

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

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I. INTRODUCTION

This lawsuit involves twelve patents: six patents asserted by Motorola against Apple and six patents asserted by Apple against Motorola.¹ The parties have each selected seven claim terms from the other side's patents for construction by the Court, and Apple presents herein its proposed constructions for those fourteen claim terms.² As discussed below, Apple's proposed constructions are faithful both to the plain language of the patents and to the purposes underlying the inventions embodied in those patents. Apple does not seek to limit artificially the scope of the claims nor to stretch the inventions beyond what the inventors envisioned and claimed.

Motorola's proposed claim constructions, on the other hand, reflect a persistent effort—in the case of Motorola's own patents—to capture more than inventors conceived as their invention, and—in the case of Apple's patents—to limit broad claim language improperly to examples in the specifications, based merely on those examples and without sufficient evidence from the specification, read as a whole, that the invention was to be so limited. In each case, Motorola's strained readings of the claim terms must give way to the more reasoned and logical constructions proposed by Apple.

II. LEGAL PRINCIPLES

The goal of claim construction is to give the disputed terms their ordinary meaning, as understood by a person of "ordinary skill in the art" to which the patents pertain, at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*). In interpreting an asserted claim, the court should start with the intrinsic evidence because it constitutes the "public record of the patentee's claim, a record on which the public is entitled to

¹ The patents asserted by Motorola, Inc. and Motorola Mobility, Inc. (collectively, "Motorola") are U.S. Patent Nos. 5,710,987 (the "'987 patent"), 5,754,119 (the "'119 patent"), 5,958,006 (the "'006 patent"), 6,008,737 (the "'737 patent"), 6,101,531 (the "'531 patent") and 6,377,161 (the "'161 patent"). The patents asserted by Apple Inc. ("Apple") are U.S. Patent Nos. 5,583,560 (the "'560 patent"), 5,594,509 (the "'509 patent"), 5,621,456 (the "'456 patent"), 6,282,646 (the "'646 patent"), 7,380,116 (the "'116 patent"), and 7,657,849 (the "'849 patent").

² Apple reserves the right to seek, at a later date, further constructions of claim terms that are important to disputes between the parties.

rely.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996); *see also Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978-79 (Fed. Cir. 1995) (*en banc*), *aff’d* 517 U.S. 370 (1996).

Claim construction begins with the language of the claims but is also a context-sensitive process that requires an appreciation of the core teaching of the specification. *Phillips*, 415 F.3d at 1313; *see also Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1315 (Fed. Cir. 2003) (“[T]he best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention.”); *Merck & Co. v. Teva Pharm. USA*, 347 F.3d 1367, 1371 (Fed. Cir. 2003) (observing that “terms in a patent document are construed with the meaning with which they are presented in the patent document.”).

In this endeavor, an understanding of the problem that the inventors were seeking to resolve and their proposed solution is often a useful orienting frame of reference. *See CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1160 (Fed. Cir. 1997) (“In construing claims, the problem the inventor was attempting to solve, as discerned from the specification and the prosecution history, is a relevant consideration.”). The exercise of construing claims involves a more holistic approach than simply adding up competing sound-bites. *See In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1367 (Fed. Cir. 2004) (“Although some of the language of the specification, when viewed in isolation, might lead a reader to conclude that the term ‘user computer’ is meant to refer to a computer that serves only a single user, the specification as a whole suggests a construction that is not so narrow.”).

Of course, when consulting the specification to clarify the meaning of claim terms, courts must “take care not to import limitations into the claims from the specification.” *Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1288 (Fed. Cir. 2009). Even where the specification only describes a single embodiment, the claim language is not to be limited to a single application “unless the patentee has demonstrated a clear intention to limit the claim scope using words or expressions of manifest exclusion or restriction.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (quoting *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir.

2002)). At the same time, claims cannot “enlarge what is patented beyond what the inventor has described as the invention.” *Biogen, Inc. v. Berlex Labs., Inc.*, 318 F.3d 1132, 1140 (Fed. Cir. 2003). A court may reach a narrower construction, limited to the embodiment(s) disclosed in the specification, however, “when the claims themselves, the specification, or the prosecution history clearly indicate that the invention encompasses no more than that confined structure or method.” *Abbott*, 566 F.3d at 1288.

In addition to the specification, the prosecution history constitutes intrinsic evidence that a court “should also consider . . . if it is in evidence.” *Markman*, 52 F.3d at 980. “[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at 1317. As discussed below, this case presents such instances in which the use of file histories, including histories of re-examination prosecutions, is informative and appropriate.

III. THE COURT SHOULD ADOPT APPLE’S PROPOSED CONSTRUCTIONS.

A. DISPUTED TERMS IN THE MOTOROLA PATENTS

1. The ’119 Patent

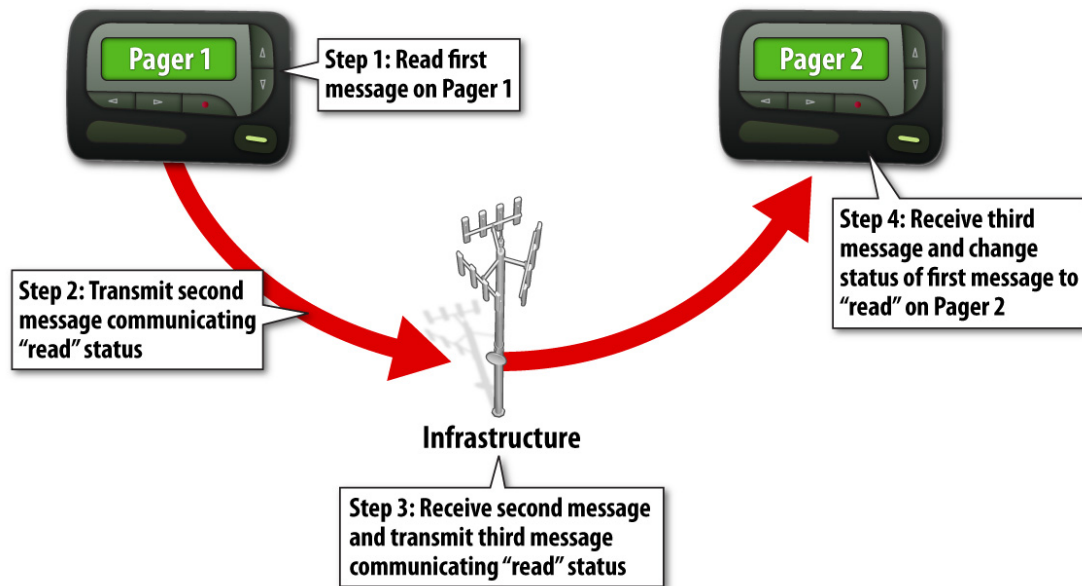
a) Background and Technology of the ’119 Patent

The ’119 patent concerns a method of synchronizing information among a plurality of pagers in a wireless messaging system. ’119 Patent at 2:5-3:9. Changes made on a pager are communicated to a “wireless messaging infrastructure.” *Id.* at abstract. The wireless messaging infrastructure then communicates the changes to one or more other pagers, which make the corresponding changes locally. *Id.*

In one embodiment, shown in Figure 1 of the patent, the method or system synchronizes changes in the status *of a message*. *Id.* at 5:40-44 (“FIG. 1 shows a flow diagram 100 of a system and method for synchronizing messages of multiple selective call transceivers, or two way pagers, operating in accordance with the present invention.”). Such changes include

changing the status of a message from “unread” to “read,” “protect” and/or “delete.” *See, e.g., id.* at 7:27-30. In a second embodiment, shown in Figure 5 of the patent, the method synchronizes changes in the status of *the pager itself*. *Id.* at 6:60-62 (“FIG. 5 shows a flow diagram 500 of a system for synchronizing status of multiple pagers operating in accordance with the present invention.”). Such changes include changing the operating mode or information content of the pager. *Id.* at 7:23-24. The synchronization method is illustrated in the figure below:

'119 Patent – Synchronizing Status



b) Disputed Claim Terms

Apple respectfully requests that the Court construe two terms from the ’119 patent. The first term, “responsive to receiving the second message, transmitting a third message,” is found in asserted independent claim 1 of the ’119 patent, from which asserted claim 2 depends. It describes the action taken by the “wireless messaging infrastructure” after receiving the “second message”; in other words, what the infrastructure does after receiving a status change from the first pager (shown as Step 3 in the figure above).

The second term, “indicative of the second status,” is found in asserted claims 1 and 2, and also in asserted independent claim 5. This term describes both the “second message” sent to

the infrastructure in Step 2 of the figure above and the “third message” sent *by* the infrastructure in Step 3 of the figure above. Claim 1 is exemplary with regard to both terms in dispute:

1. A method of synchronizing message information among a plurality of transceivers comprising the steps of:
 transmitting by a wireless messaging infrastructure a first message having a first status;
 in one transceiver of the plurality of transceivers, changing the first status of the first message to a second status responsive to an input to the one transceiver, and transmitting a second message *indicative of the second status*;
 in the wireless messaging infrastructure, receiving the second message, and *responsive to receiving the second message, transmitting a third message indicative of the second status*; and
 in at least one other transceiver of the plurality of transceivers, receiving the third message, and responsive to receiving the third message, changing the first status of the first message to the second status.

The parties’ proposed constructions are as follows:

’119 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
“responsive to receiving the second message, transmitting a third message”	“Upon receiving the second message, automatically transmitting a third message”	Ordinary meaning
“indicative of the second status”	“Descriptive of the changed status”	Ordinary meaning, but in the alternative, “providing an indication of the second status”

c) Apple’s Proposed Constructions Should Be Adopted

(1) “responsive to receiving the second message, transmitting a third message”

Motorola’s proposed construction of “ordinary meaning” fails to provide any guidance as to the scope of the asserted claims. Apple’s construction, on the other hand, is faithful to the claim language and the patentees’ statements in the intrinsic record, which require that the wireless messaging infrastructure transmit status change messages *automatically* upon receiving the status change from the first pager.

(a) The Specification of the '119 Patent Describes an Automatic Cause-and-Effect Relationship Between Receipt of the Second Message and Transmission of the Third Message

The specification describes a wireless messaging infrastructure that automatically communicates message status information in a “third message” to one or more pagers upon receiving the status information in a “second message” from a first pager. The direct cause-and-effect relationship between receipt of the second message and transmission of the third message is depicted in Figure 1 and clearly 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.

At no point does the specification disclose or suggest an intervening action between receipt of the second message and transmission of the third. *See, e.g., id.* at 2:5-28. On the contrary, the specification repeatedly describes the claimed method as being “automatic.” First, the description of the problem incorporates language of automation: “[W]hat is needed is a way to have status changes to a pager configuration made on any one of a plurality of the user’s pagers *automatically* made on the other one or ones of the plurality of the user’s pagers.” *Id.* at 1:66-2:2 (emphasis added); *see also id.* at 1:45-47. The specification then purports to address this need by allowing “a user’s status changes made on one pager [to be] *automatically* made on the user’s other pagers.” *Id.* at abstract (emphasis added); *see also id.* at 10:50-54 (“When a first status in a transceiver is changed to a subsequent status as a result of a subsequent input to the first transceiver, the invention provides a method of *automatically* changing the first status in a second transceiver to a subsequent status.”) (emphasis added).

These unequivocal statements in the specification do not apply merely to a preferred embodiment of the '119 patent. Rather, as the above-quoted sentence of the specification establishes, the inventors chose to define “the invention” as “provid[ing] a method of *automatically* changing the first status in a second transceiver to a subsequent status.” *Id.* at 10:50-54. In such a case, the Court should not grant the patentee a windfall by construing the

scope of the claimed invention beyond what was disclosed to the public. *See, e.g., Aguayo v. Universal Instruments Corp.*, 356 F. Supp. 2d 699, 727 (S.D. Tex. 2005) (“If the specification calls an embodiment ‘the invention’ or the ‘present invention,’ it is appropriate to limit the claims to that embodiment.”) (citing *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1331 (Fed. Cir. 2000) (“Whether a claim must, in any particular case, be limited to the specific embodiment presented in the specification, depends in each case on the specificity of the description of the invention and on the prosecution history.”)); *see also Newfrey, LLC v. Burnex Corp.*, 637 F. Supp. 2d 527, 538 (E.D. Mich. 2008) (“It is a well established canon of claim construction that when a particular embodiment is described in the specification as the invention itself, and not just one way of utilizing it, the claims are not entitled to a scope broader than that embodiment.”). It is therefore evident from the specification that the wireless messaging infrastructure transmits status change messages *automatically* upon receiving the status change from the first pager.

(b) The Prosecution History of the '119 Patent Supports Apple's Construction

The prosecution history of the '119 patent also confirms that the wireless messaging infrastructure transmits message status information automatically upon receiving it. For example, in distinguishing over the prior art in a June 20, 1997 amendment, the patentees stated: “In one embodiment, Applicants’ invention describes a method whereby a user having a plurality of pagers will have status changes the user has made on a message on one pager *automatically made* on other pagers of the user.” Ex. 1³, June 20, 1997 amendment at 4 (emphasis added).⁴

³ All “Ex.” cites refer to the exhibits attached to the Declaration of Christine Saunders Haskett In Support of Defendant and Counterclaim-Plaintiff Apple Inc.’s Claim Construction Brief, unless otherwise noted.

⁴ The patentees’ use of “[i]n one embodiment” in this statement does not mean that the “automatically” language did not apply to all pending claims in the application. Rather, the patentees’ statement was intended to apply to all aspects of the invention in which status changes are made to a *message*, as opposed aspects of the invention in which status changes are made to the *pager itself*. As noted above, the patentees distinguished the “message” embodiment from (continued...)

In reliance on the patentees' statements, the examiner also believed the invention involved automatically communicating a status change upon receiving it. In his statement of Reasons for Allowance, the examiner deemed the invention patentable because

[t]he prior art of record neither singularly nor in combination discloses or teaches a system and method for synchronizing status among a plurality of wireless communications devices (e.g., pagers) 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.

Ex. 2, Notice of Allowability at 3-4 (emphasis added). The patentees submitted nothing to contradict these Reasons for Allowance.

While an applicant's silence regarding statements made by the examiner during prosecution may not—at the time of the prosecution of the '119 patent—amount to a “clear and unmistakable disavowal” of claim scope, an examiner's statement of reasons for allowance may help to show that the applicant's own arguments during prosecution constituted such a disavowal. *See Salazar v. Procter & Gamble Co.*, 414 F.3d 1342, 1345-47 (Fed. Cir. 2005) (citing *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979 (Fed. Cir. 1999)); *see also ACCO Brands, Inc. v. Micro Sec. Devices, Inc.*, 346 F.3d 1075, 1079 (Fed. Cir. 2003) (relying on comments made in an Examiner's Statement for Reasons of Allowance to limit claim scope because “in this case the examiner simply repeated the arguments that the patentee had presented”).⁵ As discussed above, the *patentees* argued during the prosecution of the '119 patent

“alternate embodiments” which “include synchronization of alarm times, key word status or message threshold value status between multiple pagers.” Ex. 1 at 4.

⁵ The patent at issue in *Salazar*, like the '119 patent, was prosecuted at a time when the applicable regulations expressly indicated that silence would not be held against the patentee: “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.” 37 C.F.R. § 1.109 (1996). The applicable regulation was amended in 2000 because “[t]he examiner's statement of reasons for allowance is an important source of prosecution file history.” 65 Fed. Reg. 54,604, 54,633 (Sept. 8, 2000). Accordingly, while *Salazar* is distinguishable for patents prosecuted after the regulation was amended, it continues to be instructive for patents prosecuted prior to that date.

that the method automatically communicates message status changes to pagers, and they memorialized that position in several locations in the specification. As such, “the examiner’s Reasons for Allowance make clear that the examiner and the applicant understood that the invention requires” that the wireless messaging infrastructure automatically communicates status change messages upon receiving them from the first pager. *ACCO Brands*, 346 F.3d at 1079.

Further, “statements about a claim term made by an examiner during prosecution of an application may be evidence of how one of skill in the art understood the term at the time the application was filed.” *Salazar*, 414 F.3d at 1347. Here, the Notice of Allowability shows that a person of skill in the art would have understood the wireless messaging infrastructure to communicate status changes automatically upon receiving them from the first pager.

(2) “indicative of the second status”

The “wireless messaging infrastructure” of the asserted claims receives and transmits messages “indicative of the second status” (the “second status” being the status as updated by the user on the first pager). Again, Motorola’s proposed alternate constructions of “ordinary meaning” or “providing an indication of the second status” do nothing to define the scope of the asserted claims. Apple’s construction, on the other hand, makes clear that the status change messages are *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 construction is required in order for the method to fulfill its stated purpose, and the intrinsic evidence accords with that construction.

(a) The Specification Requires That Status Change Messages Contain the Content of the Changed Status

As explained above, the purpose of the alleged invention of the ’119 patent is for “a user’s status changes made on one pager [to be] automatically made on the user’s other pagers.” ’119 Patent at abstract. This stated purpose could not be fulfilled unless the “messages”

transmitted to and from the wireless messaging infrastructure communicated the second (i.e., changed) status.

In fact, the specification repeatedly and unambiguously explains that the messages sent to and from the wireless messaging infrastructure “communicate” the changed status. *See, e.g., id.* at abstract (“[S]tatus changes made on a first pager (130 and 530) are wirelessly *communicated* to an infrastructure (110 and 510) which *communicates* the status changes to other pagers (150 and 550) so that the other pagers make corresponding status changes.”) (emphasis added); *id.* at 6:53-54 (“Message 640 *communicates* the change in status by communicating a reconfiguration of memory in pager 530.”) (emphasis added); *id.* at 6:61-65 (“Thus, the change in status of pager 530 is able to be *communicated* by identifying at least one record, and its contents, in its virtual memory that has been modified by the status change or changes occurring during step 620 and delay 630.”) (emphasis added).

Several figures in the ’119 patent depict the content of the status change messages contemplated by the claims of the ’119 patent and provide further support for Apple’s construction:

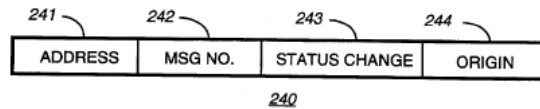


FIG. 3

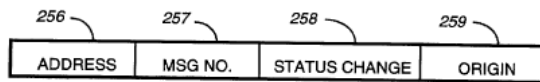


FIG. 4

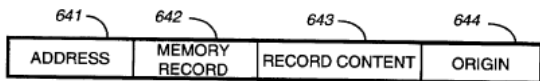


FIG. 6

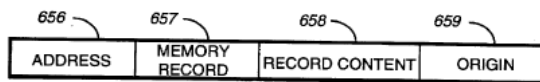


FIG. 7

Figures 3 and 6 depict the content of status change messages transmitted *to* the wireless messaging infrastructure, while Figures 4 and 7 show the content of status change messages transmitted *from* the wireless messaging infrastructure.

These figures each contain a “status change” field or a “record content” field. The portions of the specification corresponding to these figures explain that these fields are descriptive of the status change; *i.e.*, they communicate the content of the status change. *See, e.g., id.* at 8:8-18 (“FIG. 6 shows the structure of message 640, having an address field 641 for identifying pagers 530 and 550, a memory record identifier, or virtual memory address, a field 642 for indicating which memory record was affected by the status changes occurring during step 620 and delay 630, *the contents* of the changed memory record, 643, and an origin field 644 for uniquely identifying pager 530 as the source of message 640. Alternatively, message 640 contains a plurality of field 642 and *a plurality of fields 643 for indicating a plurality of status changes* occurring during step 620 and delay 630.”) (emphasis added); *see also id.* at 7:33-34; 7:61-8:5.

Not only do these passages explain that the status change messages communicate the content of the status changes, but some also use the term “indicate.” As such, they demonstrate that the patentees used the claim term “indicative of” to mean “descriptive of.” For example, one passage states:

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.*

Id. at 5:67-6:6 (emphasis added). This passage reveals that the content of the status change, *i.e.*, “a read/unread bit, a protect bit and a delete bit,” “indicate[s] the corresponding status of the identified message.” Accordingly, messages “indicative of” a status are descriptive of the status.

(b) The Prosecution History Confirms That Status Change Messages Communicate the Content of the Status Change

The file history corroborates Apple’s interpretation of the claims. In the June 20, 1997 amendment, the patentees stated that the wireless messaging infrastructure “*broadcasts* [] status change[s].” Ex. 1 at 4 (emphasis added). Adopting Apple’s construction of “indicative of the second status” is essential if the claimed method is to perform this stated function.

2. The ’006 Patent

a) Background and Technology of the ’006 Patent

The ’006 patent concerns the transmission of data from a host device to a remote user. According to the specification of the ’006 patent, a direct connection between a remote user and a host device can be prohibitively expensive because of the higher costs associated with remote communications. *See* ’006 Patent at 1:16-33. The method and system disclosed by the ’006 patent purportedly solve this problem with a three-device architecture: a “host” device communicates data to the user of a remote device through an intermediary “communication server.” *Id.* at figs. 1, 2.⁶ However, the host does not communicate all data to the user. Instead, the system implements “user-definable filter parameters” to limit the volume of downloaded data. *Id.* at 2:66-3:9. Moreover, “[a]s new data is reviewed and filtered for transfer, identifying/summary information is captured for any non-qualifying data [i.e., data not passing through the filter]” *Id.* at 3:23-25. This identifying information can be stored in a “select and summary (S&S) listing or index” *Id.* at 3:16-18. “Upon reviewing . . . its S&S index, the user may send a request for such of the data that it desires partial or full transfers for further review.” *Id.* at 3:29-31.

⁶ The devices in this three-device architecture are referred to by a variety of names within the ’006 patent.

b) Disputed Claim Term

Motorola asserts that Apple infringes claims 12 and 26 of the '006 patent. The one term for which Apple seeks the Court's construction appears only in claim 26:

'006 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
"data units not sent from the host to the communication unit" (claim 26)	"data units present at the host and not sent to the communication unit"	Ordinary meaning

c) Apple's Proposed Construction Should Be Adopted

The parties dispute whether this claim term requires that the "data units not sent from the host to the communication unit" are present at the host, or whether they may simply exist somewhere else and not be sent from the host to the communication unit. Under Apple's construction, the summary store of claim 26 contains identifying information about data units still present at the host and not sent by the host because such units were rejected by the filters. This construction is supported by the text of the claims and the specification of the '006 patent.

(1) The Claim Language Supports the Conclusion That the "data units not sent from the host to the communication unit" Are Present at the Host

The full context of the claim language of the '006 patent support Apple's construction. Claim 26, in which the disputed term appears, covers part of the summary and selection index discussed above:

26. A controller of communication unit adapted for requesting data over a wireless communication channel *from a further data processing host* via a communication server, the controller comprising: (a) a summary store to store identifying information received from the host about *data units not sent from the host to the communication unit* and not received at the communication unit; wherein said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters. (Emphasis added.)

Claim 26 makes clear that the data requested by the user resides at the "further data processing host." Thus, the data units (or parts of data units) not sent to the communication unit must also be present at the host.

Moreover, the other claims of the '006 patent show that the “data units” or parts thereof not sent to the communication unit reside at the host device. *See Southwall Techs. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995) (“The fact that we must look to other claims using the same term when interpreting a term in an asserted claim mandates that the term be interpreted consistently in all claims.”). For example, in claim 1, all “data units” are broken into two components: “an identifying information part” and “an additional part.” For qualifying data units, the host server sends both “parts” to the communication unit. In order for the host server to send both “parts” of the data unit, both parts must reside on the host server. “[F]or non-qualifying data units,” this same host server sends “the identifying information part without the additional part to the communication unit” As in the case of qualifying data units, both parts must reside at the host server. Thus, as in claim 26, the data units not passing the filter must also reside at the server.

(2) The Specification Confirms that “data units not sent from the host to the communication unit” are Data Units Present at the Host

The specification further confirms that the data units must be present at the host. In describing how the select and summary index is compiled, the specification notes:

When the host (i.e., a post office server in the illustrated case) receives the query it applies the appropriate filters; if only qualifying mail is present, this is forwarded to the client as described above (steps 704-708). Where there is partially (e.g., truncated) or fully rejected data, identifying summary information is captured for all rejected data.

See '006 Patent at 10:17-23. In the case of both qualifying and rejected data, the source of the data is the host server, where the specification expressly notes that the data is “present.” When the user wants to see the additional part of the data unit for which only identifying information is stored, the request is routed back to the host for full transmission, indicating that the portion of the data unit not yet sent resides on the host server as well. *See id.* at 10:61-11:4 (“The user is thus able to review the summary information and . . . override the filter rejection. For mail the user wants to read, the user indicates the decision The request is appropriately translated, . .

. and sent as a query object to the post office [i.e., host]. Upon retrieval, the requested data is forwarded to the client . . .”).

Finally, Apple’s construction is further supported by the purpose of the invention: to limit the transmission of data between the remote user and host. According to the ’006 patent, “it is desirable to limit the amount of information communicated between a remote user and host, both to save off-site user’s time and to limit the costs arising from the more expensive rates for remote communications.” *Id.* at 1:50-54. The purported invention of the ’006 patent claims to solve this problem by permitting “only desired data transfers (i.e., those meeting user defined filters)” “over the expense-bearing networks between the remote unit and communication server.” *Id.* at 1:12-15. Moreover, the select and summary index provides users “a cost efficient review mechanism . . . for determining whether to transfer data that otherwise fails selected filter parameters.” *Id.* at 1:31-34. If the data units not sent to the communication unit are not actually present at the host, withholding or not withholding those data units would have no effect on the size of the transmission from host to user.

3. The ’531 Patent

a) Background and Technology of the ’531 Patent

The specification of the ’531 patent is substantially similar to that of the ’006 patent, as are the purported inventions. Like the claims of the ’006 patent, the methods of the ’531 patent rely on a three-device architecture: a “host” device communicates data to the user of a remote device through an intermediary “communication server.” *Id.* at figs. 1, 2. While the ’006 patent focuses on implementing user-selected criteria to filter data, the ’531 patent also addresses how those filter parameters are prepared and communicated to the communication server.

b) Disputed Claim Terms

Motorola asserts that Apple infringes claims 1, 2, and 11 of the ’531 patent, and Apple seeks to construe two terms from those claims:

'531 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
“filtered data unit” (claims 1-2, 11)	“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”	Ordinary meaning, but in the alternative, “a data unit that has been filtered”
“wireless network” (preamble to claims 1, 11)	“a network in which the communication server is connected to both the host device and the client communication unit through a completely wireless path”	Ordinary meaning, but in the alternative, “two or more devices whose interconnection(s) is implemented, at least in part, without the use of wires”

c) Apple’s Proposed Constructions Should Be Adopted

(1) “filtered data unit”

Motorola’s proposed construction of this term provides no guidance as to the scope of the patent’s claims. Apple’s construction, on the other hand, seeks to confirm that when filters are applied to data units, data units that pass the filters are downloaded to the client communication device, while data units that do not pass the filters are not downloaded.

(a) The Claim Language Supports the Conclusion That a “filtered data unit” Is Downloaded Only Upon Passing the Implemented Filters

The full context of the claim language supports Apple’s construction. For example, claim 1 covers a method comprising:

filtering data units based on a first set of user-selected criteria to produce filtered data units;

communicating the filtered data units to the client communication unit

The text of this claim states that applying the filters to the set of “data units” changes the set in some way, thereby *producing* a different set of data units that requires a different label, “filtered data units.” Then, only these “filtered data units” are *communicated* to the user.

(b) The Specification Mandates That a “filtered data unit” Is Downloaded Only Upon Passing the Implemented Filters

The specification consistently discloses that the filters function to identify the data units that pass the filters for download so that those that fail the filters are not downloaded. *See* ’531 Patent at figs. 4 (“FORWARD QUALIFYING MAIL”), 5 (“FORWARD QUALIFYING MESSAGES”), 6 (withholding portions of data based on granularity filters), 7 (“SEND QUALIFYING MAIL”); *see also id.* at 9:12-16 (“all unprocessed messages can be forwarded to the communications server, where the filters are applied . . . , with only qualifying/filtered messages being forwarded to the client”), 10:6-9 (“If a mail message does not meet any of the criteria . . . then it is left unprocessed Once all unreviewed messages . . . have been filtered, those not rejected are forwarded”).

Apple’s construction of this term is again supported by the purpose of the invention, which is to limit the transmission of data between the remote user and host. The ’531 patent contains the same statements as the ’006 patent about the fact that “it is desirable to limit the amount of information communicated between a remote user and host, both to save off-site user’s time and to limit the costs arising from the more expensive rates for remote communications,” *id.* at 1:56-60, and that the problem is purportedly solved by permitting “only desired data transfers (i.e., those meeting user defined filters)” “over the expense-bearing networks between the remote unit and communication server.” *Id.* at 1:12-15. If the data units that do not pass the filter are not withheld from the communication unit, applying the filters would have no effect on the size of the transmission from host to user. Accordingly, the filters must function to separate out data to be downloaded from data that will not be downloaded, such that the “filtered data units” are a subset of the original data units, which subset is the set to be downloaded.

(2) “wireless network”

The parties dispute whether this claim term requires a completely or partially wireless connection between the host and the user device. The text of the claims and the re-examination

history of the '531 patent support Apple's construction, which requires a completely wireless connection.

(a) **The Claim Language Supports the Conclusion That the “wireless network” Is Completely Wireless Between the Host Device and Client Communication Unit**

The plain language of the claims supports Apple's construction. The preamble to claims 1 and 11 both cover: “A method of communicating data units *over a wireless network between a client communication unit and a host device* via a communication server” '531 Patent at cls. 1, 11. This text states that the network contains no wires between the client communication unit and the host device. *See Phillips*, 415 F.3d at 1312 (“[T]he claims of a patent define the invention to which the patentee is entitled the right to exclude.”). Thus, under the most straightforward reading of the claim, the wireless network must be completely wireless between the user and the host.

(b) **During Reexamination, the Examiner Confirmed Patentability of Claims 1 and 11 Solely on the Basis that the Claims Required a Completely Wireless Network**

On March 7, 2010, a third party requested reexamination of the '531 patent. Ex. 3, Request for *Ex Parte* Reexamination at 1. Two months later, the USPTO granted that request. Ex. 4. The examiner concluded that the combination of two prior art references—U.S. Patent Nos. 5,742,905 (“Pepe”) and 5,802,465 (“Hamalainen”)—presented a substantial new question as to the patentability of claims 1 and 11, among others. *Id.* at 6-7.

The examiner confirmed the patentability of claims 1 and 11 on September 20, 2010. Ex. 5 at 1. The examiner explained the sole basis for this conclusion:

[The] method [disclosed in Pepe] does not communicate data units over a *wireless network* because the network of **Pepe** is a wireline network (#29) between the *communications server* (#30) and the *host server* (OFFICE) and wireless (#39) between the *client communications unit* (#30) and the *communications server* (#40). As such, **claims 1-3, 5-6, and 11** are confirmed as patentable over **Pepe** because **Pepe** does not disclose or suggest a method of communicating data units over a *wireless network* between a *client communications unit* and a *host device* via a *communications*

server in combination with the other features set forth in the claims.

Id. at 2-3.

Under 37 C.F.R. § 1.105(e), “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.” In this reexamination of the ’531 patent, the examiner informed Motorola that “[a]ny comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays.” Ex. 5 at 1. Yet, Motorola made no comment on the examiner’s construction of “wireless network.” *See generally id.*

Generally, “[a]n applicant’s silence in response to an examiner’s characterization of a claim does not reflect the applicant’s clear and unmistakable acquiescence to that characterization if the claim is eventually allowed on grounds unrelated to the examiner’s unrebutted characterization.” *3M Innovative Props. Co. v. Avery Dennison Corp.*, 350 F.3d 1365, 1373-74 (Fed. Cir. 2003). Here, however, the examiner identified a completely wireless network as the sole basis for confirming the patentability of claims 1 and 11, and Motorola should be held to that construction.

Finally, while *Salazar*, 414 F.3d 1342, held that a patentee’s silence did not adopt the examiner’s statement regarding claim scope, that ruling is distinguishable. The *Salazar* decision rested on the premise that the applicable regulations, at the time the patentee failed to rebut the examiner’s statement, expressly indicated that silence would not be held against the patentee: “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.” 37 C.F.R. § 1.109 (1996). By the time of the reexamination of the ’531 patent, however, the relevant regulation had been modified so that exact sentence had been deleted. *See* 37 C.F.R. § 1.104(e) (2010).

In removing that sentence from the regulation, the USPTO explained that, because “[t]he examiner’s statement of reasons for allowance is an important source of prosecution file history, the failure of an applicant to comment on damaging reasons for allowance would give rise to a presumption of acquiescence to those reasons, and the negative inferences that flow therefrom.”

65 Fed. Reg. 54,604, 54,633 (Sept. 8, 2000). Thus, “[t]he deletion of this statement from the rule should require applicant to set forth his or her position in the file if he or she disagrees with the examiner’s reasons for allowance, or be subject to inferences or presumptions to be determined on a case-by-case basis” *Id.* Here, Motorola gave no indication that it disagreed with the re-examiner’s interpretation of “wireless network,” and should be presumed to have adopted it.

4. The '987 Patent

a) Background and Technology of the '987 Patent

The '987 patent concerns the placement and design of a pager antenna in a radiotelephone/pager handset. '987 Patent at 1:8-10. Specifically, the '987 patent addresses the problem of concealing the pager antenna in a compact handset while maintaining the antenna’s performance. *Id.* at 1:56-57.

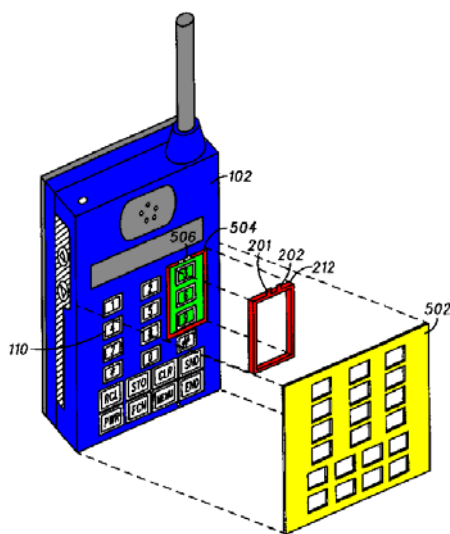


FIG. 5

The purported invention of the '987 patent involves placing a pager antenna (212-red) on the outside of the handset’s case (102-blue) concealed beneath a flat, sheet-like cover (502-yellow). *Id.* at 2:36-45. The pager antenna is preferably shaped as a loop and encircles a portion of the handset’s user interface (green). *Id.* at 2:50-58. By looping the entire antenna around a portion of the user interface and placing a cover over the loop, the antenna takes up little additional space, remains hidden, and is close enough to the pager circuitry to maintain performance. *Id.* at 2:45-58.

b) Disputed Term in the '987 Patent

Motorola has asserted claims 13, 14, and 17 of the '987 patent. Claims 13 and 17 are independent claims; claim 14 depends from claim 13. Claim 13 contains the disputed phrase, “the antenna . . . is disposed between an outside surface of the housing and the at least a portion of the user interface”:

13. A receiver including a user interface comprising:
a housing;
receiver circuitry disposed in the housing; and
an antenna coupled to the receiver circuitry;
wherein *the antenna* forms a loop surrounding at least a portion of the user interface and *is disposed between an outside surface of the housing and the at least a portion of the user interface*.

The proposed constructions for the disputed term are as follows:

'987 Claim Term	Apple's Proposed Construction	Motorola's Proposed Construction
"the antenna . . . is disposed between an outside surface of the housing and the at least a portion of the user interface"	"the entire antenna is placed between the outside surface of the receiver's case and the portion of the user interface surrounded by the antenna"	Ordinary meaning, but in the alternative, the antenna . . . is arranged between an exposed surface of the housing and at least a portion on the user interface

c) Apple's Proposed Construction Should Be Adopted

The parties' proposed constructions differ according to whether (1) "the antenna" refers to the *entire* antenna, (2) the "housing" refers to the receiver's case, and (3) "the at least a portion of the user interface" refers to the portion of the user interface that is surrounded by the antenna. The claims of the '987 patent, the specification and prosecution history, and the understanding of one of skill in the art support Apple's construction and make clear that (1) the antenna refers to the entire antenna, (2) the housing is the receiver's case, and (3) the relevant portion of the user interface is the portion surrounded by the antenna.

(1) The Language of the Claim Requires that "the antenna" Mean the Entire Antenna

Claim 13 of the '987 patent, read as a whole, requires that the term "the antenna" means the *entire* antenna. The term "*the antenna*" necessarily refers to its antecedent, "an antenna coupled to the receiver circuitry." *See, e.g., NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005) ("the definite article 'the,' refers to the antecedent"); MPEP §706.03(d) (5th ed., Rev. 14, 1992); MPEP §2173.05(e) (6th Ed., Rev. 3, 1997). The antecedent phrase, "an antenna coupled to the receiver circuitry," does not describe a part of the antenna, but the antenna in its *entirety*. Hence so must the term, "the antenna," which refers back to it.

Had the patentee wished to limit “the antenna” to only a portion of its antecedent “an antenna coupled to the receiver circuitry,” it could have done so. The patentee elsewhere recognized the necessity of limiting an antecedent reference where it wished to do so. For example, claim 13 recites the phrase “at least a portion of the user interface.” The term “the user interface” refers to the antecedent “a user interface” found in the preamble of the claim. The patentee recognized that without the restrictive language “at least a portion of,” “the user interface” would refer to the *entire* user interface. Reading the claim consistently, then, requires construing “the antenna” to mean the entire antenna.

The specification reinforces this straightforward understanding of claim 13. The specification teaches that “[e]ach of the four preferred locations for the pager’s antenna describe the pager antenna being located within a recess of the front housing 102.” ’987 Patent at 4:37-39. These locations are depicted in the figures, which illustrate that the *entire* antenna (212, located in a recess 504 on the receiver’s case, highlighted in red) rests between the outside surface of the receiver’s case (102-blue) and the portion of the user interface surrounded by the antenna (green). *See id.* at figs. 2, 4-6.⁷

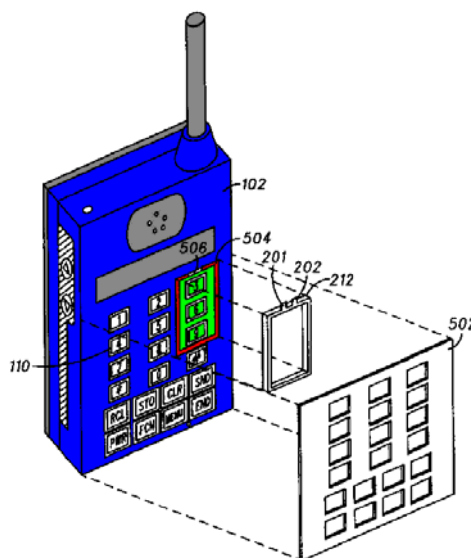


FIG. 5

For these reasons, the Court should construe the limitation, “the antenna . . . is disposed between an outside surface of the housing and the at least a portion of the user interface,” as referring to the *entire* antenna.

⁷ While the ’987 patent, including each of the four preferred embodiments, explains that concealment of the antenna using a cover is a “unique element of the present invention” (*see, e.g.,* ’987 Patent at 2:36-50), claim 13 does not require a cover or other means to conceal the antenna. Accordingly, Apple reserves the right to contend that claim 13 is invalid pursuant to 35 U.S.C. § 112, ¶¶ 1 and/or 2, for its omission of an essential element of the purported invention. *See, e.g., Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1477-80 (Fed. Cir. 1998).

(2) The '987 Patent's Specification and Prosecution History Describe the Housing as the Receiver's Case

The intrinsic record for the '987 patent uniformly describes the claimed "housing" as the receiver's case. All four of the preferred embodiments and five of the figures refer to the housing as the receiver's case. *See* '987 Patent at 3:26-4:39, figs. 1-2, 4-6. Specifically, the drawings unambiguously show the front housing 102 and the back housing 104 as comprising the receiver's case. *Id.* at 2:12-16, figs. 1-2, 4-6.

The prosecution history further supports Apple's construction. On May 21, 1996, the Examiner rejected claim 17 as anticipated by U.S. Patent No. 5,170,173 ("Krenz").⁸ Ex. 6, Office Action at 2. In rejecting the claim, the Examiner stated that the "main body 101 and hinge element 102 [of Krenz] are read as the housing." *Id.* The patentee, seeking "to overcome the rejection," argued that the "claimed main housing is analogous to the main body 101 of Krenz and does not include the hinge element 102 of Krenz." Ex. 7, Amendment at 6. This "main body" of Krenz is the receiver's case.

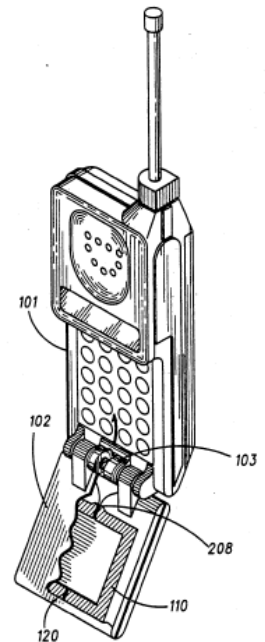


FIG. 1

⁸ The claim term "housing" appears in each claim of the '987 patent and should be construed consistently across all claims. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001) ("A claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent.").

Motorola’s proposal fails to offer an alternative construction of “housing,” but instead suggests construing “an *outside* surface of the housing” as “an *exposed* surface of the housing.” Motorola’s proposed construction, however, is unsupported by the intrinsic record and would introduce an unnecessary ambiguity—to what is the surface to be exposed? Indeed, in Figure 5 of the patent, reproduced above, at least a portion of the housing 102 is not “exposed” to the user’s view because it is covered by a cover 502. Motorola’s proposed construction therefore cannot be reconciled with the figures of the patent itself.

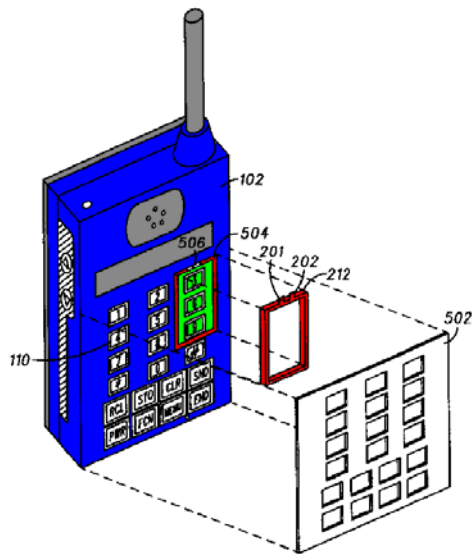


FIG. 5

Apple proposes that the term “an outside surface of the housing” be construed consistent with the plain and ordinary meaning of the term and in accordance with the claim language and specification of the ’987 patent—*i.e.* the outside surface of the receiver’s case. Each of the four preferred embodiments disclose the antenna (red) placed in a recess between an outside surface of the receiver’s case (blue) and the surrounded portion of the user interface (green). Motorola’s proposed construction will not assist the jury in understanding the asserted claims and should be rejected in favor of Apple’s proposed construction, which is supported by the intrinsic record.

(3) The Claims, Specification, and Prosecution History Support a Construction that “the at least a portion of the user interface” Refers to the Portion of the User Interface Surrounded by the Antenna

To avoid indefiniteness, and to be consistent with the intrinsic record, this Court should construe “the at least a portion of the user interface” to mean the portion of the user interface surrounded by the antenna.

The ’987 patent explains that the antenna (212-red) in each of the preferred embodiments is placed in a recess (504-red) that is located between an outside surface of the receiver’s case

(102-blue) and that portion of a user interface that is surrounded by the antenna (green). '987 Patent at 3:26-4:39, figs. 1-2, 4-6. Claim 13 describes this concept: “wherein the antenna forms a loop surrounding at least a portion of the user interface and is disposed between an outside surface of the housing and the at least a portion of the user interface.” *Id.* at 6:6-9.

As with “the antenna,” where the claim recites “*the* at least a portion of the user interface,” it references the antecedent “at least a portion of the user interface.” During prosecution, the Examiner initially could not understand where the antenna was placed because of Motorola’s failure to use antecedent language. Claim 13 had read: “wherein the antenna forms a loop surrounding *at least a portion of the user interface* and is disposed between an outside surface of the housing and *at least a portion of the user interface*.” Ex. 8, Amendment at 3 (emphasis added). In rejecting the claim as indefinite, the Examiner stated, “it is also not clear whether or not the recited ‘at least a portion’ [in the second part of the limitation] is the same as the portion recited [in the first part of the limitation].” Ex. 9 at 2. Motorola amended claim 13 to add “*the*” before the second “at least a portion of the user interface” to clarify that both recitations refer to the same portion of the user interface. Ex. 10, Amendment at 3. Motorola therefore confirmed that the entire antenna must be placed between the outside surface of the receiver’s case and the same portion of the user interface that the antenna surrounds.

Motorola’s proposed construction ignores this clarifying antecedent language. Instead, Motorola seeks to revert to the rejected claim language and reintroduce the very indefiniteness identified by the Examiner. The claim, when read as a whole, requires the specific reference back to the antecedent in order for a person of ordinary skill to understand its meaning.

Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1348 (Fed. Cir. 2005) (“[U]sage of disputed claim terms in the context of the claims as a whole informs the proper construction of the terms.”).

Motorola’s consistent descriptions in the '987 patent and its prosecution history confirm that “the at least a portion of the user interface” is the same portion of the user interface surrounded by the antenna. Apple’s proposed construction should therefore be adopted.

5. The '737 Patent

a) Background and Technology of the '737 Patent

Like several of the patents discussed above, the '737 patent, the parent of which was originally filed in 1995, arose in the world of pagers. As technology improved, pagers gained more functionality and greater flexibility, including the ability to engage in two-way communications and run complex software. As with most devices capable of running a variety of software, the possibility existed that users would acquire unlicensed copies of that software and install and run the unlicensed software on their pagers. The purported invention of the '737 patent seeks to prevent the unauthorized use of software by having mobile devices wirelessly obtain authorization from an external, "fixed portion" before allowing the software to run.

The '737 patent describes two pieces of a communication system: the "portable communication device" (mobile device) and the "fixed portion." The mobile device contains a wireless transceiver that enables communications with the fixed portion. When the user wishes to use a piece of software on the mobile device, that device sends the fixed portion an authorization request, which can include, among other things, "an address identifying the portable communication device."

Upon receiving the request, the fixed portion consults a list of records associated with the device identified by that address to determine whether or not the device is authorized to run the software in question. The fixed portion then transmits the result to the mobile device, which allows the software to be used if authorization was granted.

b) Disputed Term of the '737 Patent

Apple seeks to construe one term for the '737 patent: "address identifying the portable communication device." The parties' proposed constructions are as follows:

'737 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
"address identifying the portable communication device"	"a number used to direct messages that uniquely identifies a portable communication device"	Ordinary meaning, but in the alternative, "some reference uniquely identifying the portable communication"

		device”
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Motorola asserts only claim 9, which claims a portable communication device making an authorization request in the system described above, where the request contains at least one of three recited types of information. One of these types is the disputed term:

9. A portable communication device in a communication system having a fixed portion, the portable communication device comprising:

a processor;

an authorization element coupled to the processor for obtaining usage authorization for utilizing software in the portable communication device, in which the authorization element generates an external authorization request, and in which the authorization element communicates with the fixed portion to obtain the usage authorization in response to the external authorization request, and in which the external authorization request includes at least one of: *an address identifying the portable communication device*, a software name and a size of the software;

and a second authorization element coupled to the processor for allowing utilization of the software, in response to usage authorization being obtained from the fixed portion.

'737 Patent at 18:18-28 (emphasis added).

c) Apple’s Proposed Construction Should Be Adopted

Apple’s construction should be adopted because it is consistent with the claim language and specification, while Motorola’s construction omits an essential feature. The intrinsic and extrinsic evidence requires a construction of the “address identifying the portable communication device” that possesses two qualities: First, it must uniquely identify the device so that the described fixed portion can determine whether or not the device is authorized to run the software. The parties agree on this. Second, in order to be an *address*, it must be used to direct messages to the device. These two qualities are required by both the claim language itself and the purpose and the language of the specification.

(1) **The Parties Agree that the Address Must Uniquely Identify the Device**

Motorola and Apple agree that the “address identifying the portable communication device” must identify the device *uniquely*. This is because, in the claimed invention, the address of the device is used to determine whether or not that particular device is authorized. The claimed system therefore cannot operate unless the address uniquely identifies the device seeking the request.⁹

(2) **The Plain Meaning of the Claims and Other Intrinsic Evidence Require that the Address Be Used to Direct Messages**

The hallmark of an “address” is that it is used to direct things—for example, messages, packages, or people—to a destination: a home address is used to direct mail, packages, or people to your home; an email address directs emails to your inbox; a pager number directs pages to a pager. In the context of a digital communications system, an address is used to direct messages over that system to their destination. The plain dictionary meaning of the noun “address” is:

7a “the designation of a **place** (as a residence or place of business) **where** a person or organization **may be found or communicated with**”

7b “the **directions for delivery** given on the outside of an object to be delivered”

9: “DIRECTION”

Ex. 11, Webster’s Third New International Dictionary (unabridged) (1966 ed.) (emphasis added).¹⁰ The IBM Dictionary of Computing further supports Apple’s construction, defining “address” as “(1) A character or group of characters that identifies a register, a particular part of

⁹ See, e.g., ’737 Patent cl. 1: “a list checker element . . . for checking the list of authorized software corresponding to *the portable portion identified by the address*, to determine whether the software . . . is authorized; . . .” (emphasis added). The specification is replete with descriptions of how the address is used by the fixed portion to determine if the particular portable device that sent the request is authorized. See, e.g., *id.* at 3:42-49, 5:45-53, 14:14-22.

¹⁰ Note that other definitions related to other senses of the noun “address”—such as dressing, dexterity, deportment, speaking voice, a formal speech, the stance addressing a golf ball, and directing ships—are not relevant here.

storage, or some other data **source** or **destination**.” Ex. 12 (emphasis added).¹¹ In other words, an “address,” as used in the claims and in plain English, constitutes directions for delivery of a communication to a place or destination.

Motorola’s construction must be rejected because an address is not merely some reference for identifying the device. In the sole embodiment described in the ’737 patent, pagers are the mobile devices. Motorola’s construction would cover, for example, a serial number found on the pager. But a serial number is not an “address” because it cannot be used to direct communications to the device. Instead, the pager’s “address” within the meaning of this claim can be its telephone number, which is used to send messages to the pager. The telephone number also uniquely identifies the pager, and so would meet the claim language’s requirement that the address of the portable device also uniquely identifies it.

The prosecution history also shows that the term “address” is not merely a “reference” that identifies a device. During prosecution, all claims were rejected in light of the McGregor reference, U.S. Patent No. 5,577,100 (“McGregor”) (*see* Ex. 13). In response, the applicant stated:

The mobile phone system of McGregor et al., lacks “a request ... comprising at least a software name, a secure checksum and an ***address identifying the portable portion***”, as recited in the third element of claim 22 at lines 7 - 9.

Ex. 14, Aug. 17, 1998 Amendment at 3 (emphasis added). But McGregor teaches that the request includes a unique identifier of the device:

During the DTMF dialogue between the central processing unit of the system provider and the user's phone, the ***encrypted license number of the user's phone*** is transferred and verified.

Ex. 13, McGregor at 18:20-23 (emphasis added).

¹¹ While an address may consist of “a character or group of characters,” digital computers store characters as “numbers,” as reflected in Apple's proposed construction. It is not important whether the address is called a “number” or something else. However, to be an address, it must direct messages to a location. Not all numbers or references are addresses; only those that direct messages in the communication system are addresses.

Thus, the applicant distinguished from “address identifying the portable communication device” a number that merely uniquely identifies the device.¹² “[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.” *Spectrum Int’l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1378 (Fed. Cir. 1998); *see also Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (“The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.”). After making this statement, the applicant changed the claims to require merely one of the three recited elements.¹³ This amendment does not alter the applicant’s disclaimer. *See Hakim v. Cannon Avent Group, PLC*, 479 F.3d 1313, 1318 (Fed. Cir. 2007) (holding that an attorney letter stating that applicant was “broadening [the] claims” was insufficient to recapture disclaimed claim scope). The Court should therefore reject Motorola’s proposed construction, which seeks to expand improperly the claim language to include undefined “references” that are not addresses. Because the patent consistently uses “address” to mean a number used to direct messages, the court should adopt Apple’s proposed construction.

¹² During prosecution, the examiner also cited the Matchett reference, U.S. Patent No. 5,335,278 (“Matchett”), which teaches a portable device (a cell phone) which seeks usage authorization by sending a request that includes the phone’s Mobile Identification Number (MIN), which uniquely identifies it. *See* Ex. 15 at fig. 5. In allowing claim 9, the examiner recited in his reasons for allowance that the “prior art” does not teach, among other things, a request that “including an address identifying the portable portion, and a software name.” Ex. 16, Sept. 13, 1999 Notice of Allowability at 2. This indicates that the examiner, also, did not consider either the MIN from Matchett or the license number from McGregor to be addresses, even though they uniquely identify the requesting devices.

¹³ For example, the abstract was amended to add the bolded phrase shown here: “The portable communication device seeks ... a usage authorization for utilizing the software by generating ... an external authorization request ... that includes **[at least one of]** as size... of the software, a software name (394), a secure checksum, and an address (313) identifying the portable communication device.” Ex. 17, Nov. 9, 1998 Amendment at 3 (emphasis added). Claim 9, with corresponding language, was added shortly thereafter. *See* Ex. 18, Jan. 20, 1999 Amendment at 7.

B. DISPUTED TERMS IN THE APPLE PATENTS

As an initial matter, “district courts are not (and should not be) required to construe *every* limitation present in a patent’s asserted claims.” *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008); *see also Biotec Biologische Naturverpackungen GmbH & Co. KG v. Biocorp, Inc.*, 249 F.3d 1341, 1349 (Fed. Cir. 2001). Claim construction is only necessary “[w]hen the parties raise an actual dispute regarding the proper scope of these claims.” *O2 Micro*, 521 F.3d at 1360 (citing *Markman*, 52 F.3d at 979).

Even so, in some cases, the meaning of disputed claim terms “may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words.” *See Phillips*, 415 F.3d at 1314. In other cases, courts must engage in the process of examining the intrinsic evidence to discern the meaning of a disputed term to one of ordinary skill in the art, taking care not to confine the scope of the claims to the specific embodiments described in the specification. *Id.* at 1323; *see also Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 807-08 (Fed. Cir. 2007) (rejecting argument that claims were limited to preferred embodiment); *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1306-07 (Fed. Cir. 2006) (same). Indeed, the Federal Circuit has “expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.” *Phillips*, 415 F.3d at 1323.

1. U.S. Patent Nos. 5,583,560 (“the ’560 Patent”), 5,594,509 (“the ’509 Patent”), and 5,621,456 (“the ’456 Patent”)

Apple asserts claims 1, 2, 4-6, 8, 9, 11-13, and 15-16 of the ’560 patent; claims 7-8, 10-11, 14-20, 22-27, 43-52, 54-58, and 60-63 of the ’509 patent; and claims 1-2 and 4-10 of the ’456 patent. Motorola seeks construction of the terms “listing interface,” “listing means,” “listing interface means,” “controller in communication with,” and “control means in communication with.” Because Motorola seeks to import unnecessary limitations from the specification (especially under the guise of identifying corresponding structure for a means-plus-function claim), Apple’s proposed constructions should be adopted.

a) Background and Technology of the '560 Patent, the '509 Patent, and the '456 Patent

The '560 patent, the '509 patent, and the '456 patent are related patents¹⁴ directed to the field of audio-visual (“A/V”) systems. The inventions provide a unique user interface that helps users find and view programs of interest, access related information, control various audio-visual devices, and order products or services from their homes.

b) Disputed Terms

Motorola seeks constructions for the following terms:

'560/'509/'456 Claim Terms	Apple Proposed Construction	Motorola Proposed Construction
“listing interface”	Plain and ordinary meaning applies or, in the alternative: “an interactive interface for listing A/V program information.”	“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.”
“Listing means” / “Listing interface means”	<p><u>'509</u>: 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.”</p> <p>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</p>	<p>This element is subject to U.S.C. § 112 ¶ 6.</p> <p>Structure: A 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</p>

¹⁴ The '560 patent, the '509 patent, and the '456 patent share the same specification. For ease of reference, Apple does not list corresponding cites from multiple patents in this brief.

	<p>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.”</p> <p><u>'456:</u> Under § 112 ¶ 6, the function is “causing an A/V display to selectively display a program listing.”</p> <p>The corresponding structure is the same as above.</p>	<p>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, and other interactive listing functions. <i>See, e.g.</i>, '509 Patent FIG. 2; 8:50-10-46.</p> <p>Function: Causing the A/V display to selectively display one level of the multiple levels of information related to an audiovisual program, that level containing a list of information (including at least channel numbers, channel names, and titles) about the viewable audio-visual programs</p>
<p>“Controller in communication with” / “Control means in communication with”</p>	<p><u>'560:</u> Plain and ordinary meaning applies or, in the alternative: “controller that sends commands to”</p> <p><u>'509:</u> 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.”</p> <p>The corresponding structure is: remote control 60 or equivalent structure.</p> <p><u>'456:</u> 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.”</p> <p>The corresponding structure is the same as above.</p>	<p><u>Controller in communication with:</u> A hand-held remote control containing a transmitter for transmitting signals wirelessly to the transceiver.</p> <p><u>Control means in communication with:</u> This element is subject to U.S.C. § 112 ¶ 6. Structure: A hand-held remote control containing a transmitter. <i>See, e.g.</i>, Abstract; col. 8:42-46. Function: transmitting signals wirelessly to the transceiver</p>

Exemplary claims from the '560 patent (claim 1), the '509 patent (claim 15), and the '456 patent (claim 1) are reproduced below:

'560 Patent:

1. An audio-visual system comprising:
 - a transceiver coupled to an audio-visual (A/V) display for receiving audio-visual signals in an electronic signal spectrum from a signal source, said transceiver including an interface generator for displaying a

listing interface on said A/V display, said interface generator including a list generator for selectively displaying listing information related to audio-visual programs which may be viewed on said A/V display;

a ***controller in communication with*** said transceiver for permitting a user viewing said A/V display to selectively display said listing information on said A/V display;

wherein said controller includes a control having an activator for activating said list generator in said transceiver, the activation of said list generator resulting in said *listing interface* being displayed on said A/V display; and

wherein said *listing interface* includes a picture in a picture (PIP) window in which an audio-visual program viewed by said user prior to said activation of said list generator is displayed in said PIP window.

'509 Patent:

15. An interactive user interface and audio-visual (A/V) system, comprising:
- a transceiver coupled to an audio-visual (A/V) display for receiving audio-visual signals in an electronic signal spectrum from a signal source, said transceiver including interface generation means for causing said A/V display to display an interface, said interface including selectively displayed multiple levels of information related to an audio-visual program viewed on said A/V display;
 - control means in communication with*** said transceiver for permitting a user viewing said A/V display to selectively display said multiple levels of information on said A/V display;
 - wherein said interface generation means further includes ***listing means*** for causing said A/V display to selectively display a program listing that contains listing information related to A/V programs viewable on said A/V display;
 - wherein said program listing includes a first picture-in-a-picture (PIP) window in which the currently viewed program viewed by said user prior to said activation of said ***listing means*** is displayed on said A/V display.

'456 Patent:

1. An interactive user interface and audio-visual (A/V) system, comprising:
- a transceiver coupled to an A/V display for receiving A/V signals, said transceiver including interface generation means for displaying an interface on said A/V display;
 - control means in communication with*** said transceiver for permitting a user viewing said A/V display to display A/V programs on said A/V display;
 - wherein said interface generation means further includes an A/V ***listing interface*** for causing said A/V display to selectively display a program listing, said program listing including information related to A/V programs viewable on said A/V display;
 - wherein said A/V ***listing interface*** displays a picture in a picture (PIP) window in which the audio-visual program viewed by said user prior to said activation of said A/V listing means is displayed.

c) Apple's Proposed Constructions Should Be Adopted

(1) "listing interface"

The term "listing interface" does not need to be construed because its plain and ordinary meaning would be understood by a jury. To the extent that "listing interface" requires construction, however, one of ordinary skill in the art would understand this term—as used in the '560 patent, '509 patent, and '456 patent—to mean "an interactive interface for listing A/V program information."

If the Court deems it necessary to expressly construe "listing interface," Apple's proposed construction should be adopted because it maintains the same scope as that of the asserted claims. In contrast, Motorola's proposed construction is inconsistent with the intrinsic evidence. First, Motorola conflates multiple claim terms; in requiring that the claimed "listing interface" also "selectively display one level of the multiple levels of information related to an audio-visual program," Motorola improperly renders superfluous the separate limitation of "selectively displaying listing information related to audio-visual programs." *Tex. Instruments v. Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (rejecting proffered claim construction because it "would render the disputed claim language mere surplusage").

In addition, Motorola cherry-picks phrases found in the specifications and does so out of context. For example, the only mention of "software operating in conjunction with the CPU" is in the context of "voice recognition hardware and software." *See* '560 Patent at 22:34-35. Although the specification describes the CPU receiving "a data stream of programs/services listing information," *id.* at 11:5-7, Motorola impermissibly attempts to import additional limitations, namely "channel numbers, channel names, and/or titles," from the preferred embodiment. *See id.* at 10:61-66 (disclosing that "the data *preferably* will include titles of programs, show times, special captions, length information, categories, and key words, as well as channel numbers") (emphasis added); *see also id.* at 7:57-64 (noting that the "numerous specific details" included in the specification are not required to practice the claimed invention).

Not only is Motorola’s construction unsupported, but it also creates unnecessary confusion regarding an otherwise straightforward term. For the foregoing reasons, Apple’s construction should be adopted and Motorola’s construction should be rejected.

(2) “listing means” / “listing interface means”

The parties agree that “listing means” and “listing interface means”—as used in the ’509 patent and the ’456 patent—should be construed as means-plus-function terms under 35 U.S.C. § 112, ¶ 6. However, the parties disagree on both the function and corresponding structure.

(a) Motorola’s Proposed Functions Have No Basis in the Claim Language

As taught by the Federal Circuit, “a court may not construe a means-plus-function limitation by adopting a function different from that explicitly recited in the claim.” *JVW Enterprises, Inc. v. Interact Accessories*, 424 F.3d 1324, 1331 (Fed. Cir. 2005) (internal citations omitted). Apple’s proposed functions track the claim language nearly verbatim. *See, e.g.*, Claim 15 of the ’509 Patent (“listing means for causing said A/V display to selectively display a program listing that contains listing information related to A/V programs viewable on said A/V display”); Claim 1 of the ’456 Patent (“listing interface for causing said A/V display to selectively display a program listing, said program listing including information related to A/V programs viewable on said A/V display”).

In contrast, Motorola incorrectly interprets the function of the “listing means” and “listing interface means” as displaying just “one level of the multiple levels of information” related to a program, even though the claim language refers more generally to displaying a “program listing.” *See, e.g.*, Claim 15 of the ’509 Patent. Motorola further attempts to limit the claimed function to displaying “a list of information (including at least channel number, channel names, and titles).” The phrases “channel number,” “channel names,” or “titles,” however, never appear in the claim language; thus, Motorola’s proposed construction should be rejected.

(b) Motorola Points to More Structure Than Necessary to Perform the Claimed Function

“Once the functions performed by the claimed means are identified, we must then ascertain the corresponding structures in the written description that perform those functions.” *JVW Enterprises*, 424 F.3d at 1330 (internal citations omitted). Selection of the appropriate corresponding structure requires identifying the disclosed structures “necessary to perform the claimed function.” *Omega*, 334 F.3d at 1321 (citing *Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1352 (Fed. Cir. 2003)).

The corresponding structures necessary to cause 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” are all found in the General System Configuration section of the specification. *See, e.g.*, ’509 Patent at 9:17-23, 9:51-54, and 11:19-23. Apple’s proposed corresponding structure was explicitly associated with the function of the “listing means” during prosecution of the ’509 Patent.¹⁵ *See* Ex. 19, ’509 Patent File History, Amendment B at 20-21.

Even putting aside whether Motorola identifies the wrong function for the “listing means,” the corresponding structure identified by Motorola does not even correspond to the function that it proposes. For example, Motorola lists “tuners/demodulators . . . to read and display data from the side-band channels in picture-in-picture (pip) windows” as one component of its corresponding structure. But this component is not *necessary* to accomplish Motorola’s proposed functions of the “listing means,” which does not include the picture-in-picture feature.

Accordingly, the Court should adopt Apple’s construction, which is more consistent with the intrinsic evidence, and reject Motorola’s construction.

(3) “controller in communication with”

The phrase “controller in communication with” does not require construction because its plain and ordinary meaning is readily understandable. To the extent that any construction

¹⁵ These structures are described as corresponding to the functions associated with the claimed “interface generation means” as well as the “listing means.”

beyond its plain and ordinary meaning is required, one of ordinary skill in the art would understand this term to mean “controller that sends commands to.”

Motorola’s proposed construction, on the other hand, attempts to read in additional limitations. For example, Motorola limits the “controller” to a “hand-held remote control,” presumably drawn from the preferred embodiment described in the specification. *See, e.g.*, ’560 Patent at 2:60-61 (disclosing that “[a] remote control device is *preferably* provided for communicating with the transceiver”). In addition, Motorola attempts to restrict the claimed “controller” to contain a “transmitter for transmitting signals wirelessly to the transceiver.”¹⁶ Once again, however, this is merely a preferred embodiment. *See id.* at 24:65-67 (observing that “the present invention may be realized using a variety of computer hardware and software, and is not limited to any particular hardware or software systems”); *see also id.* at 2:34-39, 11:27-28, 12:59-61, 24:57-59.

For these reasons, Apple’s proposed construction should be adopted and Motorola’s proposed construction should be rejected.

(4) “control means in communication with”

The parties agree that “control means in communication with” should be construed as a means-plus-function term under U.S.C. § 112, ¶ 6. However, the parties disagree on the function and corresponding structure of the term.

(a) Motorola’s Proposed Functions are Unsupported by the Claim Language

As above, Apple’s proposed function tracks the claim language nearly verbatim. *See, e.g.*, Claim 15 of the ’509 Patent (“control means in communication with said transceiver for permitting a user viewing said A/V display to selectively display said multiple levels of information on said A/V display”); Claim 1 of the ’456 Patent (“control means in communication

¹⁶ A “transceiver” is different from a “transmitter,” yet Motorola conflates the two through its confusing use of the word “signal.”

with said transceiver for permitting a user viewing said A/V display to display A/V programs on said A/V display”). In contrast, Motorola’s proposed function for this means-plus-function claim improperly adds limitations like “transmitting” and “wirelessly,” which have no support in the claim language. *JVW Enterprises*, 424 F.3d at 1331.

(b) Corresponding Structure

Apple does not believe there is a meaningful difference between its proposed corresponding structure, *i.e.*, “remote control 60 or equivalent structure,” and Motorola’s proposed structure, *i.e.*, a “hand-held remote control.” To the extent Motorola argues otherwise, Apple reserves its right to address this issue in its reply brief.

2. U.S. Patent Nos. 6,282,646 (“the ’646 Patent”) and 7,380,116 (“the ’116 Patent”)

Apple asserts claims 1, 10, 13, 14, 16, and 32 of the ’646 patent and claims 1, 8-10, 16, 18-20, 27, 33, 36-38, and 42 of the ’116 patent. Motorola seeks construction of four phrases: “determin[ing][es] whether [an input/output] device which has been added or removed is a video device,” “detect[ing][s] the addition or removal of a display device,” “modifying the allocation of display space,” and “a portion of the display space to be modified.” Because these terms can be readily understood by the jury, no construction is necessary. However, should the Court decide to construe them, Apple’s alternative constructions should be adopted because they reflect the true scope of the claims while Motorola’s proposed constructions are inconsistent with the claim language and improperly import limitations from the specification.

a) Background and Technology of the ’646 and ’116 Patents

The ’646 and ’116 patents are related patents directed to computer display systems capable of dynamically accommodating changes in display configuration without requiring the user to restart the computer or place the computer into sleep mode. The claimed inventions were intended to overcome shortcomings in previous systems that prevented a user from immediately making use of newly-added devices such as monitors, as described in the ’646 specification:

In the past, changes in the configuration of the computer system, such as the addition or removal of display devices, only became effective upon a restart, or reboot, of the computer system. As part of its initial startup procedure, the computer's operating system detects the presence of each device driver loaded on the system, and registers each such detected driver to permit communications to be carried out between the operating system and the device with which the driver is associated. If a new device and corresponding driver are added to the system after this initialization procedure, the driver is not registered with the operating system, and therefore communications do not take place until the operating system goes through its initialization procedure again, *e.g.* upon next reboot of the computer.

'646 Patent at 1:40-53. The '646 and '116 patents remedied this problem by providing a display system capable of detecting and adapting to changes to display configuration.

b) Disputed Terms of the '646 and '116 Patents

Exemplary claim 1 of the '646 patent and exemplary claims 1 and 19 of the '116 patent are reproduced below:¹⁷

'646 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;

providing a notification to a display manager when a determination is made that a video device has been added or removed; and

modifying the allocation of display space to display devices via said display manager, in accordance with the addition or removal of a video device.

'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 a display device in the computer system;

providing a notification to a component of an operating system executing on said computer system that a video device has been added or removed, in response to said detection; and

modifying the allocation of display space to display devices via said operating system component, in response to said notification and in accordance with the addition or removal of a video device.

¹⁷ Although Motorola characterizes its proposed claim constructions as only construing two terms, Apple believes they should be treated as four separate terms.

19. A system which provides hot-plugging capabilities for display devices, comprising:
- a video device including a frame buffer for storing data that defines an image to be displayed on an associated display device;
 - a first operating system component which defines a display space and assigns a portion of said display space to said frame buffer, and which provides data for images to be displayed to said frame buffer; and
 - a second operating system component which *detects the addition or removal of a display device* in a computer system, and provides a notification of such addition or removal to the first operating system component in response to said detection, to cause the assignment of *a portion of the display space to be modified* in accordance with a detected addition or removal.

c) Apple’s Proposed Construction(s) Should Be Adopted

(1) “determin[ing][es] whether a[n input/output] device which has been added or removed is a video device”

As an initial matter, Apple notes that Motorola conflates this term with the “detect[ing][s] the addition or removal of a display device,” discussed below, by offering an identical construction for both. This approach should be rejected and the terms should be construed separately, because the claim terms use separate and distinct language. Indeed, even in a non-technical context, “determining” and “detecting” have different meanings. Accordingly, Apple will address the terms separately.

’646 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
“determin[ing][es] whether a[n input/output] device which has been added or removed is a video device”	Plain and ordinary meaning, or in the alternative: “determine whether a device is or is not capable of displaying video”	“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.”

There appear to be four disputes between the parties. The first dispute is whether an express claim construction is unnecessary (as asserted by Apple). To the extent that the Court finds that an express construction is necessary, Apple disputes the additional limitations that Motorola seeks to import into the claims: (1) whether the determining step must be performed by a “device manager”; (2) if so, whether the “device manager” must be “an operating system component and not a device driver”; and (3) whether the adverb “specifically” must be included.

(a) No Construction is Required

As is clear from the following sections, the disputes here do not involve the meanings of any specific words selected for construction, but instead, whether additional limitations should be imported into the claim. Indeed, much of Motorola’s proposed construction substantially repeats the words of the claims themselves—“determine that the device is a video display device”—effectively conceding that a jury will understand those words without construction. Therefore, if the Court rejects Motorola’s attempt to import additional limitations into the claims, no construction should be necessary.

(b) “having the device manager”

The parties dispute whether the phrase “determin[ing][es] whether a[n input/output] device which has been added or removed is a video device” requires the determining step to be performed by a “device manager.”

A comparison of the asserted claims shows why a “device manager” is not required. In particular, claim 1 is directed to “[a] method for reconfiguring a computer system to accommodate changes in a display environment,” and recites the steps performed to achieve the reconfiguration. Claim 1, however, places no limitation on what structures are required to perform the recited steps. Importantly, claim 1 neither recites, nor even implies the existence of a “device manager.”

In contrast, other independent claims—*see* claims 10, 13, 16, and 32—expressly require a “device manager.” In addition, those claims specify that the “device manager” either “determines” or is capable of “determining.” Motorola’s construction would effectively render the recitation of a “device manager” in claims 10, 13, 16, and 32 superfluous, which is presumptively incorrect. *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (“Claims are interpreted with an eye toward giving effect to all terms in the claim.”); *Elekta Instrument S.A. v. O.U.R. Scientific Int’l, Inc.*, 214 F.3d 1302, 1305-07 (Fed. Cir. 2000) (refusing to adopt a claim construction which would render claim language superfluous).

(c) “which is an operating system component and not a device driver”

In addition to requiring a “device manager,” Motorola’s proffered construction specifies that the device manager must be an (1) operating system component and (2) not a device driver. As discussed in the previous section, the claim language neither expressly nor impliedly requires a “device manager.” Therefore, any additional limitations that Motorola seeks to build into the phrase “device manger” must also be rejected.

Motorola’s inclusion of the “operating system component” appears to be based on the following passage from the specification of the ’646 patent:

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.*

’646 Patent at 5:17-20 (emphasis added). Yet, this implementation of a “device manager” in the specification is merely exemplary and should not limit the scope of the claims. *See Phillips*, 415 F.3d at 1323. Moreover, the ’646 patent expressly acknowledges that “the present invention can be embodied in other specific forms without departing from the spirit or essential characteristics thereof.” ’646 Patent at 8:36-38; *see also id.* at 8:45-47 (characterizing the disclosed embodiments as “illustrative, and not restrictive”). Therefore, this example is not limiting.

Finally, there is no textual support for Motorola’s exclusion of a “device driver” from its construction. Contrary to Motorola’s argument that this negative limitation must be read into the claims, nothing in the specification mandates that the “device manager” cannot comprise a “device driver.” Accordingly, this portion of Motorola’s proposed construction must be rejected.

(d) “specifically”

The last dispute is whether the phrase “determines whether a device ... is a video device” must be interpreted to mean “*specifically* determines that the device is a video display device” as asserted by Motorola. The adverb “specifically” adds nothing to this claim term, is not supported in the intrinsic record, and would only serve to confuse the jury.

(2) **“detect[ing][s] the addition or removal of a display device”**

As discussed above, Motorola improperly conflates this term with the “determin[ing][es] whether a[n input/output] device which has been added or removed is a video device” term from the ’646 patent. Because the claim terms utilize different claim language, Apple addresses them separately.

’116 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
“detect[ing][s] the addition or removal of a display device”	Plain and ordinary meaning, or in the alternative: “detecting a device capable of displaying video”	“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.”

There appear to be five disputes between the parties: (1) whether a construction is necessary; (2) whether the recited step must be performed by a “device manager”; (3) whether the “device manager” must be “an operating system component and not a device driver”; (4) whether the word “specifically” should be imported into the claims; and (5) whether the “detecting” terms should be replaced with “determining,” as asserted by Motorola. The first four disputes are substantially identical to those discussed above with respect to “determining.”

As for the fifth dispute, there is no support in the express language of the claims for replacing the recited terms “detecting” and “detects” with the terms “determining” and “determines.” The fact that those terms are not coextensive is shown by reference to claim 1 of the related ’646 patent, which recites (in relevant part):

detecting the addition or removal of an input/output device in the computer system; [and]

determining whether an input/output device which has been added or removed is a video device, in response to said detection.

As explained by the Federal Circuit in *CAE Screenplates, Inc. v. Heinrich Fiedler GmbH & Co.*, 224 F.3d 1308, 1317 (Fed. Cir. 2000), “[i]n the absence of any evidence to the contrary, *we must*

presume that the use of ... different terms in the claims connotes different meanings.” (emphasis added).

Moreover, Motorola appears to argue that performance of the “detecting” step either explicitly or implicitly requires logical steps to specifically exclude devices that are not “display devices,” *i.e.*, distinguishing between display and non-display devices. The claim language does not support Motorola’s position. Instead, the claims unambiguously encompass detection of the addition or removal of a display device without excluding non-display devices. As discussed above, this difference in scope is confirmed by reference to claim 1 of the ’646 patent.

(3) “a portion of the display space to be modified”

’646 & ’116 Claim Terms	Apple Proposed Construction	Motorola Proposed Construction
“a portion of the display space to be modified”	Plain and ordinary meaning, or in the alternative: “a part of the display space to be allocated or deallocated	“an allotment of the global coordinate space, available for use by display devices, to be changed”
“modifying the allocation of display space”	Plain and ordinary meaning, or in the alternative: “allocating or deallocating display space”	“changing the allotment of the global coordinate space available for use by display devices”

The relevant disputes between the parties are (1) whether constructions are unnecessary as asserted by Apple; and (2) whether the display space must comprise a “global coordinate space” as asserted by Motorola.¹⁸

(a) No Construction is Required

Once more, the claim terms at issue are simple English language phrases that do not require construction. In addition, as explained below, the underlying dispute is whether the requirement for a “global coordinate space” should be imported into the claims. Because that

¹⁸ To the extent that Motorola contends that the terms “a portion of” and “allocation” as used in the claims are both synonymous with “allotment,” the actual claim language would be simpler for the jury to apply, rendering the substitutions proposed by Motorola unwarranted. If, however, Motorola intends to imply a narrower or different meaning, Apple will respond in its reply brief.

dispute is resolved by simply rejecting Motorola's attempt to import limitations into the claims, no additional construction (beyond the language of the claims as recited) is needed for purposes of instructing the jury.

(b) "global coordinate space"

According to Motorola, the "display space" must be construed as a "global coordinate space." Once again, Motorola improperly attempts to limit a broad claim term ("display space") to a specific embodiment described in the specification ("a global coordinate space").

Apple agrees that Figure 2 of the '646 and '116 patents depict a global display space **30**. See '646 Patent at 3:65-4:4 ("In one known implementation for computer systems, the display environment can generally be considered to be defined by a global coordinate space 30, as depicted in FIG. 2"); '116 Patent at 4:7-10 (same). That the preferred display space is a global coordinate space, however, is an insufficient basis for importing that requirement into the claims. See *Phillips*, 415 F.3d at 1323; see also '646 Patent at 8:45-47 ("The presently disclosed embodiments are therefore *considered in all respects to be illustrative, and not restrictive.*") (emphasis added); '116 Patent at 8:61-63.

3. U.S. Patent No. 7,657,849 ("the '849 Patent")

Apple asserts claims 1-10, 12-14, and 16-18 of the '849 patent. Motorola proposes the terms "gesture" and "moving an unlock image" for construction. With regard to "gesture," Apple believes that this term does not need to be construed. If an explicit construction would assist the jury, however, Apple's alternative construction should be adopted because it more accurately reflects the description of "gesture" in the specification. As for "moving an unlock image," Apple's proposed construction should be adopted because Motorola (again) improperly attempts to limit the claimed inventions to a preferred embodiment.

a) Background and Technology of the '849 Patent

The inventions of the '849 patent relate to a user's interaction with a portable electronic device that has a touch-sensitive display or touch screen. The specification describes how such a

device may be locked to prevent a user from unintentionally activating functions through inadvertent contact with the touch screen. *See* '849 Patent at 1:33-40. Conventional methods of unlocking a locked device included “pressing a predefined set of buttons (simultaneously or sequentially) or entering a code or password.” *Id.* at 1:41-50. The goal of the invention was to provide more “efficient, user-friendly procedures for unlocking such devices, touch screens, and/or applications” without the need for memorizing passwords or pass codes. *Id.* at 1:51-62.

b) Disputed Terms of the '849 Patent

Motorola seeks to construe two terms for the '849 patent:

'849 Claim Term	Apple Proposed Construction	Motorola Proposed Construction
“gesture”	Plain and ordinary meaning, or in the alternative: “a motion of the object/appendage making contact with the touch screen”	“A motion of the object/appendage making contact with the touch screen display”
“moving an unlock image”	“causing an unlock image to change position over time via continuous contact with the touch screen”	“Translating the unlock image from one portion of the coordinate space of touch-sensitive display to another”

Exemplary claim 1 recites (with disputed terms underlined>):

1. A method of controlling an electronic device with a touch-sensitive display, comprising:
 - detecting contact with the touch-sensitive display while the device is in a user interface lock state;
 - moving an unlock image*** along a predefined displayed path on the touch-sensitive display in accordance with the contact, wherein the unlock image is a graphical, interactive user-interface object with which the user interacts in order to unlock the device;
 - transitioning the device to a user-interface unlock state if the detected contact corresponds to a predefined ***gesture***; and
 - maintaining the device in the user-interface lock state if the detected contact does not correspond to the predefined ***gesture***.

c) Apple’s Proposed Constructions Should Be Adopted

(1) “gesture”

With regard to the term “gesture,” Apple does not believe that Motorola has presented “a fundamental dispute regarding the scope of the claim term” that requires the Court’s

intervention. *O2 Micro*, 521 F.3d at 1362. Indeed, the meaning of “gesture” is straightforward and easily understood by a jury; thus, it should be accorded its plain and ordinary meaning.

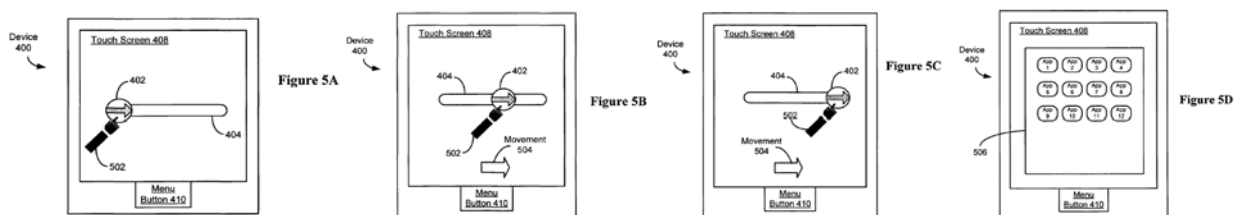
To the extent “gesture” requires a construction, however, the constructions proffered by the parties are quite similar. Apple’s is drawn from the following sentence in the specification: “As used herein, a gesture is *a motion of the object/appendage making contact with the touch screen.*” ’849 Patent at 9:26-28 (emphasis added). Motorola’s proposed construction adds the word “display.” Because Apple’s proposed construction more closely tracks the language of the patent, it should be adopted if the Court determines that a construction is necessary.

(2) “moving an unlock image”

Based on the proffered constructions, it appears that the parties dispute: (1) whether there must be a “translation” in the mathematical sense;¹⁹ and (2) whether “moving an unlock image” requires continuous contact with the touch screen. Since Apple’s proposed construction is more consistent with the intrinsic evidence and Motorola improperly attempts to import limitations of a preferred embodiment, the Court should adopt Apple’s proposed construction.

(a) The Claims of the ’849 Patent Are Not Limited to “Translations” of an Unlock Image

For context, it is worth describing one of the preferred embodiments. Figures 5A-5D show an exemplary interface with which the user interacts in order to perform the unlock action:



See also ’849 Patent at 12:55-13:32 (describing Figures 5A-5D). While Apple does not dispute that the apparent movement of unlock image 402 in Figures 5A-5D is a horizontal translation from one portion of the coordinate space of touch-sensitive display to another, as Motorola

¹⁹ In geometry, “translating” refers to a specific type of movement, wherein each point of a figure moves the same distance in the same direction on a coordinate plane.

argues “moving an unlock image” should be construed, the specification makes clear that this is only one example of the invention. *See* ’849 Patent at 12:55-57 (describing Figures 5A-5D as “the performance of an unlock action gesture, according to *some* embodiments of the invention”) (emphasis added); *see also id.* at 3:38-40 (“However, it will be apparent to one of ordinary skill in the art that the present invention may be practiced without these specific details.”); 19:6-10 (further noting that “the illustrative discussions above are not intended to be exhaustive or to limit the invention” and “[m]any modifications and variations are possible”).

The plain and ordinary meaning of “moving” merely implies that the unlock image must change position over time, a concept best captured by Apple’s proposed construction. *See, e.g.,* Ex. 20, Concise Oxford English Dictionary 934 (Catherine Soanes & Angus Stevenson eds., 11th ed. 2004) (defining “move” to mean “change the position or place of”). Contrary to Motorola’s proposed construction, “moving an unlock image” does *not* necessarily require a “translation” on the coordinate plane.

Notably, the asserted claims further recite that “the unlock image is a graphical, interactive *user-interface object* with which a user interacts in order to unlock the device.” *See, e.g.,* ’849 Patent at Claim 1; *see also id.* at 10:46-48. The specification describes various examples of such “user-interface objects,” including soft keys (or “virtual buttons”) and pull-down menus. *Id.* at 10:22-26. As such, 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 being activated (*e.g.,* like an image of a light switch flipping on or off). Similarly, Motorola’s construction should be rejected because “moving an unlock image” should be construed broadly enough to encompass the movement (and expansion) of a pull-down menu. Indeed, “moving” (by rotating in place) a circular unlock icon in a clockwise or counter-clockwise direction (like a combination lock) would not “translate” the circle to a different place on the coordinate plane.

For all of the aforementioned reasons, Motorola's attempt to limit "moving" to "translating" should be rejected.

(b) "moving an unlock image" Requires Continuous Contact With the Touch Screen

Motorola's proposed construction for "moving an unlock image" should also be rejected because it fails to reflect the fact that the user's interaction with the unlock image requires continuous contact with the touch screen. Apple's proposed construction should be adopted because it best comports with the intrinsic evidence of the '849 Patent.

Specifically, the asserted claims make clear that "moving an unlock image" occurs "in accordance with the contact," referring back to the user's "contact with the touch-sensitive display while the device is in a user-interface lock state." *See, e.g.*, Claim 1. The specification likewise contains numerous references to maintaining continuous contact with the touch screen; indeed, breaking that contact, in some embodiments, corresponds to completion of the unlock gesture and, in others, a failed unlock gesture. *See, e.g.*, '849 Patent at 11:27-30 and 13:35-37.

For these reasons, Apple's proposed constructions for the '849 patent should be adopted.

IV. CONCLUSION

Based on the foregoing, Apple respectfully requests that the Court construe the seven terms specified herein from Motorola's asserted patents, and that the Court adopt Apple's proposed constructions of those terms. Apple further respectfully requests that, if the Court construes any of the seven terms from the Apple asserted patents as to which Motorola is seeking construction, the Court adopt Apple's proposed constructions of those terms.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on July 28, 2011, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record identified on the attached Service List in the manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

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