

## Federal Circuit Patent Bulletin: *Augme Techs., Inc. v. Yahoo!*

June 20, 2014

*“The standard for indefiniteness . . . requires ‘that a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty.’”*

On June 20, 2014, *Augme Techs., Inc. v. Yahoo!*, the U.S. Court of Appeals for the Federal Circuit (Moore,\* Schall, Reyna) affirmed the district court’s summary judgment that Yahoo! did not infringe U.S. Patents No. 6,594,691 and No. 7,269,636, which related to adding functionality, such as media or advertisements, to a web page; that certain claims of the ‘691 patent were indefinite; that Augme and World Talk Radio, LLC infringed U.S. Patent No. 7,640,320, which related to retrieving digital content over a computer network using a unique identifier assigned to the content; and that claim 7 of the ‘320 patent was not indefinite. The Federal Circuit stated:

[T]he district court determined that returning a blank or advertisement-containing ad code does not indicate “whether permission is granted or denied.” . . . There is no real dispute regarding how the Yahoo! systems function, but only over whether a reasonable jury could conclude that the Yahoo! functionality includes an indication about web page permission. . . . The Yahoo! systems return either an advertisement or blank code based on the suitability of a particular advertisement. The evidence of record demonstrates that there is a genuine issue of material fact as to whether these advertisements or blank codes provide an indication of web page permission in the context of the Augme patents and the district court’s construction. Thus, the “service response” limitation is not a basis upon which we can affirm summary judgment of noninfringement. . .

Augme argues on appeal that the district court’s construction is erroneous because embedded code can include linked code, i.e., code not actually in the web page HTML, but separately retrieved after the web page download. We agree with the district court’s construction. [A] patentee may deviate from the plain and ordinary meaning of a claim term by disavowing claim scope or acting as his own lexicographer. But that principle does not apply here because the patentee is not deviating from the plain and ordinary meaning of

“embedded.” . . . Rather than disavow the plain meaning, the specification reinforces the plain-meaning construction that excludes linked code.

The district court granted Yahoo! summary judgment that its accused systems do not literally infringe the asserted claims because it determined that Yahoo!’s embedded smart tag could not be the first code module under its construction. . . . We affirm the district court’s grant of summary judgment of no literal infringement based on the “embedded first code module” limitation. Yahoo!’s embedded smart tags do not initiate retrieval of the imp code (the alleged second code module); the non-embedded smart code does. . . .

The district court also granted summary judgment that the Yahoo! systems do not include an “embedded first code module” under the doctrine of equivalents. . . . We affirm the district court’s grant of summary judgment. As construed, embedded code does not include externally linked code. . . . No reasonable jury could find equivalence here because doing so would require a determination that embedded code is substantially the same as linked code—the very thing that the construction of “embedded” excludes. “[T]he concept of equivalency cannot embrace a structure that is specifically excluded from the scope of the claims.” While we have recognized that literal failure to meet a claim limitation does not necessarily constitute a “specific exclusion,” we have found “specific exclusion” where the patentee seeks to encompass a structural feature that is the opposite of, or inconsistent with, the recited limitation. Because the Augme patents make clear that embedded and linked code are opposites, we agree with the district court that they “cannot possess only insubstantial differences.” . . .

The district court held that claims 19 and 20 of the ’691 patent are indefinite. [T]o meet the definiteness requirements of 35 U.S.C. § 112, second paragraph, the specification must disclose an algorithm for performing the claimed function. Certainly, the algorithm may be expressed in “any understandable terms including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.” But it must disclose some algorithm; it cannot merely restate the function recited in the claim. . . . Because the ’691 patent does not disclose an algorithm for performing the claimed function of assembling the second code module, we affirm the district court’s grant of summary judgment that claims 19 and 20 of the ’691 patent are invalid. . . .

We agree with the district court’s construction [of Yahoo!’s ’320 patent] which is consistent with the term’s plain meaning. Indeed, as Appellants admit, “[t]here appears to be no real dispute that ‘hostname’ refers to the network name of a particular server on a network.” . . . There is no reason to deviate from the plain meaning of server hostname based on any arguments made during prosecution. Yahoo!’s statements during original

prosecution and reexamination do not limit the server hostname to a media server from which the digital content is served. . . . We therefore affirm the district court's entry of summary judgment that Appellants infringe the asserted claims of the '320 patent based on this construction. . . .

The standard for indefiniteness is "whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." It requires "that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." The limitation at issue here is clear on its face and unquestionably meets this standard. We affirm the district court's determination that claim 7 is not indefinite.