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10 UNITED STATES DISTRICT COURT  
 11 NORTHERN DISTRICT OF CALIFORNIA

13 APPLE COMPUTER, INC.,  
 14 Plaintiff,  
 15 v.  
 16 BURST.COM, INC.,  
 17 Defendant.

Case No. C 06-0019 MHP

**APPLE COMPUTER, INC.’S MOTION  
 FOR SUMMARY JUDGMENT OF  
 NONINFRINGEMENT BASED ON THE  
 “STORED TIME COMPRESSED  
 REPRESENTATION” LIMITATION**

Date: February 8, 2007  
 Time: 9:00 a.m.  
 Hon. Marilyn Hall Patel

Complaint Filed: January 4, 2006  
 Trial Date: February 26, 2008

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## I.

## INTRODUCTION

1  
2  
3 If the Court adopts Apple’s claim construction argument that time compression  
4 should be given its ordinary meaning of compressing information in time (for example, by  
5 playing a song or video faster than it was recorded) then Apple cannot infringe the Burst patents.<sup>1</sup>  
6 Therefore, if the Court adopts Apple’s construction, Apple is entitled to summary judgment of  
7 noninfringement of all claims in suit.<sup>2</sup>

8 Apple does not practice the limitation of “storing said time compressed  
9 representation” found in all asserted claims, because the representations stored by Apple’s  
10 products are not “time-compressed representations,” and they do not have the “associated burst  
11 time period” the claims require of the “time compressed representation.” The song and video  
12 files stored in the accused iPod, iTunes, and iTunes Store products are either uncompressed files,  
13 in formats such as “AIFF,” or more typically, data compressed files, in formats such as “MP3” or  
14 “AAC” for songs, and “MPEG-4” for video. These files are simply ordinary data files, stored on  
15 the hard drive like any other file. While MP3, AAC, and MPEG-4 files are compressed to require  
16 less storage space (data compressed), they are not “time compressed representations having an  
17 associated burst time period” as required by the claims. They are not compressed in *time* in any  
18 way while they are stored. Nothing about their time scale has been altered from real time.  
19 Moreover, these files have only one time period associated with them—their playback time.  
20 Even Burst’s own expert conceded this, acknowledging that “by compressing [a] file to MP3 you  
21 aren’t changing the time period associated with it.”<sup>3</sup> A file cannot be a “time compressed

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22  
23 <sup>1</sup> Burst argues that time compression refers to compressing information in space, i.e. data  
24 compression. However, Burst expressly stated to the Patent Office that “data compression” is  
25 “not the equivalent, by any means, of applicant’s specifically claimed time compression.” See  
26 Apple’s Claim Construction Brief at 8-15.

27 <sup>2</sup> Under Apple’s proposed claim construction, Apple does not practice any of the many claim  
28 limitations that require time compression, but for simplicity moves for summary judgment based  
on the “storing said time compressed representation” limitation, because that limitation appears in  
every asserted independent claim. See Brown CC Decl. Exh. A [‘995 patent] claims 1 and 17;  
Brown CC Decl. Exh. AA [‘839 patent] claims 1, 17, 73, 76, 77, Brown CC Decl. Exh. O [‘932  
patent] claim 4; Brown CC Decl. Exh. L [‘705 patent] claims 1, 12, 21.

<sup>3</sup> Brown CC Decl. Exh. C [Hemami Depo.] at 298:6-18.

1 representation . . . having an associated burst time period” when it is not compressed in time, and  
2 its only associated time period is its real-time playback time.

## 3 II.

### 4 LEGAL BACKGROUND

5 The summary judgment procedure is “designed to secure the just, speedy and  
6 inexpensive determination of every action.”<sup>4</sup> Summary judgment is appropriate when no  
7 “reasonable jury could return a verdict for the nonmoving party.”<sup>5</sup> Here, because Apple does not  
8 bear the ultimate burden of proof on the issue of infringement, it can prevail simply by “pointing  
9 out to the district court that there is an absence of evidence to support the nonmoving party’s  
10 case.”<sup>6</sup> In such circumstances, there is no genuine issue as to any material fact, “since a complete  
11 failure of proof concerning an essential element of the nonmoving party’s case necessarily  
12 renders all other facts immaterial.”<sup>7</sup>

13 The Court’s “construction of the claims often decides the question of infringement,  
14 whether literal or under the doctrine of equivalents.”<sup>8</sup> After the disputed claims are construed, the  
15 Court determines “whether the accused product or process contains each limitation of the  
16 properly construed claims, either literally or by a substantial equivalent.”<sup>9</sup> Literal infringement  
17 occurs only “when every limitation recited in the claim appears in the accused device, i.e., when  
18 the properly construed claim reads on the accused device exactly.”<sup>10</sup> As a matter of law, an  
19 accused product cannot infringe if even a single claim limitation is not satisfied either literally or  
20 by an equivalent.<sup>11</sup>

21 <sup>4</sup> *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986) (internal quotations omitted).

22 <sup>5</sup> *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986); *Freedman Seating Co. v. American*  
23 *Seating Co.*, 420 F.3d 1350, 1356 (Fed. Cir. 2005).

24 <sup>6</sup> *Celotex*, 477 U.S. at 325; *Novartis Corp. v. Ben Venue*, 271 F.3d 1043 (Fed. Cir. 2001).

25 <sup>7</sup> *Celotex*, 477 U.S. at 323.

26 <sup>8</sup> *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1350 (Fed. Cir. 2001).

27 <sup>9</sup> *Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1357 (Fed. Cir. 2005).

28 <sup>10</sup> *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1331 (Fed. Cir. 2001) (internal citation  
omitted).

<sup>11</sup> *Freedman Seating*, 420 F.3d at 1358 (citing *Warner-Jenkinson Co. v. Hilton Davis Chemical*,  
520 U.S. 17, 29 (1997)).

1 III.

2 **APPLE'S IPOD AND ITUNES PRODUCTS DO NOT INFRINGE BECAUSE THEY DO**  
 3 **NOT STORE TIME COMPRESSED REPRESENTATIONS**

4 **A. Each of the asserted claims requires storing a time compressed representation**  
 5 **of a song or video.**

6 As discussed in Apple's claim construction brief, the asserted claims of the Burst  
 7 patents claim methods and apparatuses for handling audio/video source information, where the  
 8 end result is transmitting a "time-compressed representation" of the source information faster  
 9 than its "real-time" playback time. The independent claims asserted by Burst in this case are  
 10 claims 1 and 17 of the '995 patent, claims 1, 17, 73, 76, and 77 of the '839 patent, claim 4 of the  
 11 '932 patent, and claims 1, 12, and 21 of the '705 patent.<sup>12</sup>

12 Claim 1 of the '839 patent is set forth below:

13 **1. A method for handling audio/video source infor-**  
 14 **mation, the method comprising:**

15 **receiving audio/video source information;**  
 16 **compressing the received audio/video source infor-**  
 17 **mation into a time compressed representation**  
 18 **thereof having an associated burst time period that**  
 19 **is shorter than a time period associated with a real**  
 20 **time representation of the received audio/video**  
 21 **source information;**  
 22 **storing said time compressed representation of the**  
 23 **received audio/video source information; and**  
 24 **transmitting, in said burst time period, the stored time**  
 25 **compressed representation of the received audi-**  
 26 **o/video source information to a selected destina-**  
 27 **tion.**

28 Most of the asserted independent claims, like claim 1 of the '839 patent, require  
 receiving "audio/video source information" and then compressing it "into a time compressed  
 representation having an associated [burst] time period." All of the other asserted independent  
 claims require receiving an already "time compressed representation" in "an associated burst time  
 period."<sup>13</sup> Whether they require receiving and time-compressing, or receiving time-compressed,

<sup>12</sup> Brown CC Decl., Exh. B [Burst's Preliminary Infringement Contentions].

<sup>13</sup> See Brown CC Decl. Exh. A ['995 patent] claims 1 and 17; Brown CC Decl. Exh. AA ['839  
 patent] claims 1, 17, 73, 76, 77, Brown CC Decl. Exh. O ['932 patent] claim 4; Brown CC Decl.  
 Exh. L ['705 patent] claims 1, 12, 21.

1 all of the asserted independent claims require “storing *said* time compressed representation” or  
2 “storing *the* time compressed representation.” Thus, each claim requires storing the “time  
3 compressed representation having an associated [burst] time period” that was created (or  
4 received) in the previous step.<sup>14</sup> This motion is based on this “storing said time compressed  
5 representation” limitation.<sup>15</sup>

6 **B. Apple’s products store songs or videos on hard drives, or in the flash memory**  
7 **of the iPod Nano and iPod Shuffle.**

8 Burst’s infringement contentions against the iPod, iTunes, and iTunes Store  
9 products allege that the “storing said time compressed representation” limitation is satisfied by  
10 the fact that these products store media files on hard drives or in the flash memory of the iPod  
11 Nano and iPod Shuffle.<sup>16</sup> Burst’s contentions fail because the media files stored by Apple’s  
12 products are not “time compressed representations” and because they do not have “associated  
13 burst time periods.”

14 **1. iTunes.**

15 iTunes is a computer program for organizing and playing media files, particularly  
16 music, TV shows, or movies, but also “podcasts” and audiobooks. It can be thought of as a  
17 virtual jukebox, though it provides more functionality than a jukebox. The media files that  
18 iTunes organizes and plays can be obtained from a variety of sources. Often, music is “ripped”  
19 from a CD and then encoded (data compressed) so it will occupy less space in storage. Music and  
20 video can also be purchased from Apple’s online iTunes Store, which is accessed through the  
21 iTunes software. Music and video purchased from the iTunes Store is downloaded to the

22 \_\_\_\_\_  
23 <sup>14</sup> *Id.*

24 <sup>15</sup> Apple and Burst agree that the claimed “time compressed representation” must be a  
25 representation of an audio or video “work,” such as a song, movie, or television program. *See*  
26 Apple’s Claim Construction Brief at 39; Burst Opening Claim Construction Brief at 37.

27 <sup>16</sup> *See e.g.*, Brown CC Decl. Exh. B [Burst’s Preliminary Infringement Contentions] at Exh. A p.1  
28 (“iPod Device stores the time compressed representation on its flash drive (iPod Shuffle and iPod  
Nano) and/or hard drive (other iPod models)”; *id.* at Exh. B p.2 (“Hard drive and/or other system  
memory in Apple Computer or Windows Computer with iTunes software installed (which stores  
the time compressed representation)”; *id.* at Exh. C p.1 (“Hard drive and/or other system  
memory in computer executing software used by the iTunes Music Store (which stores the time  
compressed representation)”).



1 customer's computer by iTunes. Media files in iTunes can be organized, played, transferred to an  
2 iPod, or "burned" onto another CD. iTunes stores a user's media files on a mass storage device,  
3 which is almost always the hard drive of the computer running iTunes.<sup>17</sup>

## 4 **2. iPod.**

5 The iPod is a portable music/video player with an intuitive user interface that has a  
6 characteristic circular touchpad for scrolling through lists of songs, playlists, etc. A large number  
7 of music files—often a user's entire music collection—can be stored on an iPod. This is allowed  
8 both by data compression of the media files, i.e. by encoding them into MP3 or AAC format, and  
9 by the large amount of mass storage an iPod contains in the form of either a hard drive, in the  
10 case of most iPods, or flash memory, in the case of the iPod Nano and the iPod Shuffle. Both the  
11 iPods that use an actual hard drive and those that use flash memory present themselves "like a  
12 hard drive to the host computer."<sup>18</sup> The hard drive or flash memory of the iPod is the place where  
13 songs or videos are stored.<sup>19</sup>

## 14 **3. iTunes Store.**

15 As mentioned above, Apple's online iTunes Store is accessed through the iTunes  
16 software. Music and video purchases from the iTunes Store are downloaded to the customer's  
17 computer by iTunes. The media files sold by the iTunes Store are encoded with an AAC codec  
18 (for audio) and an H.264 codec (for video). Both of these types of files are contained in a file in  
19 the MPEG-4 format.<sup>20</sup>

20 Apple receives media to be sold in the iTunes Store either by physical delivery of a  
21 mass storage device, such as a hard drive, or by transferring them across a network, typically as a

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22 <sup>17</sup> Kalay Decl. Exh. 1 [Robbin Depo.] at 285:13-25 (explaining that "iTunes stores content" in  
23 files that "reside on the hard drive of the computer"); *id.* at 228:3-229:5 (same); *id.* at 59-61  
24 (explaining that as iTunes downloads songs onto the hard drive, system memory is only used as a  
buffer); *id.* at 113:21-114:25 (during playback, iTunes keeps only a portion of a song in memory).

25 <sup>18</sup> *Id.* at 190:8-13.

26 <sup>19</sup> Brown CC Decl. Exh. B [Burst's Preliminary Infringement Contentions] at Exh. A ('995  
27 patent) p.1 ("Flash drive (iPod Shuffle and iPod Nano); and/or Hard drive (iPod models  
other than Shuffle and Nano) (which stores the time compressed representation."); *id.* at  
28 Exh. A ('839 patent) p.1; *see also id.* at Exh. A p.2 ("iPod Device stores the time compressed  
digital representation on its hard drive."); *id.* at Exh. A ('705 patent) p.1.

<sup>20</sup> Kalay Decl. Exh. 1 [Robbin Depo.] at 47:13-17.

1 type of FTP download.<sup>21</sup> Audio is normally received already data compressed into “AAC”  
 2 format.<sup>22</sup> Videos for the iTunes Store are typically received in the MPEG-2 format.<sup>23</sup> Those files  
 3 are then further data compressed into a uniform MPEG-4 format using H.264 data compression.<sup>24</sup>  
 4 The media files offered for sale by the iTunes Store are stored as files on hard drives in a master  
 5 asset repository.<sup>25</sup> Copies of the audio and video files are also stored on hard drives in server  
 6 computers controlled by a third party, Akamai, who actually provides the media files to  
 7 customers.<sup>26</sup> The downloaded media file is stored on the user’s hard drive for use with iTunes.<sup>27</sup>

8 **C. The media files stored by Apple’s products are not the “time compressed**  
 9 **representations” required by the claims.**

10 Apple’s accused products do not use “time compressed representations.” The  
 11 media files stored by Apple’s iPod, iTunes and iTunes Store products are typically data  
 12 compressed files, in formats such as “MP3” or “AAC” for songs, and “MPEG-4” for video,  
 13 though songs can also be stored in uncompressed formats.<sup>28</sup> These media files are simply  
 14 ordinary data files, stored on a hard drive (or in flash memory) like any other file.<sup>29</sup> These files  
 15 are typically data-compressed.<sup>30</sup> But they are not “time compressed representations having an  
 16 associated burst time period” as required by the claims, because they are not compressed in *time*  
 17 in any way while they are stored. Nothing about their time scale has been altered. Nor do they  
 18 have any “burst time period” associated with them.

19  
 20 <sup>21</sup> Kalay Decl. Exh. 2 [Gautier Depo.] at 31:22-32:15.

21 <sup>22</sup> *Id.* at 33:25-34:5.

22 <sup>23</sup> *Id.* at 48:23-49:8; *see also id.* at 49:17-19 (Apple occasionally receives video in other formats).

23 <sup>24</sup> Kalay Decl. Exh. 1 [Robbin Depo.] at 51:6-11.

24 <sup>25</sup> Kalay Decl. Exh. 2 [Gautier Depo.] at 56:19-24 (“Q. Where is the content actually – on what  
 hardware is the content actually stored? Hard drives? You mentioned hard drives. A. Yes, it’s  
 all hard drives. Q. All hard drives? A. Yeah.”).

25 <sup>26</sup> *Id.* at 58:20-59:4.

26 <sup>27</sup> Kalay Decl. Exh. 1 [Robbin Depo.] at 60:21-24.

27 <sup>28</sup> Ehrlich Decl., Exh. 4 [Screens from iTunes Help].

28 <sup>29</sup> Kalay Decl., Exh. 1 [Robbin Depo.] at 38:18-22, 285:10-286:12.

<sup>30</sup> Ehrlich Decl., Exh. 5 [Apple Website Screenshots]; Ehrlich Decl., Exh. 4 [Screens from iTunes  
 Help].

1 As described in Apple's claim construction brief, time compression is what  
2 happens when one plays a regular 33 rpm record at 45 rpm. If one records this playback on a tape  
3 recorder, the resulting recording is a "time compressed representation" of the original recording.  
4 The resulting tape recording is a stored time compressed representation. The song's time scale  
5 has been altered: when played back, it would take 33/45ths of the time of the original song, and it  
6 would sound odd because the frequency of the audio has been increased.

7 Nothing like this has been done to any of the media files that are stored by Apple's  
8 products. The videos and songs stored by the iPod, iTunes, and iTunes Store play back at normal  
9 speed. These media files are stored in formats that contain internal data fields that tell the  
10 playback engine what that normal speed is.<sup>31</sup> Just like a record store does not modify the content  
11 of the CDs it sells, Apple does not alter the content of the media it sells through the Music  
12 Store—other than to remove "black bars" from the top and bottom of some videos.<sup>32</sup> In short, the  
13 media files stored by Apple's products have their original, unaltered time scales.

14 Furthermore, the media files stored by Apple's products do not have any  
15 "associated burst time period." The only time period that is "associated" with songs or videos  
16 stored by Apple's products is information about their real-time playback, such as the song length  
17 and bit rate.<sup>33</sup> The amount of time it takes to load a media file onto the iPod or into iTunes from  
18 the iTunes Store or any other source—which can be faster than real-time—is not stored or  
19 associated with the media file in any way. Indeed, the file formats for the media files that are  
20 compatible with the iPod and iTunes do not contain any field for storing a value that reflects  
21 transmission time.<sup>34</sup> Nor does iTunes or the iPod store any information on the hard drive (or in  
22

23 \_\_\_\_\_  
<sup>31</sup> Ehrlich Decl., Exh. 6 [Standards showing AAC and MP3 file formats].

24 <sup>32</sup> See Kalay Decl., Exh. 2 [Gautier Depo.] at 82:5-19.

25 <sup>33</sup> Bit rate refers to the number of bits of data used for each second of the media file, and  
26 generally is a measure of quality—using more bits per unit time allows a higher quality  
reproduction of sound or video. See Ehrlich Decl. Exh. 4 ["AAC settings" and "MP3 settings"  
from iTunes Help Screens].

27 <sup>34</sup> See Ehrlich Decl., Exh. 6 [Standards showing AAC, and MP3 file formats]; Kalay Decl., Exh. 1  
28 [Robbin Depo.] at 72:3-14 and 72:19-22 (stating that Apple uses the "open standard" AAC for  
songs from the iTunes Store, and it is not "customized or extended at all.").

1 flash memory) about how long it takes to transfer a file.<sup>35</sup> Even Burst's own expert has  
2 acknowledged that the time period associated with a data-compressed media file, such as an MP3  
3 file, is its real-time period, not a faster-than-real-time period.<sup>36</sup>

4 In short, the media files stored by Apple's products are not "time compressed  
5 representations," nor do they have an "associated burst time period." Therefore, Burst cannot  
6 carry its burden of proving infringement.

#### 7 IV.

#### 8 **APPLE DOES NOT INFRINGE UNDER THE DOCTRINE OF EQUIVALENTS**

9 There can be no genuine dispute that time compression is not equivalent to data  
10 compression. Moreover, the law forbids Burst from recapturing in litigation through the doctrine  
11 of equivalents claim coverage that it surrendered during prosecution to obtain allowance of the  
12 patents-in-suit. Burst is attempting to do just that through its assertion that a "time compressed  
13 representation" is stored in the hard drives (or flash memory) used by iTunes, the iPod and the  
14 iTunes Store. This is impermissible.

#### 15 **A. Prosecution History Estoppel Prevents Application Of The Doctrine Of** 16 **Equivalents**

17 The doctrine of prosecution history estoppel precludes patentees from recapturing  
18 through the doctrine of equivalents any claim scope that was surrendered to obtain allowance of  
19 their patent. In *Festo*, the Supreme Court explained the rationale underlying the doctrine of  
20 prosecution history estoppel:

21 Prosecution history estoppel ensures that the doctrine of equivalents  
22 remains tied to its underlying purposes. The doctrine of equivalents  
23 is premised on language's inability to capture the essence of  
24 innovation, but a prior application describing the precise element at  
25 issue undercuts that premise. In that instance the prosecution  
26 history has established that the inventor turned his attention to the  
27 subject matter in question, knew the words for both the broader and

26 <sup>35</sup> See *id.* at 78:23-25 ("Q. Does Apple have any -- keep track in any way of the download times  
27 or download durations? A. Not that I'm aware of.")

28 <sup>36</sup> Brown CC Decl. Exh. C [Hemami Depo.] at 298:6-14 (stating that "by compressing the file to  
MP3 you aren't changing the time period associated with it").

1 narrower claim, and affirmatively chose the latter.<sup>37</sup>

2 Here, Burst is estopped from asserting that storage of data-compressed media infringes the  
3 “storing said time compressed representation” limitation under the doctrine of equivalents  
4 because Burst originally filed claims covering data compression and then abandoned them. Burst  
5 is also estopped because its emphatic statement during prosecution that “data compression” is  
6 “not the equivalent by any means of applicant’s specifically claimed time compression” shows  
7 that Burst “knew the words” to describe data compression, and affirmatively chose to claim time  
8 compression instead.<sup>38</sup>

9  
10 **1. Prosecution history estoppel applies here because Burst abandoned its  
11 claims to data compression in favor of claims limited to time  
12 compression.**

13 The file history shows that Burst’s original claims included claims directed at data  
14 compression, and then cancelled them in favor of claims limited to time compression.  
15 Cancellation of claims in favor of claims with a narrower literal scope creates the same  
16 presumptive bar to the application of the doctrine of equivalents as amending the claims  
17 directly.<sup>39</sup>

18 The phrase “time compressed” does not appear in the specification or in the  
19 originally filed claims of either the December 1988 application or the May 1989 continuation-in-  
20 part application.<sup>40</sup> The originally filed claims do, however, claim data compression. Original  
21 claim 9 of the ‘932 patent describes an apparatus where audio data is received, digitized, and then  
22 “compressed”—not time compressed—before being stored and then transmitted:

23 9. Apparatus comprising:  
24 means for receiving an analog audio signal;

25 <sup>37</sup> *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734-35 (2002).

26 <sup>38</sup> Brown CC Decl., Exh. L [‘705 File History] at APBU 551; *Festo*, 535 U.S. at 734-35.

27 <sup>39</sup> *Honeywell Intern. Inc. v. Hamilton Sundstrom*, 370 F.3d 1131, 1143 (Fed. Cir. 2004)  
(explaining that prosecution history estoppel applies when a “narrower rewritten claim had been  
28 substituted for the broader original independent claim”); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*,  
457 F.3d 1293, 1309-1311 (Fed. Cir. 2006) (applying the *Festo* prosecution history estoppel  
analysis to claims that had not been amended but had replaced cancelled claims).

<sup>40</sup> See Brown CC Decl. Exh. A [‘995 File History] at APBU 18-46; Brown CC Decl. Exh. O  
[‘932 File History] at APBU 166-70.

1 means for digitizing said analog audio signal, thereby generating  
2 digital data corresponding to said audio signal and for  
3 compressing said digitized data;

4 means for storing said compressed digital data; and

5 transceiver means for transmitting said compressed digital data.<sup>41</sup>

6 The compression of this claim is data compression because “compression” alone without the  
7 word “time” implies data compression. Similarly, original claim 4 of the ‘995 patent required  
8 data compression, because it required “sequentially compress[ing]” one data signal into another:

9 4. The apparatus set forth in claim 1 wherein said first means  
10 sequentially compresses said first digital data signal into a  
11 second digital data signal and

12 said second means transmits said second digital data signal to  
13 said output port.<sup>42</sup>

14 Thus, Burst’s original claims included claims directed to data compression.

15 The PTO rejected all of the claims in the May 1989 continuation-in-part  
16 application, citing among other references the Fabris<sup>43</sup> and Workman<sup>44</sup> patents, both of which  
17 disclose storing data-compressed video and subsequent transmission thereof.<sup>45</sup> As the examiner  
18 stated, “Fabris shows data transmission in a data compression context and use of optic fibers as a  
19 transmission means.”<sup>46</sup> The examiner also rejected all of the claims in the December 1988  
20 application.<sup>47</sup>

21 <sup>41</sup> Brown CC Decl. Exh. O [‘932 File History] at APBU 167.

22 <sup>42</sup> Brown CC Decl., Exh. A [‘995 File History] at APBU 38. Burst acknowledged in its claim  
23 construction briefing that this claim “claimed data compression.” Burst Claim Construction  
24 Reply at 24 n.19. Burst’s expert also agreed that this claim described data compression. Brown  
25 CC Decl., Exh. C [Hemami Depo.] at 213-214.

26 <sup>43</sup> Brown CC Decl. Exh. Q [Fabris patent] (U.S. Patent No. 4,516,156 titled “Teleconferencing  
27 Method and System.”).

28 <sup>44</sup> Brown CC Decl. Exh. P [Workman patent] (U.S. Patent No. 4,179,709 titled “Video  
Information Bandwidth Compression.”).

<sup>45</sup> Brown CC Decl., Exh. O [‘932 File History] at APBU 199-207; *see also* Brown CC Decl., Exh.  
P [Workman patent] at 2:23-64 (disclosing both the “interframe encoding” and the “intra-frame  
encoding” described in the specification of the Burst patents); *id.* at 17:41-51 (disclosing storage  
facility 52”) Brown CC Decl., Exh. Q [Fabris patent] at 10:25-47 (describing “motion codec 45”  
that was used for “transmission to the remote site”); *id.* at 10:67-11:2 (“The digitally compressed  
document is stored and buffered in a compressor protocol interface from which it is transmitted to  
the distance teleconference room through a 448 KBPS digital data port.”).

<sup>46</sup> Brown CC Decl., Exh. O [‘932 File History] at APBU 203.

<sup>47</sup> Brown CC Decl., Exh. A [‘995 File History] at APBU 57-65.

1 In response to these rejections, Burst cancelled all the existing claims in both  
2 applications and submitted new claims that included, for the first time, the limitation that the  
3 audio/video program which is received, stored, and transmitted must be a “time compressed  
4 representation.”<sup>48</sup>

5 Thus, Burst originally included claims directed at data compression, and then  
6 cancelled them in favor of claims limited to time compression. This constitutes a surrender of  
7 claim scope that is presumed to give rise to an estoppel.<sup>49</sup> Borrowing the words of the Supreme  
8 Court, Burst is estopped from recapturing data compression because “the prosecution history has  
9 established that the inventor turned his attention to the subject matter in question, knew the words  
10 for both the broader and narrower claim, and affirmatively chose the latter.”<sup>50</sup> The file history  
11 shows that Burst knew the words for both data compression and time compression and  
12 affirmative cancelled its claims to the former in favor of the latter, in response to the examiner’s  
13 rejection of the claims. Consequently, Burst cannot now argue that storage of data compressed  
14 representations is equivalent to storage of a “time compressed” representation.

15 **2. Prosecution history estoppel also applies based on Burst’s unequivocal**  
16 **statement that data-compression was not equivalent to time**  
17 **compression.**

18 Burst is also estopped from recapturing data compression through the doctrine of  
19 equivalents because Burst stated to the Patent Office that “data compression” is “not the  
20 equivalent, by any means, of applicant’s specifically claimed time compression.”<sup>51</sup>

21 The Federal Circuit has repeatedly held that an applicant must be held to the

22 <sup>48</sup> Brown CC Decl., Exh. A [‘995 File History] at APBU 73 (Amendment canceling all pending  
23 claims); Brown CC Decl., Exh. O [‘932 File History] at APBU 212 (Amendment canceling all  
24 pending claims). Prior to canceling its claims in the original application, Burst submitted the  
25 Fabris and Workman patents to the Patent Office. Brown CC Decl., Exh. A [‘995 File History] at  
26 APBU 69-71.

27 <sup>49</sup> *Honeywell Intern. Inc. v. Hamilton Sundstrom*, 370 F.3d 1131, 1143 (Fed. Cir. 2004)  
28 (explaining that prosecution history estoppel applies when a “narrower rewritten claim had been  
substituted for the broader original independent claim”); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*,  
457 F.3d 1293, 1309-1311 (Fed. Cir. 2006) (applying the *Festo* prosecution history estoppel  
analysis to claims that had not been amended but had replaced cancelled claims).

<sup>50</sup> *Festo*, 535 U.S. at 734-35.

<sup>51</sup> Brown CC Decl., Exh. L [‘705 File History] at APBU 551.

1 statements it makes during prosecution to distinguish the prior art.<sup>52</sup> In *Cortland Line Co. v.*  
 2 *Orvis Co. Inc.*, the Federal Circuit considered a situation where the patentee for a fishing reel told  
 3 the examiner that the prior art was “completely different than the applicant’s reel both in structure  
 4 and function.”<sup>53</sup> The Federal Circuit held that such a statement “evinces a clear and unmistakable  
 5 surrender.”<sup>54</sup> In such circumstances “prosecution history estoppel precludes a patentee from  
 6 obtaining under the doctrine of equivalents coverage of subject matter that has been relinquished  
 7 during the prosecution of its patent application.”<sup>55</sup>

8 Here, Burst expressly told the Patent Office that “data compression” is “not the  
 9 equivalent, by any means, of applicant’s specifically claimed time compression.”<sup>56</sup> Burst made  
 10 this statement to distinguish U.S. Patent No. 4,974,178 to Izeke et al. (“Izeke”),<sup>57</sup> which the  
 11 examiner cited in rejecting Burst’s claims. Burst’s statement constitutes a clear and unmistakable  
 12 surrender of coverage of data compression that gives rise to an estoppel that prevents recapture of  
 13 data compression, just as the applicant’s statement in *Cortland* gave rise to an estoppel that  
 14 prevented recapture of the prior art disclaimed there.

15 **B. Allowing a data-compressed representation to be equivalent to the claimed**  
 16 **“time compressed representation” would impermissibly vitiate the “time**  
 17 **compressed” limitation.**

18 Even if prosecution history estoppel did not apply, the Court could still not find  
 19 Apple’s data-compressed files equivalent to the stored “time compressed representation” required  
 20 by the claims.

21 The law is clear that “[i]f a theory of equivalence would vitiate a claim limitation  
 22 . . . then there can be no infringement under the doctrine of equivalents as a matter of law.”<sup>58</sup>

23 <sup>52</sup> *Nystrom v. Trex Co.*, 424 F.3d 1136, 1144 (Fed. Cir. 2005); *Research Plastics v. Federal*  
 24 *Packing*, 421 F.3d 1290 (Fed. Cir. 2005); *Norian Corp., v. Stryker Corp.*, 432 F.3d 1356, 1361-62  
 25 (Fed. Cir. 2005).

26 <sup>53</sup> *Cortland Line Co. v. Orvis Co. Inc.*, 203 F.3d 1351, 1360 (Fed. Cir. 2000).

27 <sup>54</sup> *Id.*

28 <sup>55</sup> *Pharmacia & Upjohn Co. v. Mylan Pharmaceuticals, Inc.*, 170 F.3d 1373, 1376 (Fed. Cir.  
 1999).

<sup>56</sup> Brown CC Decl., Exh. L [‘705 File History] at APBU 551.

<sup>57</sup> Brown CC Decl., Exh. M [Izeke patent] (Titled “Editing Apparatus for Audio and Video”).

<sup>58</sup> *Seachange Intern., Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1378 (Fed. Cir. 2005) (citing *Asyst*



1 This “all elements” rule stems from the Supreme Court’s holding in *Warner-Jenkinson*:

2 It is important to ensure that the application of the doctrine [of  
3 equivalents], even as to an individual element, is not allowed such broad  
4 play as to effectively eliminate that element in its entirety.<sup>59</sup>

5 Under the circumstances here, application of the doctrine of equivalents to find  
6 Apple’s data-compressed files equivalent to the claimed “time compressed representation”  
7 amounts to reading the phrase “time compressed representation” as if it merely required a  
8 “compressed representation.” That would vitiate the “time compressed” limitation, and is  
9 impermissible under *Warner-Jenkinson*.<sup>60</sup>

10 **V.**

11 **CONCLUSION**

12 For the reasons set forth herein, Apple does not infringe the asserted claims of the  
13 Burst patents under Apple’s proposed construction of the phrase “time compressed  
14 representation.”

15 Dated: January 4, 2007

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19 Apple Computer, Inc.

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*Technologies, Inc. v. Emtrak, Inc.*, 402 F.3d 1188, 1195 (Fed. Cir. 2005)).

26 <sup>59</sup> *Warner-Jenkinson Co. v. Hilton Davis Chemical*, 520 U.S. 17, 29 (1997).

27 <sup>60</sup> See *Freedman Seating Co. v. American Seating Co.*, 420 F.3d 1350, 1361-1362 (finding that a  
28 “rotatably mounted” device could not be equivalent to a “slidably mounted” limitation because  
that would vitiate that limitation); *Asyst Technologies*, 402 F.3d at 1195 (finding  
that an “unmounted” device could not be equivalent to the “mounted on” limitation because it  
would vitiate that limitation).