

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA**

CASE NO.: 1:10-CV-23580-UU

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MOTOROLA MOBILITY, INC.,)
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Plaintiff,)
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v.)
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APPLE INC.,)
)
Defendant.)
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APPLE INC.,)
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Counterclaim-Plaintiff,)
)
v.)
)
MOTOROLA, INC. and)
MOTOROLA MOBILITY, INC.,)
)
Counterclaim-Defendants.)
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**DEFENDANT AND COUNTERCLAIM-PLAINTIFF APPLE INC.'S
SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF**

I. Introduction

The asserted claims of U.S. Patent No. 5,754,119 (“the ’119 Patent”) include the limitation “responsive to receiving the second message, transmitting a third message.” As “responsive to” implies, the claims require a direct cause-and-effect relationship between receiving the second message and transmitting a third message, as described throughout the intrinsic record. Accordingly, Apple, Inc. (“Apple”) respectfully submits its revised proposed construction: “transmitting a third message as a direct result of receiving the second message.”¹ Counsel for Motorola Mobility, Inc. (“Motorola”) agreed that the claim language “talks about a cause and effect” but yet still appears to dispute whether receipt of the second message must cause transmission of the third message. *See* Ex. 1, *Markman* Hrg. Tr. at 426:8-9; 446:21-25.² Yet, as the Court pointed out, if there is an intervening fourth or fifth message, then the transmission of the third message would no longer be “responsive to” the second message. *See id.* at 447:4-8. Moreover, Motorola recently argued that the language “responsive to” in the substantively identical European counterpart to the ’119 Patent requires transmission of the third message to occur “as a result of the receipt of the second message.”

II. The Parties Have a Dispute Over Claim Scope Because In the Accused Apple Products, Receipt of the Second Message Does Not Directly Result in Transmission of the Third Message

The parties’ opposing constructions relate to a dispute over the proper scope of the claims. Put simply, in the accused products, receipt of what Motorola asserts is the “second message” does not directly result in transmission of the “third message” required by the claims.

¹ During the hearing, the Court proposed a similar construction: “upon receiving the second message and as a direct result of receiving the second message, transmitting a third message.” *See* Ex. 1, *Markman* Hrg. Tr. at 446:16-19.

² All “Ex.” cites refer to the exhibits attached to the Declaration of Christine Saunders Haskett in Support of Apple Inc.’s Supplemental Claim Construction Brief, unless otherwise noted.

See Ex. 1, *Markman* Hrg. Tr. at 443-449; Ex. 2, Apple’s *Markman* Presentation at 45-49.

Instead, intervening steps are required to cause the transmission of the “third message.” If no further action is taken by the user or the user’s devices, the IMAP server does not transmit the status change that was in the “second message.” Motorola argues that the claims nonetheless capture the accused products. See Ex. 3, Motorola’s Infringement Contentions at 9-13. Such a dispute as to claim scope requires the Court to construe this term. *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008).

III. The Intrinsic Evidence Supports Apple’s Revised Construction, Which Clarifies That Receipt of the Second Message Directly Results in Transmission of the Third Message.

Apple proffers a revised wording of its proposed construction to alleviate any confusion introduced by the term “automatically.” Like “automatically,” “as a direct result of” does not require the “immediate” transmission of the third message in the temporal sense. Instead, it requires the causal relationship clearly conveyed by the claims, specification and prosecution history—that receipt of the second message directly results in transmission of the third message.

A. The Patent Repeatedly Uses the Phrase “Responsive to” in Claim 1 to Connote Causation.

The phrase “responsive to” also appears in the second and fourth elements of claim 1 to describe changing the first status of the first message to a second status at the first transceiver and the second transceiver, respectively. Because “a word or phrase used consistently throughout a claim should be interpreted consistently,” *Phonometrics, Inc. v. N. Telecom Inc.*, 133 F.3d 1459, 1465 (Fed. Cir. 1998), examining Motorola’s use of “responsive to” throughout claim 1 sheds light on the proper construction of the term at issue.

With regard to the second element of claim 1, the specification describes that the input “causes the status of message 205 to change from ‘unread’ to ‘read’” in the first transceiver.

'119 Patent at 5:45-46 (emphasis added). The specification also states that the first status is changed to the second status “as a result of a subsequent input to the first transceiver.” *Id.* at 10:50-53 (emphasis added). These disclosures indicate that the phrase “responsive to” in claim 1 connotes a direct causative relationship between two events. Similarly, with regard to the fourth element of claim 1, the Examiner believed that the language “responsive to” was language of causation, describing the claimed method as one

wherein status changes (e.g., changes to received messages, alarm times, alert thresholds and key word alerts) made on a first pager are wirelessly communicated to an infrastructure which automatically communicates such status changes to other pagers, thus causing the other pagers to make corresponding status changes in their status.

Dkt. No. 93-3, Notice of Allowability at 3-4 (emphasis added).

B. The Specification and Prosecution History Reveal That Receipt of the Second Message Directly Results in Transmission of the Third Message.

The direct cause-and-effect relationship between receipt of the second message and transmission of the third message is depicted in Figure 1 and described in column 6, lines 10-14 of the specification:

Infrastructure 110 receives message 240 at step 245. The message is then submitted to a message queue of the infrastructure 110 for transmission by the infrastructure. In step 250, the infrastructure transmits the status of the first message via a third message, or message 255.

The causative relationship between the steps of the claimed method is underscored by the patentees' repeated description in the specification and the prosecution history of the claimed method as “automatic.” *See, e.g.*, '119 Patent at Abstract, 1:45-47, 1:66-2:2, 10:50-54; Dkt. No. 93-2, June 20, 1997 Amendment at 4. *See also* Dkt. No. 93, Apple's Op. Br. at 7-9.

IV. In Litigation Concerning the Same Claim of the European Counterpart to the '119 Patent, Motorola Argued That “Responsive to” Requires a Causal Connection Between Receipt of the Second Message and Transmission of the Third Message

Motorola has also filed a parallel suit against Apple in Germany, accusing Apple of infringing the European counterpart to the '119 patent, EP 0847654 B1 ("EP '654"). The disclosure of EP '654 and the language of claim 1 is substantively identical to that of the '119 Patent. *See* Ex. 4, EP '654; *see also* Ex. 5, Comparison of '119 Patent and EP '654.

After briefing on claim construction in this case closed, Motorola submitted a brief in the German litigation construing the phrase "responsive to receiving the second message, transmitting the third message" in claim 1 of EP '654.³ Significantly, Motorola's construction requires a causal connection between receipt of the second message and transmission of the third message:

From the wording alone, "responsive to" merely requires a causal connection and no time immediacy, which would be completely undefined for one skilled in the art.

Ex. 6, Translation of Motorola's Reply Brief at 5 (emphasis added). Motorola also argued that "the sending of the third message in [the element at issue] is 'responsive to' because it occurs as a result of the receipt of the second message." *Id.* at 8 (emphasis in original).

Additionally, Motorola argued that the language "responsive to" means that transmission of the third message is initiated by receipt of the second message, and not some action by the user or by the second device:

When the server sends a synchronization message to the other receiving device without the user or his receiving device needing to initiate such a synchronization message, then the sending of this third message occurs "responsive to" the second message.

Id. at 6 (emphasis added). The Court may consider Motorola's admissions to the German court,

³ Apple is mindful of the Court's statements concerning the admission of new evidence, but here Motorola has an opportunity to respond, and Motorola's statements in the German brief were made, and therefore only became available, on October 11, 2011, almost two months after claim construction briefing in this case closed on August 18, 2011.

which are clearly relevant to the parties' dispute. *See, e.g., Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1374 (Fed. Cir. 2005) (relying on construction accused infringer gave to term "comprising" in foreign proceeding relating to foreign counterpart to asserted U.S. patent).

V. "Responsive to" Does Not Mean "Without Human Intervention"

At the *Markman* hearing, Motorola indicated that it would accept a construction of "responsive to" as "without human intervention." *See, e.g., Ex. 1, Markman Hrg Tr.* at 435:11-13, 450:7-10. Motorola's proposal, however, fails to address the issue in dispute, i.e., whether receipt of the second message must directly result in transmission of the third message.⁴

Moreover, Motorola's proposed construction of "responsive to" would not make sense if it is applied consistently, as it should be, elsewhere in claim 1. In the second substantive element of claim 1, the first status of the first message is changed to the second status "responsive to" an input to the first transceiver. The specification describes that this "input to the first transceiver" is user input. *See, e.g., '119 Patent* at 5:40-43 ("Referring again to FIG. 1, in step 220, pager 130 receives an input from the user: typically the user interacts with a user interface by depressing a button on the pager indicating a desire to read the message."). If "responsive to" were construed to mean that user intervention cannot be a triggering event, the construction could not be reconciled with the fact that user input is required by this claim element.

VI. Conclusion

Accordingly, Apple respectfully requests that the Court adopt Apple's revised proposed construction: "transmitting a third message as a direct result of receiving the second message."

⁴ Lack of user intervention is, of course, an example of how one event can directly result in another, but it is neither a requirement nor the only requirement; in order for a direct cause-and-effect relationship to exist, there must be no other intervention, human or otherwise, that results in the second event.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on October 26, 2011, I filed the foregoing document with the Clerk of the Court. I also certify that the foregoing document is being served this day on counsel of record identified on the attached Service List via email and CM/ECF.

/s/ Christopher R. J. Pace
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