web page**" is construed to have its plain and ordinary meaning.[5]

5. The term "**streaming video file comprising a streaming video format**" is construed to mean "video file containing data formatted such that the file is capable of (a) being transmitted over a network and (b) being played before all of its data is fully transmitted."[6]

6. The term "**video frame image representing a subject matter of the streaming video file and identifying the streaming video file**" are construed to mean "one or more still images from a sequence of images in the video file that is informative as to the subject matter contained in the video and is used as a reference image to identify the video."[7]

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all of the computers to perform all of the steps *as a unit*. The court disagrees. Neither the plain language of the claims nor the specification require this narrow construction.

[5] Defendants seek to specify that the 'web page' is remote from the receiving computer. The court rejects this for two reasons. First, they improperly seek to limit the claim to its embodiments. Second, as the plaintiff notes, a 'web page' is a document, but a 'website' refers to a location. (D.I. 54 at 6.) Because the claim does not deal with location, the idea of 'remoteness' does not come into play.

[6] The defendants' proposed construction improperly inserts language from an unclaimed embodiment. *See* '608 patent, at 14:23–25. The court finds that this claim term is straightforward and does not require the additional limitation of "format characteristics and format identifiers."

[7] The court adopts the plaintiff's proposed construction. The defendants refer to two embodiments to support their argument that 'video frame image' can only be the middle image of the video file. '608 patent at 22:63–23:3. But the plain meaning of 'video frame image' is clear, and absent clear intent by the patentee, these embodiments do not delimit the term's scope.

The defendants also argue that the claim requires a URL or hyperlink. Although they make a good argument for why 'identifying the streaming video file' might imply an active component (*see* D.I. 56 at 10), the court finds that the claim only covers the image as a visual identifier. The specification of the '608 patent is helpful here. It describes several ways the video can be identified. One is "an identification tag which identifies where and/or how the video can be accessed, for example a network address, or a universal resource locator ("URL"). '608 patent at 1:64–67. Alternatively, the video can be identified with "an image that represents the content or subject matter of the video, so that the video can readily be identified when held in a collection of videos." *Id.* at 2:1–3. Other options for identifiers include file names, "a file handle, a storage location, an interactive control, and a control object operating according to the Component Object Model (COM)." *Id.* at 2:3–9. The defendants advocate for the first example of an identifier, but this claim

7. The term **"executing in response to the video, an automated function automatically performing each of"** is construed to mean "in response to the receiving computer receiving the video file, carrying out computer instructions, without the need for intervention by a human operator, for each of the following operations (not necessarily in this order)."[8]

8. The terms **"associating the streaming video file with the advertisement"** and **"selectively associates the streaming video file with an advertisement based on pre-determined data"** are construed to have their plain and ordinary meanings.[9]

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clearly only applies to the second example. In identifying the video, the video frame image gives information about the contents of the file, rather than giving its location. The URL limitation desired by the defendants can be found in dependent claim 20. Because dependent claims are narrower than independent claims, this further supports the court's conclusion.

[8] The issue here is whether the listed steps of converting, generating, and embedding need to be performed in the order recited in the claims. Where a method claim does not expressly recite an order, the court examines 1) whether "as a matter of logic or grammar, they must be performed in the order written," or 2) whether the rest of the specification requires the steps to be performed in a certain order. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369–70 (Fed. Cir. 2003).

The defendants argue that the enumeration of steps as (b1), (b2), and (b3) in claim 1 of the '608 patent implies an order. The defendants also assert that logic and grammar require the enumerated order because each step refers to a completed element of the preceding step—step (b2) cannot be performed until 'the streaming video file' is created in step (b1), and step (b3) cannot be performed until 'the identification tag' is created in step (b2). Finally, the defendants note that all of the embodiments list the steps being performed in the same order.

The plaintiff responds that enumeration alone is not dispositive, because the steps do not actually recite an order. *See Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001) ("Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one."). Although the plaintiff agrees that step (b2) must be completed before step (b3), it claims that step (b1) can be performed at any point in the process—before, after, or simultaneously with steps (b2) or (b3). The plaintiff argues that step (b2)'s reference to 'the streaming video file' from step (b1) only establishes that both steps refer to the same 'streaming video file.' Additionally, the plaintiff contends, the video frame image which "represents a subject matter of the streaming video file" can be created from the pre-conversion video file, "because both the contents by which the video can be identified (i.e., the various images that make up the video) and the subject matter of the video remain the same pre- and post-conversion (only its format is different)." (D.I. 54 at 11.)

The court agrees with the plaintiffs. The claim is not limited to its embodiments, and the only order required by the intrinsic record is for the generating step, (b2), to precede the embedding step, (b3).

[9] Contrary to the defendants' contentions, the '302 patent does not require the advertisement to be selected by the user. Absent a clear definition by the patentee or disavowal of scope, the embodiments

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9. The term **"receiving, via a web page, a request to transmit the streaming video file"** is construed to have its plain and ordinary meaning.[10]

10. The term **"transmitting, via a web page, the streaming video file and the advertisement on a second computer network"** is construed to have its plain and ordinary meaning.[11]

11. The term **"wherein two or more of the first computer, second computer, third computer, fourth computer, fifth computer, sixth computer, seventh computer, eighth computer and ninth computer are part of the same computer"** is construed to have its plain and ordinary meaning.[12]

12. The term **"wherein two or more of the first computer, second computer, third computer, fourth computer, fifth computer, sixth computer, seventh computer, eighth computer and ninth computer comprise a plurality of computers"** is construed to have its plain and ordinary meaning.[13]

13. The term **"format conversion module"** is construed as a means-plus-function claim. The claimed function is: "converting the video file into a streaming video file

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referenced by the defendant do not narrow the claim. Additionally, the patent includes embodiments where the advertisement is not directly selected by the user. '302 patent at 15:36–37, 2:58–59.

[10] Similar to term 4, *see supra* note 5, the defendants' arguments that the web page must be 'remote' lack sufficient support. The defendants also attempt to use statements from the prosecution of the '608 patent to limit the terms of the '302 patent. Not only are these statements unrelated to the term at issue, but the '608 patent stems from a different parent application and is therefore extrinsic evidence for this term. The court finds that this term does not require additional construction.

[11] *See supra* note 10.

[12] The court finds that this term has a clear meaning which is not contradicted by the specification. The distinction drawn by the defendants does not have any basis in the intrinsic record.

[13] The court finds that this term has a clear meaning which is not contradicted by the specification. The distinction drawn by the defendants does not have any basis in the intrinsic record.

comprising a streaming video format, the video file converted independent from receiving a command to perform such conversion from the user." The corresponding structure is: "the file format conversion process provided by the Microsoft DirectShow software package and all equivalents thereof."[14]

14. The term **"identification module"** is construed as a means-plus-function-term. The claimed function is: "generating an identification tag comprising a video frame image representing a subject matter of the streaming video file and identifying the streaming video file." The corresponding structure is: "streaming Server D, identification module 1560, or host computer 60, and all equivalents thereof."[15]

Dated: January 6 , 2016
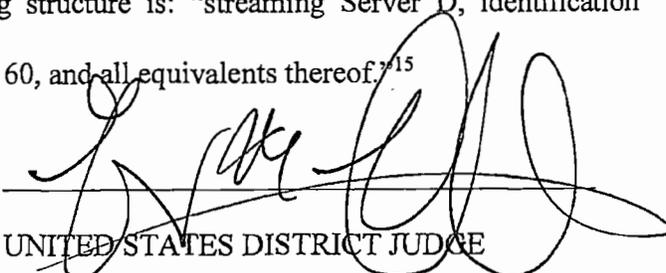
UNITED STATES DISTRICT JUDGE

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[14] The parties agree that § 112 ¶ 6 applies to this term, but disagree on the corresponding structure. For a means-plus-function term, the corresponding structure must be found in the specification. For computer-executed functions, the structure can be a specific algorithm for performing the function. *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Technology*, 521 F.3d 1328, 1331–32 (Fed. Cir. 2008).

The plaintiff's proposed construction fails because it lacks specificity. First, the plaintiff restates the parties' definition of 'module': "an assemblage of one or more parts of software, firmware, and/or hardware." If 'module' lacks sufficient structure to avoid functional claiming, its rephrased definition certainly does not satisfy the requirement for corresponding structure. Second, the plaintiff cobbles together a vague algorithm from the specification by picking and choosing portions of a broad flowchart. The specification never defines an algorithm for the 'format conversion module,' and the court finds that the plaintiff's proposed algorithm lacks specificity.

The court is therefore left with the defendants' proposal. Even though it limits the term to one embodiment, the court adopts the defendants' proposed construction because it is the *only* structure disclosed in the specification.

[15] *See supra* note 14.

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