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SUBJECT TO PROTECTIVE ORDER

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

CASE NO. 1:10-cv-24063-MORENO

MOTOROLA MOBILITY, INC.,	)
Plaintiff,	)
vs.	)
MICROSOFT CORPORATION,	)
Defendant.	)
MICROSOFT CORPORATION,	)
Counterclaim Plaintiff,	)
vs.	)
MOTOROLA MOBILITY, INC.,	)
Counterclaim Defendant.	)

MICROSOFT CORPORATION'S CLAIM CONSTRUCTION BRIEF

THIS BRIEF IS BEING FILED IN REDACTED FORM. THE UNREDACTED
VERSION OF THIS BRIEF AND ATTACHMENTS THERETO ARE BEING FILE
UNDER SEAL

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I.   INTRODUCTION

In accordance with the Court's Scheduling Order (Dkt # 23), Order Continuing Trial and

Certain Pretrial Dates (Dkt #36), Defendant Microsoft Corporation respectfully submits its

opening claim construction brief for the disputed terms of the seven Microsoft and seven

Motorola patents at issue in this suit: Microsoft's U.S. Patent Nos. 6,791,536; 6,897,853;

7,024,214; 7,493,130; 7,383,460; 6,897,904; and 6,785,901[1]; Motorola's U.S. Patent Nos.

5,502,839; 5,764,899; 5,784,001; 6,272,333; 6,408,176; 6,757,544; 6,983,370.

II.   RELEVANT BACKGROUND

As the Court is aware, this action is but one of five District Court Actions pending

between the parties. (Dkt. 62 at 1-5). In its own right, this case presents a vast and complicated

set of issues relating to patents, including seven Motorola patents asserted against almost a dozen

different Microsoft products and seven Microsoft patents asserted against more than 20 Motorola

products.

Indeed, Motorola has alleged infringement by almost a dozen Microsoft products,

ranging from operating systems to messaging systems and including products such as Windows

7, Windows Vista, Windows Phone 7, Windows Mobile 6.5, Microsoft Exchange Server, Live

Messenger, Live Hotmail, and Bing Maps infringe the patents-in-suit. With its traditional and

historic roots as a radio company, it is not surprising that Motorola's allegations of infringement

against Microsoft present significant mismatches between the asserted claims and the accused

technology. As the Court will find in addressing the claim construction disputes at issue here,

there is a fundamental disconnect between the technology disclosed and claimed in Motorola's

patents and the asserted application of those claims to the accused Microsoft technology.

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[1] There are no disputed claim terms for the '901 patent.

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On the other hand, as a leader in the development of computer software and innovator in the world of computing for more than three decades, it is not surprising that Microsoft's patents have been asserted against the handheld, commodity computing devices that are the new focus of Motorola's changing business plan. Similarly, Microsoft has been a pioneer in Internet Protocol Television (IPTV) and related set top box technology, which represent another focus of the underlying claims in this matter. Thus, Microsoft's claims do not present the mismatch in technology presented by Motorola's patents. Nevertheless, given the scope of Motorola's business and the nature of the patents at issue Microsoft's counterclaims are directed against more than 20 different Motorola products, including Motorola's Android devices and digital video recorders. Since Microsoft's patents arise in the fields in which they are asserted, Motorola seeks artificially to limit them using the claim construction process.

Taken as a whole, resolution of this case will involve the construction and interpretation of over sixty individual claim limitations in the disparate technologies associated with 14 patents in suit. Collectively, the Parties assert that more than 30 products infringe the patents-in-suit.

III. APPLICABLE LAW IN CLAIM CONSTRUCTION

A. The Claim Construction Process

Claim construction is an issue of law to be resolved exclusively by the Court. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996); *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 804 (Fed. Cir. 2007).

B. Claim Construction Guidelines

1. The primary focus is on the plain language of the claims

Claim construction begins with and focuses on the language of the claims because "[i]t is a bedrock principle of patent law that the claims of a patent define the invention to which a patentee is entitled the right to exclude." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir.

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2005) (*en banc*) (internal quotations and citations omitted). Often, the claim language itself is sufficient to resolve the parties' disputes.

Indeed, the Federal Circuit recognizes only a few limited exceptions to this general rule; for example where the "patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition" or "where the [claim] term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used." *Johnson Worldwide Assoc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999).

2. Intrinsic evidence and extrinsic evidence

The sources of claim meaning include "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*) (internal quotations and citations omitted). The "intrinsic evidence" includes the claims, the specification, and the prosecution history. *See id.* at 1314-17. Everything else is extrinsic evidence "including expert and inventor testimony, dictionaries, and learned treatises." *See Markman*, 52 F.3d at 980.

Intrinsic evidence is the most probative evidence in construing claim terms, and the patent specification is particularly key. The Federal Circuit has "long emphasized the importance of the specification in claim construction." *See Phillips*, 415 F.3d at 1315. It is "the single best guide to the meaning of a disputed term" and is usually "dispositive." *Id.* In particular, where the specification reveals "a special definition given to a claim term by the patentee," the "inventor's lexicography governs." *Id.* at 1316. Indeed, the specification may ascribe a special meaning to a claim term based on the scope of its description, its prevailing use, by disclaimer of some broader meaning, or by explicit definition. *See e.g. Watts v. XL Sys., Inc.*,

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232 F.3d 877, 882, (Fed. Cir. 2000). Without more, however, claims generally are not limited to specific embodiments set forth in the specification. *Phillips*, 415 F.3d at 1323.

The Federal Circuit has noted that "[i]n addition to consulting the specification," a court "should also consider the patent's prosecution history," *id.* at 1317, as "the record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). As with the specification, a patentee can limit the meaning of a claim term in the course of dealings with the Patent Office, which comprises a record on which the public is entitled to rely. *Id.* at 1582-3.

A court sometimes may consider extrinsic evidence, which includes "all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises." *Phillips*, 415 F.3d at 1317. However, "while extrinsic evidence 'can shed useful light on the relevant art,'" it is "less significant than the intrinsic record in determining the legally operative meaning of claim language." *Id.* (citation omitted).

3.   Means plus function claims require special consideration

"Claim construction of a means-plus-function limitation includes two steps. First, the court must determine the claimed function. Second, the court must identify the corresponding structure in the written description of the patent that performs that function." *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1332 (Fed. Cir. 2006) (internal citations omitted). "The point of [requiring] that the patentee disclose particular structure in the specification and that the scope of the patent claims be limited to that structure and its equivalents is to avoid pure functional claiming." *Aristocrat Techs. Austl. Pty Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008). "The corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification." *Id.* (quoting *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005)). Where the specification does not

provide an adequate description of structure or does not disclose the algorithm, the claim is invalid. *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1382 (Fed. Cir. 2009). *See also, In re Katz Interactive Call Processing Patent Litigation*, 2011 U.S. App. LEXIS 3212 (Fed. Cir. Feb. 18, 2011) (affirming finding that claim was indefinite for failing to disclose algorithm that corresponded to portion of recited function).

IV.   THE PATENTS AND CLAIM CONSTRUCTIONS

A.   6,791,536

The '536 patent, filed in 2001, provides an apparatus and method for simulating gestures of a pointing device, such as a left-click or right-right click of a mouse, using a touch-sensitive display surface. Around the time of filing the '536 patent, typical computer systems were optimized for accepting user input from a keyboard and a mouse. '536 Patent, Ex. 101 at 1:52-58. These computer systems could respond to the activation of the primary switch of the mouse, a left click, and the activation of the secondary switch of the mouse, a right click. *Id.* at 1:60-66. While these gestures can be easily accomplished on a desktop computer with a mouse, it is not always convenient to use a mouse on a portable computer system. *Id.* at 2:6-11. Because of this, portable computer systems often utilize what the patent calls a "stylus" as the primary means of user interaction. The patent explains that a "stylus" can be "a user's own finger, a pen, ... or any similar device suitable for pointing at a particular location on the display surface." *Id.* at 5:46-50. A typical stylus, however, can only perform three types of movements: placing the stylus tip on the screen, moving the stylus tip across the screen, and removing the stylus from the screen. *Id.* at 2:17-21. The invention described in the '536 patent provides an intuitive way to simulate mouse gestures using a stylus. *Id.* at 2:28-31. Additionally the invention provides helpful feedback to the user to assure the intended gesture is performed. *Id.* at 2:35-45.

1. "generating at least one event ..."

Term	Microsoft's Construction	Motorola's Construction
"generating at least one event representing an activation of the secondary switch of the pointing device"	Plain and ordinary meaning or, alternatively: "generating at least one action representing an activation of the secondary switch of the pointing device such as the signal to display a context-sensitive command menu"	"generating at least one down event of the secondary switch of the pointing device"
"generating at least one event representing an activation of the primary switch of the pointing device"	Plain and ordinary meaning or, alternatively: "generating at least one action representing an activation of the primary switch of the pointing device such as the signal to select an object"	"generating at least one down event of the primary switch of the pointing device"

Both of these terms can be understood and applied based on their plain meaning.

However, if the Court determines that constructions are necessary, Microsoft offers constructions

that are consistent with the claim language and the specification. The dispute over both terms is

the same: Motorola's proposes that the claim requires generating a "*down event of*" the

secondary switch and the primary switch. Motorola seeks to rewrite the claim by improperly

importing a limitation—the *down event*—from a preferred embodiment. In the specification, the

inventors only reference a "*down event*" in relation to a preferred embodiment shown in Figure

3. '536 patent, Ex. 101 at 5:54-55. As the court held in *Teleflex, Inc. v. Ficosa N. Am. Corp.*, it

is impermissible to use claim construction to read the preferred embodiments into claims. 299

F.3d 1313, 1324, 1326-27 (Fed. Cir. 2002). Claims 14, 16, and 17 are drawn to simulating

gestures of a pointing device and not generating specific events of an actual pointing device. As

the plain language of the claims show, all that is required is generating an action[2] "representing"

the activation of a switch of a pointing device. In short, Motorola's proposed constructions

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[2] *See* Microsoft Computer Dictionary (5th ed. 2002), Ex. 102 at 198 ("*event*: n. An action or occurrence, often generated by the user, to which a program might respond—for example, key presses, button clicks, or mouse movements. *See also* event-driven programming.")

improperly attempt to import limitations into the claims and are inconsistent with the

specification and should be rejected.

B.   6,897,853

One problem often encountered in portable computer systems that utilize a touch

sensitive display and stylus is that the stylus is typically limited to only three basic types of

actions it can perform: placing the tip of the stylus on the screen, moving the stylus across the

screen, and removing the stylus from the screen. Because of these limitations, stylus based

computer systems are often inconvenient and laborious to operate and cannot take advantage of

the familiar mouse gestures to which users have grown accustomed.

The '853 patent is directed to methods and apparatus for simulating familiar mouse

gestures, such as a tap, stroke, hold, and hold and drag, using a stylus and touch sensitive

display. The patent teaches using various move and time thresholds to simulate and distinguish

one form of mouse gesture from another. In this manner, portable computing devices can

maintain the intuitive way of operating a computing system most users are familiar with.

1.   "determining whether the input is a stroke ..."

Term	Microsoft's Construction	Motorola's Construction
"determining whether the input is a stroke based on a first move threshold"	"determining that the input is a stroke if the input exceeds a first threshold based upon movement of the input."	Plain and ordinary meaning or, alternatively: "determining that the input is a stroke if the input exceeds a first predetermined distance."

The dispute is whether a "first move threshold" must be limited to a "predetermined

distance" as Motorola suggests, or whether it can be "based upon movement of the input." Here,

the patent specification, consistent with Microsoft's construction, explicitly resolves the dispute

by teaching that the first move threshold is broader than just distance and can include other

measures based on the movement of the input. Specifically, Step 303 of Figure 3, represented by

a box labeled "1st move threshold?" illustrates the decision making process by which a gesture is

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determined to be a stroke. '853 Patent, Ex. 201, Fig. 3. The patent explains that at step 303 "[i]f

the first threshold has been exceeded, then . . . the user's input is classified as a stroke." Ex. 201

at 6:13-15. This threshold can be "time, distance, rate, or acceleration, and the like." Ex. 201 at

6:3-4. The explicit language of the patent broadly defines the threshold to include measures

based upon the movement of the input.

Presumably, Motorola seeks to limit the term to distance based on one example in the

patent specification. However, examples from the description of particular embodiments in the

patent cannot be read into the claims. *Phillips*, 415 F.3d at 1323 (stating "rarely would confine

their definitions of terms to the exact representations depicted in the embodiments.") This is

especially true where, as here, the patent provides other examples of move thresholds that are not

limited to just distance, such as a drag threshold of a velocity of "0.25 inches per second, and the

like." Ex. 201 at 6:45-46. Further, nothing in the patent suggests that the threshold, whether it

be distance, rate, acceleration, or otherwise, be predetermined. In fact the patent never even uses

the term "predetermined" anywhere.

2. "determining whether the input is a tap ..."

Term	Microsoft's Construction	Motorola's Construction
"determining whether the input is a tap based on a time threshold"	"determining that the input is a tap if the input does not exceed a threshold dependent on time"	Plain and ordinary meaning or, alternatively: "determining that the input is a tap if the input does not exceed a predetermined amount of time"

The dispute here centers on whether a "time threshold" must be limited to a

"predetermined amount of time." In describing Figure 3, the patent states that "[i]f the first

threshold has not been exceeded, the system determines whether the stylus was still in contact

with the digitizer when a time threshold had expired in step 306. If no . . . the system classifies

the input as a tap." Ex. 201 at 6:15-20. Nothing in the patent specification, nor in Figure 3,

requires that time threshold be a "predetermined amount of time." Indeed, the patent never

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mentions the word "predetermined." Instead the plain language of the claim and the patent

specification supports Microsoft's construction that a time threshold is simply a "threshold

dependent on time." Accordingly, Microsoft's construction for this term should be adopted.

3. "determining whether the stroke is a hold or a hold and drag"

Term	Microsoft's Construction	Motorola's Construction
"determining whether the stroke is a hold or a hold and drag"	"determining that the input is a hold if the input exceeds a threshold dependent on time and does not exceed a second threshold based upon movement of the input or a hold and drag if the input exceeds a threshold dependent on time and exceeds a second threshold based upon movement of the input"	Plain and ordinary meaning or, alternatively: "determining that the input is a hold if the input exceeds a predetermined amount of time and does not exceed a second predetermined distance or a hold and drag if the input exceeds a predetermined amount of time and exceeds a second predetermined distance"

The parties agree that if an input exceeds a time threshold it is a hold. The disagreement

is whether the input must exceed a "second threshold based upon movement," as Microsoft

proposes or whether, as Motorola suggests, it must exceed a "second predetermined distance."

The patent makes clear that move thresholds can be, at least, distances, rates,

accelerations and the like. Ex. 201, at 6:1-4. Nothing limits them to distance alone. The patent

also provides examples of move thresholds that include measurements based upon movement

other than just distance, such as a speed of "0.25 inches a second." *Id.* at 6:43-46. Finally,

nothing in the patent limits the second move threshold to one that is "predetermined." As stated

above, the term "predetermined" does not appear in the patent.

4. "simulating a right mouse click"

Term	Microsoft's Construction	Motorola's Construction
"simulating a right mouse click"	Plain and ordinary meaning or, alternatively: "generating an action that represents an activation of a secondary switch of a pointing device"	"generating a down event followed by an up event of a right mouse button"

Nothing in the language of claim 11 suggests that a "down event" and "an up event of a

right mouse button" are necessary to simulate a right mouse click and such limitations should

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therefore be rejected. The specification is also consistent with Microsoft's construction. The

portion of the '853 patent describing the functionality related to this term references U.S. Patent

No. 6,791,536. The '536 patent, in turn, teaches that "[t]o simulate a right click of a mouse . . .

the computer may generate a Microsoft WINDOWS RightMouseButtonDown event (*or other*

event that represents the secondary switch of the pointing device being activated)." '536

patent, Ex. 101, at 6:38-47. Microsoft's construction is based directly on this description.

Although a WINDOWS RightMouseButtonDown event is provided as an exemplary

implementation, the patent makes clear that any *other event* that represents the secondary switch

of the pointing device being activated may also simulate a right click of a mouse. *Id.* Moreover,

because the patent contemplates that the invention would be used with other operating systems,

the WINDOWS-specific down and up events cannot be used to limit the claim. *Id.* at 7:42-44.

C.   7,024,214 and 7,493,130

Various copies of data objects (*e.g.*, documents) stored on computers and mobile devices

in a network are desirably synchronized. See '214 Patent, Ex. 301 at 1:23-40; '130 Patent, Ex.

302 at 1:32-49. Conventional solutions for synchronization give the user very little control. The

user just selects items to synchronize and selects a single synchronization mechanism to use. Ex.

301 at 1:41-44; Ex. 302 at 1:50-53. Such a rigid approach ignores some factors that are relevant

to whether, when, and how to synchronize. Ex. 301 at 1:44-46 Ex. 302 at 1:53-55.

The '214 and '130 patents both relate to Microsoft's widely-licensed ActiveSync

technology. The '214 and '130 patents are directed at synchronizing data objects between

computers in an intelligent, flexible manner, using one of multiple synchronization mechanisms

based on the then-existing conditions. Ex. 301 at 2:31-38, 10:50-58; Ex. 302 at 2:40-47, 10:41-

49. The techniques of the '214 and '130 patents balance a user's need to access information with

economic, security, and/or data value considerations, such as, the value of the data (*e.g.*, important document versus useless spam), the cost associated with synchronization (*e.g.*, free and fast Wi-Fi versus slow and expensive GPRS), the security of the synchronization mechanisms (*e.g.*, secure physical connection versus insecure GPRS), the security of the mobile device (*e.g.*, secure encrypted device versus device with no security beyond physical possession), and/or the location of the mobile device and user in determining whether, when, and how to synchronize. Ex. 301 at 4:16-20, 7:28-36, 8:35-39; Ex. 302 at 4:22-26, 7:26-34, 8:31-34. The synchronization techniques of the '214 and '130 patents take these considerations into account using a set of flexible rules. Ex. 301 at 2:60-61; Ex. 302 at 3:1-2. With the '214 and/or '130 patents, it is much less likely that highly sensitive data will be shared with an insecure device or over an insecure channel, and much less likely that a less valuable item of data will be synchronized over an expensive network. Ex. 301 at 2:65-3:3; Ex. 302 at 3:6-10.

1.   **"synchronization mechanism"**

Term	Microsoft's Construction	Motorola's Construction
"synchronization mechanism"	Plain and ordinary meaning, or alternatively: "process or technique for synchronization"	"a communication channel used for synchronization"

Microsoft does not believe this term needs construction. To the extent that the term requires construction, Microsoft's construction is consistent with the language of the claims because it allows for a "synchronization mechanism" to use "at least one wireless network," "a GPRS network," "an 802.11a network," "an 802.11b network," "a Bluetooth network," and "a cellular network," as recited in claims 14-19, respectively, of the '214 patent.

In contrast, Motorola's construction, which seeks to limit "synchronization mechanism" to mean only communication channels, is inconsistent with the plain language of the claims. Motorola urges states that a Virtual Private Network (VPN) is not a synchronization mechanism

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under Motorola's proposed construction.[3] However, claim 21 of the '214 patent reads "A method ..., wherein the plurality of synchronization mechanisms comprises a Virtual Private Network (VPN)." And claim 9 of the '130 patent reads "A computer system ..., wherein the plurality of synchronization mechanisms comprises a Virtual Private Network (VPN)." Motorola's proposed construction of "synchronization mechanism" contradicts the other language of the claims.

The '214 and '130 patents make clear that synchronization mechanisms are not to be limited to communication channels. For example, the specification notes that "a mobile device may be capable of synchronizing with a synchronization server using a number of synchronization mechanisms such as GSM, GPRS, Bluetooth, 802.11a, 802.11b (WiFi), or the like." Ex. 301 at 8:14-18; Ex. 302 at 8:11-15. GSM, GPRS, Bluetooth, 802.11a, and 802.11b are each techniques involving specific protocols allowing for some element of control. The specification further recites, "current synchronization mechanisms do not consider the costs associated with synchronization." Ex. 301 at 1:55-56; Ex. 302 at 1:64-65. In view of the specification, "synchronization mechanisms" cannot simply be "communication channels" because, unlike a process or technique, a communication channel cannot include an element of control nor can it take cost into consideration. The specification further notes that "synchronization mechanisms *may involve* networks with a wide variety of costs and latencies." Ex. 301 at 1:56:58; Ex. 302 at 1:65-67. Under Motorola's construction, the synchronization mechanism wouldn't *involve* the network, it would *be* the network.

Motorola's proposed construction is also inconsistent with the prosecution history to the

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[3] Lavian Rebuttal Report, Ex. 303, ¶ 75 ("As an initial matter, I note a VPN is not a 'synchronization mechanism' under Motorola's proposed construction.").

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extent it urges that secured connections are not synchronization mechanisms under Motorola's

proposed construction.[4] However, the applicant explicitly used secured connections as an

example of a synchronization mechanism in the prosecution of the '214 patent application: "The

rules specify which synchronization mechanisms can be used …. When high security is needed,

a secure connection such as a hardwired connection or encrypted wireless connection may be

used." Response to Office Action of June 17, 2005, Ex. 304. Microsoft's proposed construction

for "synchronization mechanism" is consistent with the other claim language and supported by

the specification and prosecution history and should be adopted.

Microsoft's proposed construction is also supported by extrinsic evidence. Dictionaries

show that the plain English meaning of "mechanism" is "a process or technique for achieving a

result." Webster's Third New International Dictionary (1993), Ex. 305 at 1401.

2. "flexible selection rule(s)"

Term	Microsoft's Construction	Motorola's Construction
"flexible selection rule(s)"	Plain and ordinary meaning, or alternatively: "rules for selection to determine whether, when, and/or how"	"changeable rule(s) which specify which synchronization mechanisms can be used for synchronizing certain types of data"

Microsoft does not believe this term needs construction. However, to the extent the

Court deems it necessary, Microsoft's construction is consistent with the other language of the

claims. For example, various dependent claims of the '214 and '130 patents specify conditions

for determining *whether* to synchronize a data item. *See e.g.*, Ex. 301, claims 1, 44, and 55; Ex.

302, claim 11. And other dependent claims of these patents specify conditions for determining

when to synchronize a data item. *See e.g.*, Ex. 301, claims 30 and 31. Motorola's proposed

construction does not give the flexible selection rules any ability to govern whether or when

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[4] Lavian Rebuttal Report, Ex. 303, ¶ 74 ("As an initial matter, I note that a secure connection is
not a 'synchronization mechanism' under Motorola's proposed construction.").

synchronization occurs, and is thus inconsistent with the language of the claims.

Furthermore, Motorola's proposed construction improperly adds the limitation that the rules be "changeable"—a limitation that is present in dependent claims—to the independent claims. For example, dependent claims 22-27 of the '214 patent and dependent claims 10, 14-19 of the '130 patent add in requirements that the flexible selection rules be changeable: "an act of receiving instructions to change the set of flexible selection rules; and an act of changing the set of selection rules in response to the instruction." Ex. 301, claim 22, Ex. 302, claim 10. As the Federal Circuit has held, "the presence of a dependent claim that adds a particular limitation gives rise to the presumption that the limitation in question is not present in the independent claim." *Phillips*, 415 F.3d at 1315.

Microsoft's proposed construction is consistent with the specification. The specification distinguishes the invention over the rigid approach of conventional synchronization techniques that "ignore some factors that are relevant to whether, when, and how to synchronize." Ex. 301 at 1:41-46; Ex. 302 at 1:50-55. In the invention of the '214 and '130 patents, "one or more of the pair of computers involved with the synchronization automatically considers the then-existing circumstances to determine whether, when and how to synchronize." Ex. 301 at 2:31-38; Ex. 302 at 2:40-47.

3. "value, from having access to synchronized data"

Term	Microsoft's Construction	Motorola's Construction
"value, from having access to synchronized data"	Plain and ordinary meaning, or alternatively: "value associated with obtaining synchronized data"	"importance to the user of having access to the synchronized data item"

Microsoft does not believe this term needs construction.

Microsoft's construction—"value associated with obtaining synchronized data"—is the value of having access *generally* to synchronized *data*, rather than the value of having access to

any *particular data item*. This proposal is consistent with the plain language of the claims as the claims recite simply "data." In contrast, Motorola's proposal is inconsistent with the plain language of the claims because it improperly substitutes "data item" for "data" and improperly adds in a limitation – i.e., that "value" is measured with respect to "to the user."

Microsoft's proposal is also consistent with the specification. *See e.g.*, Ex. 301 at 9:60-61; Ex. 302 at 9:54-55. The specification of the '214 and '130 patents makes clear that "value" is not restricted to only being measured from the perspective of the user, as Motorola's proposal requires. For example, the value of the data may be determined by user preferences and/or by a network administrator. *See e.g.*, Ex. 301 at 7:37-50; Ex. 302 at 7:35-48. The network administrator could consider the preferences of entities other than the user, such as the IT department, the user's boss, or the wireless service provider.

D.   7,383,460

Computer systems include timers within the computer's hardware, which are known as "hardware timers." Prior art applications, however, used "software timers" by requesting timers from the computer's operating system. The operating system would check periodically whether any timer requests had expired during a preceding time period, and if so, notify the appropriate application. As a result, applications were only notified that their timers expired when the operating system got around to its periodic check: *i.e.*, timers were not guaranteed to expire *at* a specific time, but only to *not* expire *before* the requested time. '460 patent, Ex. 501 at 1:12-16.

The inventors of the '460 patent invented a system that allows applications to program a hardware timer to expire at a specific time, bypassing the bottleneck imposed by the operating system. Ex. 501 at Abstract. The patent's preferred embodiment includes a hardware-independent interface that can be accessed by any application, (Ex. 501 at 3:56-4:2), and a

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hardware-dependent interface that takes into account the details of how to set a specific hardware

timer, which may vary from one hardware timer to the next. Ex. 501 at 3:45-53.

1. "the hardware-dependent process"

Term	Microsoft's Construction	Motorola's Construction
"the hardware-dependent process"	"the hardware-dependent interface"	Indefinite.

7. A system to configure a timer in a computing device, the system comprising:

...

a *hardware-independent interface* ...

a hardware-dependent interface to the timer; and

a processor in which the *hardware-independent interface* operates to ...

relay the validated request to *the hardware-dependent process*, and further in

which the *hardware-dependent interface* operates to set the timer to expire in

accordance with the validated request ....

Claim 7 recites "the hardware-dependent *process*" instead of "the hardware-dependent

interface" because of imperfect claim drafting when filed. (*See* claims as filed, Ex. 502, at claim

11.) As there is no other logical reading of the claim, however, a person of ordinary skill in the

art would understand that these terms refer to the same thing.

Where separate claim terms refer to the same component, courts construe them to mean

the same thing, even if the terms could be more clear. *See Masimo Corp. v. Mallinckrodt Inc.*,

18 Fed. Appx. 852, 856 (Fed. Cir. 2001) ("an adaptive filter" "must be construed to mean the

same thing" as "said adaptive canceler" because of synonymous usage in the claims,

notwithstanding lack of antecedent basis.) Here, the only logical reading of the claim language

is that "hardware-dependent *process*" is "the hardware-dependent *interface*." The "hardware-

dependent process" limitation is sandwiched directly between two limitations involving the

"hardware-dependent interface," and all three limitations are functionally related. The claim sets

forth "a hardware-independent interface" and "a hardware-dependent *interface*"; then recites that

"the hardware-independent interface" relays "the validated request" to "the hardware-dependent

process"; and finally recites that "the hardware-dependent *interface*" sets the timer in accordance

with "the validated request." The component that sets the timer in accordance with the validated

request must be the same component to which that validated request was relayed. As such, these

terms should be construed to mean the same thing. *Masimo Corp.*, 18 Fed. Appx. at 856.

The specification further confirms Microsoft's construction because it describes a

hardware-dependent *interface* that receives a validated request from a hardware-independent

interface, mirroring the functionality described in claim 7's "hardware-dependent process"

limitation. Figure 1 shows a "hardware-dependent timer application programming *interface*"

106 that receives a request from a hardware-independent interface **104**. *See* Ex. 501 at Figure 3.

Figure 3 also depicts a "hardware-dependent *interface*," (*see* Ex. 501 at 3:5-7; 5:48-52), and

explains that this component receives validated requests from a hardware-independent interface

(*id.* at 6:1-6). *See also* Ex. 501 at 4:9-21. Thus, "the hardware-dependent process" in claim 7

refers to the hardware-dependent interface.

> ### 2.   "[a timer] substantially guaranteed to expire at a time certain"

Term	Microsoft's Construction	Motorola's Construction
"[a timer] substantially guaranteed to expire at a time certain"	"a hardware timer that is programmed to expire at a specific time or interval"	Indefinite under 35 U.S.C. § 112 ¶ 2

Motorola asserts, in its <u>third</u> supplemental response to Microsoft's interrogatories that

this claim term is indefinite. It is not. "[C]laims are not indefinite merely because they present a

difficult task of claim construction." *Halliburton Energy Servs. Inc. v. M-I LLC*, 514 F.3d 1244,

1249. Microsoft's proposed construction comes directly from the specification.

First, the specification makes clear that the term "substantially guaranteed" refers to a

hardware timer: "Timers that are *guaranteed to expire at a certain time* are typically *hardware*

timers." Ex. 501, at 1:23-24. *See also id.*, at 3:37-39 ("Unfortunately, *hardware timers* are

generally the only timers that are *guaranteed to expire at a specified time*"); *Id.* at 3:45-46 ("As

already noted, *guaranteed timers* are generally *hardware timers*").

Second, the specification makes clear that "at a time certain" means that the hardware

timer is programmed to expire at a specific time or interval. In the prior art, "timers [were] not

guaranteed to expire *at a programmed time*; rather, they [were] only guaranteed to *not expire*

before the programmed time." *Id.*, at 1:13-16. To address this problem, the patent discloses "a

computing system suitable for implementing a method for facilitating access to a timer

guaranteed to expire *at a specified time or interval* in accordance with embodiments of the

present invention is described in detail in the following discussion." *Id.*, at 3:39-44. *See also id.*

at 1:55-59 and 3:65-4:2.

3. "high precision event timer (HPET)"

Term	Microsoft's Construction	Motorola's Construction
"high precision event timer (HPET)"	"the combination of a counter, comparator, and match register"	"a hardware timer that operates in accordance with the '*Intel Architecture/Personal Computer (IA/PC) HPET (High Precision Event Timers) Specification*'"

To the extent the Court decides that this claim term needs construction, the Court should

adopt Microsoft's construction because it is the verbatim definition provided by the most

relevant intrinsic evidence, the Intel specification cited in the patent. Motorola's construction

relies on the same intrinsic evidence, but only adds confusion because it cites a 33-page technical

specification without explaining which aspects of these 33 pages it proposes limit the claim term.

The '460 patent states that "[t]he general behavior and operation of HPET timers are

known in the art and are set forth in Intel's Intel Architecture/Personal Computer (IA/PC) HPET

(High Precision Event Timers) Specification, Revision 1.0a, October 2004." Ex. 501 at 5:39-42.

That specification ("Intel specification," Ex. 503) includes a section called "Terminology,"

which expressly defines "HPET" as follows: "The terms Timer, Event Timer, HPET, MMT and

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MM Timer refer to the combination of a Counter, Comparator, and Match Register." Ex. 503 at

6. This definition is in accord with the patent specification, which consistently describes the

operation of HPET as involving counting, comparing, and matching. *See, e.g.* Ex. 501 at Figure

1 component **218**; Figure 2 component **218**; 5:12-20; 5:32-38; 5:57-64; 7:15-20; 8:60-65.

U.S. Application No. 2003/0204792 to Cahill et al. ("Cahill"), entitled "Watch Dog

Timer using a *High Precision Event Timer*" (Ex. 504), has one inventor in common with the

'460 patent and is also part of the intrinsic evidence. While Cahill uses the term HPET, it does

not even mention the Intel specification. Instead, Cahill describes comparing, counting, and

matching, consistent with Microsoft's proposed construction. *See* Ex. 504 at ¶ 56 ("The

hardware timers ... can also be referred to as ... high precision event timers. The hardware

timers 506 generally operate and are enabled by the following: the *compare* value is set, the

counter value is set ... the counter value is incrementally updated ... and an interrupt is

generated on the compare value being *substantially equal* to the counter value.")

Motorola's construction is untenable for at least two reasons. First, the patent uses

exemplary language to make clear that the term HPET should not be limited to Intel hardware:

"In one embodiment, the timer **108** may be a high precision event timer (HPET) *such as* that

provide in Intel computer hardware." Ex. 501 at 4:39-43. *See Doyle v. Crain Industries, Inc.*,

243 F.3d 564, *4 (Fed. Cir. 2000) (exemplary language in specification demonstrate patentee's

intent that feature is merely exemplary). Second, it is unhelpful to incorporate the entire Intel

specification as a proposed construction. That specification is 33 pages long and includes

exacting levels of detail, leaving the trier of fact with no guidance on which aspects of it

supposedly limit the claim. *Modine Mfg. Co. v. U.S. Intern. Trade Com'n*, 75 F.3d 1545, 1553

(abrogated on other grounds, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234

F.3d 558 (Fed. Cir. 2000) (en banc)) (declining to limit a claim term based on dimensions recited

in a document that the patent incorporated by reference).

E.   6,897,904

The '904 Patent is generally directed to systems and methods for selecting among

multiple tuners to tune to a particular channel, for allowing a user to record a program with a

tuner while watching a different program with another tuner without requiring any user input

concerning selection of tuners, and when the user switches back to a channel that is being

recorded, for providing an indication that the user is now watching a recorded program and for

allowing the user to view previously recorded parts of the program.

1.   "program content currently being tuned"

Term	Microsoft's Construction	Motorola's Construction
"program content currently being tuned"	Plain and ordinary meaning, or alternatively: "the program content that a tuner is currently receiving"	"live program content"

Motorola's proposed construction is improperly narrow. Motorola ignores the ordinary

and customary meaning of the term and fails to interpret this term in the context of the entire

patent, including the specification. *See Phillips*, 415 F.3d at 1313.

The plain meaning of the term "program content currently being tuned" is clear from the

claim. It is referring to the program content that a tuner is currently receiving. There is nothing

in the claim to indicate or suggest that this claim term should be narrowed to "live program

content."

Motorola's proposal is also not supported by the intrinsic evidence. The "live content"

described in the '904 Patent is directed to types of content that are provided by a content

provider, not the program content that is begin tuned by the tuner. Ex. 601 at Fig. 1; 2:32-42.

Indeed, the '904 Patent describes three types of content that are being provided by the content

provider: (1) "stored content" which is stored by the content provider; (2) "live content" which is

defined as "content that was not previously stored by the content provider"; and (3) "content

stored at other locations" (*i.e.*, stored content that is stored by an entity other than the content

provider). *Id.* The claim language is clear—claim 19 is directed to the program content that is

being received by the tuner, not where that program content came from (*e.g.*, whether the content

was stored by the content provider or is from a live feed). Accordingly, Motorola's proposed

construction is without any basis and should be rejected.

F.   5,502,839

The '839 patent relates to a software interface through which physical input and output

devices can interact with a computer system. The '839 patent uses device-independent

abstractions of input/output represented in a standardized data structure.

The parties agree that six elements from the asserted '839 patent claims are "means-plus-

function" elements requiring construction as a matter of law. 35 U.S.C. § 112(6).

1.   **"means for performing processing operations ..."; "means for
accepting ..."; "means for converting ..."; and "means for
performing processing operations on ... picture elements"**

Term	Microsoft's Construction	Motorola's Construction
"means for performing processing operations on said virtual input and for generating virtual output"	**Function**: performing processing operations on said virtual input and generating virtual output **Structure**: the operations performed by the Console Manager process as explicitly defined at 15:30-17:6, 44:6-34 and 5:20-46.	**Function**: performing processing operations on virtual input and generating virtual output **Sstructure**: Console Manager, which is any process that processes virtual input and, in response, generates virtual output, as described, for example, at least at FIGs. 8, 9, 12, 13; Cols. 15:30-17:17; 24:49-26:24; 27:5-28:17; 29:65-30:48; 43:51-65; 44:6-34; 47-56.
"means for accepting said virtual output"	**Function**: accepting said virtual output **Structure**: the operations by which a Picture Manager process receives and processes	**Function**: accepting virtual output **Structure**: Picture Manager, which is any process that accepts virtual output as described, for example, at least at FIGs. 8, 9, 12, 14; Cols. 13:64-14:7; 16:4-56; 17:23-

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	incoming requests related to picture elements, as explicitly defined at 17:23-25, 17:63-18:10, and 5:20-46.	25; 17:63-18:23; 25:44-56; 30:51-33:5; 43:60-65; 44:35-39; 145-150.
"means for converting said virtual output into at least one physical output suitable for use by at least one physical output device"	**Function**: converting said virtual output into at least one physical output suitable for use by at least one physical output device **Structure**: the operations performed by the Output Manager process as defined at 19:32-20:64 and 5:20-46.	**Function**: converting virtual output into at least one physical output suitable for use by at least one physical output device **Corresponding structure**: Output Manager, which is any process that converts virtual output into physical output suitable for use by a physical output device as described, for example, at least at FIGs. 8, 9, 12, 14; Cols. 19:32-20:64; 23:51-24:44; 25:33-43; 26:33-43; 43:58-65.
"means for performing processing operations on said one or more picture elements"	**Function**: performing processing operations on said one or more picture elements **Structure**: the operations performed by the Console Manager process on picture elements as described at 44:6-34 and 5:20-46.	**Function**: performing processing operations on one or more picture elements **Corresponding structure**: Console Manager processes that perform processing operations on one or more picture elements, as described, for example, at least at FIGs. 8, 9, 12, 13; Cols. 15:30-17:17; 24:49-26:24; 27:5-28:17; 29:65-30:48; 43:51-65; 44:6-34; 47-56.

The only difference between the parties' proposed *functions* for these terms is that

Microsoft's construction incorporates the word "said," as required to provide the proper context

for the terms. "The use of the word 'said' in a claim refers to an earlier use of the term in the

claim." *Intamin, Ltd. v. Magnetar Tech. Corp.*, 483 F.3d 1328, 1333 (Fed. Cir. 2007).

Limitations associated with the prior use of a term are incorporated by reference by the use of

"said." *See, e.g., Bell Commc'n Research, Inc.*, 55 F.3d at 621 (finding that elements with term

"*said* packet" "expressly incorporate by reference" limitations from prior usage of term)

(emphasis in original). Consequently, by omitting "said," Motorola's proposed construction

impermissibly removes limitations that arise from the previous use of the terms, therefore

improperly broadening the scope of these elements. *See Lockheed Martin Corp. v. Space*

Sys./Loral, Inc., 324 F.3d 1308, (Fed. Cir. 2003) ("In identifying the function of a means-plus-

function claim, a claimed function may not be improperly narrowed or limited beyond the scope

of the claim language. Conversely, neither may the function be improperly broadened by

ignoring the clear limitations contained in the claim language.") (internal citation omitted).

With respect to the *corresponding structure* for these terms, both parties agree that the

specification discloses a "Console Manager," a "Picture Manager," and an "Output Manager"

(respectively) as the structures for these functions. The crux of the dispute between the parties,

however, is what these various managers comprise. The '839 specification clearly describes the

structures for the Console Manager ('839 patent, Ex. 801 at 15:30-17:6, 44:6-34, and 5:20-46),

the Picture Manager (*id.* at 17:23-25, 17:63-18:10, and 5:20-46), and the Output Manager (*id.* at

19:32-20:64 and 5:20-46). As previously noted, "[t]he corresponding structure for a § 112 ¶ 6

claim for a computer-implemented function is the algorithm disclosed in the specification."

Harris Corp. v. Ericsson Inc., 417 F.3d 1241, 1253 (Fed. Cir. 2005). Microsoft's proposed

structure is based on the explicit disclosures of the specification, which specifies the various

properties that each of the "managers" must possess, including that each of these managers be a

"process" (a term explicitly defined in the specification at 5:20-46). Motorola, however,

impermissibly seeks to broaden these claims by arguing that each manager is any process that

can perform the claimed function, referencing the disclosures of the specification as merely

exemplary ("as described, for example, at least at . . ."). That is, Motorola seeks a construction

that encompasses any theoretical structure that could provide the claimed functions, rather than

pointing to a single structure. But "section 112(6) rules out the possibility that any and every

means which performs the function specified in the claim literally satisfies that limitation."

Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1536 (Fed. Cir. 1991) (citation omitted). This

Court should not allow Motorola to impermissibly broaden these section 112(6) claims beyond

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the structure described in the specification, and should adopt Microsoft's proposed construction

that expressly incorporates the structure disclosed in the specification for these terms.

2. **"means responsive to ... physical input devices ..." and "means responsive to ... processed picture elements ..."**

Term	Microsoft's Claim Construction	Motorola's Claim Construction
"means responsive to one of said physical input devices for generating a picture"	**Function**: generating a picture from the input from a physical input device[1] **Structure**: the Input Manager, Console Manager, and Picture Manager processes communicating between each other as described at 25:25-31, 25:44-56, and 5:20-46. [1] as the term "said physical input devices" has no antecedent basis other than in the preamble, this term becomes indefinite unless the preamble to Claim 15 is limiting.	**Function**: generating a picture comprising one or more picture elements responsive to a user's interaction with a physical input device. **Structure**: Input Manager and Console Manager processes that generate a picture comprising one or more picture elements responsive to a user's interaction with a physical input device, as described, for example, at least at FIGs. 8, 9, 12; Cols. 12:14-23; 13:64-14:7; 18:24-19:31; 25:25-31, 25:44-56; 43:51-65; 47-56; 70-71.
"means responsive to said one or more processed picture elements for coupling said one or more processed picture elements to one of said physical output devices"	**Function**: sending one or more processed picture elements to one or more said physical display devices[2] for display **Structure**: the operations performed by the virtual output manager process as described at 20:4-42 and 5:20-46. [2] as the term "said physical output devices" has no antecedent basis other than in the preamble, this term becomes indefinite unless the preamble to Claim 15 is limiting.	**Function**: coupling said one or more processed picture elements to a physical output device **Corresponding structure**: Output Manager processes that couple one or more processed picture elements to a physical output device, as described, for example, at least at FIGs. 8, 9, 12, 14; Cols. 19:32-20:64; 23:51-24:44; 25:33-43; 26:33-43; 43:58-65.

The parties agree that these elements are "means-plus-function" elements requiring

construction as a matter of law, but disagree on both the *function* and *structure* for these

elements. One basic tenet of claim construction is that "[t]he function of a means-plus-function

limitation . . . must come from the claim language itself." *Creo Prods., Inc. v. Presstek, Inc.*, 305

F.3d 1337, 1344 (Fed. Cir. 2002). Further, the courts apply ordinary principles of claim

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construction to determine the claimed function of a means-plus-function element. *Lockheed*

Martin Corp. v. Space Systems/Loral, Inc., 324 F.3d 1308, 1319 (Fed. Cir. 2003). Consequently,

the claim term must be read "in the context of the entire patent, including the specification."

Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed. Cir. 2005).

Motorola's proposed *function* for the term "means responsive to one of said physical

input devices for generating a picture," should be rejected as it focuses on a "user's interaction

with a physical input device" despite the fact that the claim element does not contain a reference

either to a user or to interaction with an input device.

With respect to the term "means responsive to said one or more processed picture

elements for coupling said one or more processed picture elements to one of said physical output

devices," only Microsoft's proposed *function* properly captures the meaning of the term

"coupling" as used in the claim. When read in light of the specification, "coupling" means

"sending" processed picture elements to physical display devices for display. In describing the

Output Manager (the process to which Motorola points for corresponding structure), the

specification teaches: "Which process initializes the manager becomes tightly coupled to it; *i.e.*,

they can exchange messages via PID's rather than by name." '839 patent, Ex. 801 at 19:59-61;

see also id. at 23:51-54 ("A Window Manager is tightly *coupled* to its creator (a Console

Manager), Picture Manager, and Output Manager; *i.e. they communicate with each other* using

process identifiers (PID's)) (emphasis added). Consequently, Microsoft's proposed construction

properly defines these functions in terms of the claim language, as well as provides additional

guidance where necessary to define terms as they are used within the context of the entire patent.

With respect to the *corresponding structure*, the parties agree that the specification

discloses a "Console Manager," an "Input Manager," and an "Output Manager" that are relevant

for these claim terms. However, as discussed in part IV.F.3., *supra*, Motorola impermissibly

attempts to broaden these claims by arguing for constructions that encompass any theoretical

structures that could provide the claimed functions, rather than pointing to the structure actually

disclosed in the specification. See *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1536 (Fed.

Cir. 1991) ("[S]ection 112(6) rules out the possibility that any and every means which performs

the function specified in the claim literally satisfies that limitation." (citation omitted)).

Consequently, this Court should not allow Motorola to impermissibly broaden these section

112(6) claims beyond the structure described in the specification.

3. Proposed Construction Of Disputed "Means-Plus-Function" Limitations

Five additional elements from the asserted '839 patent claims are "means-plus-function"

elements that require construction according to the requirements of 35 U.S.C. § 112(6). In

particular, the following terms should be construed under 35 U.S.C. § 112(6):

Term	Microsoft's Claim Construction	Motorola's Claim Construction
"wherein said virtual output accepting means comprises a picture manage process for controlling said plurality of related picture elements"	**Function**: accepting virtual output to control a picture, a meta element, or a macro element **Structure**: the operations by which a Picture Manager process controls the modification and retrieval of a picture, meta element, or macro element as explicitly defined at 17:23-25, 17:63-18:10, and 5:20-46.	This element is not a means-plus-function element that should be construed according to 35 U.S.C. §112, ¶ 6 because it recites sufficient structure to perform the claimed function in its entirety. (see Picture Manager Process above)
"wherein said virtual output accepting means further comprises a window manager process for controlling the display of said plurality of related picture elements on said	In addition to the structure and function defined in claim 10, the claimed means includes: **Function**: mapping said plurality of related picture elements onto a rectangular area (called a "window) on the screen of said display device **Structure**: the operations performed by the Window Manager process,	This element is not a means-plus-function element that should be construed according to 35 U.S.C. §112, ¶ 6 because it recites sufficient structure to perform the claimed function in its entirety. (see Window Manager

display device"	which is a process that maps a given picture (or portion thereof) to a rectangular area of a given size on a given screen (a "window") in virtual pixels, as explicitly defined at 22:53-24:11 and 5:20-46.	Process above)
"wherein said virtual output converting means comprises a virtual output manager process responsive to said one or more processed picture elements for coupling said one or more processed picture elements to said at least one physical output device"	**Function**: coupling said one or more processed picture elements to said at least one physical output device **Structure**: the operations performed by the Output Manager process as explicitly defined at 19:32-20:64 and 5:20-46, wherein the physical output suitable for the screen is sent to the display device. Coupling is defined at 18:51-52, 19:59-61, and 23:51-54 as processes or structures that exchange messages via process identifiers (PID's) rather than by name	This element is not a means-plus-function element that should be construed according to 35 U.S.C. §112, ¶ 6 because it recites sufficient structure to perform the claimed function in its entirety. "Virtual output manager process" means the process by which virtual output is converted into real output on a particular physical device.
"wherein said means responsive to one of said physical input devices comprises a virtual input manager process"	**Function**: generating a picture from the input from a physical input device **Structure**: the operations performed by the virtual input manager process as defined at 18:24-19:31 and 5:20-46.	"Virtual input manager process" means the process by which input from a physical device is converted into virtual form
"wherein said means responsive to said one or more processed picture elements comprises a virtual output manager process"	**Function**: coupling one or more processed picture elements to one or more said physical display devices **Structure**: the operations performed by the virtual output manager process as defined at 20:4-42 and 5:20-46.	"Virtual output manager process" means the process by which virtual output is converted into real output on a particular physical device

Microsoft's proposed construction for these terms properly construes these limitations

under 35 U.S.C § 112 ¶ 6 by providing functions and structures that are consistent with the claim

language and disclosure by the patentee in the specification for the '839 patent. Motorola's

suggestion that these terms are not means-plus-function elements is improper. Each of these

terms uses the word "means," thereby creating the presumption that § 112 ¶ 6 applies. *TriMed,*

Inc. v. Stryker Corp., 514 F.3d 1256, 1259 (Fed. Cir. 2008) ("Use of the word 'means' in claim

language creates a presumption that § 112 ¶ 6 applies."). And Motorola may only overcome this presumption by proving that "the claim recites sufficient structure for performing the described functions in their entirety." *Id.* "Sufficient structure exists when the claim language specifies the exact structure that performs the functions in question without need to resort to other portions of the specification or extrinsic evidence for an adequate understanding of the structure." *Id.* at 1259-60. Motorola cannot meet this burden for these terms, however, because the structure disclosed in the claim cannot be adequately understood without reference to the specification. For example, Motorola points to at least one of the following structures for each term: "picture manager," "window manager," "virtual output manager," and "virtual input manager." None of these structures has a readily understandable meaning when read simply as part of the claim language; reference to the specification is required in order to understand the properties of these various "managers." This deficiency is evidenced by the fact, that in at least one instance ("wherein said virtual output accepting means comprises a picture manage process for controlling said plurality of related picture elements"), Motorola specifically incorporates by reference portions of the specification that are needed to define this structure. Thus, these terms do not "recite[] sufficient structure for performing the described functions in their entirety", *TriMed*, 514 F.3d at 1259, and thus are subject to § 112 ¶ 6.

By contrast, as discussed in part IV.F.3., *supra*, Microsoft's proposed functions for these elements comes from the language of the claims themselves, and Microsoft's proposed constructions limit these structures to those disclosed in the specification by incorporating the relevant portions of the specification by reference to line and column numbers. *See* part IV.F.3, *supra*. This Court should adopt Microsoft's proposed construction.

4. "picture element comprising ..."

Term	Microsoft's Construction	Motorola's Construction
"picture element comprising a plurality of device independent data structures in a predetermined, standard data format, at least one of said data structures comprising a plurality of different data fields each containing information describing said picture element"	an abstraction of a displayable object made up of a collection of predefined, standard device-independent data structures, including at least a common header data structure	A device-independent abstraction of a displayable object (e.g., line, text, etc.)

The claim language specifies that a "picture element" exists as a predetermined standard data format comprising a plurality of data fields. And the specification demonstrates that the patentee acted as his own lexicographer for the term "picture element"; the specification states that a "picture element" must include a "common header" data structure, including at least position, color, and size. '839 patent, Ex. 801 at 33:8-11 ("Picture elements are **defined** by a collection of data structures, **comprising one for a common 'header'**, some optional structures, and one for each of the possible element types.") (emphasis added), *id.* at 17:31-35 ("Each [picture] element consists of a common header, which includes the element's position in the picture coordinate system, its color, size, etc. and a 'value' which is unique to the element's type (e.g. a character string etc.).")". Consequently, a "picture element" must include a common header structure, which includes common attributes, such as color and size. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (*en banc*) ("[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs.") (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). Motorola's proffered construction impermissibly removes this requirement from the claim.

5. "virtual output"; "virtual input"

Term	Microsoft's Construction	Motorola's Construction
"virtual output"; "virtual input"	**"virtual input"** is a device-independent abstraction of physical input represented as one or more of a set of standard messages **"virtual output"** is a device-independent abstraction of physical output represented as one or more of a set of standard messages	**"virtual input"** means one or more picture elements generated from user input **"virtual output"** means one or more picture elements of a picture

Consistent with the claim language and the specification, Microsoft proposes that "virtual input/output" should be construed as a device-independent abstraction of physical input/output represented as one or more of a set of standard messages. One of the stated purposes of the alleged invention of the '839 patent is to allow physical input and output devices to interact with a computer system in a device-independent manner. *See* '839 patent, Ex. 801 at Abstract ("Since all human interface with the operating system is performed through such virtual devices, the system can accept any form of real input or output devices."); *see also id.* at 43:37-51 ("In the present invention all system interaction with the outside world is either through 'virtual input' or 'virtual output' devices. The system can accept any form of input or output device. . . . Virtual output devices produce device-independent output: text, lines, rectangles, polygons, circles, ellipses, discrete points, bit-mapped symbols, and bit-mapped arrays."). The patent specifies that this interaction is accomplished through "standard" messages. *See id.* at 12:14-26 ("All interaction with the user's environment is through either 'virtual input' or 'virtual output' devices. A virtual input device accepts keyboards, mice, light pens, analog dials, pushbuttons, etc. and translates them into text, cursor-positioning, action, dial, switch, and number messages. All physical input devices must map into this set of **standard messages**. . . . Similarly, a virtual output manager translates **standard output messages** to the physical representation appropriate to a specific device (screen, printer, plotter, etc.).") (emphasis added).

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Motorola's proposed construction for "virtual input/output" improperly focuses on the

term "picture element" without properly tying this term to input or output. The problem with

such a construction can be easily seen by the fact that Motorola's definition of "virtual output" is

so broad (a picture element that is part of a picture) that all "virtual input" necessarily qualifies

as "virtual output." Such a construction would directly contradict the plain language of claim 1,

which notes that virtual input can be in the form of a picture. The other relevant aspects of

"picture elements" are entirely in line with Microsoft's proposed construction for this term,

however. As discussed in part IV.G.1., the specification for the '839 patent specifically defines

"picture elements" as a "collection of data structures, comprising one for a common 'header',

some optional structures, and one for each of the possible element types." *See* '839 patent, Ex.

801 at 33:8-11. Therefore, a "picture element" includes one or more of a set of standard

messages as per its definition in the '839 specification. *See Phillips v. AWH Corp.*, 415 F.3d

1303, 1315 (Fed. Cir. 2005) (*en banc*) ("[T]he specification may reveal a special definition given

to a claim term by the patentee that differs from the meaning it would otherwise possess. In such

cases, the inventor's lexicography governs." (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288

F.3d 1359, 1366 (Fed. Cir. 2002))). Microsoft's construction properly ties these terms to input

and output (respectively), and therefore should be adopted.

6. "source of virtual input"

Term	Microsoft's Construction	Motorola's Construction
"source of virtual input"	"a physical input device corresponding to a virtual input device"	"A process which generates one or more picture elements from user input"

Consistent with the disclosures of the '839 patent, Microsoft proposes that this term be

construed as "a physical input device corresponding to a virtual input device." One of the stated

purposes of the alleged invention of the '839 patent is to allow physical devices to interact with a

computer system through virtual input and output devices. The specification and figures

demonstrate that virtual input is generated by a physical (or "real") device. Indeed, the

specification states that "[t]he lowest layer of HI software converts input from any '**real**'

physical devices to the generic, virtual form." '839 patent, Ex. 801 at 43:52-55 (emphasis

added). Further, the specification states that the input devices to be coupled to the system

through the "virtual" interface include physical devices such as "keyboards of varying

manufacture, 'mice', touch-pads, joy-sticks, [and] light pens." *Id.* at 2:6-8. Finally, the figures

of the '839 patent show that it is always a physical or real device interacting with a virtual input

manager to generate virtual input. For example, Figure 8 shows a physical device corresponding

with a virtual input device. Likewise, Figure 9 shows a physical input device corresponding to

an "input manager." Nothing in the '839 patent suggests that virtual input can be generated from

anything other than real world user input on a physical device. Thus, Microsoft's proposed

construction of a "source" of virtual input as a physical device corresponding to a virtual input

device is the correct one and should be adopted by the Court.

7.   "picture manager process"

Term	Microsoft's Construction	Motorola's Construction
"picture manager process"	"a process that constructs a device-independent representation of a picture using a small set of elemental picture elements and controls modification and retrieval of these elements, as explicitly defined at 17:23-25, 17:63-18:10, and 5:20-46."	"A Picture Manager process is a process that constructs a device-independent representation of a picture using a set of related picture elements and controls modification and retrieval of the picture elements."

Microsoft's proposed construction for this term is taken directly from the patent

specification and incorporates, as required by law, explicit definitions of terms provided by the

patentee in the specification. "The specification is the single best guide to the meaning of a

disputed term, and that the specification acts as a dictionary when it expressly defines terms used

in the claims or when it defines terms by implication." *Phillips v. AWH Corp.*, 415 F.3d 1303,

1321 (Fed. Cir. 2005) (internal citation omitted). The specification for the '839 patent contains

an explicit definition of the term "process":

> A 'process,' as used within the present invention, is defined as a self-contained
> package of data and executable procedures which operate on that data,
> comparable to a "task" in other known systems. Within the present invention a
> process can be thought of as comparable to a subroutine in terms of size,
> complexity, and the way it is used. The difference between processes and
> subroutines is that processes can be created and destroyed dynamically and can
> execute concurrently with their creator and other "subroutines". Within a process,
> as used in the present invention, the data is totally private and cannot be accessed
> from the outside, i.e., by other processes. Processes can therefore be used to
> implement "objects", "modules", or other higher-level data abstractions. Each
> process executes sequentially. Concurrency is achieved through multiple
> processes, possibly executing on multiple processors. Every process in the
> distributed data processing system of the present invention has a unique identifier
> (PID) by which it can be referenced. The PID is assigned by the system when the
> process is created, and it is used by the system to physically locate the process.
> Every process also has a non-unique, symbolic "name", which is a variable-length
> string of characters. In general, the name of a process is known system-wide. To
> restrict the scope of names, the present invention utilizes the concept of a
> "context".

'839 patent, Ex. 801 at 5:20-46; *see Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363,

1380 (Fed. Cir. 2009) ("When a patentee explicitly defines a claim term in the patent

specification, the patentee's definition controls."); *see also Sinorgchem Co., Shandong v. ITC*,

511 F.3d 1132, 1136 (Fed. Cir. 2007) (quotation marks are a strong indicator of a definition).

Furthermore, the specification for the '839 patent also provides an explicit definition of "picture

manager."*See* '839 patent, Ex. 801 at 17:23-25, 17:63-18:10. Consequently, Motorola's

proposed construction should be rejected because it does not define "picture manager" according

to how it is explicitly defined in the '839 specification, thereby impermissibly broadening the

scope of this claim element.

By contrast, Microsoft's proposed construction comes almost verbatim from the

specification, where the applicant defined "picture manager":

> The Picture Manager constructs a device-independent representation of a picture using a small set of elemental "picture elements" and controls modification and retrieval of the elements.

Id. at 17:9-12. Further, Microsoft's proposed construction explicitly incorporates the definition of "process." Consequently, Microsoft's proposed construction "stays true to the claim language and . . . aligns with the patent's description of the invention" (*Phillips*, 415 F.3d at 1316) and should be adopted.

8. **"window manager process"**

Term	Microsoft's Claim Construction	Motorola's Claim Construction
"window manager process"	"a process that maps a given picture (or portion thereof) to a rectangular area of a given size on a given screen (a 'window') in virtual pixels, as explicitly defined at 22:53-24:11 and 5:20-46."	"The Window Manager process is a process that maps all (or a portion) of a picture to a particular rectangular area (window) of a display screen, updates the display screen and controls the size and appearance of the window."

Microsoft's proposed construction for this term is taken directly from the patent specification and incorporates, as required by law, explicit definitions of terms provided by the patentee in the specification. As described above in part IV.G.2.b, the '839 specification explicitly defines "process." Further, the specification also defines "window manager":

> A Window Manager . . . maps a given picture (or portion thereof) to a rectangular area of a given size on the given screen . . . . Window Managers deal strictly in virtual pixels and have no knowledge about the physical characteristics of the screen to which they are writing. Consequently, a window's size and location are specified in virtual pixels, implying a conversion from real pixels if these are different.

Id. at 22:54-57; 24:7-11. *See Phillips*, 415 F.3d at 1315 (Fed. Cir. 2005) (*en banc*) (where the specification reveals "a special definition given to a claim term by the patentee," the "inventor's lexicography governs"). Microsoft's proposed construction explicitly incorporates the definitions of "process" and "window manager" and consequently "stays true to the claim

language and . . . aligns with the patent's description of the invention." *Phillips*, 415 F.3d at

1316. Thus, the Court should adopt Microsoft's proposed construction.

G.   5,764,899

The '899 patent describes methods of managing and reducing the bandwidth transmission

costs associated with email. *See generally* '899 patent, Ex. 901 at 1:16-2:14 (describing

problems solved by the patent). The claimed invention relates to the embodiment disclosed in

11:37 – 13:59 and various other places. The claimed invention allows an email recipient to use a

data communication unit to formulate a reply email, which is then optimized, meaning that the

device sends the communication server only the new portion of the message along with an

indicator of the message to which the reply responds. *Id.* at 11:48-12:8. The communication

server retrieves the original email that prompted the reply from a host storage device, adds the

new portion of the reply to the original message, and sends the combined reply ("replica reply")

to the intended target. *Id.* at 12:9-67.

1.   "A system for communicating reply data with a communication unit comprising"

Term	Microsoft's Construction	Motorola's Construction
"A system for communicating reply data with a communication unit comprising"	The preamble is limiting. The term means "A system for transmitting or receiving the reply email formulated on the communication unit before optimization"	The preamble is not limiting and should be construed according to its plain and ordinary meaning.

When the preamble provides antecedent basis for the claim, as in this claim, the preamble

is limiting. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005).

This term is the preamble to claim 1. The preamble's inclusion of "a communication unit"

provides antecedent basis for "a communication server, in communication with *the*

communication unit..." later in claim 1. The preamble provides antecedent basis and the context

to understand the meaning of the term "communication unit," so the preamble limits the claim's

scope. *See Seachange Int'l, Inc. v. C-Cor Inc.*, 413 F.3d 1361, 1376 (Fed. Cir. 2005).

Claim 1 defines "reply data" as "reply email of the communication unit." This is distinguished from the "further data" (the delta between the first email and the reply email), the "replica reply" (a replica of the reply email), and the "optimized reply" (comprised of a first data unit identifier and further data). '899 patent, Ex. 901 at Claim 1. Microsoft's definition substitutes the definition of "reply data" into the limiting preamble.

After that substitution, the specification further clarifies the confusing phrase "the reply email of the communication unit." This is what the communication unit user composed or formulated on the communication unit in response to the email that it received. The "reply email" is then optimized and sent according to the rest of the claim. *See id.* at 11:48-53 ("the process of FIG. 9 commences with *a client formulating a reply to a received mail message,* much as he or she would for any typical mail application. . . . [W]hen the user executes the reply, *e.g.*, by clicking on a send button, *the client controller . . . optimizes the reply message* by calculating a delta or difference . . .") (emphasis added). Microsoft asks the Court to adopt its construction because it is fully supported by the claim language and the specification.

2. The term "A system for communicating reply data with a communication unit" is indefinite

The '899 patent is invalid for failure to comply with 35 U.S.C. § 112 because the term "a system for communicating reply data with a communication unit" in the preamble of Claim 1 is indefinite. The '899 patent describes the optimized reply as "the remote communication units' controller generates a delta (e.g., data representing the content difference between the two messages) between a preceding message and the reply message, and *forms an optimized reply* using the delta and an identifier of the preceding message [sic]." *Id.* at 3:35-42 (emphasis added). The patent also describes a distinct formulation of a reply email on the communication

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unit before the formation of the optimized reply. *See id.* at 11:48-53 ("the process of FIG. 9

commences with *a client formulating a reply to a received mail message*, much as he or she

would for any typical mail application. . . . [W]hen the user executes the reply, e.g., by clicking

on a send button, *the client controller . . . optimizes the reply message* by calculating a delta or

difference . . .") (emphasis added). Motorola contends that Microsoft's proposed definition

requiring "the reply email formulated on the communication unit before optimization" is met by

"transmitting and receiving email that is formulated on the communication unit and sending an

optimized reply." Kaliski First Report on the '899 Patent at ¶ 84. Motorola essentially argues

that sending the optimized reply is sufficient to meet Microsoft's proposed definition of this

term. There is no definition for this term that acknowledges to one of ordinary skill in the art

that the "reply email of the communication unit" is different from the optimized reply, as

discussed above. This term is not amenable to construction and therefore indefinite.

The patent also describes this process in 11:48-12:8 where either the "normal reply" is

sent because it is a very short message or the optimized reply is sent "to ensure that only the

shortest message is being sent." When the communication server receives an optimized reply

(there are other embodiments related to other unasserted claims that send the reply email to the

communication unit for optimization), as in Claim 1, the communication unit has sent only the

optimized reply. There is no discussion in the '899 patent of a communication unit that could

send both the optimized reply and the "normal reply" (*i.e.* the reply email composed on the

communication unit before optimization). Because there is no description of such an operation,

this term is indefinite.

3. "a host server, in communication with the communication server"

Term	Microsoft's Construction	Motorola's Construction
"A host server, in	"The host server and the	"A computer or a program that

Term	Microsoft's Construction	Motorola's Construction
communication with the communication server"	communication server are separate processing devices (e.g., computers) transmitting to or receiving from each other over a network."	operates as an e-mail post office, which can exchange data with the communication server"

As a preliminary matter, the claim itself requires active transmission. It says that the host server is "in communication with" the communication server, which requires a state of transmitting or receiving instead of an option to exchange data at some point as Motorola's definition implies. This claim language is also distinct from other portions of the claim, where a server is "operable for" a task, meaning that it has the ability to perform the operation. Actual transmission is required by the plain and ordinary meaning of the claim language and Motorola's definition reads this limitation out of the disputed phrase.

The specification makes clear that the host server and the communication server are separate computers connected over a communication network. The claimed invention permits "a user to *minimize the data transmitted* for responses to earlier data transmissions." '899 patent, Ex. 901 at 11:37-39. The benefit of reducing transmissions is to reduce the cost in time and tariff charges in bandwidth limited communication systems. *Id.* at 11:44-46; *see also id.* at 12:55-67. There is no similar concern mentioned in this patent about reducing transmissions from program to program within a single processing device, a limitation that Motorola's definition tries to add.

The embodiment in Motorola's definition of different programs on the same processing device is simply not enabled in the claimed invention of the '899 patent. At 7:23-32, the communication server's role is described as maintaining the communication session between the client and the host, and not acting as a remote server that stores emails. The communication server is a separate physical entity that is an intermediary between the communication unit and the host server where the emails are stored. A program on the same processing device cannot

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maintain both a sessionless and session-oriented protocol between different programs because these terms relate to network connections. *See, e.g., id.* at 4:4:16.

It is unnecessary to resort to related patent applications as Motorola does since the patentees addressed this language during **the prosecution of the patent-in-suit** in a manner inconsistent with the evidence Motorola cites. The public is entitled to rely upon statements made in the prosecution history of the patent to distinguish the scope and meaning of the claims, and such statements should be considered during claim construction. *See Seachange Int'l, Inc.,* 413 F.3d at 1372. While distinguishing over the Morgan reference, the patentees emphasized that Morgan did not provide a second server for mailbox storage. Ex. 902 at MS-MOTO-SDFLA_00000014174. Specifically, their invention was different from Morgan because Morgan "fails to teach or suggest that the office server 101 *sends a request for a data unit to another server or any other computer* during the document transmission mode." *Id.* The patentees also argued that one or ordinary skill would not have been motivated to combine Morgan storage of documents at a **remote location** that requires additional network transmissions. *Id.; see also id.* at MS-MOTO-SDFLA_00000014175. When, as here, the patentees argue that a claim possesses a feature to distinguish over prior art, the argument may narrow the claim's scope. *See Seachange Int'l, Inc.,* 413 F.3d at 1372-73 (Fed. Cir. 2005).

In fact, the patentees also distinguished a portion of the patent specification during prosecution based on the need for the host server to store emails remote from the communication server in the claimed invention. The examiner said that it doesn't matter where the servers are located as long as the signal path is clear (*see* '899 patent, Ex. 901 at 5:11-13). The patentees distinguished this section by saying (correctly) that all words in a claim must be given meaning and that the claim says that the mailbox is at the host server. Ex. 903 at MS-

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MOTO_SDFLA_00000014328-14330 (distinguishing Morgan's document stored in

communication server's memory from the claimed invention). Motorola even submitted a

declaration from an expert during the prosecution of the patent stating that the patent should be

understood in light of the terminology in the SMTP protocol and the post office protocols that

allowed a client device to remotely access a post office email mailbox at another location. Ex.

904 at MS-MOTO_SDFLA_00000014442-14448.

Since Motorola has previously argued that the claim requires the host server at a remote

location from the communication server, it cannot now argue that the claim covers separate

programs on the same computer. Motorola's reliance on the prosecution history of related

patents instead of the prosecution of this patent shows that its definition is unfounded and does

not apply to the claims in this patent. Microsoft respectfully asks the Court to adopt its

construction that is based on the arguments the applicants made about this claimed invention.

4. "email"; "e-mail"

Term	Microsoft's Construction	Motorola's Construction
"Email"; "e-mail"	"A message, transmitted to a mailbox, having text and header information used for transmitting the text. The header information includes at least the recipient mailbox address and the author address and may include other message attributes such as subject, date, and priority level."	Plain and ordinary meaning or, alternatively: "electronic mail"

It is necessary to define exactly what the claim means when it requires transmitting email

so that it is clear what must be transmitted for infringement. Motorola argues that it is not

necessary to define this term and is presumably satisfied with the idea the jury may have that

only the text portion of an email must be transmitted. Microsoft's definition is based on the

prosecution history of this patent and the patent's specification.

During prosecution, the patentees submitted an affidavit from an expert who declared that

email was exemplified by the SMTP protocol, which has

> ...a description of the process for sending an email from one user to another user's mailbox. This involves addressing the email appropriately with the destination user's mailbox address and then communicating with the SMTP protocol using RFC 821. See Ex. 904 at MS-MOTO_SDFLA_00000014446-14448.

Microsoft's definition is based primarily on this particular definition that Motorola supplied to the USPTO. The email is the text plus the information necessary to transmit it (the header) to the intended mailbox. The header must include the destination mailbox address and the author's address so that replies can be properly addressed.

The patent specifically references the use of header information as the identifying information for the original email sent to the communication unit for the claimed invention. '899 patent, Ex. 901 at 4:55-56 and 11:60.

Claim 15 requires a specific email to include "a textual message . . . accompanied by a file attachment." This claim reinforces the idea that the email is more than the textual portion of the message. *See Phillips*, 415 F.3d at 1335 ("an independent claim should be given broader scope than a dependent claim to avoid rendering the dependent claim redundant") (citation omitted).

Finally, the specification discusses filterable attributes that include the priority, date, size, author, and subject of the message. '899 patent, Ex. 901 at 8:16-39; 9:62-67 (listing filtering criteria as priority, date, size, author, or subject/key word); 10:23-34 ("This *header information* may include any filterable attribute (e.g., date, author, subject size, priority, attachment indicator) . . ."); 13:29-42 (describing finding a preceding email based on author, date, recipient, subject); Fig. 8 (showing specific header information); 14:15. Because the patent allows these email attributes to be filtered, they must be transmitted as part of the email.

Both parties cite extrinsic evidence that shows email is both the text and the process of

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communicating the text. *A Computer Dictionary*, Ex. 905 at p. 125 (Microsoft Press 1991)

defines electronic mail as "the transmission of messages over a communication network."; *see*

also The Microsoft Press Computer Dictionary, 2d ed., p. 174 (1994) (a dictionary identified by

Motorola that defines electronic mail the same way).

Microsoft's definition clarifies that the email is not just the text portion of the message

and is supported by the intrinsic and extrinsic evidence.

5. "forwarding"; "forward" "forwards" "forwarded"

Term	Microsoft's Construction	Motorola's Construction
"forwarding" / "forward" / "forwards" / "forwarded"	"Sending [send, sends, sent] from one processing device (e.g., computer) to a separate processing device (e.g., computer)"	Plain and ordinary meaning or, alternatively: "Forwarding from one computer or program to another"

As the various claims containing this term (1, 14, 16, and 17) make clear, the forwarding

occurs from one entity to another. For example, the first data unit is sent from the host server to

the communication server in claim 1.

The specification further proves that "forwarding" describes sending from one processing

device to another. Claim 14 requires a determination to be made on the communication server

about whether to forward the optimized reply or replica reply, a process the specification

describes in 12:9-13. There the forwarding is from the communication server to the target unit,

which is indisputably a separate processing device.

As discussed above regarding the "host server, in communication . . ." term, the patent is

concerned with the network connection between the host server and communication server and

between the communication server and the client. *See* '899 patent, Ex. 901 at 7:23-32. The

point of the claimed invention is to limit the bandwidth transmissions. *Id.* at 11:37-39.

Transmissions on programs within a device would not be transmitted over a communication

network, and would not require attention to bandwidth usage and transmission costs associated

with limited bandwidth networks. *See id.* at 11:44-46; *see also id.* at 12:55-67.

As also discussed above regarding the "host server, in communication . . ." term,

Motorola's prosecution of this patent makes clear the requirement that the entities in the claim

are distinct processing devices and not merely separate programs on the same device. Since

Motorola distinguished its invention over Morgan, where Motorola claimed the host storage was

on the same device as the communication server (*see, e.g.*, Ex. 902 at MS-MOTO-

SDFLA_00000014174), Motorola cannot now claim that it is unimportant whether the various

entities between which the forwarding occurs are distinct devices.

Microsoft asks the Court to adopt its construction, which comports with the language of

the claim, the specification, and the prosecution history – all of which require forwarding from

one processing device to another rather than among programs on a single device.[5]

6. **"a determination is made whether to forward the optimized reply or a replica reply"**

Term	Microsoft's Construction	Motorola's Construction
"A determination is made whether to forward the optimized reply or a replica reply"	"A comparison is made at the communication server whether to forward the optimized reply or replica reply based on the known parameters of the target communication unit, such as whether the target is served by the same communication server, was an original addressee, or has deleted the original message."	Plain and ordinary meaning or, alternatively: "the communication server decides whether to forward the optimized reply or the replica reply."

Microsoft's definition comes straight from the specification. In fact, it is based on the

portion of the specification that Motorola cites for its definition. Unlike Motorola's arbitrary and

incomplete definition, Microsoft's definition is true to the specification's language.

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[5] The parties previously sought construction for the term "a determination is made whether to forward the optimized reply or a replica reply." Since this term appears only in claim 14, a claim which, according to Motorola's expert, Motorola is no longer asserting, To the extent that Motorola still claims that this term requires construction, Microsoft reserves the right to respond in subsequent briefing with a proposed construction and basis for that construction.

The specification says:

> When the optimized reply is received *at the QM of the communication server*, a *determination is made* whether to reconstruct the normal reply message (i.e., form a replica reply) or to forward the optimized reply, *based on the known parameters (if any) of the target communication unit/client*. '899 patent , Ex. 901 at 12:9-13.

Microsoft's definition is from this portion of the specification and paraphrases the examples of "parameters of the communication unit" listed in 12:14-28. It is not as critical that the examples are included in the definition, but the Court may agree that their inclusion as examples of the complicated phrase "parameters of the target communication unit" is clarifying for the jury and prevents the experts from arguing about what the patent intended by this phrase.

H.   5,784,001

The '001 patent describes the problem it solves as allowing a user who speaks a particular language to understand messages he receives in a different language. *See* '001 patent, Ex. 1001 at 1:30-36. Although there are several embodiments in the patent, the *claimed* invention is mainly described in 6:1-50. In that embodiment, the data communication receiver receives an alphanumeric message and compares the words in the message to the key words in a database located on the data communication receiver. *Id.* at 6:39-43. When a match is found, the message text is displayed along with a supplemental image. *Id.* at 6:49-50. When there is no match, just the message is displayed. *Id.* at 6:43-44.

1.   "A method ..."; "A data communication receiver ..."

Term	Microsoft's Construction	Motorola's Construction
"A method for displaying messages in a data communication receiver"; "A data communication receiver for presenting information"	The preamble is limiting. All claim elements are a part of or performed on the mobile communication device receiving the message.	The preamble is a limitation that should be construed according to its plain and ordinary meaning.

Although Motorola agrees that the preamble is limiting, Motorola does not agree that all

of the elements of the claims are a part of or performed on the data communication receiver.

Each independent claim of the '001 patent contains the "data communication receiver" limitation in the preamble, which (along with the specification) indicates the importance of the data communication receiver as a characteristic of the claimed invention. *See Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1310 (Fed. Cir. 2004) (limitation in title, summary of the invention, preferred embodiments, and each claim shows that the inventor considered the preamble language represented an important characteristic of the claimed invention). Since asserted claims 4 and 6 are each for data communication receivers, it seems that the only real dispute once the parties agree that the preamble is a limitation is whether the method steps in claim 1 must all be performed on a data communication receiver.

The title of the patent is "Method and Apparatus for Presenting Graphic Messages *in a Data Communication Receiver,*" which highlights that the claimed invention is intended to be in a data communication receiver. The patent also describes the method and apparatus as taking part of or being a part of the data communication receiver in several places. *See* '001 patent, Ex. 1001 at 2:57-60 ("predetermined code is *recognized by the data communication receiver 100*"); 3:1-3 ("graphic images . . . are preferably stored by the *data communication receiver* 100 in . . . a graphics database 155."); Abstract; claims 1, 3, 4, and 6; Fig. 1, 1:9-11 (field of the invention is "*data communications receivers* ..."). The patent also specifically describes each step of the method claim as being part of or performed on the data communication receiver. *See* '001 patent, Ex. 1001 at 3:46-48 (receiving an alphanumeric message); Fig. 1 at 110 (having a receiver); 5:66-6:4 (receiving programming message...); 6:5-13 (storing a key word and image data in a database); 2:57-60 and 3:1-2 (referencing a database to determine...); and 4:33-63 (both presenting elements).

2. "referencing a database ..."; "determining whether at least one word included in the alphanumeric message ..."

Term	Microsoft's Construction	Motorola's Construction
"referencing a database to determine whether at least one word included in the alphanumeric message matches at least one key word included in the database"; "determining whether at least one word included in the alphanumeric message matches at least one key word included in the database"	"Searching a particular database on the data communication receiver to compare each alphanumeric word parsed from the message for a match between it and the alphanumeric key words in the database. Alphanumeric only includes numbers and alphabet characters."	Plain and ordinary meaning.

Throughout the specification, the database is described as included on the data communication receiver. *See e.g.,* '001 patent, Ex. 1001 at 3:16; Fig. 1; Abstract ("a *data communication receiver* (100) *includes* a receiver for receiving a message including at least one code, *a database* (155) for storing codes and image data associated with the codes...").

The "present invention" has "codes and image data *stored in a graphics database included in the data communication receiver of FIG. 1 in accordance with the present invention.*" *Id.* at 1:45-47. "When a patent thus describes the features of the 'present invention' as a whole, this description limits the scope of the invention." *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007). Further, there is no enablement in the patent of a database on a *transmitter* that is compared with a message received on the data communication receiver. The database referenced must be on the receiver.

The prosecution history makes clear that the claimed invention is also limited to alphanumeric key words. The original claims were directed to code words. *See* Ex. 1002 at MS-MOTO-SDFLA_00000017201-204 (original claims) and Ex. 1003 at MS-MOTO-SDFLA_00000017248-251 (amended claims). The patent gives "#09#04" ('001 patent, Ex. 1001 at 3:42) as an example of codes and says "*codes* recognized by the receiver 100 as

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indicative of graphic messages *begin with the "#" character...*" '001 patent, Ex. 1001 at 3:19-21.

In response to the examiner's rejection of the original claims, the applicants amended the remaining claims to require the use of key words for comparison with the message. Ex. 1003 at MS-MOTO_SDFLA_00000017247-258. Further, the applicants distinguished Gaskill from their invention because it did not disclose "determining whether a *word* of a received message *matches a key word* stored in a database...." *Id.* at 17253. A word has meaning and is not just a nonsensical combination of characters. The applicants have clearly surrendered simply using codes for this element based upon the amendment to the claims and distinguishing over prior art on this basis. Thus, the claimed invention is limited to key **words** that do not include symbols, instead of codes, which would include symbols.

The key word is compared against the alphanumeric message. The key words contained within that message must also be alphanumeric or else they would never match. This is consistent with the applicants' description of their invention as requiring a determination of whether a **word** matches a key word in the database. Ex. 1003 at MS-MOTO_SDFLA _00000017253. In both places, the emphasis is on the use of words rather than symbols.

3. "graphic message ... accompanied by ..."

Term	Microsoft's Construction	Motorola's Construction
"graphic message that is accompanied by the alphanumeric message"; "graphic message accompanied by the alphanumeric message"; "graphic message accompanied by the message"	"At least one supplemental image is displayed along with the entire alphanumeric message."	"At least one image is displayed along with a portion of, or the entire, alphanumeric message"

The plain language of the claims requires the graphic to supplement the entire alphanumeric message. Each independent claim of the '001 patent requires the data communication receiver to display the graphic "accompanied by the alphanumeric message" or

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"accompanied by" the message. '001 patent, Ex 1001 at Claims 1, 4, 5, and 6. There is no

language allowing for substitution of the key word with the image or for displaying only a part of

the alphanumeric message that the data communication receiver received (such as everything but

the key word).

The patent's specification also supports Microsoft's construction: "when *messages are*

displayed, images associated with the key words *are displayed as well to supplement the*

message." *Id.* at 6:23-25. An example shows that if a message includes the words "CALL" or

"PHONE" "the *message would be displayed* as text along *with a supplement image* of a

telephone as shown in **FIG. 15.**" *Id.* at 6:27-31; *see also id.* at 6:31-36; Figs. 15 and 16; 6:48

(display the *message text and the supplemental image*); 7:67-54 (text *message* can be displayed

along *with a supplemental image*). The applicants claimed very specific embodiments and the

prosecution history required the narrowing of the claimed invention as discussed above in the

"referencing a database ..." element, so not every portion of the specification is relevant to the

claimed invention. Only portions referencing a database for a *key word* and where the graphic

message accompanies the alphanumeric message are claimed.

As discussed above, the original claims were directed to embodiments using codes,

including embodiments using codes to substitute graphics into a portion of the message. *See*

e.g., Ex. 1002 at MS-MOTO-SDFLA_000000017201-204 (original claims); '001 patent, Ex. 1001

at 3:17-5:14. However, in response to the Examiner's rejection of those claims, the applicants

cancelled the claims directed to codes and amended the remaining claims substantially. *See* Ex.

1003 at MS-MOTO-SDFLA_00000017248-251 (amended claims). One amendment was the

addition of the "accompanied by" language. *Id.* at 17248-251. The applicants distinguished

their invention from the cited art by saying that the references did not disclose "a *graphic*

message ... as well as the *original alphanumeric message* received by the communications

receiver" and contained "no suggestion that a *graphic message can be displayed to supplement*

the meaning of a conventionally entered and received *alphanumeric message.*" *Id.* at 17254-255

(emphasis added). The applicants explained that "the *alphanumeric message itself is presented*

along with any graphic message so that meaning of the graphic message is clarified when read

by user having the appropriate language skills." *Id.* at 17255 (emphasis added). As the

applicants stated, the claimed invention is to a graphic that is a supplement to the entire

alphanumeric message. To adopt Motorola's overly broad definition wrongly would allow

Motorola to recover disclaimed subject matter. *Phillips,* 415 F.3d at 1317.

4. "programming means ..."; "storing means ..."

Term	Microsoft's Construction	Motorola's Construction
"programming means coupled to the processor and to the database for programming the database, the programming means further comprising: the receiver for receiving a programming message including a key word and image data; a memory for storing a programming word; and storing means for storing the key word and image data in the database in response to determining that the programming message includes the programming word"	**Function**: programming the database, receiving a programming message including a key word and image data, storing a programming word, storing the key word and image data in the database in response to determining that the programming message includes the programming word **Structure**: none. The claim is indefinite for claiming processor 120, programmed to perform the function of "storing the key word and image data in the database in response to determining that the programming message includes the programming word" without disclosing the internal structure of that processor in the form of an algorithm.	This element is not a means-plus-function element, alternatively: **Function**: "programming the database" **Structure**: "The Receiver, the Decoder, the Memory, and a program for operating the Processor according to the algorithm of Figure 13."
"storing means for storing the key word and image data in the database in response to	**Function**: storing the key word and image data in the database in response to determining that the programming message includes the programming word	**Function**: "storing the key word and the image data in the database in response to determining

| determining that the programming message includes the programming word" | **Structure**: none
The claim is indefinite for claiming processor 120, programmed to perform the function of "storing the key word and image data in the database in response to determining that the programming message includes the programming word" without disclosing the internal structure of that processor in the form of an algorithm. | that the programming message includes the programming word"
Structure: A program for operating the Processor according to steps 360, 370, 375 and 380 of the algorithm of Fig. 13. |

These terms are indefinite because the patent does not disclose sufficient structure for the "storing means." The shorter "means" term is contained in the longer "means" term, so any problems with the shorter term also infect the longer term.

"In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclose structure is not the general purpose computer, but rather the special purpose computer, or microprocessor, programmed to carry out an algorithm." *Blackboard Inc. v. Desire2Learn Inc.*, 574 F.3d 1371 (citing *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008)). For the function of "storing the key word and image data in the database in response to *determining that the programming message includes the programming word*" Motorola claims the corresponding structure is "a program for operating the Processor according to steps 360,370, 375 and 380 of the algorithm of Fig. 13." The alleged algorithm fails to disclose **how** to determine that the programming message includes the programming word. In fact, Motorola's definition omits the part of the figure that shows the determination in question. Looking at Fig. 13, box **355** is labeled "message include programming word?" but it is not part of Motorola's definition.

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Further, this box 355 is not a

disclosure of an algorithm, but simply an

acknowledgement that an algorithm is

needed. It does not tell one of ordinary skill

in the art **how** to determine whether the

message includes a programming word, just

that they **should** do it. "A patentee cannot

avoid providing specificity as to structure

simply because someone of ordinary skill in

the art would be able to devise a means to

perform the claimed function. To allow that

form of claiming under section 112,

FIG. 13

paragraph 6, would allow the patentee to claim all possible means of achieving a function."

Blackboard Inc, 574 F.3d at 1385 (citation omitted).

When there is no disclosed algorithm, the claims are invalid for lack of a sufficient

recitation of structure. *Id.* at 1384 (citations omitted). Motorola has identified some structure for

part of the function and then argues that the "determining..." portion of the recited function is

merely a precondition for the portions of the function for which they identified structure. The

reason Motorola makes this argument is because there is no disclosure in the patent for how to

make this determination. This argument reads out a portion of the claim. It is not possible for

this claim to be performed without making this determination, and the applicants chose to

include it in the means-for portion of their claim. The failure to identify any structure for

"determining..." renders the claim indefinite for failing to disclose a corresponding structure to
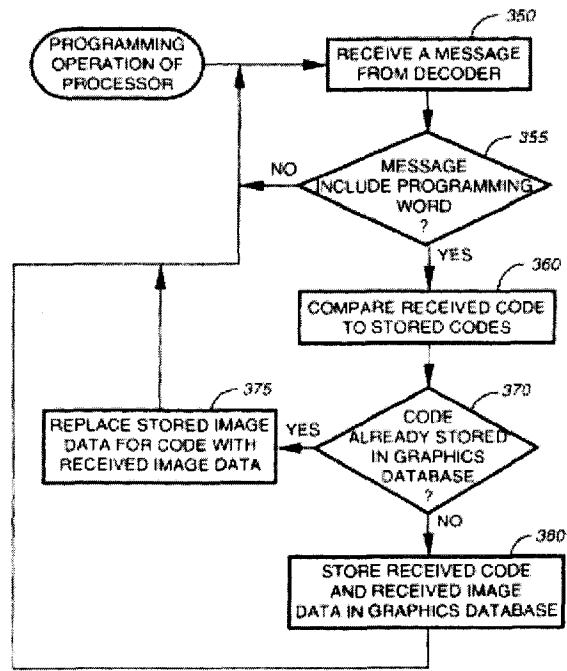
the complete recited function. *See In re Katz Interactive Call Processing Patent Litigation*, 2011

U.S. App. LEXIS 3212 (Fed. Cir. Feb. 18, 2011) (affirming finding that claim was indefinite for

failing to disclose algorithm that corresponded to portion of recited function). The function

requires the determination, so Motorola's failure to identify a corresponding structure is fatal.

Since this term is indefinite, claim 4 is invalid and no further analysis is necessary.

If the Court finds separate analysis of the longer phrase necessary, the term is also a

"means-plus-function" term. A claim element that contains the word "means" and recites a

function is presumed to be subject to 35 U.S.C. § 112 ¶ 6. *Altiris, Inc. v. Symantec Corp.*, 318

F.3d 1363, 1375 (Fed. Cir. 2003). And the longer term of "programming *means* . . ." is written

in just that way.

Motorola, however, identified less than the entire recited function. The Court may not

improperly broaden the claim by ignoring clear limitations in the claim language. *Lockheed*

Martin Corp. v. Space Systems/Loral Inc., 324 F.3d 1308 (Fed. Cir. 2003) ("The function of a

means-plus-function claim must be construed to include the limitations contained in the claim

language.") Because the "programming means" language uses the open transition "comprising,"

the programming means must include at least structure for each of the functions included in the

subordinate elements. Once all of the recited function is correctly identified, the problems

discussed above with the shorter phrase also infect the longer phrase.

There is an additional problem with the longer term. The claim requires "programming

means, *coupled to the processor*. . ." Both parties agree that the shorter phrase "storing

means..." appears to disclose a processor performing an algorithm. But the processor in the

claim language lacks antecedent basis to any additional processor, and it is unclear how the

programming means, specifically the storing means, can be both coupled to the processor and

include the processor. The patent does not disclose multiple processors. Since the patent does

not disclose a corresponding structure for the recited function, this claim is indefinite for failing

to identify the corresponding structure. *See In re Katz Interactive Call Processing Patent*

Litigation, 2011 U.S. App. LEXIS 3212 (Fed. Cir. Feb. 18, 2011) (affirming indefiniteness for

failing to disclose algorithm corresponding to portion of recited function).

5. "programming message"

Term	Microsoft's Construction	Motorola's Construction
"programming message"	"A message, received by the receiver separately from the alphanumeric message, that includes a predetermined programming word indicative of programming information, a key word, and an image associated with the key word."	A message that creates or modifies an association between a key word and image data.

The claims require a programming message that is a distinct element from the

alphanumeric message. All limitations in a claim have meaning and a construction that reads out

claim elements cannot be correct. *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*,

381 F.3d 1111, 1119 (Fed. Cir. 2004) (rejecting a construction that would read the term

"operatively" out of the phrase "operatively connected" because all claim terms are presumed to

have meaning in a claim). Since the claim language requires two different messages, it is

improper to eliminate the distinction between them. Further, since a programming message will

include an image, it is not an alphanumeric message.

Microsoft's definition is also grounded in the specification. The patent explains the

programming message as:

> *a programming message, which includes the predetermined programming word*
> ....The programming word, which indicates to the data communication receiver
> **100** that the information appended to the word is to be utilized for programming
> the graphics database **155** .... The *message also includes a code, either existing*

or new, followed by image data to be written into the graphics database 155.
'001 patent, Ex 1001 at 5:52-62 (emphasis added). [6]

According to the patent, **Fig. 12** shows an example of a programming message transmitted to the data communication receiver. *See* '001 patent, Ex. 1001 at

ADDRESS	MESSAGE		
	PROGRAMMING WORD	CODE	IMAGE DATA
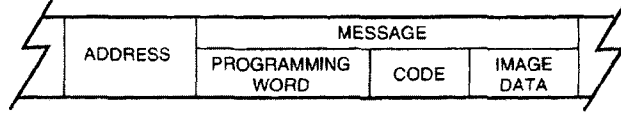
FIG. 12

1:61-64; 5:48-65. In this example, and throughout the patent's specification, the programming message contains a programming word that indicates the transmission of programming information. *See also id.* at 6:1-7 (describing determination of whether message includes a programming word as the first step upon receiving a programming message). The programming word is necessarily part of the programming message.

Further, the patent describes the programming message (*see* '001 patent, Ex. 1001 at 5:66-6:18) and the alphanumeric message (6:19-50) as distinct messages. The first step upon receiving a programming message is to check for the programming word; the first step in receiving an alphanumeric message is to compare the words of the message to the words in the graphics database. *See id.* at Fig. 17. There is no enablement of a combined alphanumeric/programming message in the specification.

Motorola's definition also adds the unsupported limitation that the programming message creates or modifies an association between a key word and an image. As Fig. 12 shows, the message contains data, it does not execute any program or take any actions to create or modify anything.

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[6] Since the applicants amended the claims to require key words instead of code words, Microsoft's definition changes the patent's definition to require a key word and image data. Motorola's definition similarly acknowledges the change to key word from code word.

Finally, the parties dispute the meaning of image data. As discussed above, the patent describes the programming message as having image data that is stored in the graphics database. The '001 patent makes clear that the image data is stored in the database on the receiver and referenced to display a graphic. Claims 1, 4, and 6. Motorola argues that the image data needs only be representative of an image. However, this patent's description of being representative of an image is more than a pointer or a key word; it is what is needed to draw the image. For example, in Figure 10, element 245 says "drive display with image data." It is not possible to drive the display with a pointer to a file. You need the file. The same figure says that step 240 is to "compare message codes in graphics database to retrieve associated image data." Since the very next step is to drive the display with the **image data**, we know that the associated **image data** is what you need to display the image, not a reference to an image. *See also* Fig 17 ("drive display with image data" in 425); 4:56-63 (the image data is used to drive the display). The image data that drives the display is the same image data that is stored in the database. *See id.* at 3:6-12; 6:45-50. With this broader understanding of the patent, it is clear that the image data is the actual content needed to draw the image, and not a mere pointer to the information needed to draw an image.

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6. Claim 6 is indefinite.

Claim 6 requires "a display for presenting, when at least one alphanumeric word matches at least one key word, a corresponding image as a graphic message accompanied by the message, and for presenting, when at least one alphanumeric word does not match at least one key word, the message unaccompanied by any graphic messages." To see why this phrase is indefinite, suppose key word A is a match and the word B is not a match. If the message "A then B" is received, the claim element requires the display of a corresponding graphic message to A accompanying the message and also that the message be unaccompanied by any graphic messages due to the non-match of B. This cannot happen. Thus, this phrase is indefinite because one of ordinary skill in the art cannot understand how to perform both requirements.

I. 6,272,333

The "Background" section of the '333 patent sets up the problem to be solved, stating that it is "desirable *not* to send data to a subscriber unit that the subscriber unit cannot utilize." Ex. 1101, at 1:27–:29 (emphasis added). The solution disclosed by the '333 patent requires maintaining an "application registry" in the "subscriber unit" that includes a list of the applications accessible to the "subscriber unit," and *also* keeping a current copy of the "application registry" in the "fixed portion" of the wireless communication system, so that whenever the "fixed portion" has data to send to the "subscriber unit," the "fixed portion" can check its copy of the "application registry" (rather than the "application registry" in the "subscriber unit") and send the data only if the checking step determines that an application compatible with the data is accessible to the "subscriber unit." *Id.* at 1:43–:58, 3:67–4:1; ███████ ███ Thus, for example, the "fixed portion" would not send PDF data to a subscriber unit that did not have access to the Acrobat application. According to the '333 patent, the advantage of this solution is that it does "not

require an over-the-air session for each delivery of data to determine whether the subscriber unit

can utilize the specific data type." Ex. 1101, at 1:36–39; *accord id.* at 7:13–:16; ███████████

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1. "data"

Term	Microsoft's Construction	Motorola's Construction
"data"	"information to be processed by an application, not an application or a software update for an application"	"digital information"

1. A method . . . for controlling a delivery of *data* from a fixed portion of the wireless communication system to a subscriber unit . . . comprising . . . sending the *data* only when the checking step determines that an *application* compatible with the *data* is accessible [t]o the subscriber unit.

5. The method of claim 1, . . . wherein the method further comprises . . . taking a predetermined action to trigger a *software update* when the application version number is an old version.

The language of the claims shows that "data," "application," and "software update" are three separate things. The claims distinguish between "data" and "applications," and always refer to data as information to be processed by an application. *See* Ex. 1101. For example, claims 1 and 7 recite "an *application* compatible with the *data*," and claims 2 and 8 recite converting "incompatible *data* to a format compatible with one of the *applications*." *Id.* The claims also distinguish between "data" and a "software update." For example, claim 5, which depends from claim 1, includes triggering a "software update" if the application version number is old, *in addition* to sending "data" only when there is an "*application* compatible with the *data*." *See id.* Claim 10 is similar. *See id.*

The Federal Circuit has held that "[d]ifferences among claims can . . . be a useful guide in understanding the meaning of particular claim terms." *Phillips*, 415 F.3d at 1314. An instructive case is *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1329, 1331–32 (Fed. Cir. 2008).

The specification, like the claims, also distinguishes between "data" and "applications."

The specification asserts that "it is impractical to expect that a class-of-service distinction . . . can define all the *types of data* that the *applications* accessible to a specific subscriber unit can support." Ex. 1101, at 1:21–25 (emphasis added). Thus the specification proposes keeping an "application registry" and then "sending the *data* only when the [step of checking the application registry] determines that an *application* compatible with the *data* is accessible to the subscriber unit." *Id.* at 1:56–58 (emphasis added).

The prosecution history, like the specification and the claims, also distinguishes between "data" and "applications." *See* Ex. 1102, at 1397, 1419. So does the cited[7] prior art. *See, e.g.*, Ex. 1105, at 1:36–:39, 4:65–:67, 5:4–:13 & Fig. 3.

2. "controlling a delivery of data"

Term	Microsoft's Construction	Motorola's Construction
"controlling a delivery of data"	"delivering data only after checking in the fixed portion whether an application compatible with the data is accessible to the subscriber unit"	"managing whether and when data is delivered"

12. A subscriber unit in a wireless communication system for *controlling a delivery of data* from a fixed portion of the wireless communication system . . .

The phrase "controlling a delivery of data" is fundamental to the claimed invention: it is in the title of the invention; the description of the patent's solution for the problem to be solved, *see* Ex. 1101, at 1:30–:32; the description of the invention in the "Summary of the Invention," *see id.* at 1:43–2:24; the conclusion of the specification, *see id.* at 7:6–:9; and every single

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7 "This court has established that 'prior art cited in a patent or cited in the prosecution history of the patent constitutes intrinsic evidence.'" *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1311 (Fed. Cir. 2005). The Smith '085 patent, *see* Ex. 1105, was cited as prior art, *see* Ex. 1101 (upper-right of cover page), and discussed extensively during prosecution, *see, e.g.*, Ex. 1102, at 1381–88, and thus constitutes intrinsic evidence that may be used to understand the '333 patent.

claim.[8]

The specification states that *"the present invention"* requires the *"fixed portion"* to

accomplish the act of "controlling a delivery of data" by "sending the data only when the [step of

checking the application registry *in the fixed portion*] determines that an application compatible

with the data is accessible to the subscriber unit." *See id.* at 1:41–:58. The use of "the present

invention" in the quote above is significant, because it indicates that the quote is describing the

invention itself, not merely a preferred embodiment: "[w]hen a patent thus describes the features

of the 'present invention' as a whole, this description limits the scope of the invention." *Verizon

Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007).[9]

The description of "the present invention," as quoted above, is consistent with the

repeated statements throughout the specification that the *"fixed portion"* sends data to the

subscriber unit only after checking *in the fixed portion* whether an application compatible with

the data is accessible to the subscriber unit. *See, e.g.*, Ex. 1101, at Abstract, 1:54–59, 2:6–9,

4:36–44, 7:35–40, 8:33–37. The specification emphasizes that the advantage of the claimed

method and apparatus for "controlling a delivery of data" is that it "does not require an over-the-

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[8] Given the importance of the phrase "controlling a delivery of data," it must be treated as a
limitation in claim 12, even though the phrase only appears in the preamble. *See, e.g., Vizio, Inc.
v. ITC*, 605 F.3d 1330, 1340 (Fed. Cir. 2010) ("[T]he 'for decoding' language in the preamble of
claims 1 and 23 is properly construed as a claim limitation . . . because 'decoding' is the essence
or a fundamental characteristic of the claimed invention."); *Poly-America, L.P. v. GSE Lining
Tech., Inc.*, 383 F.3d 1303, 1310 (Fed. Cir. 2004) (holding that "blown-film" liner in the
preamble was a limitation because the term appeared in the title of the patent, the Summary of
the Invention, the description of the preferred embodiments, and every single claim).

[9] *See also, e.g., Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1378 (Fed. Cir.
2008) ("[T]he specification repeatedly describes the invention as a microcomputer . . . . [T]he
specification never identifies the invention as a laptop."); *Honeywell Int'l, Inc. v. ITT Indus.,
Inc.*, 452 F.3d 1312, 1318 (Fed. Cir. 2006) ("On at least four occasions, the written description
refers to the fuel filter as 'this invention' or 'the present invention' . . . .").

air session for each delivery of data to determine whether the subscriber unit can utilize a

specific data type." *Id.* at 7:13–16.

During prosecution, the applicant repeatedly distinguished *all* the claims from the prior

art by arguing that "controlling a delivery of data" meant delivering data only after checking *in*

the fixed portion whether an application compatible with the data is accessible to the subscriber

unit, thus avoiding unnecessary over-the-air communications with the subscriber unit. *See* Ex.

1102, at 1395–97, 1417–22; Ex. 1114 (summarizing prosecution). The Federal Circuit has

repeatedly held that "[w]here an applicant argues that a claim possesses a feature that the prior

art does not possess in order to overcome a prior art rejection, the argument may serve to narrow

the scope of otherwise broad claim language." *Terlep v. Brinkmann Corp.*, 418 F.3d 1379, 1384

(Fed. Cir. 2005) (internal quotation marks omitted); *see also, e.g., Verizon Servs. Corp.*, 503 F.3d

at 1307 (similar).

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3. "fixed portion of [a/the] wireless communication system"

Term	Microsoft's Construction	Motorola's Construction
"fixed portion of [a/the] wireless communication system"	"the stationary portion of the wireless communication system that includes base stations and a controller that controls the base stations, as distinct from the portable portion that includes subscriber units, or the public network portion that includes telephones or computers that originate data messages"	"the stationary portion of the wireless communication system that includes base stations and a controller"

Figure 1 shows that the "fixed portion" (item **102**) includes the controller (item **112**) and

the base stations (items **116**), but *not* the subscriber units (items **122**), the public switched

telephone network (item **110**), or the originators of data messages (telephone **111** or computer

117). *See* Ex. 1115 at 1; Ex. 1101 at 2:43–:48, 3:18–:24 & fig.1.

The prior art repeatedly shows that the "fixed portion" does *not* include the subscriber

units, the public network portion, or telephones or computers that originate data messages. *See*

Ex. 1115, at 2–3. ████████████████████████████████████

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4. "subscriber unit"

Term	Microsoft's Construction	Motorola's Construction
"subscriber unit"	"a device that can receive data from the fixed portion of the wireless communication system"	"A portable device for use in a wireless communication system"

Nothing in the claims, specification, or prosecution history requires a "subscriber unit" to

be *portable*. Indeed, the word "portable" cannot be found anywhere in the claims or

specification. *See* Ex. 1101.[10] The cited prior art, by way of contrast, explicitly refers to a

"*portable* subscriber unit." *See* Ex. 1116. The fact that the cited prior art refers to "*portable*

subscriber units" strongly implies that a "subscriber unit" is not inherently "portable." *See*

Phillips, 415 F.3d at 1314 ("[T]the claim in this case refers to 'steel baffles,' which strongly

implies that the term 'baffles' does not inherently mean objects made of steel."). And if there

were any doubt about the matter, ████████████████████████████████

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5. "application registry comprising ..."

Term	Microsoft's Construction	Motorola's Construction

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[10] A text-searchable version of the '333 Patent is available online at
<http://patft1.uspto.gov/netacgi/nph-Parser?patentnumber=6272333>.

Term	Microsoft's Construction	Motorola's Construction
"application registry comprising a list of all software applications that are currently accessible to the subscriber unit"	"one official list of all applications currently accessible to the subscriber unit, including applications that can be downloaded over the air"	"A portion of memory that includes a list of all software applications that are immediately available for use by the subscriber unit"

The specification emphasizes that an application can be "accessible" even if it is *external*

to the subscriber unit:

> The application registry **226** comprises a list of applications that are *accessible* to
> the subscriber unit **122**. The applications can reside either internal to *or external*
> *to the subscriber unit 122, e.g., in a personal computer to which the subscriber*
> *unit 122 is connected.*

Ex. 1101, at 3:67–4:4 (emphasis added). Importantly, nothing in the specification excludes an

over-the-air connection to an external device from which applications can be downloaded.

The arguments and amendments made during prosecution to overcome the prior art

confirm that "applications currently accessible" to the subscriber unit includes "applications that

can be downloaded over the air":

> Deluca's Fig. 3, depicting the elements of the subscriber unit, does not include
> "an application registry comprising a list of *all* software applications that are
> *currently accessible* to the subscriber unit." Deluca's Fig. 3 depicts software
> modules and authorization records of processes, either software or hardware,
> which have been authorized for use by the portable subscriber unit. (See
> Deluca, col. 7, lines 57-62.) The software modules and authorization records
> do not define "a list of *all* software applications that are *currently accessible*
> to the subscriber unit", because "external authorizations" can be requested
> when necessary, and *additional software can be downloaded from the system*
> *over the air.* (See Deluca Fig. 7 and col. 3, lines 57-64.)

Ex. 1102, at 1420 (emphasis added); *see also id.* at 1422 (similar); Ex. 1114 (summarizing

prosecution). As shown in the quote above, the applicant very clearly stated — in an effort to

distinguish the prior art — that a list of *all* software applications *currently accessible* to the

subscriber unit must include applications that *can be downloaded over the air*.[11]

J.   6,408,176

The '176 patent discusses a limitation of conventional voice mail systems in that (1) the

user either has to memorize or write down a callback number; or (2) re-access a voice mail

device to use the voice mail system's automatic redial feature. *See* '176 Patent, Ex. 1301 at

1:44-47, 1:56-65. In order to alleviate this issue, the '176 patent discusses extracting and storing

caller-related information (*e.g.*, a telephone number) so that a user can automatically initiate a

conversation using the caller-related information. *See* Ex. 1301 at Abstract, 2:28-44, 4:33-39.

1.   "extracts ..."; "extracting ..."; "receiving ... after extraction"

Term	Microsoft's Construction	Motorola's Construction
"extracts the caller-related information from the stored voice mail"; "extracting the caller-related information from the stored voice mail"; "receiving the caller-related information ... after extraction from stored voice mail"	"To select and remove the spoken words that relate to the caller (e.g. a telephone number) from the remainder of the stored voice mail message to produce caller-related information in voice format"	See constructions for "extracts / extracting / extraction" and "caller-related information"
"extracts"; "extracting"; "extraction"[12]	"To select and remove from a group of items those which meet specific criteria"	selecting

Microsoft's proposed construction is consistent with the specification which describes

selecting and removing caller-related information (e.g., a telephone number) from the remainder

of a voice mail. See Ex. 1301 at Abstract, 2:28-34, 3:33-39, 4:55-60, 4:64-5:2, Fig. 2. The

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[11] The word *"registry"* means "an *official* record book." *Webster's Third New International Dictionary* 933 (1993), Ex. 1110, at 1912 (emphasis added). The word *"currently"* means "at present." *Id.* at 557. The word *"accessible"* means "capable of being reached or easily approached <a town ~ by rail>." *Id.* at 11.

[12] These terms will be analyzed together, even though Motorola proposed to separately construe the term "extract."

caller-related information is removed and separately stored so that the caller-related information

alone is used to initiate a communication. See Ex. 1301 at 2:35-39, 5:66-6:2.

The prosecution history also supports Microsoft's proposed construction. To overcome a

prior art rejection, Motorola argued that its invention required "extracting" the "caller-related

information" rather than converting the entire voice mail:

> "Agraharam does not teach **extracting** the caller-related information from the
> voice mail. Agraharam does not extract anything from the stored audio message.
> Rather Agraharam clearly teaches converting the entire message into ... text. "

See 01/19/2001 Amendment, Ex. 1302 at p. 4 (emphasis in original). Thus, the scope of the

claims is properly limited to selecting and removing only the caller-related information from the

voice mail message, rather than selecting and converting the entire voice mail message.

Microsoft's proposed construction is also supported by extrinsic evidence. Dictionaries

show that the meaning of "extract" is that an item must be "selected" and "removed" from a

group of items.[13] Even Motorola's dictionary favors Microsoft,[14] as Motorola merely cherry-

picks portions of a dictionary definition to broaden its claims.[15]

Motorola's proposed construction, which replaces "extract" with "select," is overly-broad

because it reads on a scenario where the "caller-related information" is never separated from the

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[13] *See, e.g.,* Ex. 1303, JONAS C. NADER, PRENTICE HALL'S ILLUSTRATED DICTIONARY OF COMPUTING 210 (2nd ed. 1995) (defining "extract" as "to select and remove from a group of items those which meet specific criteria."); Ex. 1304, MICHAEL F. HORDESKI, THE MCGRAW-HILL ILLUSTRATED DICTIONARY OF PERSONAL COMPUTERS 174 (4th ed. 1995) (defining "extract" as "to remove from a set of items all items that meet a particular criterion").

[14] *See* Ex. 1305, MERRIAM WEBSTER'S COLLEGIATE DICTIONARY 412 (10th ed. 1993) (defining "extract" as "to select (excerpts) *and copy out* or cite") (emphasis added). Motorola previously identified this dictionary as extrinsic evidence that Motorola intends to rely on to support its proposed construction.

[15] *See Felix v. Am. Honda Motor Co.,*562 F.3d 1167, 1179-80 (Fed. Cir. 2009) (rejecting a misleading dictionary definition argument where the party excluded relevant portions of the dictionary definition).

voice mail. This is erroneous because the specification describes how the "caller-related information" is used to initiate a communication, which means it must be discrete information (*e.g.*, a phone number) that is removed from the voice mail. *See* Ex. 1301 at 3:21-25, 5:44-51.

2. Order of the "extracting" and "converting" operations

Term	Microsoft's Construction	Motorola's Construction
Order of the functional operation (Claim 1 -extracts caller-relation information/Claim 8 - extracting the caller-related information/Claim 11 - extraction from stored voice mail) and the functional step (Claim 1 - converts the caller-related information from the voice format to an alpha-numeric string format/Claim 8 - converting the caller-related information from a voice format into an alpha-numeric-string format/Claim 11 - caller-related information in an alpha-numeric string format resulting from a voice-to-alphanumeric-string–format conversion).	The functional operation (Claim 1 -extracts caller-relation information/(Claim 8 - extracting the caller-related information/Claim 11 - extraction from stored voice mail) is performed prior to the functional step (Claim 1 - converts the caller-related information from the voice format to an alpha-numeric string format/Claim 8 - converting the caller-related information from a voice format into an alpha-numeric-string format/Claim 11 - caller-related information in an alpha-numeric string format resulting from a voice-to-alphanumeric-string–format conversion).	The operation of "extracts"; "extracting"; "extraction" of caller-related information and the operation of "converts" / "converting" / "conversion" of caller-related information may take place in any order in accordance with known speech-recognition techniques.

Operations must be performed in order if (1) logic or grammar mandate the order; or (2) the specification directly or implicitly requires a narrow construction.[16] For claims 1 and 8, logic and grammar mandate that the "converting" operation follow the "extracting" operation because the "caller-related information" is created by the "extracting" operation.[17] Furthermore,

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[16] *See TALtech Ltd. V. Esquel Apparel, Inc.*, 279 Fed. Appx. 974, 978 (Fed. Cir. 2008); *Mantech Envt'l. Corp. v. Hudson Envt'l. Servs., Inc.*, 152 F.3d 1368, 1375-76 (Fed. Cir. 1998) (finding that the step of "providing the wells" must be performed before the step of "providing acetic acid *from* the wells").

[17] A basic claim drafting principle is that a claim element is first introduced and then later referenced in the claim by the words "said" or "the." *See Baldwin Graphic Sys., Inc. v. Siebert,*

claim 11 explicitly states that the "caller-related information ... result[s] from a ... conversion

after extraction from stored voice mail." (emphasis added.)[18]

The specification also describes how "caller-related information" is first "extracted" from

stored voice mail and then "converted" to a string for transmission. See Ex. 1301 at Abstract,

3:33-39, 4:55-60, 4:64-5:2, Fig. 2.

3. "receiving a request from a user of the communication unit"

Term	Microsoft's Construction	Motorola's Construction
"receiving a request from a user of the communication unit"	"the communication system infrastructure is receiving a request from the communication unit"	Plain and ordinary meaning.

Motorola clearly and unmistakably disavowed claim scope during prosecution.[19] In

response to a rejection, Motorola argued that claim 11 (then claim 12) contained the limitation of

"receiving a request from the communication unit." *See* 01/19/2001 Amendment, Ex. 1302 at p.

5. However, at the time, the claim actually recited "receiving a request from a user of the

communication unit." *See* Ex. 1302 at p. 3. Motorola's prosecution statements clearly disclaim

"receiving a request *from a user*" and clearly aver that the scope of the claim is "receiving a

request *from a communication unit*."

Continued from previous page
Inc., 512 F.3d 1338, 1342-43 (Fed. Cir 2008). In Claim 1 "caller-related information" is
introduced in the "extracts" operation and the "converts" operation uses the phrase "the caller-
related information," mandating the order of the "extracts" and "converts" operations.

[18] This also makes logical sense since the "extraction" operation operates on voice mail (voice
format input and output) and the "converting" operation converts "caller-related information"
from voice format (input) to alpha-numeric string (output). Since the "extraction" operation
cannot take in the "conversion" output, it must come first.

[19] *See Purdue Pharma L.P. v. Endo Pharms. Inc.*, 438 F.3d 1123, 1136 (Fed. Cir. 2006) ("[A]
patentee may limit the meaning of a claim term by making a clear and unmistakable disavowal of
scope during prosecution."); *N. Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335,
1340, 1345 (Fed. Cir 2005) (construction of the term "inner walls are generally convex"
disclaimed inner walls that had any concavity based on prosecution statements).

This construction is also supported by the specification, as the fixed network equipment **108** and the communication system infrastructure **205** receive requests from a communication unit. *See* Ex. 1301 at 3:26-31, 4:46-49.

Motorola has not proposed any clarifying construction, insisting that no construction is necessary. However, "[w]e cannot look at the ordinary meaning of the term . . . in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history." *Philips*, 415 F.3d at 1313. Motorola clearly disclaimed claim scope in the prosecution history and that disclaimer must be taken into account in a claim construction.

4. "fixed network equipment"

Term	Microsoft's Construction	Motorola's Construction
"fixed network equipment"	"a telecommunication equipment installation that routes voice calls between the communication, target and voice mail devices and routes data between the converter and the communication devices"	"communication system infrastructure component"

Microsoft's proposed construction is consistent with the plain language of claim 1. Claim 1 recites how (1) the "fixed network equipment ... provides communication services to a communication unit"; (2) the "voice mail device" is "coupled to the fixed network equipment"; and (3) the "fixed network equipment ... initiate[s] a communication between the communication unit and at least one target device." Thus, claim 1 recites how the fixed network equipment routes calls between the communication, target, and voice mail devices. Furthermore, claim 1 recites how the "converter device ... conveys the caller-related information ... to the communication unit via the fixed network equipment," which means that the fixed network equipment is routing data between the converter and communication devices.

The specification also supports Microsoft's proposed construction, as it describes how the "FNE 108 ... provides communication services to the communication unit 102" and that the

"converter device 112 ... conveys the caller-related information ... to the communication unit

102 via the FNE 108." See Ex. 1301 at 3:31-41.

In contrast, Motorola's proposed construction should be rejected as it merely identifies

the fixed network equipment as a "communication system infrastructure component," which fails

to clarify the claim as "communication system infrastructure" is not even a term used in claim 1.

5.   "caller-related information"

Term	Microsoft's Construction	Motorola's Construction
"caller-related information"	"information present in a stored voice mail that enables a communication device to initiate a communication to a target device"	"information provided by a caller in a stored audio message"

Specification: Microsoft's proposed construction is consistent with the specification,

which describes how "[c]aller-related information ... is extracted from the voice mail message."

See Ex. 1301 at Abstract (emphasis added); see also Ex. 1301 at 2:26-28, 3:21-25, 5:25-28, 5:44-

51, 6:13-20. The specification also describes the "caller-related information" as "enabl[ing] the

communication unit to initiate a communication." See Ex. 1301 at 2:26-28, 3:21-25, 5:44-51.

In contrast, Motorola's proposed construction impermissibly broadens the claim to

encompass "stored audio messages," whereas the specification is limited to voice mail systems.

Indeed, the field of the "present invention" is "communication systems and, in particular, to

initiating a communication using caller-related information obtained from voice mail." See Ex.

1301 at 1:6-9. "[W]hen the preferred embodiment is described in the specification as the

invention itself, the claims are not necessarily entitled to a scope broader than that embodiment."

Edwards Lifesciences LLC v. Cook Inc., 582 F.3d 1322, 1330 (Fed. Cir. 2009).

K.   6,757,544

The '544 patent attempts to solve the problem of accurately locating the position of a

communication device. *See* '544 patent, Ex. 1201 at 1:48-49. When the '544 patent was filed,

Global Positioning System ("GPS") and other location identification technologies lacked

precision. User-specified input, by itself, was also inaccurate. *See* Ex. 1201 at 1:42-47. The

'544 patent addresses this issue by using location identification technologies to ascertain the

communication device's general location. Once the general location has been determined,

specific location information input by a user is used to narrow down a device's precise location

by comparing the user's input with a set of known location parameters in a database to determine

a match. *See* Ex. 1201 at 2:6-8, 7:56-8:34, Fig. 2 (blocks **325** and **330**). After the device has

been located, location-based services can be provided. *See* Ex. 1201 at 1:21-25, Fig. 3.

1. "specific location information of the communication device"

Term	Microsoft's Construction	Motorola's Construction
"specific location information of the communication device"	"location information input by the user to indicate the location of the communication device"	Plain and ordinary meaning or, alternatively: "Information about the specific location of the communication device"

The parties' fundamental dispute is about whether the "specific location information" is

input by the user. Microsoft's proposed construction should be adopted because every

embodiment in the specification *requires* a user to input a specific location.[20] Sometimes, the

"service request ... include[s] input from user **20, 30** indicating ... specific location

information." *See* Ex. 1201 at 4:60-61. The "specific location information" may also be input

by a user after "general location information" is obtained. *See* Ex. 1201 at 7:55-8:6. Block **325**

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[20] *See, e.g., Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc.*, 554 F.3d 1010, 1018-19 (Fed. Cir. 2009) (refusing to construe "wound" to cover fistulae and 'pus pockets' because it would expand the scope of the claims beyond the specification); *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1328-30 (Fed. Cir. 2009) (construing "grafts" as "intraluminal grafts" because the specification only described intraluminal grafts); *Decisioning.com, Inc. v. Federated Dep't Stores, Inc.*, 527 F.3d 1300, 1311 (Fed. Cir. 2008) (construing "remote interface" to exclude personal computers because the specification, 'd[id] not evoke the use of ... personal computers.'").

of Figure 2 is even entitled "receive user specified location information," emphasizing how the

"specific location information" is "user specified." Furthermore, in Example A, Bob is prompted

"to specify a location ... and Bob responds with 'Ohio and State' (block **325**)." *See* Ex. 1201 at

10:16-19. Also, in Example B, "[t]he application prompts Sunil to make a selection .... Sunil

selects 'O'Hare' and the application obtains the selection (block **325**)." *See* Ex. 1201 at 11:5-8.

In contrast, Motorola maintains that no construction of this term is needed, and in the

alternative, proposes a construction that does not provide any meaning beyond the original claim

language. Since the parties have a fundamental dispute which cannot be resolved by the plain

meaning of the claim language, it must be construed. *See O2 Micro Int'l Ltd. v. Beyond*

Innovation Tech. Co., 521 F.3d 1351, 1361 (Fed. Cir. 2008) ("A determination that a claim term

'needs no construction' or has the 'plain and ordinary meaning' may be inadequate when ...

reliance on a term's 'ordinary' meaning does not resolve the parties' dispute.").

2.   **"general location information ..."**

Term	Microsoft's Construction	Motorola's Construction
"general location information of the location relevant to the user"	"a geographic area that is determined by the nature of the service request of a user"	Plain and ordinary meaning or, alternatively: "Information about the general area of a location relevant to the user"

The specification treats the "general location information of the location relevant to the

user" in different ways, so a construction is needed that encompasses these embodiments.[21] In

Example A, Bob wants to locate the nearest ATMs. *See* Ex. 1201 at 9:62-67. An application

"obtains Bob's location from Bob's cellular service provider and determines that he is in a given

cell and sector (block **310**)." *See* Ex. 1201 at 10:4-6. Thus, the "general location information" is

the "cell and sector" where Bob is located. In contrast, in Example B where "Sunil is looking for

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[21] *See Funai Elec. Co., Ltd. v. Daewoo Elecs. Corp.*, 616 F.3d 1357, 1371 (Fed. Cir. 2010) ("A
claim construction that excludes a preferred embodiment is rarely, if ever, correct").

directions to a nearby airport, the application uses Sunil's current location obtained from the GPS

unit ... as the general location (block **310**)." *See* Ex. 1201 at 10:60-63. Thus, the "general

location information" in Example B is Sunil's exact location, which is different than the general

area described in Example A.

The inconsistencies of Examples A and B can be reconciled by looking at the nature of

the service requests made by Bob and Sunil, respectively. In Example A, Bob requested the

"Nearest ATMs to here," which required the "general location information" to describe an area

encompassing ATMs. *See* Ex. 1201 at 9:62-67. Similarly, in Example B, Sunil is looking for

driving directions, so the "general location information" must describe an exact point in order to

get accurate directions. *See* Ex. 1201 at 10:42-48. Thus, it is clear from Examples A and B that

the "general location information" is determined by the nature of the service request of a user.

Microsoft's proposed construction also harmonizes the elements of claims 9 and 10 into a

workable invention.[22] Claims 9 and 10 both contain "a service request" limitation that is not

connected to any other limitation. Ordinarily, a claim is indefinite for failure to interrelate

essential claim elements.[23] Microsoft's proposed construction obviates this problem by

connecting the "service request" to the "general location information."[24, 25]

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[22] *See Lexion Med., LLC v. Northgate Techs., Inc.*, 2009-1494, 2011 U.S. App. LEXIS 8299, at
*9 (Fed. Cir. Apr. 22, 2011) ("This court prefers a claim interpretation that harmonizes the
various elements of the claim to define a workable invention.").

[23] *See In re Collier*, 397 F.2d 1003, 1005 (C.C.P.A. 1968) ("if there is no positive recitation of
any structural cooperation among the elements listed," then the claim is indefinite); *Boston
Scientific Corp. v. Micrus Corp.*, 556 F. Supp. 2d 1045, 1060 (N.D. Cal. 2008); MANUAL OF
PATENT EXAMINING PROCEDURE § 2172.01 (8th ed. 2010).

[24] The Court is permitted to take judicial notice of conventional relationships between elements.
See Acacia Media Techs. Corp. v. New Destiny Internet Grp., 405 F. Supp. 2d 1127, 1138 (N.D.
Cal. 2005).

In contrast, Motorola maintains that no construction of this term is needed, and in the alternative, proposes a construction that does not provide any meaning beyond the original claim language. Since the parties have a fundamental dispute which cannot be resolved by the plain meaning of the claim language, it must be construed. *See O2 Micro*, 521 F.3d at 1361.

3. "determining the location relevant to a user by comparing ..."

Term	Microsoft's Construction	Motorola's Construction
"determining the location relevant to a user by comparing the list of location parameters with the specific location information"	"determining the geographic location that corresponds to the specific location information by matching the specific location information with a list of location parameters to identify a matching location parameter"	"identifying the location relevant to the user by selecting from the list of location parameters based on the specific location information"

Microsoft's proposed construction is supported by the specification and should be adopted. With regards to the "determining the location relevant to a user" term, the specification shows that this term pertains to the result **335** of the process depicted in Figure 2, which is the location described by the "specific location information." *See* Ex. 1201 at 8:29-37. This is also illustrated in Example B, where the "location relevant to the user" is O'Hare Airport, which is the "specific location information" input by Sunil. *See* Ex. 1201 at 10:54-59, 11:10-14.

With regards to the "comparing the list of location parameters with the specific location information" term, Microsoft's proposed construction emphasizes how the location relevant to the user "is determined by *matching* the specific location information responses with the database of location parameters." *See* Ex. 1201 at 8:27-29 (emphasis added.) This interpretation is also supported by Example A, as Bob's "specific location information" ("Ohio and State") is

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Continued from previous page
25This proposed construction is equally applicable to claims 1 and 3 because the claim language is identical. *See Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1087 (Fed. Cir. 2009).

matched to a location parameter in a database. *See* Ex. 1201 at 10:16-23. Similarly, in Example

B, an "application compares 'O'Hare' to the selected list of airports." *See* Ex. 1201 at 11:8-10.

Motorola's proposed construction broadens the scope of the term far beyond the scope of

the specification. Motorola has replaced the "comparing" operation with a "selecting" operation

that is "based on the specific location information." However, the "comparing" step in the

specification is consistently described as a "matching" step. *See* Ex. 1201 at 8:27-29, 10:16-23,

11:8-10. Since Motorola's proposed construction construes the claims far beyond the scope of

the specification, it should be rejected. *See, e.g., Kinetic Concepts,* 554 F.3d at 1018-19;

Edwards Lifesciences, 582 F.3d at 1328-30; *Decisioning.com,* 527 F.3d at 1311.

L.   6,983,370

The '370 Patent explains that prior art messaging systems allowed users to access

messaging services from multiple devices, such as a laptop, desktop, or a mobile phone. Users

could connect to the messaging system using alternating devices or using multiple devices at the

same time. See, '370 patent, Ex. 1401, at 2:65 – 3:12. The '370 Patent sought to address a lack

of "messaging session continuity" between such prior art devices:

> In order to switch to a different device with existing technology, the account user
> may have to cause the currently connected device to disconnect from the message
> server. The account user would then have to cause the second device to connect to
> the message server and login. Finally, the account user would have to re-initiate
> each messaging session (one-to-one, public chat, private chat, electronic game)
> that was in progress on the first device. The disadvantage of this method is the
> numerous manual operations required of the account user to change devices. A
> further disadvantage is the lack of messaging session continuity. For example, the
> second device will not have the session history that was available on the first
> device, and the second device may not be able to re-connect to chat rooms that
> restrict the number of active account users since another account user may have
> connected to the chat room after the account user's first device disconnected.

Ex. 1401, at 3:21 – 37. The '370 Patent purports to claim a method, system, and plurality of

messaging clients capable of providing "continuity" between messaging clients such that an

account user can switch to a different messaging client without being required to re-initiate

communication connections and/or each messaging session that was in progress on the first

messaging client.

1. "messaging session"

Term	Microsoft's Construction	Motorola's Construction
"messaging session"	"an active communication connection during which there is a transfer of electronic messages between two or more communicating devices with a defined beginning and end."	"A session of real time electronic messaging, between two or more messaging clients."

Context of Claim Term:

> 22. establishing at least one **messaging session** having a session identifier
> between the first messaging client and at least one other messaging client of the
> plurality of messaging clients;

The dispute with respect to the construction of this term is clearly related to the definition

of a "session." Microsoft's construction is consistent with the claim language, the patent

specification, the prosecution history, and extrinsic definitions. Motorola's proposed

construction provides a circular definition with no resolution as to the meaning of the critical

term "session" and fails to account for arguments made by the patentees during prosecution.

The '370 Patent provides examples of what the inventors considered to be "messaging

sessions":

> The plurality of messaging sessions 24, for example, can include the
> communication of a plurality of electronic messages such as chat sessions, instant
> message sessions, and electronic mail, facilitating substantially real time
> communication among the plurality of messaging clients 12. Similarly, the
> plurality of messaging sessions 24 can include communication of gaming
> messages for one or more gaming sessions (e.g. battleship, checkers, chess, tic tac
> toe and doom).

Id. at 4:35 – 46. The patent also repeatedly refers to the "messaging session" as something that

is actively maintained or "in progress." *Id.* at 3:13, 18, and 28 and 25:34. It has a defined

beginning when initiated by a user of a messaging client:

> The account user can click on the name of a person in his/her contact list who is
> online, and a window is created in which the account user can enter a message.
> The account user enters a message and clicks "send" to communicate with that
> person. The other person gets the message and can respond

Id. at 2:14 – 44. The "messaging session" likewise has a defined end when terminated by the

user: "When the messaging session is complete, the account users close the message window for

that messaging session." *Id.* at 2:54 – 64.

According to the patent, therefore, a "messaging session" is a maintained or active

communication connection between two or more communicating devices (such as two

messaging clients or a messaging client and a server) that allows for the exchange of messages.

The "session" is initiated by the user and is clearly defined by a beginning and an end.

During the prosecution of the application that resulted in the '370 Patent, the applicants

distinguished the "session" of the '370 Patent from the "sessionless" messaging of the Examiner

cited U.S. Patent No. 6,101,531 to Eggleston, et al. (the '531 Patent"). *See,* Prosecution History,

9/20/2005 Amendment, Ex. 1403, at 20 (Prosecution History for the '370 patent attached as Ex.

1402). Specifically, the applicants distinguished the "session" of the '370 Patent from the

"sessionless data flow between a mobile user 105 and a server 110":

> In this embodiment the mobile user 105 communicates with the server/VSM 110
> using any appropriate data protocol being used by the data network 130, as
> necessarily modified for transport over the wireless infrastructure; . . . **Thus, a
> sessionless data flow between the mobile user 105 and server/VSM 110
> occurs on an event driven basis, and no costly connection is maintained when
> there is nothing being communicated.** . . .

The '531 Patent, Ex. 1405, 4: 35 – 56 (emphasis added).

Clearly, the "session" contemplated by the '370 Patent is a maintained, active connection

between the communicating devices. Motorola's proposed construction, however, improperly

incorporates the prior art "sessionless" data flow that does not require an active and maintained

communication connection between the devices.

While less significant than the intrinsic record, Microsoft's proposed construction is also

fully consistent with extrinsic evidence in the form of █████████████ and specialized,

technical dictionaries. *See, e.g., Microsoft Comp. Dictionary,* Ex. 1406, at 405 (4th Ed. 1999)

("the time during which two computers maintain a connection."); *Newton's Telecom Dictionary,*

Ex. 1407, at 617 (17th Ed. 2001) ("an active communication, measured from beginning to end,

between devices or applications over a network. . . .").[26] ██████████████████████████

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██

██████████

Motorola's proposed construction of "a session of real time electronic messaging,

between two or more messaging clients" uses the critical term "session" as a part of the

definition and leaves the parties to continue to debate the meaning and scope of the term. It fails

to a account for the meaningful distinction made by the applicants during prosecution that the

"messaging session" contemplated by the inventors clearly involves an active, maintained

communication connection between communicating devices. It also introduces an unnecessary

debate as to the meaning of the phrase "real time electronic messaging" versus the "substantially

real time electronic messaging" used in the '370 Patent. *See,* Ex. 1401, at 4:35 – 46.

2. "client data"; "session data"

Term	Microsoft's Construction	Motorola's Construction
client data	data associated with the messaging client and with each messaging session for which the messaging client is currently participating, has participated in, or plans to participate in	Motorola agrees with Microsoft's proposed construction.

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[26] *See also, Newton's Telecom Dictionary,* Ex. 1406, at 794 (16th Ed. 2001) and *Newton's Telecom Dictionary* at 616 (13th Ed. 1998), at 643 (14th Ed. 1998), and at 706 (15th Ed. 1999).

session data	Data relating to each of the plurality of messaging sessions for which the account user is currently participating, has previously participated, or plans to participate in.	Data relating to one or more of the messaging sessions in which the account user is participating, has participated or plans to participate, using the messaging client.

> 1. transferring the plurality of *client data* from the first messaging client to a second messaging client; and
>
> 22. transferring a plurality of *session data* for the first session connection including the session identifier from the first messaging client to a second messaging client;

The patentees acted their own lexicographer and defined these terms for the '370 Patent.

Microsoft's constructions adopt those definitions explicitly. While Motorola agrees to the patent's definition of "client data," Motorola's proposed construction for "session data," inexplicably seeks to change the clear language in the patent from "each" to "one or more of."

> The patentees defined the term "client data" and "session data" explicitly:
>
> Each messaging client 26 preferably includes a plurality of client data 25. The plurality of client data 25 includes data associated with the messaging client 26 and data associated with each messaging session for which the messaging client 26 is currently participating, has participated in, or plans to participate in.[27]
>
> The plurality of session data 36 included within the plurality of client data 25 contains information relating to each of the plurality of messaging sessions 24 for which the account user 30 is currently participating, has previously participated, or plans to participate in, using the messaging client 26.[28]

Ex. 1401, at 5:30 – 35 and 6:44 – 49 (emphasis added).

Motorola's proposed construction improperly alters the clear language of the patentees' definition from "each" to "one or more of." The two are not synonymous. If the patentees intended the data to relate to "one of more" messaging sessions, the patentees would have used

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[27] *See also*, Ex. 1401, at 17:5 – 10

[28] *See also*, *id.* at 5:44 – 48; 6:51 – 55; 17:5 – 10, 17:35 – 39, Fig. 2, and Fig. 3.

those words, as they did, repeatedly, elsewhere in the patent.[29] Rather, the patentees repeatedly

referred to "each messaging session" throughout the patent and consistently defined "client data"

and "session data" as relating to "each messaging session."[30] In fact, the patent repeatedly

describes the transfer of the "accumulation" of "client data" and "session data" for each

messaging session for which the messaging client participates:

> the first account user 29 can transfer the first client data 17 including the plurality
> of session data 36 **accumulated** for the first communication connection 16 to the
> second messaging client 20 which for example can operate on the mobile device
> 90. When no data transfer is required or requested in Step 304, the first
> communication connection 16 is maintained in Step 302, whereby the first
> messaging client 14 continues to **accumulate the plurality of session data 36 for
> each messaging session** 40 for which the first messaging client 14 participates.

Ex. 1401, at 23:46 - 59 (emphasis added).[31]

There is no justifiable reason to change the clearly stated definition of "session data"

provided by patentees.

3. "for providing continuity"

Term	Microsoft's Construction	Motorola's Construction
"for providing continuity"	Indefinite.	"Allowing an account user to continue at least one messaging session and maintain preferences on different messaging clients"

Context of Claim Term:
1. Within a messaging communication system having a message server for
managing the communication of a plurality of messages among a plurality of
messaging clients, a method *for providing continuity* between the plurality of
messaging clients comprising:

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[29] *See, id.* at 10:9 – 19; 13:36 – 46; and 15:3 – 12. See also, id. at 1:55; 4:42; 4:54; 5:20; 5:24; 5:35 – 37; 6:28; 11:10; 12:14 – 15; 13:59 – 60; 16:62; 16:66; 18:28; 23:27 – 28; 24:32; 30:14; 30:44 – 45; 32:19; 32:27 – 28; 32:36; 34:57 – 58; 34:66; 35:7; 37:16; 37:24; 37:33; 39:57; 39:65; 40:7; 41:65; 42:6, 42:15.

[30] Ex. 1401, at 5:30 – 35; 6:44 – 49; 17:5 – 10; 17:35 – 39; See also, id. at 9:37; 11:51 – 52; 13:3 – 4; 13:11 – 12; 13:32 – 33; 25:33; 30:10, 30:30 – 31.

[31] *See also,* Ex. 1401, at 23:31 – 34; 25:56 – 60; 27:43 – 48; 28:1 – 5; 28:29 – 33.

The purpose of the definiteness requirement is to ensure that "the claims, as interpreted in view of the written description, adequately perform their function of notifying the public of the scope of the patentee's right to exclude." *Honeywell, Int'l, Inc. v. Int'l Trade Comm'n*, 341 F.3d 1332, 1339 (Fed. Cir. 2003). . The specification of the '370 Patent fails to define the precise meaning and scope of the term "continuity" and denies potential competitors the opportunity to avoid infringement. The term and, therefore, all asserted claims of the '370 Patent are indefinite.

a. "Continuity" is the allegedly inventive concept of the '370 Patent.

It is indisputable that the transfer of data between messaging clients is prior art.[32] The '370 Patent acknowledges this fact. For example, in describing the prior art, the patent explains that:

> [s]ome messaging service providers maintain the same user preference settings such as screen names, buddy list groups, electronic mailboxes, and parental control settings regardless of which device is used to access the service. By having this capability the service providers are providing continuity of user preferences from device to device, which simplifies the use of multiple devices in the messaging system

Ex. 1401, at 2:7 – 13. The patentees spend pages repeatedly describing, in detail, the prior art concepts of connecting messaging clients to a server; exchanging connection, contact, and availability data for the messaging clients; updating "Buddy Lists" with client data from other users; and engaging in instant messaging communications with other users. *See, e.g.*, Ex. 1401, at 31:62 – 33:30; Fig. 20 – 24; 2:14 – 44 (quoted above). The ability of messaging clients to transfer data from one device to another is admitted prior art and cannot alone constitute the "continuity" invention.[33]

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[32] ███████████████████████

[33] ███████████████████████

The recited elements of the independent claims of the '370 Patent, however, do not

expand upon these known concepts in the prior art. Each requires the same three essential

elements: (1) a "first messaging client" connecting to the server, (2) a "second messaging client"

connecting to a server, and (3) the transfer of "client data" from one client to the other. For

example,

> 1. Within a messaging communication system having a message server for
> managing the communication of a plurality of messages among a plurality of
> messaging clients, a method for providing continuity between the plurality of
> messaging clients comprising:
>> establishing a first communication connection including a plurality of
> client data between a first messaging client and the message server;
>> transferring the plurality of client data from the first messaging client to a
> second messaging client; and
>> establishing a second communication connection including the plurality of
> client data between the second messaging client and the message server.

The recited elements of the independent claims relate to the *connection* of messaging

clients to servers and the transfer of *data* between the devices, i.e., the "very essence" of prior art

communication systems. *See*, Office Action dated June 15, 2005, Ex. 1404, at 3. *See also*, Ex.

1401, at 2:18 – 44 (the patentees themselves describe the prior art as including the connection of

messaging clients to a server and the transfer of account, availability, contact data, and messages

between messaging clients). The entirety of the alleged invention, therefore, must be found in

the word "continuity." ▮▮▮▮▮▮▮▮▮▮▮▮▮▮

> **b.** **"Continuity" has no plain and ordinary meaning to one of skill
> in the art.**

The word "continuity" itself does not have a plain and ordinary meaning to one skilled in

the art of messaging communication systems. Technical dictionaries define the term as "an

uninterrupted electrical path." *See* Ex. 1407 at 173, 180, 197, 222, and 172.[34] Aside from the

general idea that "continuity" implies something unbroken or uninterrupted, dictionaries are not

helpful.

c. The specification fails to define "continuity."

The patent describes the problem in the prior art as the lack of "messaging session

continuity":

> For example, the second device will not have the session history that was
> available on the first device, and the second device may not be able to re-connect
> to chat rooms that restrict the number of active account users since another
> account user may have connected to the chat room after the account user's first
> device disconnected.

Id. at 3:30 – 37. This suggests that "continuity" relate to the maintenance of connections and the

transfer of data between messaging clients. As noted above, however, the patent also explains

that the transfer of data between messaging clients is prior art.

After repeatedly describing the prior art transfer of data, the patentees repeatedly and

succinctly refer to the "seamless" transfer of uninterrupted connections and/or "messaging

sessions" without ever describing how this is accomplished or detailing the steps of their alleged

"continuity" invention. The patent merely states that, once the "second messaging client" makes

that second connection with the server and "client data" is transferred from the "first messaging

client" to the "second messaging client," the user operates the "second messaging client" and

"seamlessly" maintains "continuity" with its previous connection and/or "messaging sessions."

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[34] *See also, McGraw Hill Dictionary of Scientific and Tech. Terms*, Ex. 1409, at 422 (4th Ed.
1989) and at 448 (5th Ed. 1994) ("Continuity: continuous effective contact of all components of
an electric circuit to give it high conductance by providing low resistance."); *McGraw-Hill
Elecs. Dictionary*, Ex. 1410, at 95 (6th Ed. 1997) ("Continuity: the presence of a complete path
for current flow.").

Id. at 33:30 – 34:14.[35] The specification never explains how the user's open connection is maintained and uninterrupted when the user switches devices, and these vague descriptions provide no guidance as to the scope and functionality of maintaining "continuity" between messaging clients and/or servers.

In fact, the language describing the result itself is unclear. One of skill in the art cannot determine whether the invention requires the maintenance of an uninterrupted communication connection with a server while the user switches devices, the maintenance of uninterrupted session connections with other users, or the maintenance of both. The patent likewise fails to disclose the steps required for the maintenance of either. The patentees vaguely state that messaging clients include "data transfer capabilities" and "session transfer capabilities." *Id.* at 36:1 – 12. They suggest that "continuity" allows for the sessions to be "seamlessly" transferred and continued, without requiring the user to re-initiate a connection with the server or to re-initiate a session with another user.

While the patent describes the prior art transfer of data between messaging clients and the server, it never discloses how the user "can pass the current messaging session from his/her personal computer to his/her cellular telephone with no loss of communication or of session data." The patentees provide no explanation of how the transfer of uninterrupted connections – to the server or between the messaging clients – is accomplished. The patentees fail to even specify which connection must remain uninterrupted. Rather, the specification leaves "continuity" a vague, magical concept.

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[35] *See also,* Ex. 1401, at 34:30 – 36:44; 36:56 – 39:18; 39:30 – 41:29; 41:41 – 43:37; Fig. 18 (showing a transfer of client data, followed by a session transfer message, immediately followed by second messaging client participation).

███

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██████████████████████████ However, there are 67 claims in the '370 Patent, and this

scenario is only contemplated by claim 12: "A method for providing continuity between a

plurality of messaging clients as recited in claim 1 further comprising: disconnecting the first

messaging client from the first communication connection **after** the transferring step." ████

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███

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However, while this transfer of a session is explicitly recited by claim 59, it does not appear in

any other claim, and it is unclear whether it is a necessary part of "continuity."

If either of these scenarios is a necessary part of the "continuity" invention, the question

remains as to why the patentees would have explicitly spelled them out in claims 12 and 59. In

fact, despite the fact that the invention is allegedly directed to "messaging session continuity,"

asserted claims 1, 50, and their dependents (and previously asserted claim 15) do not even

require a "messaging session." The necessarily elements of the invention, therefore, remain

unclear. One of skill in the art cannot practice this invention, and a competitor cannot determine

how to avoid infringement. By vaguely claiming methods, systems, and messaging clients

capable of providing "continuity," Motorola has sought to cover an unreasonably large scope of

the operations of messaging systems to the detriment of the public. In the *quid pro quo* with the

Patent Office, Motorola must disclose "continuity" and provide clear warning to others as to

what constitutes infringement of the '370 Patent. It has failed to do so, and the claims of the

'370 Patent are indefinite.

4. "transfer the at least one messaging session ..."

Term	Microsoft's Construction	Motorola's Construction
"transfer the at least one messaging session from the first messaging client to the second messaging client using the session identifier"	Indefinite.	Plain and ordinary meaning or, alternatively: "Using the session identifier to transfer the at least one messaging session from the first messaging client to the second messaging client."

59. A messaging communication system for providing continuity between a plurality of messaging clients comprising: the plurality of messaging clients including:

a first messaging client, a second messaging client, and at least one other messaging client;

a message server for managing the communication of a plurality of session messages among the plurality of messaging clients, wherein the message server is programmed to:

establish a first communication connection for the first messaging client

establish at least one messaging session having a session identifier between the first messaging client and the at least one other messaging client,

transfer a plurality of client data for the first communication connection including the session identifier from the first messaging client to the second messaging client,

establish a second communication connection including the plurality of client data for the second messaging client, and

transfer the at least one messaging session from the first messaging client to the second messaging client using the session identifier.

Microsoft contends that the phrase "transfer the at least one messaging session from the first messaging client to the second messaging client using the session identifier" is indefinite and cannot be construed. Assuming either party's definition of "messaging session," "continuity" apparently allows for the "messaging session" to be "seamlessly" transferred between devices, without requiring the user to re-initiate the session and with no loss of communication.

The specification fails to disclose whether the alleged invention requires no loss of communication with the server or between the users. The specification likewise fails to disclose

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how the transfer of an uninterrupted "messaging session" is accomplished and, more specifically, how it is accomplished "using the session identifier." The '370 Patent simply states that "the session identifier 41 identifies the messaging session 40 of the plurality of messaging sessions 24." Ex. 1401, at 6:59 – 60. This identifier can be included in the "session data," which can be transferred between devices. See, id. at 6:51 – 55.

The step of "transfer[ring] the at least one messaging session . . . using the session identifier" cannot merely reference the transfer of this "session data" (or, more generally, "client data") between the devices. That element appears as an earlier limitation in the claim: "transfer a plurality of client data for the first communication connection including the session identifier from the first messaging client to the second messaging client." The "session identifier" clearly must play some role in the transfer of an on-going and uninterrupted "messaging session" between users of messaging clients. That role, however, is never discussed in the specification and remains ambiguous.

Motorola's proposed construction leaves this question unanswered and merely reverses the order that the words appear in the phrase, further evidence that the phrase cannot be construed. One skilled in the art cannot determine the steps involved in "transfer[ring] the at least one messaging session from the first messaging client to the second messaging client using the session identifier." The term and claim 59, therefore, are indefinite.

5.   "adding the second messaging client ..."

Term	Microsoft's Construction	Motorola's Construction
adding the second messaging client to the at least one messaging session using the session identifier	Indefinite.	plain and ordinary meaning or, alternatively: "using the session identifier to allow the second messaging client to participate in the at least one messaging session."

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46. Within a messaging communication system having a plurality of messaging clients, a method for providing continuity between the plurality of messaging clients comprising:

establishing a first communication connection for a first messaging client;

establishing at least one messaging session having a session identifier between the first messaging client and at least one other messaging client of the plurality of messaging clients;

transferring a plurality of client data for the first communication connection including the session identifier from the first messaging client to a second messaging client;

establishing a second communication connection including the plurality of client data for the second messaging client; and

adding the second messaging client to the at least one messaging session using the session identifier.

Microsoft contends that the phrase "adding the second messaging client to the at least one messaging session using the session identifier" is indefinite and cannot be construed.

Unlike claim 59, claim 46 does not require the transfer of an on-going "messaging session" from one messaging client to the other. Rather, the "second messaging client" is simply "added" to a "messaging session." How this is accomplished and its relationship to "continuity" remains unclear, as neither the concept nor the phrase "adding the second messaging client to the at least one messaging session using the session identifier" appears anywhere else in the specification.

As noted above with respect to "continuity," the '370 Patent vaguely states that, once the second messaging client makes that second connection with the server and "client data" is transferred from the "first messaging client" to the "second messaging client," the user operates the "second messaging client" and somehow maintains "continuity" with its previous connection and/or "messaging sessions." The patent fails to disclose how this is accomplished. To the extent that "adding" the "second messaging client" is related to this act of transferring an uninterrupted "messaging session" to the second device, the patent likewise fails to describe how this is achieved or to define the steps required. The phrase is indefinite.

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6. "first / second messaging client"

Term	Microsoft's Construction	Motorola's Construction
"first / second messaging client"	Client application operating on a messaging device that includes software capability for transferring client data to and receiving client data from at least one other messaging client. The First and Second Messaging Clients can be operated by one or more account users.	First client software to interface a user's device within a messaging communication system Second client software to interface a user's device within a messaging communication system

1. transferring the plurality of client data from the **first messaging client** to a **second messaging client**;

Microsoft's proposed construction is consistent with the claim language, the patent specification, and extrinsic definitions. Motorola's proposed construction, while consistent with the intrinsic evidence, is incomplete.

Microsoft's proposed construction tracks the language of the patent and provides the necessary clarification that the first and second messaging clients can be operated by one or more account users.

For example, the '370 Patent explains that,

[e]ach of the plurality of messaging clients 12 such as a first messaging client 14 and a second messaging client 20 includes **client software to interface within the messaging communication system** 10. The client software, for example, can include a software application for communication through an Internet service provider. Further, the client software can include a software application for participation in one or more electronic games offered by a gaming software provider.

Ex. 1401, at 4:46 – 57 (emphasis added); *see also, id.* at 16:27 – 30 and 2:14 – 18. It is from here that Motorola has taken its proposed definition: "client software to interface within the messaging communication system." While accurate, this definition is incomplete.

The patent further explains, repeatedly, that the messaging clients include

software capability for transferring all or a portion of the plurality of client data 25 to one or more other messaging clients for use by the other messaging

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> client to participate within one or more of the plurality of messaging sessions 24.
> The fixed messaging client 84, in accordance with the present invention, further
> includes **software capability for receiving all or a portion of the plurality of
> client data** 25 from at least one other messaging client to participate within one or
> more of the plurality of messaging sessions 24.

Ex. 1401, at 10:9 – 23; *see also, id.* at 13:36 – 46 (mobile messaging client) and 15:3 – 12 (cable

messaging client). The messaging clients, therefore, are client applications that operate on

messaging devices and are capable of transferring client data to and receiving client data from at

least one other messaging client.

Microsoft's proposed construction is also fully consistent with extrinsic evidence in the

form of specialized, technical dictionaries. *See*, Ex. 1406 at 288 ("an application program that

enables its user to send or receive messages (such as e-mail or fax) to and from other users with

the help of a remote server.") (emphasis added).

To fully resolve the dispute between the parties on the particular meaning of this claim

term, however, the Court must also consider the operation of the messaging clients within the

'370 Patent. The patentees clearly intended for the "first messaging client" and the "second

messaging client" to be operated by the same or by different users. The patent explains that a

single user can operate the "first messaging client" and the "second messaging client": "a first

account user 29 can establish communication within the plurality of messaging sessions 24 using

the first messaging client 14, and, in accordance with the present invention, also using the second

messaging client 20." Ex. 1401, at 5:25 – 29. The patent further explains, however, that a first

user can operate the "first messaging client" and a second user can operate the "second

messaging client":

> For example, if the first account user 29 is a customer service representative and
> the first account user 29 is a participant in the plurality of messaging sessions 24
> with customers. The first account user 29 may want to transfer a portion of the
> plurality of messaging sessions 24 to another account user 30 such as a second
> customer service representative. The second customer service representative

would benefit from having access to the session history 45 of the transferred messaging sessions.

Id. at 25:40 – 49; *see also, id.* at 5:18 – 19; 24:46 – 52; and 25:12 – 18. The patentees intended for the first and second messaging clients to be operated by the one or more users, and Microsoft's proposed definition accurately reflects this.

The question of whether the same or different users can operate the first and second messaging clients is relevant to validity issues for the '370 Patent. Microsoft therefore asks the Court to resolve this dispute now, through claim construction, and allow the parties to focus their arguments with respect to those issues.

7.   **"a first messaging client …"; "a second messaging client …"**

Term	Microsoft's Construction	Motorola's Construction
"a first messaging client, for establishing a first communication connection including a plurality of client data with a message server"	Indefinite. **Function**: establishing a first communication connection including a plurality of client data with a message server. **Structure**: none. The claims are indefinite for failing to identify a structure capable of providing or maintaining continuity by "establishing a first communication connection including a plurality of client data with a message server."	This element is not a means-plus-function element, alternately: **Function**: "establishing a first communication connection including a plurality of client data with a message server." **Structure**: "first messaging client"
"a second messaging client for receiving the plurality of client data from the first messaging client and for establishing a second communication connection including the plurality of client data with the message server"	Indefinite. **Function**: receiving the plurality of client data from the first messaging client and for establishing a second communication connection including the plurality of client data with the message server **Structure**: none. The claims are indefinite for failing to identify a structure capable of providing or maintaining continuity by "receiving the plurality of client data from the first messaging client and for establishing a second communication connection including the plurality of client data with the message server"	This element is not a means-plus-function element, alternately: **Function**: "receiving the plurality of client data from the first messaging client, and establishing a second communication connection including the plurality of client data with the message server" **Structure**: "second messaging client"

50. A plurality of messaging clients within a messaging communication system for providing continuity between the plurality of messaging clients comprising:

a first messaging client, for establishing a first communication connection including a plurality of client data with a message server; and

a second messaging client for receiving the plurality of client data from the first messaging client and for establishing a second communication connection including the plurality of client data with the message server.

It is Microsoft's contention that claim 50 includes "means-plus-function" limitations that require construction as a matter of law according to the requirements of 35 U.S.C. § 112 ¶6.

a. Claim 50 employs means-plus-function language.

The recitation of a "first messaging client" and a "second messaging client" is insufficient to identify the specific structure that performs the claimed functions. As noted above, both parties' proposed constructions for "first messaging client" and "second messaging client" simply point to software operating on a computer. "Software," however, is not structure. Software is the means by which the messaging clients "interface a user's device within a messaging system" (*see* Motorola's proposed construction) or the means by which the messaging clients "transfer[ ]client data to and receiv[e] client data from at least one other messaging client." (*see* Microsoft's proposed construction). The simple recitation of "first / second messaging clients" provides no defining limitation as to how the claimed functions must be accomplished. The claim is a "means-plus-function" claim.

b. The patentees failed to disclose the particular algorithm necessary to perform the claimed invention.

As the Federal Circuit has repeatedly clarified, "[s]imply reciting 'software' without providing some detail about the means to accomplish the function is not enough." *Finisar Corp.* 523 F.3d at 1340-41; *Aristocrat*, 521 F. 3d at 1333. The patentees must disclose the particular algorithm to be executed by the messaging client software in order to perform the recited functions. The '370 Patent specification, however, discloses no such algorithm and "fail[s] to

particularly point out and distinctly claim the invention as required by the second paragraph of section 112." Claim 50 is indefinite.

As discussed above, the recited functions of claim 50 refer to two known concepts in the prior art: the connection of messaging clients to servers and the transfer of data between the devices, i.e., the "very essence" of prior art communication systems. The claim recites a "first messaging client" capable of "establishing a first communication connection including a plurality of client data with a message server" and a "second messaging client" capable of "receiving the plurality of client data from the first messaging client" and of "establishing a second communication connection including the plurality of client data with the message server." Although the language of the claim is ambiguous, this claimed "plurality of messaging clients" is either able to provide "continuity" or is able to maintain "continuity" within a messaging communication system.

The messaging clients disclosed in the specification are essentially black boxes that perform the functions recited in claim 50. The patent repeatedly states that the messaging clients include "software capability for transferring all or a portion of the plurality of client data 25 to one or more other messaging clients" and "software capability for receiving all or a portion of the plurality of client data." Ex. 1401, at 10:9 – 23; 13:36 – 46; and 15:3 – 12. In a preferred embodiment, the "second messaging client" further includes "session transfer capabilities." *Id.* at 36:1 – 3.

The specification never describes these "capabilities" or explains how the functions are performed by the messaging clients. A reference to messaging clients with the necessary capabilities or the "appropriate programming" is insufficient. *See, Aristocrat Techs.,* 521 F.3d at 1331. As explained by the Federal Circuit, "relying on such general structure is equivalent to

saying that the function is performed by a computer that is capable of performing the function."
Blackboard, 574 F. 3d at 1383 (quoting *Aristocrat*, 521 F.3d at 1334). The patentees provide no
description of the process or algorithm that these general purpose messaging clients must
perform in order to complete these functions. *See also, Net MoneyIN, Inc.*, 545 F.3d at 1367;
Blackboard, Inc., 574 F.3d at 1384.

Motorola cannot simply point to the fact that one skilled in the art at the time of the
alleged invention was familiar with messaging clients. The question is not "whether one of skill
in the art would have been able to write such a software program. ... It is not proper to look to
the knowledge of one skilled in the art apart from and unconnected to the disclosure of the
patent." *Med. Instrumentation & Diagnostics Corp.*, 344 F.3d at 1212. The patentees cannot
avoid providing specificity as to the required structure "simply because someone of ordinary
skill in the art would be able to devise a means to perform the claimed function. To allow that
form of claiming under section 112, paragraph 6, would allow the patentee to claim all possible
means of achieving a function." *Blackboard*, 574 F. 3d at 1385 (citing, *Atmel Corp. v. Info.
Storage Devices, Inc.*, 198 F.3d 1374, 1380 (Fed. Cir. 1999) ("consideration of the understanding
of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient
structure in the specification").

Further, the idea that one skilled in the art would have been familiar with a messaging
client capable of performing these functions undermines the argument that the "continuity"
invention was, in fact, a novel invention. If one skilled in the art knew how to program
messaging clients to perform these functions in a messaging system for providing "continuity,"
the '370 Patent is merely directed to the admitted prior art.

The '370 Patent discloses insufficient structure to perform the functions of "establishing a

first communication connection including a plurality of client data with a message server,"

"receiving the plurality of client data from the first messaging client," and "establishing a second

communication connection including the plurality of client data with the message server" within

a messaging communication system for providing "continuity." Claim 50 is therefore indefinite.

V. **CONCLUSION**

For the foregoing reasons, Microsoft respectfully requests that its constructions be

adopted.

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By_____

Roberto Martinez
Curtis Miner
COLSON HICKS EIDSON
255 Alhambra Circle, Penthouse
Coral Gables, FL 33134
Telephone: (305) 476-7400
Attorneys for Defendant /
  Counterclaim Plaintiff
MICROSOFT CORPORATION

David T. Pritikin
Richard A. Cederoth
Douglas I. Lewis
John W. McBride
SIDLEY AUSTIN LLP
One South Dearborn
Chicago, IL 60603
Telephone: (312) 853-7000

Brian R. Nester
SIDLEY AUSTIN LLP
1501 K Street NW
Washington, DC 20005
Telephone: (202) 736-8000