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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

IN RE: PERSONAL WEB TECHNOLOGIES,
LLC ET AL., PATENT LITIGATION

Case No. 5:18-md-02834-BLF

AMAZON.COM, INC., and AMAZON WEB
SERVICES, INC.,

Case No.: 5:18-cv-00767-BLF

Plaintiffs,

~~PROPOSED~~ JUDGMENT AND
DISMISSAL OF CERTAIN
CUSTOMER CASES

v.

PERSONALWEB TECHNOLOGIES, LLC and
LEVEL 3 COMMUNICATIONS, LLC,

Defendants.

PERSONALWEB TECHNOLOGIES, LLC and
LEVEL 3 COMMUNICATIONS, LLC,

Counterclaimants,

v.

AMAZON.COM, INC., and AMAZON WEB
SERVICES, INC.,

Counterdefendants.

~~PROPOSED~~ JUDGMENT AND DISMISSAL OF
CERTAIN CUSTOMER CASES

CASE NO.: 5:18-cv-02834-BLF
CASE NO.: 5:18-cv-00767-BLF

[PROPOSED] JUDGMENT


On March 13, 2019, the Court issued its order granting in part and denying in part Amazon’s motion for summary judgment (the “Order”) (Dkt. 394). The following eight customer cases which allege infringement based solely on the customer’s use of Amazon S3 are fully adjudicated by the Order:

- PersonalWeb Technologies, LLC et al. v. Patreon, Inc., No. 5:18-cv-05599;
- PersonalWeb Technologies, LLC et al. v. Dictionary.com, LLC, No. 5:18-cv-05606;
- PersonalWeb Technologies, LLC et al. v. Vox Media, Inc., No. 5:18-cv-05969;
- PersonalWeb Technologies, LLC et al. v. Vice Media, LLC, No. 5:18-cv-05970;
- PersonalWeb Technologies, LLC et al. v. Oath Inc., No. 5:18-cv-06044;
- PersonalWeb Technologies, LLC et al. v. Buzzfeed Inc., No. 5:18-cv-06046;
- PersonalWeb Technologies, LLC et al. v. Popsugar, Inc., No. 5:18-cv-06612; and
- PersonalWeb Technologies, LLC et al. v. Ziff Davis, LLC, No. 5:18-cv-07119

The Court hereby enters final judgment in these actions. Pursuant to this final judgment, PersonalWeb’s claims in the above actions are **DISMISSED WITH PREJUDICE**. For the cases listed above, the deadline to file a motion for costs and for attorney’s fees under Federal Rule of Civil Procedure 54(d) is hereby extended until 14 days after the latter of entry of final judgment in *Amazon.com, Inc. and Amazon Web Services, Inc. v. PersonalWeb Technologies, LLC and Level 3 Communications, LLC* (Case No. 5:18-cv-00767-BLF) or entry of final judgment in *PersonalWeb Technologies, LLC and Level 3 Communications, LLC v. Twitch Interactive, Inc.* (Case No. 5:18-cv-05619-BLF).

IT IS SO ORDERED.

Dated: Apr. 22, 2019



Honorable Beth L. Freeman
United States District Court Judge

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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

IN RE: PERSONALWEB
TECHNOLOGIES, LLC, ET AL. PATENT
LITIGATION

Case No. 18-md-02834-BLF

**ORDER GRANTING IN PART AND
DENYING IN PART AMAZON’S
MOTION FOR SUMMARY
JUDGMENT**

[Re: ECF 315]

United States District Court
Northern District of California

PersonalWeb Technologies LLC and Level 3 Communications, LLC (collectively, “PersonalWeb”) allege patent infringement by Amazon.com, Inc. and Amazon Web Services, Inc. (collectively, “Amazon”), and separately by dozens of customers of Amazon, related to the customers’ use of Amazon’s S3 in connection with downloading files from S3. However, PersonalWeb previously sued Amazon in the Eastern District of Texas (“the Texas Action”) for infringement of the same patents by the same product.

Amazon now seeks summary judgment under claim preclusion and the related *Kessler* doctrine, arguing that PersonalWeb’s current lawsuits are barred by the prior action. PersonalWeb counters that claim preclusion does not apply because the instant litigation involves a different feature of S3 than what was accused in the Texas Action. PersonalWeb further argues that the instant litigation does not involve the same parties or their privies and that the previous litigation did not end in a final judgment on the merits.

The Court has considered Amazon’s motion for summary judgment of Amazon’s declaratory judgment claims and defenses under the claim preclusion and *Kessler* doctrines, ECF No. 315 (“Mot.”), PersonalWeb’s opposition, ECF No. 334 (“Opp.”), Amazon’s reply, ECF No.

1 350 (“Reply”), and PersonalWeb’s sur-reply, ECF No. 354-1 (“Sur-reply”).

2 For the reasons discussed below, Amazon’s motion for summary judgment is GRANTED
3 IN PART and DENIED IN PART.

4 **I. BACKGROUND**

5 **A. Procedural Background**

6 Beginning in January 2018, PersonalWeb filed numerous lawsuits against Amazon’s
7 customers alleging infringement related to their use of Amazon S3. *See, e.g.*, Case No. 18-cv-
8 00149-BLF, ECF No. 1 ¶ 56 (“Defendant has utilized . . . both hardware and software hosted on
9 the Amazon S3 hosting system.”). On February 5, 2018, Amazon filed a complaint for declaratory
10 judgment against PersonalWeb, seeking to preclude PersonalWeb’s infringement actions against
11 Amazon’s customers. ECF No. 18-cv-767-BLF (“Amazon DJ Action”). On February 27, 2018,
12 PersonalWeb filed a motion for transfer and consolidation of pretrial proceedings before the
13 Judicial Panel on Multidistrict Litigation (JPML). MDL No. 2834, Dkt. No. 1. On June 7, 2018,
14 the JPML transferred and assigned to this Court all then-existing cases comprising this MDL. ECF
15 No. 1. Following consolidation of the MDL, additional cases were related or transferred to this
16 Court. *See* ECF Nos. 23, 42, 44, 158, 160, 311.

17 On September 26, 2018, this Court ordered that it would proceed with the Amazon DJ
18 Action first. ECF No. 157. At that time, the Court stayed the proceedings in the “customer cases”
19 (any case comprising this MDL other than the Amazon DJ Action). *Id.* On October 3 and 4, 2018,
20 PersonalWeb filed amended complaints in the customer cases and an amended counterclaim in the
21 Amazon DJ Action. ECF Nos. 175-257.

22 During the November 2, 2018 Case Management Conference, the Court raised the concern
23 that a verdict against Amazon in the Amazon DJ Action may leave unresolved issues as to the
24 liability of the other defendants in the customer cases. ECF No. 300 at 4. After considering the
25 parties’ oral and written statements, the Court designated *PersonalWeb v. Twitch*, 18-cv-05619-
26 BLF as a representative customer case. Order Re Representative Customer Case, ECF No. 313.
27 PersonalWeb represented to the Court that PersonalWeb would not be able to proceed against the
28 defendants in the other customer cases if it lost against Twitch. Nov. 2, 2018 Case Mgmt. Conf.,

1 ECF No. 300 at 6. The Court ordered the stay lifted as to Twitch and ordered that Twitch shall
 2 participate in all proceedings. Order Re Representative Customer Case, ECF No. 313 at 3.
 3 Accordingly, for purposes of discussing Amazon’s motion for summary judgment, the Court relies
 4 on PersonalWeb’s pleadings against Twitch as representative of PersonalWeb’s pleadings in the
 5 customer cases. ECF No. 198 (“Twitch Compl.”). The Court also refers to the operative complaint
 6 in the Amazon DJ Action. *See* 18-cv-767-BLF, ECF No. 36 (“DJ Compl.”).

7 **B. Factual Background Regarding the Technology**

8 **1. Patents-In-Suit**

9 In the earliest complaints filed in the customer cases, PersonalWeb alleged infringement of
 10 U.S. Patent Nos. 5,978,791 (the “791 patent”), 6,928,442 (the “442 patent”), 7,802,310 (the
 11 “310 patent”), 7,945,544 (the “544 patent”), and 8,099,420 (the “420 patent”) (collectively,
 12 “patents-in-suit”).¹ *See, e.g.*, Case No. 18-cv-00149-BLF, ECF No. 1 ¶ 1. All five patents share a
 13 specification and each claims priority to a patent filed on April 11, 1995. All of the patents-in-suit
 14 have expired, and PersonalWeb’s allegations are directed to the time period prior to their
 15 expiration. Twitch Compl. ¶ 18. PersonalWeb has dropped the ‘791 patent from the operative
 16 complaints in the customer cases and its counterclaim against Amazon; however, Amazon’s FAC
 17 in the DJ Action still includes the ‘791 patent. DJ. Compl. ¶¶ 49-56.

18 In its complaint, PersonalWeb represents that the patents-in-suit address the problem of
 19 how to efficiently name and identify files on a computer network. Twitch Compl. ¶ 11. The patent
 20 specification describes the alleged problem that the patents address: “[t]he same [file] name in two
 21 different [folders] may refer to different data items, and two different [file] names in the same
 22 [folder] may refer to the same data item.” ‘442 Patent at 2:15-17 (available at ECF No. 315-3).
 23 PersonalWeb’s complaint explains that the patents-in-suit involve using a cryptographic hash
 24 function to produce a content-based “True Name” identifier for a file, which “ensure[s] that
 25 identical file names refer[] to the same data, and conversely, that different file names refer[] to
 26

27 _____
 28 ¹ PersonalWeb does not allege infringement of the ‘544 patent in its counterclaim against Amazon. ECF No. 257. However, Amazon includes the ‘544 patent in its complaint in the DJ Action. DJ Compl. at 18.

1 different data.” Twitch Compl. ¶¶ 13, 15-17. For a small file, “[a] True Name is computed using a
2 [hash] function . . . which reduces a data block . . . to a relatively small, fixed size identifier, the
3 True Name of the data block, such that the True Name of the data block is virtually guaranteed to
4 represent the data block B and only data block B.” ‘442 Patent at 12:58-63. Larger files are split
5 into smaller segments. The hash function is applied to each segment, and the resulting values are
6 strung together into an indirect data item. The True Name of this indirect data item is then
7 computed. This becomes the True Name of the larger file. *Id.* at 14:16-35.

8 The summary of the invention describes multiple uses for these True Names, including (1)
9 to avoid keeping multiple copies of a given data file, regardless of how files are named; (2) to
10 avoid copying a data file from a remote location when a local copy is already available; (3) to
11 access files by data name without reference to file structures; (4) to maintain consistency in a
12 cache of data items and allow corresponding directories on disconnected computers to be
13 resynchronized with one another; (5) to confirm whether a user has a particular piece of data,
14 regardless of its name; and (6) to verify that data retrieved from a remote location is the intended
15 data. ‘442 Patent at 3:49-4:37. The patents-in-suit are directed to various specific aspects of this
16 system.

17 **2. Background Regarding Website Functions**

18 In both the Twitch case and Amazon DJ Action, PersonalWeb’s infringement allegations
19 involve website cache management. PersonalWeb summarizes the following relevant background
20 regarding website functioning in the Twitch Complaint. Typically, a “webpage base file” includes
21 text, formatting, and links to other web content such as images (“asset files”) that make up part of
22 the webpage. Twitch Compl. at ¶ 20. An individual’s web browser retrieves a webpage base file
23 from a remote web server, and then the individual’s web browser retrieves the referenced asset
24 files from the same or different servers. *Id.* at ¶ 22. The web browser retrieves a webpage base file
25 or asset file by making a “GET” request to a web server using the Hypertext Transfer Protocol
26 (“HTTP”). *Id.* The web server may respond to a GET request with a response that includes the
27 requested content and may include other information or instructions. *Id.* In order to improve the
28 speed of retrieving webpages, a web browser can store a webpage base file and related asset files

1 1052.

2 **1. Final Judgment on the Merits**

3 Typically, this element is undisputed. Here, however, PersonalWeb contends that there is
4 no prior final judgment on the merits for purposes of claim preclusion because the contracted
5 stipulation of dismissal in the Texas Action contained express reservations limiting the dismissal’s
6 preclusive effect. Opp. at 18.

7 A dismissal with prejudice “constitutes a final judgment on the merits, and prevents [the
8 plaintiff] from reasserting the same claim in a subsequent action against [the same defendant].”
9 *Int’l Union of Operating Eng’rs v. Karr*, 994 F.2d 1426, 1429 (9th Cir. 1993). The “parties can
10 draft the terms of a settlement agreement so as to alter the preclusive effect of prior judgments,”
11 but the court will not “supply by inference what the parties have failed to expressly provide [in the
12 settlement agreement], especially when that inference would suspend the application of this
13 circuit’s principles of res judicata.” *Id.* at 1432-33 (citations omitted).

14 In the Texas Action, the parties’ stipulation of dismissal with prejudice provided:

15 Now, therefore, it is hereby stipulated, by and among Plaintiffs PersonalWeb
16 Technologies LLC and Level 3 Communications LLC and Defendants
17 Amazon.com, Inc., and Amazon Web Services LLC, that all claims in the above-
18 captioned action shall, in accordance with the concurrently submitted Order of
19 Dismissal, be dismissed with prejudice, that Defendant Amazon.com, Inc. and
20 Amazon Web Services LLC retain the right to challenge validity, infringement,
and/or enforceability of the patents-in-suit, via defense or otherwise, in any future
proceeding, and that each party shall bear its own costs, expenses and attorneys’
fees. ECF No. 340-1.

21 The stipulation contained no additional language as to the preclusive effect of the
22 dismissal. In the Order of Dismissal with Prejudice, the Texas court specified that Amazon
23 “retain[s] the right to challenge validity, infringement, and/or enforceability of the patents-in-suit
24 via defense or otherwise, in any future suit or proceeding.” ECF No. 315-7.

25 PersonalWeb submits several arguments in opposition. First, PersonalWeb argues that
26 “PersonalWeb retained the right to pursue both the *identical* as well as *additional* patent
27 infringement claims pertaining to the TrueName patents against Amazon, which is the only reason
28 Amazon expressly reserved all future, substantive defense rights.” Opp. at 18. However, nothing

United States District Court
Northern District of California

1 in the stipulation or judgment supports that contention. The stipulation is remarkably and
2 unequivocally one-sided in favor of Amazon. The Court cannot infer that PersonalWeb retained
3 the right to assert future infringement contentions in the absence of express language in the
4 stipulation. *See Karr*, 924 F.2d at 1432-33; *see also Aspex Eyewear, Inc. v. Marchon Eyewear,*
5 *Inc.*, 672 F.3d 1335, 1346 (Fed. Cir. 2012) (“the parties’ decision to depart from the normal rules
6 of claim preclusion by agreement ‘must be express’”) (citation omitted)).

7 Second, at the hearing PersonalWeb argued that at the time of the stipulated dismissal, the
8 parties understood that the dismissal would be construed according to *Aspex*. Trans., ECF No. 376
9 at 58, 69. Specifically, PersonalWeb quoted from *Aspex*: “In order to construe the settlement
10 agreement to reach [new] products that were introduced during the several-month period before
11 the settlement agreement was executed, we would have to conclude that the parties intended to
12 depart from the normal rule that the products at issue in a patent suit are those in existence at the
13 time the suit is filed.” 672 F.3d at 1346. *Aspex* has to do with whether a settlement agreement
14 applies to new products and offers no support to PersonalWeb. In this case, the very same S3 at
15 issue in the Texas Action is again at issue here.

16 Additionally, in its briefing, PersonalWeb cites declarations of PersonalWeb’s counsel and
17 PersonalWeb’s Non-Executive Chairman stating that the parties to the Texas Action recognized
18 that PersonalWeb retained the right to assert infringement claims involving S3 in the future.
19 Hadley Decl. & Bermeister Decl., ECF Nos. 335, 337. However, at the hearing, PersonalWeb
20 conceded that it does not intend to argue that these declarations should be interpreted to modify
21 the express language of the stipulated dismissal. Trans., ECF No. 376 at 57-58.

22 Because PersonalWeb did not reserve any rights in the stipulated dismissal in the Texas
23 Action, the Court finds that the dismissal with prejudice in the Texas Action constitutes a final
24 judgment on the merits for purposes of the claim preclusion analysis in the instant case. *See Karr*,
25 994 F.2d at 1429 (dismissal with prejudice constitutes judgment on the merits for purposes of
26 claim preclusion).

27 **2. Identical Parties or Privies**

28 For the reasons discussed below, there appears to be privity between Amazon and its

1 customers. However, the Court does not rely solely on this conclusion to bar PersonalWeb’s
2 claims. Even if the Court found no privity between Amazon and its customers with respect to
3 claim preclusion, the *Kessler* doctrine would fill the gap and thus preclude PersonalWeb’s claims.
4 As discussed further below, the *Kessler* doctrine developed specifically to address customer-
5 manufacturer relationships.

6 There is no question that the Amazon DJ Action involves the identical parties as the Texas
7 Action. As to the customer cases, Amazon argues that the defendants are in privity with Amazon
8 (1) because their interests as customers are identical to Amazon’s own interests in the use of S3,
9 and (2) because Amazon is indemnifying the customer-defendants in the instant actions. Mot. at 8-
10 9.

11 In the Ninth Circuit, “privity may exist . . . when there is sufficient commonality of
12 interest” between the parties. *Tahoe-Sierra Pres. Council, Inc. v. Tahoe Reg’l Planning Agency*,
13 322 F.3d 1064, 1081 (9th Cir. 2003) (internal quotation and citation omitted). Specifically, the
14 Ninth Circuit has concluded that privity exists when the interests of the party in the subsequent
15 action were shared with and adequately represented by the party in the former action. *See Shaw v.*
16 *Hahn*, 56 F.3d 1128, 1131-32 (9th Cir. 1995). Moreover, a “lesser degree of privity is required for
17 a new defendant to benefit from claim preclusion than for a plaintiff to bind a new defendant in a
18 later action.” *Mars Inc. v. Nippon Conlux Kabushiki-Kaisha*, 58 F.3d 616, 619 (Fed. Cir. 1995).

19 As to whether the technology provider-customer relationship creates privity, Amazon
20 relies primarily on another case from this district, *Adaptix, Inc. v. Amazon.com, Inc.*, No. 14-cv-
21 01379-PSG, 2015 WL 4999944 (N.D. Cal. Aug. 21, 2015). There, the court concluded that privity
22 existed between the manufacturers of 4G LTE-compatible devices and the manufacturers’
23 customers because the patent-holder “was fully aware that customers like the John Does existed
24 [and] were in possession of the allegedly infringing devices . . . yet failed to bring claims against
25 them [in the earlier litigation].” *Id.* at *6. In response, PersonalWeb cites Federal Circuit dicta and
26 a federal practice treatise for the general propositions that a manufacturer “typically is not in
27 privity with a [customer],” and unrelated parties “ordinarily do not have authority to bind each
28 other by litigation with third parties.” *Transclean Corp. v. Jiffy Lube Int’l, Inc.*, 474 F.3d 1298,

1 1306 (Fed. Cir. 2007); 18 Wright et al., Federal Practice & Procedure § 4460 (3d ed. 2018). These
2 authorities state only general propositions that are entirely consistent with this Court’s analysis.
3 *Transclean Corp.* recognizes that privity exists between a manufacturer and customer “when the
4 parties are so closely related and their interests are so nearly identical that it is fair to treat them as
5 the same parties for purposes of determining the preclusive effect of the first judgment.” 474 F.3d
6 at 1306 (internal quotations and citation omitted).

7 The Court agrees with Amazon that the defendants in the customer cases are in privity with
8 Amazon because they share the same interest in the unfettered use of Amazon’s web services, and
9 Amazon adequately represented this interest in the Texas Action. *See Shaw*, 56 F.3d at 1131-32
10 (privity exists when the interests of the party in the subsequent action were shared with and
11 adequately represented by the party in the former action); *see also Mars Inc.*, 58 F.3d at 619 (a
12 “lesser degree of privity is required for a new defendant to benefit from claim preclusion than for a
13 plaintiff to bind a new defendant in a later action.”); *Adaptix*, 2015 WL 4999944, at *6 (customers
14 are in privity with manufacturer for purposes of determining preclusive effect of previous non-
15 infringement judgment against manufacturer). None of PersonalWeb’s arguments displace the fact
16 that in the instant MDL, PersonalWeb sues Amazon’s customers for infringement of the same
17 patents related to use of the same technology as PersonalWeb sued Amazon for in the Texas
18 Action. Moreover, PersonalWeb’s indirect infringement accusations against “Amazon’s end-user
19 customers and defendants” in the Texas Action further support the conclusion that Amazon and its
20 customers share the same interest in the use of S3.

21 As to the effect of the indemnification agreement, it is undisputed that: (1) Amazon’s
22 customer agreement has contained an indemnification provision since June 2017, prior to the date
23 that PersonalWeb filed any of the complaints in the cases comprising this MDL; (2) sometime
24 following PersonalWeb’s filing of complaints in the customer cases, Amazon agreed to indemnify
25 its customers; and (3) during the alleged infringement period in this case (January 2012 through
26 December 2016, *Opp.* at 10), Amazon’s customer agreement did not include the indemnification
27 provision.

28 In support of its argument that privity flows from the indemnity agreement, Amazon cites a

1 case from the Northern District of California with similar facts. *See SpeedTrack, Inc. v. Cjffice*
2 *Depot, Inc.*, 2014 WL 1813292 (N.D. Cal. May 6, 2014), *aff'd*, 791 F.3d 1317 (Fed. Cir. 2015). In
3 *SpeedTrack*, the court found that the defendant-customers were in privity with the supplier of
4 software for managing defendants' websites, and thus the customer-defendants could assert *res*
5 *judicata* defensively against SpeedTrack based on the software supplier's previous non-
6 infringement judgment. *Id.* at *6. The court explained that "[b]ecause [the software supplier] is
7 contractually obligated to indemnify defendants for any losses stemming from a finding of
8 infringement, the court finds that the parties are in privity." *Id.* The court reasoned that express
9 limitations in the indemnification agreement, including language stating that "[neither] party is the
10 agent or representative of the other party," merely defined the limits of the indemnification
11 agreement and did not defeat the preclusive effect of the indemnification agreement. *Id.* (emphasis
12 omitted).

13 For its part, PersonalWeb does not dispute that an indemnification agreement can create
14 privity. Rather, PersonalWeb argues that the indemnification agreement in this case is insufficient
15 to create privity because prior to June 2017 Amazon was not contractually obligated to indemnify
16 its customers for infringement, and the agreement does not apply to claims "arising from
17 infringement by combinations of [Amazon's services], with any other product, service, software,
18 data, content or method." *Opp.* at 9-10. In addition, PersonalWeb argues that privity is improper
19 because Amazon's customer agreement states that "neither party . . . is an agent of the other for
20 any purpose or has the authority to bind the other." *Opp.* at 8. PersonalWeb fails to cite any
21 authority in support of its arguments regarding a lack of preclusive effect flowing from the
22 indemnification agreement.

23 On the specific facts before it, the Court finds that the indemnification agreement provides
24 an additional basis to find that there is privity between Amazon and its customers for the specific
25 "purpose[] of determining the preclusive effect of the first judgment." *Transclean Corp.*, 474 F.3d
26 at 1306. As the court in *SpeedTrack* explained, PersonalWeb's objections regarding the scope of
27 the indemnification agreement "merely set[] an outer limit on the relationship between [Amazon]
28 and defendants." 2014 WL 1813292, at *6. It is undisputed that Amazon's customer agreement

1 included an indemnification provision prior to PersonalWeb’s filing of any of the customer cases,
2 and that Amazon expressly assumed the defense of its customers sometime between when
3 PersonalWeb filed complaints in the customer cases and when Amazon filed its First Amended
4 Complaint in the DJ Action. Thus, Amazon assumed the indemnification of its customers prior to
5 the consolidation of the MDL, and Amazon has not turned away any customer who has asked for
6 indemnification.

7 3. Same Cause of Action

8 Federal circuit law applies to the question of whether two actions for patent infringement
9 constitute the same cause of action. *See Brain Life, LLC*, 746 F.3d at 1052. The Federal Circuit
10 considers two factors to determine whether the same cause of action is present for claim
11 preclusion purposes: (1) “whether the same patents are involved in both suits” and (2) whether
12 “the products or processes are essentially the same” in both suits. *Serju Pharm. Co. v. Apotex*
13 *Inc.*, 746 F.3d 1344, 1349 (Fed. Cir. 2014) (emphasis omitted). “Accused devices are essentially
14 the same where the differences between them are . . . unrelated to the limitations in the claim of
15 the patent.” *Acumed LLC v. Stryker Corp.*, 525 F.3d 1319, 1324 (Fed. Cir. 2008) (internal
16 quotations and citation omitted).

17 As to the first factor, PersonalWeb asserted infringement of the ‘791, ‘442, ‘310, and ‘544
18 patents in the Eastern District of Texas Action. PersonalWeb did not previously assert
19 infringement of the ‘420 patent. In its briefing, Amazon argues that the ‘420 patent “makes no
20 difference as a matter of law” because it is a “continuation of the twice-asserted ‘442 patent,
21 claims priority to the same patent application as [the other patents-in-suit], shares the same
22 specification with the other [patents-in-suit], and is limited by a terminal disclaimer.” Mot. at 4. At
23 the hearing, counsel for PersonalWeb stated on the record that PersonalWeb does not contest that
24 the ‘420 patent alleges the same claims at issue in the Texas Action. Trans., ECF No. 376 at 75.
25 Accordingly, the Court finds that for purposes of claim preclusion, the scope of the ‘420 patent is
26 essentially the same as the previously asserted ‘442 patent. *See SimpleAir, Inc. v. Google LLC*,
27 884 F.3d 1160, 1167 (Fed. Cir. 2018) (“[W]here different patents are asserted in a first and second
28 suit, a judgment in the first suit will trigger claim preclusion only if the scope of the asserted

1 patent claims in the two suits is essentially the same.”).

2 As to the second factor, it is undisputed that the infringement contentions in Category 3
3 involve the use of Amazon S3, the same product in dispute in the Texas Action. However, the
4 parties dispute (1) the scope of the contentions in the previous litigation and (2) whether claim
5 preclusion applies to different features of the same product.

6 **a. Scope of the Contentions in the Previous Litigation**

7 PersonalWeb argues that claim preclusion does not apply because “[t]he Texas
8 infringement contentions were very specific to the MPU features of S3, not to S3 in general.” Opp.
9 at 11. In particular, PersonalWeb argues that the conditional HTTP GET request used in the cache
10 control feature central to the instant MDL is not used in MPU. Opp. at 5. Amazon argues that the
11 complaint in the Texas Action involved the entire S3 product. Reply at 4. Moreover, Amazon
12 argues that PersonalWeb’s infringement contentions in the Texas Action included the same use of
13 GET and ETags that it accuses in the instant litigation, and that PersonalWeb sought discovery
14 related to these commands in the Texas Action. Mot. at 13.

15 PersonalWeb’s argument regarding the scope of the Texas Action is not persuasive. The
16 complaint in the Texas Action alleged that Amazon infringed “by its manufacture, use, sale,
17 importation and/or offer for sale of . . . Amazon Simple Storage Service.” Texas Compl., ECF No.
18 315-2 ¶ 28. The complaint does not discuss any specific features of S3, does not include the words
19 “upload” or “download” anywhere, and does not limit PersonalWeb’s allegations to any specific
20 features of S3. This evidence alone is sufficient for this Court to conclude that the allegations in
21 the Texas Action involved all of S3, not just a particular feature. *See Mars Inc.*, 58 F.3d at 619-20
22 (looking to the prior complaint to determine whether two cases related to the same set of
23 transactions for purposes of claim preclusion).

24 Moreover, PersonalWeb’s enumerated patent claims in the Texas Action included claims
25 directed to downloading. ECF No. 340-2 at 1. PersonalWeb also made discovery requests in the
26 Texas Action including the use of GET operations related to downloading. ECF No. 350-6
27 (discovery request related to “conditional matching GET Object operation, using an eTag, such as
28 “If-Match” and “If-None-Match.”); ECF No. 350-7 at 90:19-23, 91:5-8 (deposition testimony on

1 conditional GET commands). The Court finds that this evidence supports Amazon’s argument that
2 the Texas Action included the specific functionality accused in the instant case.

3 At the hearing, PersonalWeb offered two arguments to get around this evidence. First,
4 PersonalWeb argued that there are disputed issues of material fact as to whether the infringement
5 contentions in the Texas Action included use of the HTTP GET command. Trans., ECF No. 376 at
6 51. PersonalWeb cited the declaration of Mr. Hadley, who stated that the use of “conditional
7 HTTP GET requests containing ETags . . . was not a part of the Texas Action and PersonalWeb
8 made no contention that such uses infringed any PersonalWeb patent.” Hadley Decl., ECF No.
9 337 ¶ 4. Mr. Hadley explained that “[t]he references to conditional HTTP GET requests in the
10 [Texas] Infringement Contentions” were related to showing that conditional HTTP GET requests
11 are analogous to MPU. Hadley Decl., ECF No. 337 ¶ 4.

12 The Court finds that Mr. Hadley’s declaration does not create a genuine dispute of material
13 fact because the declaration is “uncorroborated and self-serving.” *Villiarimo v. Aloha Island Air,*
14 *Inc.*, 281 F.3d 1054, 1061 (9th Cir. 2002). Mr. Hadley’s recollection of the gravamen of the Texas
15 Action does not dispute the plain meaning of the Texas Complaint, infringement contentions, and
16 discovery requests. Viewing the evidence in the light most favorable to PersonalWeb, the evidence
17 shows that the discovery and infringement contentions in the Texas Action primarily involved
18 MPU but also encompassed the HTTP GET (download) command. No reasonable jury could
19 conclude otherwise. *See Scott v. Harris*, 550 U.S. 372, 380 (2007) (“When opposing parties tell
20 two different stories, one of which is blatantly contradicted by the record, so that no reasonable
21 jury could believe it, a court should not adopt that version of the facts for purposes of ruling on a
22 motion for summary judgment.”). Mr. Hadley’s posthoc recollection of his litigation strategy is
23 simply insufficient to place this issue in dispute.

24 Second, PersonalWeb argues that the scope of the Texas Action should be limited to what
25 was included in the infringement contentions, and not the complaint. Trans., ECF No. 376 at 44-
26 45. Even if the Court agreed with PersonalWeb, the Texas infringement contentions included the
27 HTTP GET command, and thus PersonalWeb’s argument fails on its own terms. Moreover, the
28 case that PersonalWeb cites does not support its argument. Contrary to PersonalWeb’s description,

1 *Wowza* involved *d*ifferent versions of the same product. See *Adobe Sys. Inc. v. Wowza Media Sys.,*
2 *LLC*, 72 F. Supp. 3d 989, 995 (N.D. Cal. 2014). During the prior case in *Wowza*, the court struck
3 Adobe’s “RTMP Enhanced” infringement theory because the theory was added to an expert report
4 but was not in the infringement contentions. *Id.* at 991. In the second case, the court held that the
5 RTMP Enhanced theory was not barred by claim preclusion because the “RTMP Enhanced theory
6 [was] asserted against products released after the filing of the infringement contentions in *Wowza*
7 *I.*” *Id.* at 995. Thus, the RTMP Enhanced theory was not barred in *Wowza II* because it related to
8 new products, not as PersonalWeb would have it because the court limited its claim preclusion
9 analysis to the infringement contentions.

10 In sum, the Court finds that both the complaint and the infringement contentions in the
11 Texas Action indisputably support the Court’s conclusion that the Texas Action asserted
12 infringement against all of S3 and was not limited only to MPU.

13 **b. Different Features of the Same Product**

14 Even if the Texas Action involved all of S3, PersonalWeb argues that claim preclusion
15 does not apply because “the accused *features* of S3 here and in the Texas Action were completely
16 different.” *Opp.* at 12. PersonalWeb argues that “MPU is priced separately from the downloading
17 and serving features of S3.” *Opp.* at 13. Amazon argues that “multipart upload is a *feature* of S3,
18 not a separate product, and a feature that uses ETags no less so than single-part upload files.” *Mot.*
19 at 12.

20 As an initial matter, the Court finds that there is no genuine dispute of material fact as to
21 whether multipart upload is a feature of S3, not a separate product. The declaration that
22 PersonalWeb cites explains that S3 customers are charged for each individual transaction
23 involving uploading or downloading objects and for retaining storage. Markle Decl., ECF No.
24 341-11 at 97-99, 101. At most, this evidence shows that Amazon charges individual prices for
25 specific transactions within S3, not that MPU is a separate product.

26 The Court notes that PersonalWeb does not argue that S3 has changed in any way that is
27 meaningful to PersonalWeb’s infringement contentions, and Amazon does not argue that the
28 differences between multipart upload and cache control are “unrelated to the limitations in the

1 claim of the patent.” *Acumed LLC*, 525 F.3d at 1324. Accordingly, the issue before the Court is
2 the legal question of whether claim preclusion applies where the later suit involves different
3 features of the same product as the original suit.

4 Amazon has pointed the Court to a single case involving similar facts. *See ViaTech Techs.,*
5 *Inc. v. Microsoft Corp.*, No. 17-570, 2018 WL 4126522 (D. Del. Aug. 28, 2018). The court there
6 explained:

7 Plaintiff accused Windows alone of directly infringing the ’567 patent in the First
8 Action. Now, reading the Amended Complaint in the manner most favorable to
9 Plaintiff, Plaintiff’s direct infringement claim in the Second Action includes not
10 only Windows, but other items, such as media, as well. Plaintiff has not alleged that
11 adding media changes Windows, nor alleged that Windows has changed since the
12 First Action. Given that Plaintiff previously asserted that Windows infringed the
13 ’567 patent, Plaintiff cannot once again accuse Windows of infringing the ’567
14 patent, but argue that other items, like media, are necessary for infringement.
15 Likewise, Plaintiff cannot repeatedly assert its patent against different parts of
16 Windows in separate suits, even if one accused part is on the left-hand side of
17 Windows and the other is on the right-hand side, so to speak.

18 *Id.* at *3 (internal citations omitted).

19 *ViaTech* is consistent with the doctrine of claim splitting. “It is well established that a party
20 may not split a cause of action into separate grounds of recovery and raise the separate grounds in
21 successive lawsuits.” *Mars Inc.*, 58 F.3d at 619. “A main purpose behind the rule preventing claim
22 splitting is to protect the defendant from being harassed by repetitive actions based on the same
23 claim.” *Clements v. Airport Auth. cf Washoe Cty.*, 69 F.3d 321, 328 (9th Cir. 1995) (internal
24 quotation and citation omitted). In the patent infringement context, the Federal Circuit has
25 explained that “claim preclusion bars both claims that were brought as well as those that *could*
26 *have been brought.*” *Brain Life*, 746 F.3d at 1053 (emphasis in original).

27 PersonalWeb cites *Young Engineers, Inc. v. U.S. Int’l Trade Comm’n.*, 721 F.2d 1205,
28 1316 (Fed. Cir. 1983), which states the unremarkable proposition that “claim preclusion [does not]
apply to conduct of a different nature from that involved in the prior litigation.” PersonalWeb
argues that “[n]one of Amazon’s cases suggest that the commercial packaging of different features
or aspects of accused devices has any bearing whatsoever on whether they are part of the ‘same
transaction’ for claim preclusion purposes.” *Opp.* at 13.

1 PersonalWeb’s argument is unpersuasive. PersonalWeb fails to cite any cases that support
2 its contention that infringement allegations related to different features of the same product give
3 rise to separate causes of action. The Court finds nothing in the relevant Federal Circuit precedent
4 to support PersonalWeb’s argument. *See, e.g., Acumed LLC*, 525 F.3d at 1324 (“[O]ne of the
5 essential transactional facts giving rise to a patent infringement claim is the structure of the *device*
6 or *devices* in issue. . . . Adjudication of infringement is a determination that a *thing* is made, used
7 or sold without authority under the claim(s) of a valid enforceable patent.” (emphasis added)
8 (internal quotations and citations omitted)). The doctrine against claim splitting applies with full
9 force here. Accordingly, the Court concludes that the fact that this suit allegedly involves a
10 different feature of S3 from the Texas Action makes no difference to whether claim preclusion
11 applies.

12 4. Post-Judgment Claims of Infringement

13 Having concluded that claim preclusion applies to the instant case, the Court now turns to
14 Amazon’s argument that claim preclusion applies “through the expiration of the patents.” Mot. at
15 14. As a fallback, Amazon argues that PersonalWeb’s claims are barred at least through the date of
16 final judgment in the Texas Action. Reply at 10. PersonalWeb contends that claim preclusion only
17 applies up to the date of its amended complaint in the Texas Action. Opp. at 15. The Court
18 concludes that claim preclusion bars PersonalWeb’s claims through the date of the final judgment
19 in the Texas Action.

20 Recent Federal Circuit case law is conclusive on this point. In *Mentor Graphics Corp. v.*
21 *EVE-USA, Inc.*, 851 F.3d 1275, 1301 (Fed. Cir. 2017) the court held that “claim preclusion does
22 not bar a patentee from bringing infringement claims for acts of infringement occurring after the
23 final judgment in a previous case.” The court explained that “for products made or sold after the
24 previous actions, it [does] not matter whether the new products [are] essentially the same as the
25 previously accused products. . . . [T]he patentee *could not* have brought those claims in the prior
26 case.” *Id.* at 1299 (internal quotation and citation omitted); *see also Asetek Danmark A/S v. CMI*
27 *USA Inc.*, 852 F.3d 1352, 1365 (Fed. Cir. 2017) (claim preclusion does not apply to post-dismissal
28 conduct, “even if all the conduct is alleged to be unlawful for the same reason”); *Brain Life*, 746

1 F.3d at 1054 (claim preclusion does not bar infringement claims arising from “acts occurring after
2 final judgment was entered in the first suit”).

3 Amazon argues that there is an intra-circuit split within the Federal Circuit as to whether
4 claim preclusion bars infringement claims arising from acts occurring after the date of the first
5 judgment. Mot. at 14. Amazon argues that, until the Federal Circuit resolves the alleged conflict
6 *en banc*, *Nystrom v. Trex Co., Inc.*, 580 F.3d 1281 (Fed. Cir. 2009) is the controlling precedent. In
7 *Nystrom*, the Federal Circuit held that claim preclusion barred the patentee’s suit as to products
8 that “reached the market after the filing date of the original . . . complaint.” *Id.* at 1284. However,
9 the Federal Circuit has since clarified that “[a]lthough the *Nystrom* court characterized its analysis
10 as falling under the general rubric of res judicata or claim preclusion, the principle that the court
11 applied was” that of issue preclusion. *Aspex*, 672 F.3d at 1343. Accordingly, this Court will follow
12 the Federal Circuit’s own interpretation of *Nystrom* as not conflicting with more recent Federal
13 Circuit precedent directing that claim preclusion only applies to acts of infringement that pre-date
14 the first judgment.

15 PersonalWeb argues that claim preclusion can only apply up to the date of the amended
16 complaint in the Texas Action because PersonalWeb was not required to assert any cause of action
17 that it acquired during the pendency of the Texas Action, and that any such cause of action is not
18 barred by claim preclusion. Opp. at 16. PersonalWeb submits that *Gillig*, *Aspex*, and *Dow*
19 *Chemical* support its argument. Opp. at 15; Trans., ECF No. 376 at 38-42. PersonalWeb’s
20 argument that it was not required to assert any *new* cause of action is true as far as it goes, but that
21 does not help PersonalWeb here. As discussed above, this case involves the same cause of action
22 as the Texas Action. The cases that PersonalWeb cites do not say otherwise.

23 *Gillig*, which did not involve patent infringement claims, states that “The *res judicata*
24 doctrine does not apply to new rights acquired during the action which might have been, but which
25 were not, litigated.” *Gillig v. Nike, Inc.*, 602 F.3d 1354, 1363 (Fed. Cir. 2010) (citation omitted).
26 Quoting this language, *Aspex* explains that “[i]n patent cases, this court has applied the general
27 rule that res judicata does not bar the assertion of ‘new rights acquired during the action which
28 might have been, but were not, litigated.’” *Aspex*, 672 F.3d at 1345 (quoting *Gillig*, 602 F.3d at

1 1363). In *Aspex*, the Federal Circuit concluded that claim preclusion does not apply to products
2 that were not in existence at the time of the filing of the prior complaint. *See id.* Unlike *Aspex*, the
3 instant case does not involve new products that were not in existence at the time of the filing of the
4 prior complaint. Moreover, *Aspex* explicitly held that claim preclusion could apply to new
5 products introduced between the filing of the complaint and the judgment in the previous case, if
6 the patentee elected to have those products included in the previous action. *See id.* Thus, *Aspex*
7 and *Gillig* do not support the conclusion that claim preclusion only applies up to the date of the
8 complaint in the prior action.

9 At the hearing, PersonalWeb specifically directed the Court to the holding in *Dow*
10 *Chemical*, Trans., ECF No. 376 at 39, a case it had cited only once in a string cite in its papers,
11 Opp. at 17. In *Dow Chemical*, the Federal Circuit reiterated that “traditional notions of claim
12 preclusion do not apply when a patentee accuses new acts of infringement, i.e., *post-final*
13 *judgment*, in a second suit.” *Dow Chem. Co. v. Nova Chems. Corp.*, 803 F.3d 620, 627 (quoting
14 *Brain Life*, 746 F.3d at 1056) (emphasis added). In the language quoted by counsel for
15 PersonalWeb, the *Dow Chemical* court applied the general rule on claim preclusion to the specific
16 facts of that case to explain why claim preclusion did not apply from a previous judgment to a
17 period of supplemental damages. *Id.* (“Here, the bulk of the supplemental damages accrued after
18 the [previous judgment], and it is clear that claim preclusion also does not apply to damages
19 accruing after the filing of the complaint and not the subject of the first judgment.”). *Aspex* and
20 *Dow Chemical* are both consistent with Federal Circuit precedent instructing that claim preclusion
21 in patent infringement cases applies up to the date of the judgment in the previous case, at least
22 when the same product is involved in both cases.

23 **5. Summary**

24 For the reasons discussed above, the Court finds that claim preclusion applies because the
25 Texas Action ended in a final judgment, involved the same parties or privies, and involved the
26 same cause of action. Claim preclusion applies to PersonalWeb’s claims up to the date of the final
27 judgment in the Texas Action.

28 **C. Kessler Doctrine**

1 Amazon contends that the *Kessler* doctrine bars all of PersonalWeb’s S3 claims,
2 “including claims against Amazon customers for conduct occurring after the date of the Texas
3 judgment.” Mot. at 15. Amazon argues that the dismissal with prejudice in the Texas Action
4 “created a trade right [under *Kessler*] that conferred upon Amazon and its customers the status of
5 non-infringers and upon S3 the status of a non-infringing product.” Mot. at 17. PersonalWeb
6 argues that *Kessler* is “rooted in . . . issue preclusion,” and accordingly requires that the question
7 of infringement was actually litigated in the prior case. Trans., ECF No. 376 at 65; Opp. at 19.
8 Under issue preclusion rules, PersonalWeb argues that the dismissal with prejudice in the previous
9 case is insufficient to trigger preclusion under the *Kessler* doctrine. *Id.* In addition, PersonalWeb
10 argues that *Kessler* does not apply to the cache-busting feature of S3 because that feature has
11 never been “held to be non-infringing by any court.” Opp. at 20. For the reasons discussed below,
12 the Court finds that the *Kessler* doctrine bars PersonalWeb’s post-judgment infringement claims
13 against Amazon and its customers related to use of S3.²

14 In *Kessler v. Eldred*, 206 U.S. 285, 288 (1907), the Supreme Court held that a prior non-
15 infringement judgment conferred upon the manufacturer “the right to manufacture, use, and sell”
16 the adjudged non-infringing product. Accordingly, the Court concluded that “it is *Kessler*’s right
17 that those customers should, in respect of the articles before the court in the previous judgment, be
18 let alone by [the patentee].” *Id.* at 289. The Federal Circuit has recently affirmed the continued
19 vitality of the *Kessler* doctrine, explaining that “the Court granted *Kessler* a limited trade right to
20 continue producing, using, and selling the [adjudged non-infringing product] . . . even when the
21 acts of infringement occurred post-final judgment and even when it was third parties who
22 allegedly engaged in those acts of infringement.” *Brain Life*, 746 F.3d at 1056. The Federal Circuit
23 explained that “[t]he *Kessler* doctrine fills the gap between [claim preclusion and issue preclusion]
24 doctrines.” *Id.*

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² At the hearing, Amazon acknowledged that they have not seen a case specifically addressing whether *Kessler* applies to claims arising prior to the final judgment in the previous case. Trans., ECF No. 376 at 71. Because this Court concludes that claim preclusion bars PersonalWeb’s claims against both Amazon and its customers prior to the previous judgment, this Court does not need to consider whether *Kessler* also applies to that time period.

1 The Court finds persuasive the only case that the parties have identified that squarely
2 addresses the applicability of *Kessler* based on a prior dismissal with prejudice. In *Molinaro v.*
3 *Am. Tel & Tel. Co.*, 460 F. Supp. 673, 675 (E.D. Penn. 1978), the previous suit was dismissed with
4 prejudice as a sanction for failure to comply with discovery orders. The *Molinaro* court explained
5 that the “analysis of the applicability of the *Kessler* doctrine is not altered by the fact that the
6 infringement question in the instant case was not actually litigated in the [prior] suit.” *Id.* at 676.
7 *Molinaro* is consistent with Federal Circuit precedent, which explains that the *Kessler* doctrine
8 applies to claims that “could have been brought”—and were necessary not adjudicated—in the
9 prior action. *See Brain Life*, 746 F.3d at 1059 (method claims were not actually litigated in the
10 prior action and thus were not barred by issue preclusion but were barred by *Kessler*).

11 PersonalWeb seeks to distinguish *Molinaro* on two grounds, neither of which is
12 persuasive. First, PersonalWeb fails to explain how the fact that *Molinaro* was based on a
13 dismissal entered as a sanction for failure to comply with discovery orders makes any difference to
14 the preclusive effect of the dismissal. *Opp.* at 19. At the hearing, PersonalWeb argued that a
15 judicial sanction of dismissal should be treated differently than the parties’ voluntary stipulation to
16 dismiss the case because of the punitive aspect of the sanction. *Trans.*, ECF No. 376 at 62-63.
17 Other than the emotional appeal of that distinction, PersonalWeb points to no authority or
18 anything rooted in the *Kessler* doctrine to support its argument.

19 Second, PersonalWeb’s characterization of *Molinaro* as “a non-controlling 50 year-old
20 district court case,” *Opp.* at 19, is inconsistent with the Federal Circuit’s 2015 opinion citing
21 *Molinaro* approvingly. *See Speedtrack, Inc. v. C, J, fice Depot, Inc.*, 791 F.3d 1317, 1326 (2015).
22 Although *Speedtrack* cited *Molinaro* for the specific proposition that a customer could invoke the
23 *Kessler* doctrine, nothing in *Speedtrack* suggested that the Federal Circuit disagreed with
24 *Molinaro* as to the preclusive effect of a dismissal with prejudice.

25 In its briefing and at the hearing, PersonalWeb cited numerous additional cases that it
26 argues require actual adjudication of noninfringement in order for *Kessler* to apply. *Trans.*, ECF
27 No. 376 at 68; *Opp.* at 19. As discussed above, neither *Brain Life* nor *Speedtrack* supports
28 PersonalWeb’s argument. In *MGA, Inc. v. General Motors Corp.*, 827 F.2d 729, 734 (Fed. Cir.

1 1987), the Federal Circuit applied *Kessler* as the equivalent of nonmutual defensive issue
2 preclusion. However, nothing in *MGA* limits *Kessler* to the issue preclusion context, and *Brain*
3 *Life* cites *MGA* approvingly for its discussion of *Kessler*. See *Brain Life*, 746 F.3d at 1056-57.
4 None of the additional cases that PersonalWeb cites support PersonalWeb’s argument that *Kessler*
5 requires actual adjudication of non-infringement. See *Mentor Graphics*, 851 F.3d at 1301 (*Kessler*
6 does not apply when previous case ended with grant of a license to the alleged infringer); *Foster v.*
7 *Hallco Mfg. Co., Inc.*, 947 F.2d 469, 479-80 (Fed. Cir. 1991) (addressing requirements for claim
8 preclusion); *Wowza*, 72 F. Supp. 3d at 996 (concluding that *Kessler* did not apply where earlier
9 case was still pending at time that second case was file).

10 As to PersonalWeb’s attempt to limit *Kessler* to the MPU feature of S3, the Court finds the
11 *Brain Life* opinion instructive. In the first suit, Brain Life dismissed without prejudice their
12 method claims and pursued only their apparatus claims. The Federal Circuit reasoned that the
13 products in question “have acquired the status of noninfringing products as to the [relevant]
14 patent,” and accordingly “all claims that were brought or could have been brought in the first suit”
15 were barred under *Kessler* in the second suit. *Brain Life*, 746 F.3d at 1058-59. PersonalWeb fails
16 to identify any authority suggesting that the question of whether this case involves the same
17 product as the prior case should be any different under *Kessler* than under claim preclusion.
18 Accordingly, this Court concludes that the *Kessler* doctrine bars PersonalWeb’s current suit as to
19 both Amazon and its customers for all claims related to use of S3 after the prior final judgment.

20 **IV. ORDER**

21 For the foregoing reasons, IT IS HEREBY ORDERED that:

- 22 1. Amazon’s motion for summary judgment is GRANTED with respect to Amazon’s DJ
23 Action and PersonalWeb’s counterclaim against Amazon. Amazon’s motion is GRANTED
24 with respect to the Category 3 allegations involving use of Amazon Simple Storage
25 Service (“S3”) in the *Twitch* case.
- 26 2. PersonalWeb is barred by claim preclusion from asserting any claim of infringement in any
27 case based on use or operation of S3 and is barred from asserting any patent infringement
28 claim against Amazon or an Amazon customer in which a feature or operation of S3 is

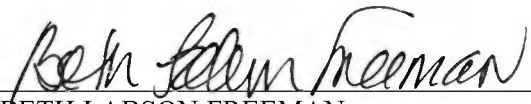
United States District Court
Northern District of California

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alleged to infringe any claim of U.S. Patent Nos. 5,978,791, 6,928,442, 7,802,310, 7,945,544, and 8,099,420 (the “patents-in-suit”), up to the date of the final judgment in the Texas Action.

- 3. PersonalWeb is barred, under the *Kessler* doctrine, from asserting any claim of infringement in any case based on use or operation of S3 and is barred from asserting any patent infringement claim against Amazon or an Amazon customer in which a feature or operation of S3 is alleged to infringe any claim of the patents-in-suit.
- 4. Amazon’s motion for summary judgment related to CloudFront is DENIED WITHOUT PREJUDICE. Amazon is free to challenge the inclusion of CloudFront in a separate motion. If Amazon files such a motion, the Court will expect Level 3 to either join in PersonalWeb’s opposition or to file a separate opposition.
- 5. Amazon’s requested relief to preclude assertion that S3 meets any limitation of any claim of the patents-in-suit is DENIED as beyond the scope of the motion.
- 6. The Parties shall advise the Court as to which customer cases are fully adjudicated by this Order, and which claims of the remaining cases are fully adjudicated regarding accused S3 no later than April 3, 2019.

Dated: March 13, 2019


 BETH LABSON FREEMAN
 United States District Judge