

**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 RESPONSE TO APPLE'S
SUPPLEMENTAL CLAIM CONSTRUCTION BRIEF**

INTRODUCTION

With respect to the '119 patent, which discusses a system and method of synchronizing messages over multiple devices, Apple now makes explicit the result it has sought all along with its prior constructions of the term, "responsive to receiving the second message, transmitting a third message." Apple continues to seek a construction that has no support in the intrinsic evidence and Apple's rewriting of the claim in this manner should be rejected.

Apple first injected the word "automatically" into the claim language of the '119 patent where it did not exist. In doing so, Apple concealed its true position from Motorola and the Court, apparently hoping to obtain a construction that it would later argue achieves its desired outcome – no intermediate steps. Apple's plan failed when the Court correctly observed that automatically merely means without user intervention. 10/18/11 Markman Tr. at 429:15-17; *id.* at 424:14-17 ("Now, what the invention said is that you can have a change in the status amongst all your devices without user intervention. THE COURT: Right, automatically."). After Motorola indicated it would be fine including that language in the claims, Apple backed away from its "automatically" construction, given that it did not preclude intermediate steps.

Instead, Apple next argued that the third message must be "caused by" receipt of the second message. 10/18/11 Markman Tr. at 426:4-6 (THE COURT: So the issue is not the automatically. The issue is it's a response to the second message? MR. HASLAM: It's caused by."); 426:23-427:1 (By Mr. Haslam: "If they will stipulate that the third message is caused by the receipt of the second message, we have no dispute.")). It turns out, though, that Apple wanted that construction so that it could later argue "caused by" means "directly caused by with no intermediate steps in between," which, again, does not appear in the claims of the '119 patent.

Now, in their Supplemental Claim Construction Brief, Apple – in apparent and accurate concern that "caused by" will not be understood to mean "directly caused by with no intermediate

steps in between" – offers yet *another* construction to accomplish its goal of injecting a no-intermediate-steps limitation into the claims. Apple has now further deviated from the claim language through a construction that provides that the transmission of the third message must be a "direct result" of the receipt of the second message.¹

Apple's latest attempt to inject limitations into the '119 Patent claims that would preclude any intermediate steps between the infrastructure's receipt of the second message and its transmission of the third message is as unsupported as its prior attempts and should be rejected.

ARGUMENT

The parties' proposed constructions for the "responsive to" claim term are set forth below, including a new alternative construction Motorola proposes in response to Apple's new construction:

Disputed Claim Term	Motorola's Proposed Construction	Apple's Newly-Proposed Construction
<i>"responsive to receiving the second message, transmitting a third message"</i>	Plain and ordinary meaning (Needs no further construction) <u>Alternative construction:</u> "transmitting a third message as a result of receiving the second message"	"Transmitting a third message as a direct result of receiving the second message"

I. THE DISPUTED CLAIM TERM DOES NOT REQUIRE CONSTRUCTION BEYOND THE TERM'S ORDINARY MEANING

Motorola agrees there is a dispute regarding the phrase "responsive to receiving the second message, transmitting a third message." *See* Apple Supp. Br. at 2. But, the parties do not dispute the meaning of the terms "transmitting a third message" or "receiving the second

¹ Motorola does not object to a construction when the transmission of the third message is a result of the receipt of the second message.

message." (*See* chart above). Thus, the dispute here is over the plain English words "responsive to." Motorola submits that these are ordinary, non-technical terms that do not require construction by the Court beyond their plain and ordinary meaning.

Apple suggests that because the parties dispute the meaning of the claim term, the Court must construe it by altering its language. Indeed, Apple's counsel stated at the hearing "And with all due respect, I wanted to point out that obviously that's what claim construction is, is you have to change the claim language or you are not defining anything. 10/18/11 Markman Tr. at 491:13-16. This is simply untrue. "In fact, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms." *Johnson Worldwide Assoc., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999).

The Patent Case Management Guide, cited repeatedly by Apple in its legal tutorial, eloquently explains that some terms in dispute require no construction:

If a claim term is non-technical, is in plain English, and derives no special meaning from the patent and its prosecution history, then the court has no need to function as a thesaurus. See § 5.2.3.1. To do so could well encroach upon the factfinder's domain. The "ordinary" meaning of such terms should speak for itself, and the court should avoid merely paraphrasing claim language with less accurate terminology.

Patent Case Management Judicial Guide at 5-23 (2009). The "Guide" repeatedly warns that the Court should avoid merely paraphrasing claim language with less accurate terminology:

- "The 'ordinary' meaning of such terms should speak for itself, and the court should avoid merely paraphrasing claim language with less accurate terminology." Patent Case Management Judicial Guide at 5-23.
- "Where 'construing' a claim term would involve simply substituting a synonym for the claim term, it may be appropriate to allow the claim language to speak for itself." *Id.* at 5-39.
- "But where the intrinsic evidence and extrinsic evidence do not meaningfully add to the definition of a term, it is appropriate (and often preferred) to allow straightforward claim language to stand as is." *Id.*

- "Nonetheless, courts should be skeptical of construing lay terms for which neither party can produce intrinsic evidence indicating a specialized meaning." *Id.* at 5-42.

Here, Apple is requesting that the Court do precisely what the Guide cautions it not to – act as a thesaurus by merely paraphrasing unambiguous claim language with less accurate terminology. These are non-technical terms with simple meanings that any lay person or juror can easily understand and there is simply no reason to paraphrase the claim language. Apple's proposed construction should be rejected on this basis alone.

II. IF CONSTRUCTION WERE NECESSARY, THERE IS NO SUPPORT FOR APPLE'S "DIRECT RESULT" LANGUAGE

If further construction of the term "responsive to" were necessary, the Court should adopt Motorola's proposed construction ("as a result of") rather than Apple's proposed construction ("as a *direct* result of"). Motorola's construction is consistent with the claim's plain language, which is "responsive to," not "directly responsive to." In contrast, Apple's restrictive construction not only asks the Court to discard a basic tenet of patent law, it also lacks even a scintilla of evidentiary support. The word "direct" never appears in the intrinsic evidence. It is a limitation that Apple has literally created out of thin air. Thus, none of the guide-posts that could warrant a departure from plain meaning, such as a disclaimer in the specification or prosecution history, or use of a phrase like "the invention" or "the present invention," apply here.

Tellingly, Apple's own evidence supports a construction of "as a result of," without the word "direct." Apple first cites the specification to the '119 patent, which uses the words "as a result of" in supposed support of its revised construction. Apple argues:

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).

Apple Supp. Br. at 2-3 (emphasis in Apple Supp. Br.). The cited language explicitly supports Motorola's proposed "as a result of" alternative construction, if construction is necessary at all.

Apple next points to statements made by Motorola concerning the European counterpart to the '119 Patent as further support for its revised construction. Apple Supp. Br. at 3-5. The cited portions yet again support the conclusion that the receipt of the second message need not be a "direct" cause, only that there be "a causal connection." *See* Apple Supp. Br. at 4. Notably, Apple previously stated to the Court "If they will stipulate that the third message is caused by the receipt of the second message, we have no dispute." 10/18/11 Markman Tr. at 426:23-427:1. Now, however, Apple now requires it be directly caused by the receipt of the second message so that it can achieve its goal of eliminating any intermediate steps.

Apple also argues that "the patentees' repeated description in the abstract, specification and prosecution history of the claimed method as "automatic" supports its revised construction. Apple Supp. Br. at 3. Not so. In fact, as acknowledged by the Court, "automatic" means only that the transmission occurs "without user [human] intervention 10/18/11 Markman Tr. at 429:15-17; *id.* at 424:14-17 ("Now, what the invention said is that you can have a change in the status amongst all your devices without user intervention. THE COURT: Right, automatically."). The word "automatic" does not speak to direct or indirect.²

Motorola agrees that there must be "a causal connection" between the second and third message, just not a "direct" one. It is on this ground that Apple's newly-proposed construction fails and must be rejected.

² In a footnote, Apple argues that "automatic" requires "no other intervention, human or otherwise." Apple Supp. Br. at fn 4. The "or otherwise" is not correct. As the Court acknowledged, "automatic" merely means "without user intervention" and does not foreclose other intermediate steps. An automatic process could have multiple non-human steps after the first step in the process.

Dated: November 4, 2011

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on November 4, 2011, I served the foregoing document via electronic mail on all counsel of record identified on the attached Service List.

/s/ Edward M. Mullins

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