IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA

Case No. 1:10cv023580-Civ-UU

MOTOROLA MOBILITY, INC., Plaintiff, v. APPLE INC., Defendant.	**JURY TRIAL DEMANDED**
APPLE INC., Counterclaim Plaintiff, v. MOTOROLA, INC. and MOTOROLA MOBILITY, INC., Counterclaim Defendants.	

MOTOROLA'S RESPONSIVE BRIEF ON CLAIM CONSTRUCTION

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I. INTRODUCTION

Each of the disputed terms in the Apple patents require construction. Some of the terms – such as "gesture" – were defined by the patentees in the patent specification. (*See infra* at Part II(B)). Some of the terms – such as "determining whether an input/output device . . . is a video display device" were subject to a surrendering of claim scope during prosecution. (*See infra* at Part III(A)). Some of the terms – such as "display space" – consist of a term of art in their field that is different from a more ordinary meaning of that term (*e.g.*, a global coordinate system, and not a department store display). (*See infra* at Part III(B)). Some of the terms were "means-plus-function" claim terms – such as "listing means" – that should be construed to be limited by the structure disclosed in the specification. (*See infra* at Part IV(A)). It was for these reasons that Motorola asked the Court to construe the disputed terms in Apple's patents.

In contrast, Apple has requested that the Court construe terms in Motorola's patents that are not defined in the specification, were not subject to the a surrendering of claim scope during prosecution, were not a "means-plus-function" claim element, and were not used in a manner that differed from their ordinary meaning. Indeed, most of the terms in Motorola's patents for which Apple seeks a construction do not require one. Moreover, the constructions proposed by Apple consistently ignore the plain meaning of the claim language and the teachings of the Motorola patents. Rather than construe the disputed terms, Apple seeks to re-write the claim language.

For all of the disputed terms, Motorola's constructions are consistent with the intrinsic and extrinsic evidence, and should be adopted by the Court.

II. UNITED STATES PATENT NO. 7,657,849

A. "Moving An Unlock Image"

Disputed Claim Phrase	Motorola's Proposed Construction	Apple Proposed Construction
moving an unlock image	"Translating the unlock image from one portion of the coordinate space of the touch-sensitive display to another"	Ordinary meaning, or in the alternative, "causing an unlock image to change position over time via continuous contact with the touch screen"

Motorola's construction of "moving an unlock image" requires actual movement of the "unlock image" – a plain element of the disputed term. Apple's construction, in contrast, is designed to confuse the jury into believing that actual movement isn't required, such that a button that merely "stretches" or "shrinks" or otherwise "changes" shape is enough to fall within the scope of the asserted claims. Indeed, Apple argued in its Opening Brief that Motorola's construction should be rejected because it does not allow these changes to be movement of an unlock image:

> "Motorola's proposed construction is too limiting because, as interpreted by Motorola, 'moving' a soft key (or activating a virtual button) would require shifting the *entire* image to a different location on the coordinate plane **even though a button may stretch or shrink or otherwise change shape to depict it being activated** . . . ."
>
> (Apple's Br. at 49 (bold added / italics in original)).

But movement of an object – whether that object is a physical object or is an image displayed on a screen – does require changing its position over time. That is what "movement" is. (Apple's Br. Ex. 20 (defining "move" to mean "change the position or place of")). Movement of an object is not merely distorting that object or changing its shape without movement as Apple suggests. It is for that reason that Motorola's proposed construction is correct, as it requires the unlock image to go "translating the unlock image ***from one portion of the coordinate space of the touch-sensitive display to another***."[1]

The specification of the '849 patent provides no basis for removing the requirement of actual movement of the unlock object from the plain language of the claims. In its Opening Brief, Apple refers to general language in the specification that "[many] modifications and variations are possible." (Apple's Br. at 49). That language, however, does not support changing the meaning of the disputed term so that it no longer requires actual movement. Indeed, the issue here is not that the ***specification may have*** contemplated unlocking an

[1] Notably, in its Opening Brief, Apple did not assert that the claimed movement of the unlock object occurs through the "coordinate space of the touch-sensitive display."

electronic device without movement of an unlock object (it did not), but that the ***claims*** require movement (which they do). *Camp Scandinavia AB v. Trulife, Inc.*, 628 F.Supp.2d 743, 746 (E.D. Mich., 2008) ("It is error to read a limitation into a claim based on an unclaimed aspect of an embodiment disclosed in the specification."); *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998) ("The actual words of the claim are the controlling focus."). Similarly, it matters not that the specification describes various types of "user interface objects" other than an "unlock image," for those other user-interface objects were not claimed.[2] (*Compare* Apple's Br. at 49 *with* Ex. 1 at 19:15-24:49).

Apple's final argument regarding the proper construction of this term is that it should be construed broadly enough to encompass movement "by rotating in place" of the unlock object in a clockwise or counterclockwise direction "like a combination lock." (Apple's Br. at 49). As an initial matter, this hypothetical (not disclosed) describes moving the ***entire*** object, rather than the object merely changing shape, and thus would only serve to support the requirement of actual movement of the entire object.

Further, while Apple's hypothetical does include actual movement of an unlock object, it fails to consider the remainder of the claim language concerning the movement of the unlock object.[3] Specifically, "moving an unlock image ***along a predefined displayed path on the touch-sensitive display*** . . . ." (Ex. 1 at 19:21-22). Movement by simple rotation does not move an object "along a . . . path." Movement of the unlock object by rotation alone would not move that unlock object "along a predefined . . . path."

Apple's proposed construction is also incorrect because it inserts the requirement that the movement be caused "via continuous contact with the touch screen." (Apple's Br. at 8). The

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[2] Apple's reliance on the disclosure of "soft keys (or virtual buttons)" is particularly confusing, (Apple's Br. at 49), as it was the stated goal of the inventors of the '849 patent to avoid "pressing a predefined set of buttons." (Ex. 1 at 1:41-50).

[3] In its Opening Brief, Apple provides an incorrect definition of "translating," (Apple's Br. at 48, fn.19); the correct definition of "translation" is "the act of moving a system to a new position ***without*** rotating it or changing its shape or structure." (Motorola's Br., Ex. 3 at 3).

insertion of this additional limitation is completely unsupported by the language of the claims and inventor testimony. First, there is already a claim limitation that requires the user's contact with the touch screen – (*See, e.g.*, Ex. 1 at 19:19-20 ("detecting contact with the touch-sensitive display")). Thus, the inclusion of "via . . . contact with the touchscreen" limitation would be superfluous. *See Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1315 (Fed. Cir. 2009) (affirming the district court's rejection of a claim construction that would render a claim phrase superfluous); *Mangosoft, Inc. v. Oracle Corp.*, 525 F.3d 1327, 1330 (Fed. Cir. 2008) (same). Second, even Bas Ording, one of the inventors of the '849 patent, did not agree that a user's contact with the touch screen must be "continuous." (Ex. 32 at 64:14-17 ("Q. Tapping could be a gesture, with the touchscreen? A. It could. A gesture can be different things."); 65:2-10 (Q. But with regard to interacting with a touchscreen. Forget the normal, you know, meaning of "gesture" that you may have in your head, which my questions are limited to just interacting with a touchscreen. And so you're not saying that the movement of the user has to be continuous contact; is that correct? A. Yeah, I'm saying that it doesn't necessarily have to be continuous contact there.").

For all of the foregoing reasons, Motorola respectfully requests that the Court adopt its proposed construction. In the alternative, Motorola respectfully requests that the Court not construe Apple's proposed construction as it removes the requirement of actual movement of the unlock object.

B. "Gesture"

Disputed Claim Phrase	Motorola's Proposed Construction	Apple Proposed Construction
gesture	"A motion of the object / appendage making contact with the touch screen display"	Plain and ordinary meaning applies, or in the alternative, "a motion of the object / appendage making contact with the touch-screen"

Motorola's proposed construction and Apple's alternate construction are essentially the same, and both are based on the definition of that term provided in the '849 patent specification.

(*See* Ex. 1 at 9:26-28) ("As used herein, a gesture is a motion of the object/appendage making contact with the touch screen."). Nonetheless, Apple has refused to agree to this definition of "gesture," and instead proposes that the term be accorded its "plain and ordinary meaning." . While Apple contends that there is no dispute between the parties, (Apple's Br. at 47-48), it has refused to accept the patentee's definition, and instead contends (at least, in the first instance) that the term should be given its "[p]lain and ordinary meaning." (Apple's Br. at 47). The ordinary meaning of "gesture" – i.e., "a motion of the limbs or body made to express thought or to emphasize speech, (Ex. 5, at 3) – would include user motion that does not actually contact the touch screen display of the claimed device. As a result, the ordinary meaning of "gesture" is plainly not supported by the intrinsic evidence. See *Phillips*, 415 F.3d at 1316 ("[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs."); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (holding that "it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning [because the specification] acts as a dictionary when it expressly defines terms ... or when it defines terms by implication").

Because the '849 patent has defined the term "gesture" and because the ordinary meaning of that term does not comport with the disclosure of the patent, the Court should adopt Motorola's proposed construction.

III. UNITED STATES PATENT NOS. 6,282,646 AND 7,380,116

A. "Determin[ing][es] Whether [A] Device Is . . . A Video Device" / "Detect[ing][s] . . . A Display Device"

Disputed Claim Phrase	Motorola's Proposed Construction	Apple Proposed Constructions
Determi[ning][es] whether [a] device . . . is a video device Detect[ing][s] . . . a display device	"Having the device manager, which is an operating system component and not a device driver, specifically determine that the device is a video display device"	Apple believes that these phrases should be construed separately as follows: Determin[ing][es]… Plain and ordinary meaning applies or, in the alternative: "determine

		whether a device is or is not capable of displaying video" Detect[ing][s]… Plain and ordinary meaning applies or, in the alternative: "detecting a device capable of displaying"

1. Patent Applicants Surrender Claim Scope By Distinguishing The Pending Claims From Prior Art During Prosecution

The Federal Circuit has repeatedly rejected a patentee's attempt to reclaim claim scope in litigation after surrendering it during prosecution. The facts of this case closely parallel those of *Verizon Services Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295 (Fed. Cir. 2007) and *Alloc, Inc. v. International Trade Com'n*, 342 F.3d 1361 (Fed. Cir. 2003). In *Verizon*, the patentees held a patent on a "localized wireless gateway system" (an invention allowing wireless telephones to register with a base station and make calls). During prosecution, and in order to gain allowance of their pending claims, the patentees distinguished their invention on the grounds that the prior art was "directed to non-localized systems," whereas the present invention was "restricted to operate within a few feet from a base station (i.e. wireless handsets)." *Id.* at 1307. In *Verizon*, the Federal Circuit reversed the district court's construction that failed to limit the claims in this manner because the applicants had "clearly disclaimed coverage of systems operating with a range greater than a "few feet," and ordered a new trial on infringement that would properly include the "few feet" limitation. *Id.* at 1306-07.

Similarly, the patentees in *Alloc* represented during prosecution that the word "play" (which refers to space between a locking groove and locking element in a new floor paneling system) made their invention novel, after their previous application was rejected due to prior art. *Alloc,* 342 F.3d 1361 at 1371-72. Relying on the patentees' statement distinguishing the invention from the prior art based on their use of "play," the USPTO allowed the claims. *Id.* After the USPTO approved these claims, however, the patentee added new claims nearly identical to those allowed, except without the term play, and without retracting or modifying the representations that secured allowance of the original claims. *Id.*

The Federal Circuit rejected *Alloc*'s subsequent attempts during litigation to construe those claims more expansively as encompassing flooring systems that did not include play: "Because the applicant invoked play to overcome the prior art, . . . Alloc cannot now contend that the '621 patent claims a flooring system and method for installing that system without play. The applicant expressly disavowed systems without play during prosecution of the parent '621 application." *Id.*

Like the patentees in *Verizon* and *Alloc*, the patentees of the Display Space Patents also disclaimed subject matter during prosecution in order to gain allowance of the claims. Specifically, the patentees expressly disavowed the performance of the claimed methods that are achieved without a "device manager," which is an "operating system component," during prosecution in order to gain allowance of the claims.[4] Apple cannot now ignore that clear surrender of claim scope. *See, e.g.*, *Senmed, Inc. v. Richard-Allan Med. Indus., Inc.*, 888 F.2d 815, 819 n. 8 (Fed. Cir. 1989) ("A patentee may not proffer an interpretation for the purposes of litigation that would alter the indisputable public record consisting of the claims, the specification and the prosecution history, and treat the claims as a "nose of wax.""); *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1349 (Fed. Cir. 2004) (interpreting "sending," "transmitting," and "receiving" limitations as requiring direct transmission over telephone line when patentee stated during prosecution that invention transmits over a standard telephone line, thus disclaiming transmission over a packet-switched network); *Bell Atl. Network Servs. v. Covad Commc'ns Group, Inc.,* 262 F.3d 1258, 1273 (Fed. Cir. 2001) (limiting operation of the "transceiver" to the three stated modes because of clearly limiting statements made by the patentee to try to overcome a prior art rejection); *Seachange Int'l, Inc. v. C-COR Inc.*, 413 F.3d 1361, 1372-73 (Fed. Cir. 2005) ("[w]here an applicant argues that a claim possesses a feature

[4] The independent claims of the '116 incorporate the same limitations adopted by the applicant to secure allowance of the '646 patent. *See, e.g., Ormco Corp. v. Align Technology, Inc.,* 498 F.3d 1307, 1314 (Fed. Cir. 2007) ("[w]hen the application of prosecution disclaimer involves statements from prosecution of a familial patent being construed those statements in the familial application are relevant in construing the claims at issue").

that the prior art does not possess in order to overcome a prior art rejection, the argument may serve to narrow the scope of otherwise broad claim language"); *Chimie v. PPG Indus.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) (holding that claims should not be construed "one way in order to obtain their allowance and in a different way against accused infringers").

2. The Patentees Disavowed Any Rights To Performing The Claimed Methods Without The Disclosed Device Manager

As an initial matter, Apple's contention that these disputed terms should be construed according to their "[p]lain and ordinary meaning,"(Apple's Br. at 39, 42), is without merit. First, whether or not the individual words in these disputed terms have an ordinary meaning, the intrinsic evidence – in particular the prosecution history – makes clear that the patentees conceded claim scope in order to be awarded the claims. **In effect, the patentees stated what is meant by "determining" and "detecting" in *these* patents.** *See CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir. 2005) ("a patent applicant may consistently and clearly use a term in a manner either more or less expansive than its general usage in the relevant community, and thus expand or limit the scope of the term in the context of the patent claims.").

The disavowal of claim scope that the applicants made – repeatedly – during prosecution of the Display Space Patents was studiously avoided by Apple in its Opening Brief, despite the fact that Apple devoted a full 8 pages to the construction of the disputed terms of the Display Space Patents. (*See* Apple's Br. at 39-47). It is, of course, obvious why Apple would want to avoid any discussion of the statements made by the applicants during prosecution – they unequivocally support Motorola's construction:

> "In accordance with one aspect thereof, the present invention adds to the system of the Hendry et al. patent by utilizing a device manager to provide hot-plugging capabilities. More particularly, ***the device manager detects the addition or removal of any type of input/output device*** in the computer system. Upon detecting the addition or removal of a device, ***the device manager then determines whether that input/output device is a video device.***"

(Apple's Br., Ex. 10 at 9 (3/28/00 Response)). By so stating, the applicants disavowed any right to the performance of the claimed methods in which the "detecting" and/or "determining" steps were not performed by the disclosed device manager.[5] *See, e.g.*, *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1349 (Fed. Cir. 2004) (limiting the term "transmitting" to require direct transmission over telephone line because the patentee stated during prosecution that the invention transmits over a standard telephone line, thus disclaiming transmission over a packet-switched network); *Alloc v. Int'l Trade Comm'n*, 342 F.3d 1361, 1372 (Fed. Cir. 2003) (finding the patentee expressly disavowed floor paneling systems without "play" because the applicant cited the feature during prosecution to overcome prior art); *Bell Atl. Network Servs. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1273 (Fed. Cir. 2001) (limiting operation of the "transceiver" to the three stated modes because of clearly limiting statements made by the patentee to try to overcome a prior art rejection); *Omega Eng'g, Inc. v. Raytek Corp.,* 334 F.3d 1314, 1323 (Fed. Cir. 2003) ("A patentee may not recapture through claim interpretation specific meanings disclaimed during prosecution."); *Computer Docking Station Corp. v. Dell, Inc.*, 2006 WL 5999613, at *10 (W.D. Wisc. 2006) (disclaimer in prosecution history limited scope of patent, even where it excluded a preferred embodiment in the specification) (citing *Rheox, Inc. v. RMT, Inc.*, 276 F.3d 1319 (Fed. Cir. 2002)).

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[5] Apple's reliance on *Bicon* and *Elekta Instrument*, (Apple's Br. at 42), is misplaced. First, the Court in *Elekta Instruments* did not refuse to adopt a claim construction that would render claim language superfluous. Rather, the Court in *Elekta Instruments* adopted a claim construction that was consistent with a disavowal of claim scope made by the applicants during prosecution. *See Elekta Instrument S.A. v. O.U.R. Scientific Int'l, Inc.*, 214 F.3d 1302, 1308 (Fed. Cir. 2000) (changing the claim language from "to" to "between" due to applicant's disavowal of claim scope during prosecution). Second, *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945 (Fed. Cir. 2006), did not address the construction that involved – like here – the surrendering of claim scope during prosecution. *See Bicon, Inc. v. Straumann Co*., 441 F.3d 945, 950-953 (Fed. Cir. 2006).Even if the rebuttable presumption that Apple on which relies is applicable here, it would be overcome by the fact that the patentees surrendered the scope of the claim 1 in order to make it consistent with the other pending claims (which explicitly recited that the device manager performed the "determining" step).

3. The Specification Clearly States That The Device Manager Performs The Claimed "Detecting" and "Determining" Steps

Similarly, the Display Space Patents' specification states that the claimed "determining" and "detecting" steps are performed by the disclosed device manager. (Ex. 6 at 5:15-21). Indeed, the fact that the "device manager" handles these functions – can be described as the heart of the alleged invention of the Display Space Patents. That is exactly what the patentees of the Display Space Patents did in the Abstract:

> When an input/output device is added to or removed from the computer system, an interrupt signal informs ***a device manager*** of the fact that a change in configuration has occurred. In response thereto, ***the device manager determines*** whether the changed component relates to the computer's display function. If so, ***the device manager*** makes a call to the computer's display manager, to inform it of the fact that the display configuration has changed.

(*Id.* at Abstract (emphasis added)). And again, in the "SUMMARY OF THE INVENTION":

> ***In accordance with the present invention, the foregoing objective is achieved by utilizing a device manager to automatically recognize and react to changes in the configuration of a display environment***, rather than wait for the computer's operating system to proactively determine the status of the display environment, for example upon restarting. When an input/output device is added to or removed from the computer system, an interrupt signal ***informs the device manager*** of the fact that a change in configuration has occurred. In response thereto, ***the device manager determines*** whether the changed component relates to the computer's display function.

(*Id.* at 2:23-33 (emphasis added)). See *Genzyme Corp. v. Transkaryotic Therapies, Inc*., 346 F.3d 1094, 1099 (Fed. Cir. 2003) (finding that statements in a patent's "Summary of the Invention" and "Abstract" portions limited the scope of a phrase in the patent's claims to a specific technique).

4. Motorola's Construction Properly Requires That The Device Manager Is A "Component Of The Operating System, And Not A Device Driver"

In light of the intrinsic evidence discussed above, the "detecting" and "determining" steps must be performed by the "device manager" disclosed in the Display Space Patents. As it happens, "device manager" is defined in the specification as being a "portion of the computer's operating system": "The detection of the presence of such devices, as well as their removal from

the system, is handled by *a portion of the computer's operating system that is referred to herein as a device manager.*" (Ex. 6 at 5:15-21 (emphasis added)). This definition should govern and that a device manager must be part of the operating system is appropriately included in the construction. *See, e.g.*, *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1374 (Fed. Cir. 2003) ("Because 3M expressly acted as its own lexicographer by providing a definition of embossed in the specification, the definition in the specification controls the meaning of embossed . . . ."); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005) (en banc) ("[T]he specification 'acts as a dictionary when it expressly defines terms used in the claims ...")

In its Opening Brief, Apple mistakenly refers to this definition as being merely "exemplary." (Apple's Br. at 43). Apple's argument that this definition of a device manager is "merely exemplary" is belied by the intrinsic evidence of the Display Space Patents. A plain reading of this passage is that the patentees *defined* the disclosed "device manager" to be "a portion of the computer's operating system." (Ex. 6 at 5:15-21).[6] This definition is further supported by Figures 1, 3, and 4 of the Display Space Patents, all of which illustrate that the disclosed "device manager" is part of the computer's operating system. (*See id.* at FIGS. 1, 3, & 4).

That the claimed device manager be something different from the individual device drivers is also supported by the by the prosecution history of the Display Space Patents. (*See,*

[6] In an attempt to avoid this definition, Apple relies on some generalized language – found at the end of most patents – that the disclosed invention could come in other forms. (Apple's Br. at 43). First, Apple provides no legal basis for overruling an explicit definition with such generalized "catch-all" language. Second, even the generalized "catch-all" language cited to by Apple requires not departing from "the spirit or essential characteristics" of the invention. (Motorola's Br., Ex. 6 at 8:36-38). *Wavestream Corp. v. CAP Wireless, Inc.*, 2006 WL 5104656 at *7 (C.D. Cal., November 13, 2006) ("This boilerplate is merely a statement of the law of claim construction. It is certainly true, as the boilerplate states, that claims are not to be limited to illustrated embodiments. That said, if the inventors expressly say in the specification what the invention is, they will be held to their word."). Here, as discussed above, the disclosed "device manager," as defined by the Display Space Patents' specification, is such an essential characteristic.

e.g., Ex. 33 at 12 (7/20/07 Response). In responding to a prior art rejection, the applicants asserted that "communications between the operating system and the device driver may not take place after the operating system completes its initialization procedure . . . .", thus explicitly referring to the device driver as something separate from the operating system.

In addition, during prosecution of the '116 patent, the applicants distinguished the prior art – in order to receive the grant of the pending claims – on the basis that the prior art did not disclose "a device manager program" that was "an operating system component" that performed the determination that an attached device was a video display device. (Ex. 33 at 14 (7/20/07)). As a result, the applicants surrendered claim scope – this time surrendering any rights to the claimed methods in which the "detecting" and "determining" steps are performed by something other than an operating system component. *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998) ("[E]xplicit statements made by a patent applicant during prosecution to distinguish a claimed invention over prior art may serve to narrow the scope of a claim."); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995) ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.").

5. Both Of The Disputed Terms Require A Determination That The Attached Device Is A Video Display Device

With regard to the disputed term "detecting[ing][s] . . . a display device" in the '116 patent[7] Apple contends that it should not be construed to require any "determination" that the attached device is a video display device. (Apple's Br. at 44). In support of this argument, Apple quotes part of Claim 1 of the '646 patent, which lays out a two-step process of (1) "detecting the addition or removal of an input / output device . . ." and (2) "determining whether an input / output device which has been added or removed is a video device." (*See id*; *see also*

[7] In its Opening Brief, Apple inserts words into the term actually disputed between the parties. (Apple's Br. at 44). As identified by Motorola, the actual disputed term is "detecting . . . a video display device." Prior to its Opening Brief, Apple made no indication that it believed the words of "the addition or removal" were in dispute.

Ex. 6 at 8:57-61). Apple's reliance on the claim language of the "detecting" step in that claim is a slight of hand, as the disputed term of "detect[ing][s] . . . a display device" is found in claims 1, 19, and 33 of the '116 patent, not the '646 patent. (Ex.7 at 10-12).

Claim 1 of '646 Patent	Claim 1 of '116 Patent
1. A method for reconfiguring a computer system to accommodate changes in a display environment, comprising the steps of: ***detecting the addition or removal of an input/output device*** in the computer system; ***determining whether an input/output device*** which has been added or removed ***is a video device***, in response to said detection;	A method for reconfiguring a computer system to accommodate changes in a display environment, comprising the steps of: ***detecting the addition or removal of a display device*** in the computer system;

The disputed claim language of the '116 patent implicitly – and logically – requires that the device manager positively determine that an attached input / output device is actually a video display device. Indeed, how else could the device manager know that a display device has been attached to the system?

That both claim 1 of the '646 patent and claim 1 of the '116 patent require a determination that an attached device is actually a video display device was recognized by the USPTO Examiner during prosecution of the '116 patent. During prosecution, the Examiner initially rejected all of the pending claims of the '116 patent as being unpatentable over the claims of the '646 patent. (Ex. 34 at 2). The Examiner stated that "[a]though the conflicting claims are not identical, they are not patentably distinct from each other . . . ." (*Id.*). The applicants, upon receiving this rejection, filed a Terminal Disclaimer that limited the term of the '116 patent.[8] (Ex. 35 at 1).

[8] A terminal disclaimer limits the term of a patent. *See Western Union Co. v. MoneyGram Payment Systems, Inc.*, 626 F.3d 1361, 1364 (Fed. Cir. 2010); *Quad Envtl. Techs. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874 (Fed. Cir. 1991). In this case, the applicants agreed that the '116 patent would expire at the same time as the '646 patent.

Finally, Apple contends that "the claims unambiguously encompass detection of the additional or removal of a display device without excluding non-display devices." (Apple's Br. at 45). The plain language of the claims demonstrates the fallacy of this argument. The '646 patent claims require "determining whether an input/output device . . . is a video device" and the '116 patent claims require "detecting . . . a display device." (Ex. 30 at 1). Thus, both of these steps explicitly requires a positive identification of a "display device" -- which inherently requires the ability to distinguish between a display device and a non-display device.

For all of the foregoing reasons, Motorola respectfully requests that the Court adopt its proposed construction.

B. "Modifying The Allocation of Display Space" / "A Portion Of The Display Space To Be Modified"

Disputed Claim Phrase	Motorola's Proposed Construction	Apple Proposed Constructions
"modifying the allocation of display space"	"Changing the allotment of the global coordinate space available for use by display devices"	Plain and ordinary meaning applies or, in the alternative: "allocating or deallocating display space"
"a portion of the display space to be modified"	"An allotment of the global coordinate space, available for use by display devices, to be changed	Plain and ordinary meaning applies or, in the alternative: "a part of the display space to be allocated or deallocated"

The underlying dispute between the parties here is how to construe the term "display space." Here Apple has made two attempts to avoid construction of "display space." First, Apple contends that the "modifying the allocation of display space" and "a portion of the display space to be modified" terms have a "[p]lain and ordinary meaning" and thus should not be construed. (Apple's Br. at 41-44). Second, Apple's alternate constructions of the those terms fails to provide any construction for "display space." (*Id.*).

To the extent that this term has a "plain and ordinary meaning," it is the meaning provided in the Display Space Patents – i.e., "a global coordinate space." (Ex. 6 at 3:65-67). That a "display space" is defined by a "global coordinate space" – is well known in the computer

graphics industry. Indeed, Bas Ording, a named inventor on the '849 patent, and presumably one of skill in the art, could not even identify a display space that is not so defined. (Ex. 36 at 143:20-22 (Q. As far as you sit here today, you're not aware of any [screens] that do not have a coordinate system? A. No, I'm not….”). The term “display space” is clearly a term of art in the field of computer graphics, and thus requires construction in order to assist the finder of fact. Indeed, the common meaning of “display space” – and one probably more familiar to the finder of fact – could just as easily refer to a department store window. But that is not what the Display Space Patents are directed towards.

Apple also asserts that this meaning of "display space" is merely just a preferred embodiment. (Apple's Br. at 46). Apple is incorrect. The Display Space Patents state that one known implementation of a ***computer system*** is one that has a display environment generally defined by a global coordinate system . (Ex. 6 at 3:65-67). The Display Space Patents do not, however, state that one known implementation of a ***display space*** is a global coordinate system.

For all of the foregoing reasons, Motorola respectfully requests that the Court adopt its proposed construction.

IV. UNITED STATES PATENT NOS. 5,583,560; 5,594,509; AND 5,621,456

A. “Listing Means” / “Listing Interface Means”

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
listing means / listing interface means	*Corresponding Function*: Causing the A/V display to selectively display one level of the multiple levels of information related to an audio-visual program, that level containing a list of information (including at least channel numbers, channel names, and titles) about the viewable audio-visual programs *Corresponding Structure*: A	Apple believes that these phrases should be construed separately as follows: ’509 Under § 112 ¶ 6, the function is “causing an A/V display to selectively display a program listing that contains listing information related to A/V programs viewable on the A/V display.” The corresponding structure is: a combination of the CPU module 62, which receives the

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
	central processing unit (CPU), a system bus; an A/V decoder; a wireless control unit; a system memory unit; an A/V memory unit; a memory and bus controller; an A/V encoder; a highspeed digital A/V bus; an A/V processor; one or more tuners/demodulators, wherein one tuner/demodulator reads and displays a current program from one of the channels received; additional tuners/demodulators (or the same tuner/demodulator, used in alternation) to read and display data from the side-band channels in picture-in-picture (pip) windows; a remote control device including a transmitter for transmitting signals to the audio-visual system; and software applications that generate picture-in-picture windows, program listing information, program recording, and other interactive functions.	data stream of program listings, the system memory 65, which stores the section of the program listings most relevant to the user, A/V processor 77, which is "used to manipulate, process, render, mix, and otherwise rearrange digital data into coherent audio-visual displays," and A/V connect module 66, which "provides a graphic overlay function that superimposes an A/V signal from the video encoder 78 against another A/V signal" that allows "both signals to be simultaneously displayed on the TV." <u>'456</u> Under § 112 ¶ 6, the function is "causing an A/V display to selectively display a program listing." The corresponding structure is: a combination of the CPU module 62, which receives the data stream of program listings, the system memory 65, which stores the section of the program listings most relevant to the user, A/V processor 77, which is "used to manipulate, process, render, mix, and otherwise rearrange digital data into coherent audio-visual displays," and A/V connect module 66, which "provides a graphic overlay function that superimposes an A/V signal from the video encoder 78 against another A/V signal"

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
		that allows "both signals to be simultaneously displayed on the TV."

1. The Correct Structure Must Include Software And A Remote Control.

Regardless of the function that the Court ultimately concludes to be correct, the structure of the disputed terms must include software that enables that function. In its Opening Brief, Apple contends that Motorola's proposed structure for the "listing means" and "listing interface means" contain more structure than is necessary to perform the claimed function. (Apple's Br. at 37). Apple is incorrect.

As a matter of established Federal Circuit law, when a means-plus-function claim element is performed by a computer, the structure *must* incorporate the specific software algorithm corresponding to that function and disclosed in the specification. *See e.g.*, *Aristocrat Technologies Australia Pty Ltd. v. Int'l Game Technology*, 521 F.3d 1328, 1332-33 (Fed. Cir. 2008); *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241. 1253-55 (Fed. Cir. 2005); *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 1348-49 (Fed. Cir. 1999) Motorola's proposed construction for the structure of the disputed terms includes the software that – in combination with the hardware elements identified in Motorola's proposed structure – actually creates the program listing. The specification of the Florin patents states that "[t]he A/V hardware is complemented with an operating system software program with supports the functions provided in the present invention's audio-visual interface." (Ex. 11 at Abstract). The claims plainly state that the disputed "listing means" and "listing interface means" are part of that audio-visual interface. (*E.g.*, Ex. 11. at 27:23-28).

In contrast, Apple proposes that the court construe the structure of listing means to be a collection of purely hardware components: a central processing unit (CPU); an A/V processor; system memory; and an "A/V connect module," which the specification describes as a set of hardware including a switcher and tuner/demodulator that "switches and receives analog audio-

visual signals and digital data." (Ex.11 at 8:65-66; *see also id.* at 9:3-16). Although these hardware components are found in the "General System Configuration" section of the patent, as Apple notes, that section itself does not comprise the complete structure of the "listing means" function, for it does not discuss the selective display of program listing information, which both parties agree is included in the function of "listing means." For that reason alone, Apple's proposed structure is incomplete.

Moreover, Apple's proposed structure would be wholly unable to perform the stated function of the "listing means" – under either party's proposed function. For example, as proposed by Apple, the function is "***causing*** an A/V display to selectively display a program listing that contains listing information related to A/V programs viewable on the A/V display." The structure proposed by Apple (hardware without software) could not "cause" the display of anything on the A/V display. Apple's construction therefore violates the very legal rule Apple cites in its opening brief: The disclosed structure must include all components "necessary to perform the claimed function." (Apple's Br. at 37 (*citing JVW Enterprises, Inc. v. Interact Accessories*, 424 F.3d 1324 (Fed. Cir. 2005)).

While Apple contends that Motorola's construction is incorrect, its Opening Brief is devoid of any argument as to why the disclosed software program is not a necessary component of the "listing means" and "listing interface means" elements. (*See* Apple's Br. at 37). It does not because it cannot. The disclosed hardware, by itself, is simply unable to create any part of the user interface – including the program listing. Similarly, Apple's Opening Brief is also devoid of any argument as to why the remote control device should be excluded from the structure of these terms. (*See id.*). Again, Apple does not because it cannot – the Florin Patents specification explicitly states that the remote control is a necessary part of creating the program listing. (*See* Ex. 11 at 15:30-32 & Abstract). In fact, the only portion of the structure identified by Motorola that Apple even attempts to argue should not be included is the "tuner/demodulators . . . to read and display data from the side-band channels in picture-in-picture (pip) windows." (Apple's Br. at 37). Nonetheless, Apple again has no basis for excluding this structure. The

tuner/demodulator plays a key role in helping to read and display digital listing information as visual data with which the user can interact. (*See* Ex. 10 at 8:61-9:1). The creation of a program listing is included in either parties' proposed function for these disputed terms. (*See* Ex. 30 at 1-2). Thus, the structure for the "listing means" and "listing interface means" elements must also contain the tuner / demodulators. *See B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997).

Finally, Apple contends that statements in the Florin Patents' prosecution history support its proposed structure for these terms. (Apple's Br. at 37). Again, Apple is incorrect. The cited pages do not discuss the structure that performs the function of "listing means" or "listing interface means." Rather, the cited pages lists structure that the applicant contended performed the function of a different limitation in the asserted '509 patent claims, the "interface generation means." (*See* Apple's Br. Ex. 19 at 20-21). Contrary to Apple's statement in footnote 15, the structure is not described as corresponding to both the interface generation means and the listing means; although the cited document does later refer to the listing means, it is in an entirely different context than the discussion of the "interface generation means" structure.

For all of the foregoing reasons, Motorola respectfully requests that the Court adopt its proposed construction.

2. The Correct Function

The parties disagree on the scope of the function of "listing means" and "listing interface means." Apple contends that Motorola is improperly relying on the specification to insert additional limitations into a function that did not appear in the claim language. Apple is incorrect. The function of a means-plus-function claim may not be "improperly broadened by ignoring the clear limitations contained in the claim language;" rather, it "must be construed to include the limitations contained in the claim language." *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003).

Here, Motorola's proposed function for "listing means" and "listing interface means" is based on the clear limitations contained in the claim language, with the aid of the specification.

(Moto. Br. at 21). The claims implicitly limit the function of these disputed terms to the display of a single level of multiple possible levels of information. (Ex. 11 at 27:9-32). The "listing means" and "listing interface means" limitations are a discrete part of a broader "interface generation means," which is a means for displaying multiple levels of information. (*Id.* at 12:15-18).

For all of the foregoing reasons, Motorola respectfully requests that the Court adopt its proposed construction.

B. "Listing Interface"

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
Listing Interface	A software application executing on the CPU causing the A/V display to selectively display one level of the multiple levels of information related to an audio-visual program, that level containing a list of information (including at least channel numbers, channel names, and/or titles) about the viewable audio-visual programs	Plain and ordinary meaning applies or, in the alternative: "an interactive interface for listing A/V program information"

There is no plain and ordinary meaning for this term. Indeed, in its Opening Brief, Apple provides no support for its assertion that a jury would understand its scope and meaning. (*See* Apple's Br. at 35). This fact, and the dispute between the parties as to its meaning, is the basis for Motorola's request that it be construed. Again, the creation of the disclosed user interface – of which the listing interface is a part – requires both software and hardware. (*See* Ex. 10 at 15:10-16:49). Only Motorola's proposed construction accurately reflects this necessity. (*Compare* Ex. 30 at 3 (central column, Motorola's construction) ("A software program executing on the CPU . . . .") *with* Ex. 30 at 3 (right column, Apple's construction) ("an interactive interface . . . .").

Apple contends that the "listing interface" should not include the very information that makes up the program listing disclosed in the specification of the Florin Patents. (Apple's Br. at 35). In doing so, Apple ignores the disclosure of the Florin Patents specification, which states

that the program listing functionality of the user interface provides "a program/service listing for the current date and time during which the user is watching television." (Ex. 11 at 15:31-33). The disclosed program listing includes "channel numbers, channel name identifiers . . . and by titles of the programs/services." (*Id.* at 15:36-39). Further, the program listing is but one part of the claimed user interface, which includes "selectively displayed multiple levels of information related to an audio-visual program." (*Id.* at 25:35-37).

Contrary to Apple's contentions, this program list functionality are not examples of a preferred embodiment of the "listing interface," but a description of the invention itself. (*See, e.g.*, Ex. 10 at 15:12-13 ("Referring now to FIG. 12, ***the list function of the present invention*** will be described." (emphasis added)). When a patent "describes the features of the 'present invention' as a whole, this description limits the scope of the invention." *TiVo, Inc. v. EchoStar Communications Corp.*, 516 F.3d 1290, 1300 (Fed. Cir. 2008); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007); *Honeywell Int'l Inc. v. ITT Indus., Inc.*, 452 F.3d 1312, 1318-19 (Fed. Cir. 2006) ("Use of the terms 'this invention' and 'the present invention' in the specification establish that the patentee intended to limit the meaning of a term to that disclosed in the specification."); *See also Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1324 (Fed. Cir. 2008); *Kinetic Concepts, Inc. v. Blue Sky Med. Group, Inc.*, 554 F.3d 1010, 1018-19 (Fed. Cir. 2009); *SafeTCare Mfg., Inc. v. Tele-Made Inc.*, 497 F.3d 1262, 1270 (Fed. Cir. 2007). Indeed, the specification of the Florin Patents states that this program information is an integral part of the listing interface. (*See* Ex. 10 at 15:17-324; *see also* FIG. 12).

Apple also contends that generalized "catch-all" language in the Florin Patents specification provides a basis for not construing the claims in a manner consistent with the rest of the specification. (Apple's Br. at 35). While it may be true that the Florin Patents contain generalized "catch-all" language (again, as most patents do), that language does not apply where, as here, specific elements have been recited in the claim language. *See Fromson v. Anitec Printing Plates,* 132 F.3d 1437, 1447 (Fed. Cir. 1997) (rejecting boilerplate statement that other "suitable liquids" could be used as insufficiently specific); *Les Traitments Des Eaux Poseidon,*

Inc. v. KWI, Inc., 135 F.Supp.2d 126, 135 (D. Mass. 2001) (assigning "little weight" to boilerplate language in specification indicating general description of invention was "non-restrictive"); *Wavestream Corp. v. CAP Wireless, Inc.,* 2006 WL 5104656 at *7 (C.D. Cal., November 13, 2006) ("This boilerplate is merely a statement of the law of claim construction. It is certainly true, as the boilerplate states, that claims are not to be limited to illustrated embodiments. That said, if the inventors expressly say in the specification what the invention is, they will be held to their word.").

C. "Control Means In Communication With"

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
Controller in communication with	A hand-held remote control containing a transmitter for transmitting signals wirelessly to the transceiver.	Apple believes that these phrases should be construed separately as follows: '560 Plain and ordinary meaning applies or, in the alternative: "controller that sends commands to"
Control means in communication with	This element is subject to U.S.C. § 112 ¶ 6. ***Corresponding Structure:*** A hand-held remote control containing a transmitter. See, e.g., Abstract; col. 8:42-46. ***Corresponding Function***: transmitting signals wirelessly to the transceiver	'509 Under § 112 ¶ 6, the function is "sending commands to the transceiver to allow a user to selectively display multiple levels of information on an A/V display." The corresponding structure is: remote control 60 or equivalent structure. '456 Under § 112 ¶ 6, the function is "sending commands to the transceiver to allow a user to display A/V programs on an A/V display." The corresponding structure is: remote control 60 or equivalent structure.

1. The Correct Function

In its Opening Brief, Apple asserts that its proposed function of the "control means" element "tracks the claim language nearly verbatim." (Apple's Br. at 38). This is not correct. Apple simply ignores the language immediately following "control means" in the term in dispute– *i.e.*, "control means in communication with." (Ex. 11 at 27:19). This "in communication with" language is central to the function of the "control means" element. The Florin Patents clearly states that the "remote control" device – the only control means disclosed in the specification– "communicates with the transceiver 54 preferably through a wireless transmission signal." (*Id.* at 8:41-44). The only communication between the remote control and the transceiver that is disclosed in the Florin Patents is a wireless transmission of signals. (*Id.* at 13:7-15).

2. Apple Failed To Dispute Motorola's Proposed Structure

Apple's contention that there is no dispute between the parties' proposed structures of "controls means" is incorrect, as discussed fully in Motorola's Opening Brief. Apple fails to provide any argument with regard to this issue in its Opening Brief, and should therefore be precluded from asserting any new arguments in its Reply. *See Local Rule* 7.1.C; *Fromm–Vane v. Lawnwood Med. Ctr., Inc.*, 995 F.Supp. 1471, 1475 (S.D. Fla., 1997) (relying on Local Rule 7.1.C, court refused to consider new argument raised for first time in reply memorandum); *Martinez v. Weyerhaeuser Mortgage Co.*, 959 F.Supp. 1511, 1515–16 (S.D. Fla., 1996) (pursuant to Local Rule 7.1.C., court struck portion of reply memorandum that raised new issues).

D. "Controller In Communication With"

As Motorola predicted in its Opening Brief, (Motorola's Br. at 28-29), Apple ignores the "in communication with" language of this disputed term. (*See* Apple's Br. at 37-38). The plain and ordinary meaning of a device that is "in communication with" another device indicates that there is a physical separation between them. *See* Ex. 37 (communications are "the various electronic processes by which information is conveyed from one person or place to another, especially by means of wires, cables, or radio waves."). The Florin Patents specification is

consistent with this ordinary meaning, as it discloses a controller that is separate from the transceiver itself and that communicates wirelessly via a transmitter. (Ex. 11 at 13:7-15).

In support of its construction, Apple argues that the disclosed hand-held remote control is but only one preferred embodiment. (Apple's Br. at 38). Apple is incorrect. Not only is the hand-held remote control the ***only*** disclosed embodiment, but the Florin Patents specification makes clear that the hand-held remote control is a necessary part of the "present invention." (*See, e.g.*, Ex. 10 at 4:7-15 (listing figures that illustrate embodiments of "the remote control device of the present invention"); *id.* at 11:15-12:67 (discussing hand-held remote controls in the context of the "general system configuration" of the invention)); *see also* Ex. 11, Abstract ("Additionally, a remote control device is provided to communicate with the A/V transceiver….) Again, when a patent "describes the features of the 'present invention' as a whole, this description limits the scope of the invention." *TiVo*, 516 F.3d at 1300; *see also* "present invention" cases cited in "listing means" discussion *infra*. It follows that a "controller" must be a hand-held remote control.

Finally, given the purpose of the patent—to create an "*improved* user interface" (Ex. 10 at 2:21), including a "user-friendly mechanism for consumers to view, record, and play back TV and A/V programs" (*Id.* at 2:7-12)—common sense dictates that "controller in communication with" is a remote control. A non-wireless controller system would hardly improve the technology available at the time, as described in the "Art Background" section of the patent (*Id.* at 1:19-2:16) and certainly would not provide a more "user-friendly interface" than the past art. One need only imagine a user standing directly in front at her television to access the set box to understand that this could not have been what the Florin Patents contemplate.

Since Motorola's construction of "controller in communication with" contains these necessary limitations, and since Apple's construction of "controller in communication with" is inappropriately broad, Motorola requests that the Court select Motorola's construction.

V. THE MOTOROLA PATENTS

A. The '119 Patent

1. "Responsive to Receiving the Second Message, Transmitting a Third Message" Does Not Need to Be Construed

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
"responsive to receiving the second message, transmitting a third message"	Ordinary meaning – this phrase requires no additional construction.	"upon receiving the second message, automatically transmitting a third message"

As Motorola explained in its opening brief, the claim phrase "responsive to receiving the second message, transmitting a third message" is comprised of simple and ordinary language that a jury will easily understand. (Motorola's Br. at 40-41). In such circumstances, the Federal Circuit has consistently held that there is no need for a construction simply because a party contends it is necessary. S*ee Phillips*, 415 F.3d at 1314; *O2 Micro*, 521 F.3d at 1362 ("district courts are not (and should not be) required to construe every limitation present in a patent's asserted claims") (emphasis in original); *U.S. Surgical*, 103 F.3d at 1568 ("resolution of disputed meanings and technical scope . . . is not an obligatory exercise in redundancy").

In fact, Apple does not challenge the ordinary meaning of the actual words in this claim phrase. (Apple's Br. at 5). Apple's proposed construction – "upon receiving the second message, automatically transmitting a third message" – essentially just repeats the words of the claim phrase verbatim ***but also*** inserts the substantively narrowing word "automatically" into the claim. *Id.* Apple's construction is thus apparently an attempt to avoid infringement by reading non-existent limitations into Motorola's patent claims through claim construction. This strategy is improper and should be rejected.[9] *Phillips*, 415 F.3d at 1323.

Apple sets up its arguments that this disputed claim phrase should be limited in light of references to certain embodiments of the "present invention" in the specification and prosecution

[9] Unlike the terms of Apple's patents for which Motorola has sought constructions, Apple has proposed that the Court construe terms in Motorola's patents that (1) were not defined by the patentee in the specification, (2) were not part of the surrendering of claim scope during prosecution, and (3) do not have a more limited meaning than their plain and ordinary meaning.

history. But this is a red herring. (Apple's Br. 6-9). What these references describe is a method that is performed "automatically" by the devices and infrastructure carrying out the method, *i.e.*, there is no need for a user to manually synchronize transceivers. (Motorola's Br. at 39; *see also* Ex. 17 at 6:38-39 ("This has the advantage of alleviating the inconvenience of [a user] changing the status of unread messages in [transceiver] 150."); Apple's Br., Ex. 1 at 5 ("[S]tatus change is made by the user on the first [transceiver] … [and] [a]ccording to the invention … The user may then switch to using the second [transceiver] without having to manually change the status of the message on the second [transceiver]."); Ex. 38 at p. 4 (defining "automatically" to mean "pertaining to a function, operation, process, or device that…functions without intervention by a human operator").[10]

This aspect of the invention, however, does not require the claimed "wireless messaging infrastructure" to perform this "automatic" task, as Apple suggests, without "an intervening action between receipt of the second message and transmission of the third [message]" by the infrastructure. (Apple's Br. at 6). To the contrary, as explained in Motorola's opening brief, the specification expressly contemplates that the infrastructure delays its transmission of the third message: "Infrastructure 110 receives [the second] message 240 at step 245…" and "[t]he [third] message is then submitted to a message queue of the infrastructure 110 for transmission by the infrastructure." (Motorola's Br. at 41 (*citing* Ex. 17 at 6:10-13)). Thus, while the '119 patent specification and prosecution history describe a method that is performed automatically, *i.e.*, without intervening ***user*** action, there is nothing in the specification or prosecution history that supports Apple's insertion of the word "automatically" in this particular claim element.. (*See* Apple's Br. at 6-9; Apple's Br., Ex. 1 at 4, Ex. 2 at 3-4; *Motorola's Br.,* Ex. 17 at 1:45-47, 1:66-2:2, 2:5-28, 6:10-14, 10:50-54). Apple's proposed construction is therefore incorrect and should be rejected.

[10] Apple's proposed construction would only serve to cause more confusion to the jury, as it is very likely that Apple and Motorola would disagree on what "automatically" means.

2. The Claim Phrase "indicative of the second status" Does Not Need To Be Construed

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
"indicative of the second status"	Ordinary meaning – this phrase requires no additional construction, but in the alternative, "providing an indication of the second status"	"descriptive of the changed status"

Apple's argues in favor of its construction that "indicative of a second status" must be "descriptive of the second status, rather than merely indicating the occurrence of a status change. In other words, Apple's construction requires that the status change message include the content of the status change (*e.g.*, that a particular message has been deleted on the device) and not just a general indication that there has been some type of status change." Apple's proposal is thus a complete re-write of the plain language in Apple's preferred parlance in an another attempt to manufacture a non-infringement argument.[11] (Apple's Br. at 9-11). This strategy is also improper and should be rejected. *Phillips*, 415 F.3d at 1323.

Apple contends that the Court should adopt its proposed construction because messages "indicative of the second status" are supposedly described in the context of communicating some unidentified "descriptive" content of changed status. (Apple's Br. 9-12). This is unsupported by either law or fact. As a general rule, while a court may read a claim in light of a specification, it may not read a limitation from the specification into a claim. *See Phillips*, 415 F.3d at 1323 (courts should "avoid importing limitations from the specification into the claims"); *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1355 (Fed. Cir. 2003) (rejecting construction limited to description of preferred embodiment and giving claims their ordinary meaning in absence of clear disclaimer). As a result, even if the specification and prosecution history

[11] The claim phrase "indicative of the second status" is also comprised of plain and ordinary language that does not require construction. (*See* Motorola's Br. 41-43; *see also Phillips*, 415 F.3d at 1314; *O2 Micro*, 521 F.3d at 1362; *U.S. Surgical*, 103 F.3d at 1568). It means what it says and there is no need to vary its ordinary meaning. *Id.*

describe "communicating" status changes that Apple contends are "descriptive" of status changes (which Motorola disputes), Apple cannot simply import a limitation from the preferred embodiment to vary the plain claim language (and there is no disclaimer in the intrinsic record that would allow Apple to do so). Accordingly, the plain meaning of the claim language should prevail.

In addition, the specification and prosecution history excerpts that Apple identifies as "support" for its improper construction demonstrate the fallacy of its proposed construction. For example, the specification provides the following description for Figure 3, which Apple contends supports its proposed construction:

> The status change information field 243 comprises, in this embodiment, a status change control signal indicating that status change information (rather than some other type of information) follows, and ***three bits of status change information: a read/unread bit, a protect bit, and a delete bit. These three bits indicate the corresponding status of the identified message***.

(Ex. 17 at 5:67-6:6 (emphasis added). This embodiment is shown in Figure 3 below:

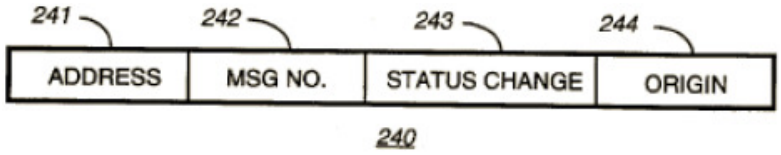


FIG. 3

Id., Fig. 3.

As explained in Motorola's Opening Brief, this excerpt relating to Figure 3 describes the "status change" of messages sent to and from the wireless messaging infrastructure as containing three bits: a single binary value of either 0 or 1 for the read/unread bit, protected/unprotected bit, and deleted/not deleted bit. (Motorola's Br. at 43 (citing Ex. 17 at 5:67-6:6)). The binary value (0 or 1) can therefore be "indicative" of the status of a message if it is associated with a particular status, even if the value is not "descriptive" of the content of a message. (*See* Motorola's Br., Ex. 19). In other words, although a number value may not "describe" a message as read or unread,

where the number for a particular field is known to have one value where a message is read and another where it is unread, the value can "indicate" the status of the message.

Moreover, Apple's argument that its "construction is required in order for the method to fulfill its [supposedly] stated purpose" in the specification of communicating status changes, (Apple's Br. at 9-11), finds no support in the law. Indeed, it is also improper to limit the scope of a claim to arrangements having particular advantages or benefits ascribed to a disclosed embodiment. *See, e.g., Sigma-Aldrich, Inc. v. Open Biosystems, Inc.*, 521 F. Supp. 2d 975, 991 n.9 (E.D. Mo. 2007) (finding "without merit" defendant's argument that "the claims must be limited to embodiments that have particular 'advantages' disclosed in the specification"); *Phillips*, 415 F.3d at 1327 ("Although deflecting projectiles is one of the advantages of the baffles of the [asserted] patent, the patent does not require that [the baffles] always be capable of performing that function."). "The fact that a patent asserts that an invention achieves several objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives." *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 908 (Fed. Cir. 2004). Further, a method implemented as in the embodiment described in Figure 3 will fulfill the stated purpose of communicating status changes between devices and the infrastructure performing the method vis-à-vis the binary values associated with particular status changes and bits. Indeed, Figure 3 discloses one of the preferred embodiments of the invention that performs the supposed stated purpose of the invention.

For all these reasons, Apple's proposed construction is not only wrong but also unnecessary and should be rejected.

B. The '987 patent

1. "The Antenna … Is Disposed Between an Outside Surface of the Housing and the At Least a Portion of the User Interface" Does Not Need To Be Construed

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
"the antenna . . . is disposed between an outside surface of	Ordinary meaning – this phrase requires no	"the entire antenna is placed between the outside surface of

the housing and the at least a portion of the user interface"	construction, but in the alternative, "the antenna . . . is arranged between an exposed surface of the housing and at least a portion on the user interface"	the receiver's case and the portion of the user interface surrounded by the antenna"

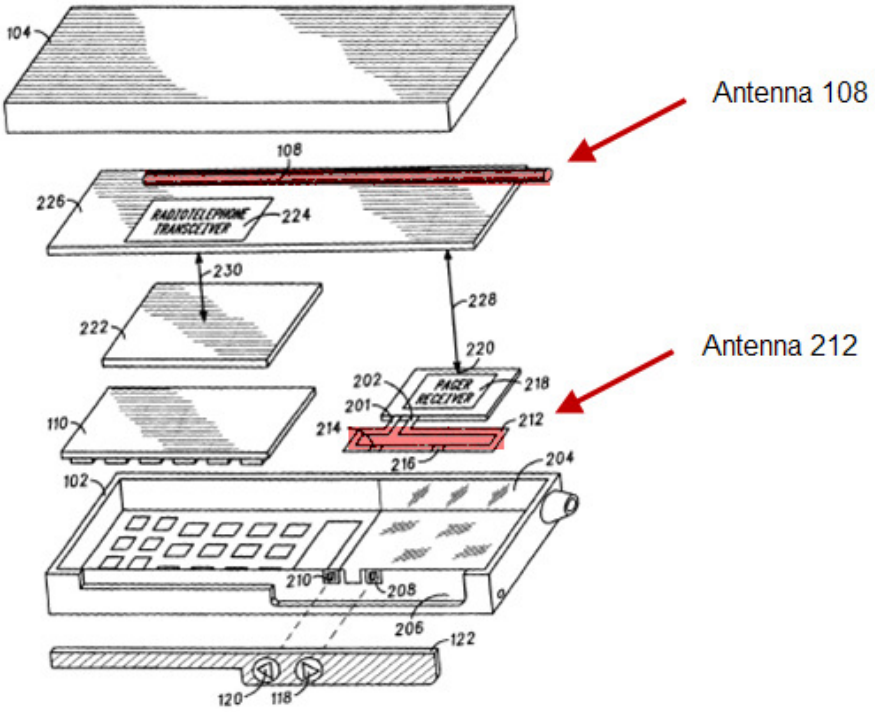
The claim phrase "the antenna … is disposed between an outside surface of the housing and the at least a portion of the user interface," like many other phrases in the asserted Motorola patents that Apple has identified for construction, is comprised of non-technical, simple words that can be understood by their ordinary meaning, and have no separate meaning to one of skill in the art. (Motorola's Br. at 45; *Phillips*, 415 F.3d at 1314). If the Court is inclined to construe this phrase, the intrinsic record supports Motorola's alternative construction of the phrase to mean "the antenna … is arranged between an exposed surface of the housing and at least a portion on the user interface." (Motorola's Br. at 44).

Apple's proposed construction, on the other hand, attempts to artificially narrow this claim language by adding three limitations to the claims. Specifically, Apple proposes limiting the claim language (1) "the antenna" to "the ***entire*** antenna," (2) "the housing" to "the ***receiver's case***," and (3) "the at least a portion of the user interface" to "***the portion of the user interface that is surrounded by the antenna***." (Apple's Br. at 21). As explained below, these limitations are not supported by the claim language, the specification or the prosecution history.

Apple's first limitation – "the ***entire*** antenna" – is another example of Apple inserting words into the claim, apparently to manufacture a non-infringement argument. In "support" of this limitation, Apple contends that because the antecedent basis for antenna – "an antenna coupled to the receiver circuitry" – does not refer to only "a portion" of the antenna that any reference in the claim to "the antenna" necessarily refers to "the ***entire*** antenna." (Apple's Br. at 21). This conclusion is as incorrect as it is illogical. There is nothing in the claim language that even suggests that the antecedent basis for "the antenna" refers to the ***entire*** antenna. In fact, the claim language read in light of the specification and in view of Figure 2 show in part below rather indicates that only a portion of the antenna (108 and 212) would be "coupled to the

receiver circuitry," as opposed to the entire antenna. (*See* Motorola's Br., Ex. 22 at FIG. 2). Apple's antecedent basis argument simply does not withstand scrutiny, and given that the claim language does not require the "***entire*** antenna," the plain meaning should prevail.

Apple's second limitation – replacing "the housing" with "the ***receiver's case***" – is another instance in which Apple improperly re-writes the claim language in its own words.



Here, Apple attempts to support this limitation with nothing other than citations to a preferred embodiment disclosed in the specification and its own biased characterization of prior art considered during prosecution. (Apple's Br. at 23-24). For example, Apple contends that its construction is required simply because "[a]ll four of the preferred embodiments and five of the figures [allegedly] refer to the housing as the receiver's case." (*Id.*). As explained above, however, the Federal Circuit has repeatedly held that courts should "avoid importing limitations from the specification into the claims" and there is no disclaimer that would allow Apple to do so. *Phillips*, 415 F.3d at 1323. Similarly unavailing is Apple's contention that its construction is proper because the patentee allegedly described the "main body" of a prior art cellphone as "analogous" to the "housing" claimed in the '987 patent and, in Apple's opinion, the "main body" of the prior art cell phone is the "receiver's case." (Apple's Br. at 23).

Courts may only depart from the ordinary meaning of a claim term in limited circumstances and "claim terms take on their ordinary and accustomed meanings unless the

patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex*, 299 F.3d at 1327. Here, the patentee's comparison of the "main body" of a prior art cell phone to the claimed "housing" does not amount to a clear disavowal of claim scope, much less the logical leap that Apple asks the Court to make in arguing that the "main body" is synonymous with a "receiver's case." In fact, Apple's conclusion that the "main body" is the "receiver's case" is belied by the prior art figure illustrated in Apple's opening brief:

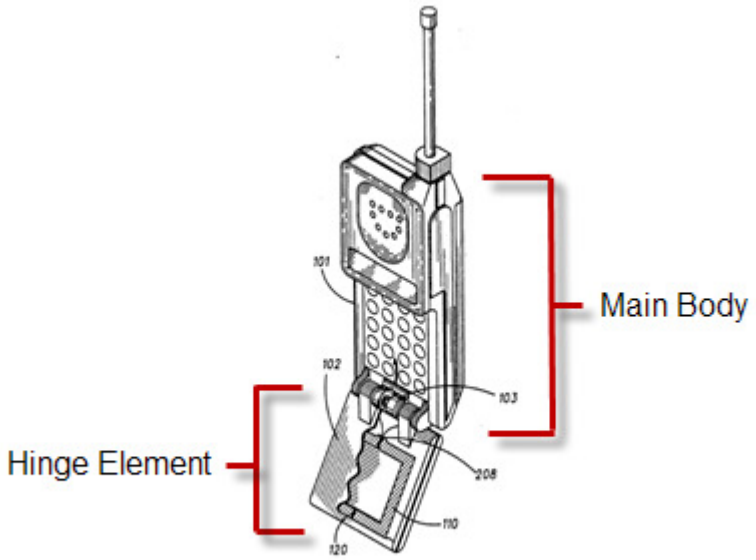


FIG.1

(Apple's Br. at 23). As shown above, the "main body" 101 refers to the upper half of the prior art cellphone while the "hinge element" 102 refers to the lower half of the phone. Nothing about these components of the phone or the description of them in the specification, however, suggests that the "main body" is limited to the "receiver's case."

Apple's third limitation – "***the portion of the user interface that is surrounded by the antenna***" – merely parrots other claim language and again incorporates its erroneous "***entire*** antenna" limitation into the claim. Indeed, Apple argues in support of this limitation that "Motorola [allegedly] confirmed that the entire antenna must be placed between the outside

surface of the [housing] and the same portion of the user interface that the antenna surrounds." (Apple's Br. at 25). Because this limitation merely repeats other claim language and incorporates Apple's flawed "entire antenna" limitation, it is redundant and compounds the errors in Apple's construction. As a result, the plain and ordinary meaning of the claim phrase should prevail. Furthermore, if construction is required, contrary to Apple's assertions, Motorola's alternative construction – "the antenna … is arranged between an exposed surface of the housing and at least a portion on the user interface" – does not render the claim indefinite. (Apple's Br. at 24-25). Motorola's alternative construction rather requires at least a portion of the antenna surrounding the user interface referenced earlier in the claim, but not the ***entire*** antenna, to be arranged between an exposed surface of the housing and at least a portion of the user interface that is also surrounded by the antenna. This is entirely consistent with the prosecution history and the claim language and should be adopted if the Court is inclined to construe this claim phrase.

For all these reasons, Apple's proposed construction should be rejected, and if construction is required, the Court should adopt Motorola's alternative construction.

C. The '737 Patent

1. "Address Identifying the Portable Communication Device" Does Not Need To Be Construed

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
"address identifying the portable communication device"	"Ordinary meaning – this term requires no construction, but in the alternative, some reference uniquely identifying the portable communication device"	"a number used to direct messages that uniquely identifies a portable communication device"

The claim phrase "address identifying the portable communication device" is also comprised of simple words that the jury will understand, rendering construction unnecessary. (Motorola's Br. at 48-49; *see also Phillips*, 415 F.3d at 1314). Apple again, however, attempts to completely rewrite the claim language to mean "a number used to direct messages that uniquely

identifies a portable communication device." While the parties appear to agree, if construction is required, that the claim phrase requires the "address" to "uniquely identify" the portable communication device with numbers or some other character. (*Id.*; Apple's Br. at 28). Apple also contends that the "address" must be used to direct messages to the communication device. (Apple's Br. at 28). There is nothing in the claim language, specification, or prosecution history that requires this added limitation. (Motorola's Br. at 48-49). An address is simply an identifier and there is nothing that explicitly or implicitly requires the address to affirmatively "direct messages to the communication device."

In fact, Apple primarily relies on extrinsic evidence to support this erroneous added limitation and yet even the evidence Apple cites does not require the "address" be used to direct messages to the device. (*See, e.g.,* Apple's Br. at 28-29, Ex. 12 ("The IBM Dictionary of Computing [supposedly] further supports Apple's construction, defining 'address' as '(1) A character or group of characters that **identifies** a register, a particular part of storage, or some other data source or destination.")). Instead, this definition supports Motorola's construction of the claim phrase and demonstrates the problem with Apple's construction.

Apple's purported reliance on the '737 specification and prosecution history to support its construction is similarly misguided. First, Apple argues that its construction is proper merely because "the sole embodiment described in the '737 patent [is allegedly] pagers" and, according to Apple, a pager's address is its telephone number, which is used to send messages to the pager. (Apple's Br. at 29). As explained above, however, courts should "avoid importing limitations from the specification into the claims." *Phillips*, 415 F.3d at 1323. There is nothing about the disclosure of a pager in the specification that limits the claimed "address" to a telephone number or that would require the "address" be used to direct messages to the communication device. Rather, again, the "address" provides a unique identifier for a device.

Second, Apple argues based on the prosecution history that the patent applicant supposedly distinguished a prior art reference that disclosed a number that merely uniquely identifies the device, which according to Apple constitutes a disclaimer. (Apple's Br. at 30). On

the contrary, it is clear from the '737 patent prosecution history excerpts cited by Apple that statements concerning the prior art reference raised in Apple's briefing merely distinguished the art on the basis of it not disclosing a system or method that utilized (1) a software name, (2) a secure checksum, and (3) an address identifying the portable portion of the system. *Id.* In other words, the statements regarding the prior art were not made to distinguish the "address" of this invention from the unique identifier disclosed in the prior art but rather to show that the prior art reference simply did not collectively contain all of the essential elements of the claim. This certainly does not rise to the level of "words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Teleflex*, 299 F.3d at 1327. Apple's suggestion that this prosecution history supports its construction should therefore be disregarded.

For all these reasons, Apple's proposed construction should be rejected.

D. The '531 Patent

1. "Filtered Data Unit" Does Not Need To Be Construed

Disputed Claim Phrase	***Motorola's Proposed Construction***	***Apple's Proposed Construction***
"filtered data unit"	Plain meaning; or "a data unit that has been filtered"	"one of a subset of data units at the host device that are selected for download to the client communication unit based on having passed a filter"

As explained in Motorola's opening brief, the Apple's proposed construction for the claim term "filtered data unit" is not supported by the intrinsic evidence.[12]

Apple proposes that the filtered data units be limited to being located "at the host device" before downloading to the client communication unit. (Apple's Br. at 16). This proposed limitation would exclude from the definition, however, any data units that are stored at location, for example, connected to the host device like network attached storage. This limitation also

[12] In any event, this term requires no construction because it has a straightforward ordinary meaning that is self-evident, it refers to "a data unit that has been filtered." (Motorola's Br. at 34; *see also Phillips*, 415 F.3d at 1314).

excludes any data units that are filtered at another place – namely, the communications server that sits between the host device and the communications unit. Contrary to Apple's assertion that data units must be present only on the host, the claim language and specification make clear that filtered data units, although possibly originating on the host, can also originate on the communications server or the remote device. (Motorola's Br. at 31-33; Ex. 14 at 18:9-11, 3:9-14, 9:11-16.) Apple's proposed construction seeks to import a limitation from a preferred embodiment disclosed in the specification and, in so doing, rewrite the claim language. This is improper. *Phillips*, 415 F.3d at 1323.

Apple notably failed to address this evidence in its opening brief. Instead, Apple argues that failing to filter before download to the remote device is counter to the "purpose of the invention," which Apple describes as limiting the size of data transmissions to the remote user. Apple's Br. at 17. As a preliminary matter explained above, it is improper to limit the scope of a claim to arrangements having particular advantages or benefits ascribed to a disclosed embodiment. *See, e.g., Sigma-Aldrich*, 521 F. Supp. 2d at 991 n.9; *Phillips*, 415 F.3d at 1327; *Liebel-Flarsheim*, 358 F.3d at 908. Even if this purpose was required, it also does not follow, however, that all filtering must be at the host. Indeed, the same filter applied at the communications server would be equally effective in limiting data transmissions to the remote user. There is no need to arbitrarily require the filtered data units to reside at the host or to require that the filtering happen at the host as opposed to the communications server.

Apple also argues that the "filtered data unit" must be a subset of data units that "require a different label" from other units. (Apple's Br. at 16). Not so. This argument ignores the possibility that 100 percent of the data units meet the requirements of the filter, and therefore all of the data units, not just a "subset," would be downloaded to the communication device as "filtered data units." In fact, the claim language and specification do not suggest or even mention that the claimed “filtered data units” must belong to "subset."

As explained above, nothing in the '531 patent supports Apple's proposed construction of the term “filtered data units.” Apple’s construction is still another obvious attempt to

manufacture a non-infringement argument by limiting the claims to a preferred embodiment. This is improper under *Phillips*, and Apple's proposed construction should be rejected.

2. "Wireless Network" Does Not Need To Be Construed

Disputed Claim Phrase	***Motorola's Proposed Construction***	***Apple's Proposed Construction***
"wireless network"	Ordinary meaning – this term requires no additional construction, but in the alternative; "two or more devices whose interconnection(s) is implemented, at least in part, without the use of wires"	"a network in which the communication server is connected to both the host device and the client communication unit through a completely wireless path"

The parties continue to dispute whether the term "wireless network" needs to be construed and, if it does, how to construe it.[13] Apple's proposed construction – "a network in which the communication serves is connected to both the host device and the client communication unit through a completely wireless path" – imports an unnecessary limitation that not only defies common sense but also contradicts the specification. This blatant rewriting of the claim language is improper and should be rejected. *Phillips*, 415 F.3d at 1323.

Apple's made-for-litigation construction is even at odds with how Apple normally refers to wireless networks. For instance, when describing the wireless functionality of its own routers and network hubs used at homes and at work, Apple recognizes that a "wireless" network can also include some wires in or connected to the devices. For example, the below illustrates a wire between a printer and a router, even while Apple refers to this as "Wireless Printing."

[13] As explained in Motorola's opening brief, the court need not construe "wireless network" because it has a plain and ordinary meaning. (Motorola's Br. At 36; *Phillips*, 415 F.3d at 1314). If the Court is inclined to construed the term, Motorola proposes that the Court construe the term to mean "two or more devices whose interconnection(s) is implemented, at least in part, without the use of wires." (Motorola's Br. at 36). This alternative construction is amply supported by the intrinsic and extrinsic evidence. (*Id.* at 36-38).

(Ex. 39; *see also* 40, and 41). Every lay person that has used a wireless network understands this fact – in fact, there is no such wireless network, as Apple hypothecates, that exists to this day. Nevertheless, as "support" for this construction, Apple argues that the claim language "states that the network contains no wires between the client communication unit and the host device." (Apple's Br. at 18). On the contrary, the claim language simply requires "a method of communicating over a wireless network between a client communication unit and a host device." (Ex. 14 at 16:27-46). Nowhere does this claim language state or even imply, as Apple suggests, that the network must be devoid of wires. Rather, there simply must be some part of the communication that occurs over a wireless portion of the network. Moreover, as explained in Motorola's opening brief, the specification explicitly contemplates embodiments in which the communication between the devices on the network occurs in part over a wireless network and in part over wired connections. (Motorola's Br. at 37-38; (*citing* Ex. 14 , FIGS. 1 & 2)). At bottom, Apple's proposed limitation is simply spun from whole cloth where it is neither present in the claim language nor required by the specification or prosecution history.

Apple also asserts that during re-examination of the '531 patent that Motorola acquiesced to a statement by the patent examiner that allegedly supports Apple's proposed construction of "wireless network." (Apple's Br. at 18-20). This argument is without merit. The patent examiner's statement identified by Apple was unilateral, and, since the examiner made it while confirming patentability, Motorola had neither an obligation nor a need to file any response correcting the examiner's statement. An "examiner's unilateral remarks alone do not affect the scope of the claim, let alone show a surrender of claimed subject matter." *Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1347 (Fed. Cir. 2005). Consequently, "an applicant's silence regarding statements made by the examiner during prosecution, without more, cannot amount to a 'clear and unmistakable disavowal' of claim scope." *Id.* at 1346. Moreover, the patent examiner's statement does not state that the *entire* network need be wireless. (*See* Apple's Br. Ex. 3 at 2-3).

Of course, Apple makes much ado about a recent change to the federal regulation that allows a patentee (if they so choose) to file a response to an examiner's stated reasons for allowance. *Compare* 37 C.F.R. 1.109 (1996) *with* 37 C.F.R. 1.104(e)(2010). The updated regulation excised a sentence that read, "Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner." Apple argues that the deletion of this sentence imposed an affirmative obligation on Motorola to comment on the examiner's reasoning or be presumed to acquiesce in the examiner's alleged limitation of the claim's scope. (Apple's Br. at 19-20). This argument is yet another a red herring. The federal regulation in question does not impose an affirmative obligation on a patentee to respond to the stated reasons for notice of allowance and does not require a presumption of acquiescence in the examiner's understanding if the patentee chooses not to respond:

> (e) Reasons for allowance. If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or

> patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner.

37 C.F.R. 1.104(e).

Even if the change in the federal regulation did impose an obligation, the examiner's statement does not negate the fact that the plain language of the claims does not require the claimed communication to occur over a network that is completely devoid of wires. Furthermore, there is no evidence that Motorola intended to disavow claim scope, let alone narrow the ordinary meaning of "wireless network" as it appears in the claim. While a patentee "may limit the meaning of a claim term by making a clear and unmistakable disavowal of scope during prosecution," *Univ. Of Pittsburg of Commonwealth System of Higher Educ. v. Hedrick*, 573 F.3d 1290, 1297 (Fed. Cir. 2009), "[s]uch a disavowing statement must be so clear as to show reasonable clarity and deliberateness." Here, Motorola's silence "without more" cannot amount to a disavowal of claim scope or the term "wireless network." *Salazar*, 414 F.3d at 1346.

In sum, Apple has attempted to limit the construction of "wireless network" with a limitation not present in the claim language, which is also contradicted by the specification. Apple's construction is therefore improper and should be rejected.

E. The '006 Patent

1. "Data Units Not Being Sent From The Host To The Communications Unit" Does Not Need To Be Construed

Disputed Claim Term	Motorola's Proposed Construction	Apple's Proposed Construction
"Data Units Not Being Sent From The Host To The Communications Unit"	Ordinary meaning – the phrase requires no construction.	"data units present at the host and not sent to the communication unit"

For similar reasons to those expressed above regarding the term "filtered data unit" in the '531 patent, the court should not construe the term "data units not being sent from the host to the communications unit" in the '006 patent. As explained in Motorola's opening brief, the court need not construe this term because its language is easy to understand by its plain and ordinary

meaning. (Motorola's Br. at 29-31; *see also Phillips*, 415 F.3d at 1314). The '006 specification provides no special definition for this phrase, or any of its individual terms.

Apple's proposed construction, by contrast, inserts the same unsupported limitation into the claim language as it did for the term "filtered data unit" – that the data units must be "present at the host." This is an improper rewriting of the claim language, *Phillips*, 415 F.3d at 1323, and fails for the same reasons set forth above with respect to the term "filtered data units."

Moreover, Apple's additional arguments based on the '006 patent claim language and specification that data units are only "present at the host" are similarly misguided. (Apple's Br. at 13-15). Apple argues, for example, that claim 26 of the '006 patent, which contains the disputed phrase, describes using a "summary store" to store identifying information received from a "further data processing host" about "data units not sent from the host to the communication unit." Apple argues that, since data requested by the user allegedly "resides at the 'further data processing host,'" data units not sent to the communication unit "must also be present at the host." (Apple's Br. at 13). Nowhere does the claim language require, however, that the requested data "reside" anywhere in particular. It is certainly conceivable, for example, that the requested data "reside" in network attached storage that can be accessed or controlled by the host (*e.g.*, to send the requested data units directed to the communication device) and Apple's proposed limitation would exclude such an implementation that would otherwise be covered by the plain language of the claims.

Further, as explained above with respect to the '531 patent, the specification makes clear that filtering data units – which prevents some data units from being sent to the communication unit – can occur either at the host or at an intermediate communications server that sits between the host and the communication unit. Thus, the intrinsic record expressly contemplates that "data units not sent from the host to the communications unit" could also be present at the communications server in addition to or to the exclusion of the host (or some other device connected to the host).

Apple's other argument in support of its construction is to merely cite to a preferred embodiment disclosed in the specification in which the host device applies filters and captures summary store information. (Apple's Br. at 14-15). But as explained above, the Federal Circuit has repeatedly held that courts should "avoid importing limitations from the specification into the claims" and there is no disclaimer that would allow Apple to do so. *Phillips*, 415 F.3d at 1323. Likewise, Apple's contention that its construction is also supported by the purpose of the invention must fail because it is improper to limit the scope of a claim to arrangements having particular advantages or benefits ascribed to a disclosed embodiment. *See, e.g., Sigma-Aldrich*, 521 F. Supp. 2d at 991 n.9; *Phillips*, 415 F.3d at 1327; *Liebel-Flarsheim*, 358 F.3d at 908.

In sum, Apple has attempted to limit the construction of "data units not sent from the host to the communication unit" to a single embodiment, in which rejected data units live only at the host server. This is improper under *Phillips*, and Apple's construction should be rejected.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on August 18, 2011, I served the foregoing document via electronic mail on all counsel of record identified on the attached Service List.

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