

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

CASE NO. 10-24063-CIV-MORENO

MOTOROLA MOBILITY, INC.,)

Plaintiff / Counterclaim Defendant,)

v.)

MICROSOFT CORPORATION,)

Defendant / Counterclaim Plaintiff.)

MOTOROLA MOBILITY, INC.'S RESPONSIVE CLAIM CONSTRUCTION BRIEF

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Motorola respectfully submits this responsive claim construction brief. For the Court's convenience, Motorola presents the claim terms in the same order presented in Microsoft's opening brief. Tab A is a chart of the parties' respective constructions for each disputed term. Submitted with this Brief is the Declaration of Leslie Spencer with supporting Exhibits (Exhs. 54 -57).¹

I. MICROSOFT'S USE OF EXTRINSIC EVIDENCE

In its opening brief, Microsoft relies repeatedly on extrinsic evidence, such as inventor testimony, to support its constructions. Motorola anticipates that Microsoft will do the same in its responsive brief. This is improper. As set forth in Motorola's opening brief, the disputed claim terms can be construed based on the intrinsic evidence. *See Intel Corp. v. VIA Techs.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003). If anything, Microsoft's reliance on extrinsic evidence shows that its constructions are improper and inconsistent with the intrinsic record.

The Federal Circuit has repeatedly warned against reliance on inventor testimony, even if the inventor is testifying against his party's interest. *See, e.g., Howmedia Osteonics Corp. v. Wright Med. Tech.*, 540 F.3d 1337, 1346-47 (Fed. Cir. 2008) (refusing to rely on inventor testimony contrary to interest and holding that any inventor testimony as to subjective intent is irrelevant to claim construction).

The Court also should not consider expert opinions in construing the disputed terms. First, an expert's understanding of the basis for a construction is not useful to the Court without specific evidence by the expert that the proffered construction has an accepted meaning in the field. *See Gen. Protecht Group, Inc. v. ITC*, 619 F.3d 1303, 1310-11 (Fed. Cir. 2010). Moreover, the parties agreed not to rely on experts and any opinions offered thus far are contrary to party agreement.²

¹ Throughout this brief all emphasis is added unless noted otherwise. "MSFT _" refers to the indicated page of "Microsoft Corporation's Claim Construction Brief" (D.I. 135). "MOTO _" refers to the indicated page of "Motorola Mobility's Opening Claim Construction Brief" (D.I. 134). "MSFT Exh. _" refers to the indicated exhibit submitted by Microsoft in support of its opening brief.

² *See* Motorola Motion *In Limine* No.2, D.I. 129.

II. THE DISPUTED TERMS OF MICROSOFT'S PATENTS

A. U.S. Patent No. 6,791,536

1. “generating at least one event representing an activation of the primary switch of the pointing device”
“generating at least one event representing an activation of the secondary switch of the pointing device”³

The primary dispute between the parties is whether the language “event representing an activation” means “action” (as Microsoft contends) or “down event” (as Motorola contends). Other than a citation in a footnote to an irrelevant dictionary definition, Microsoft makes no attempt to support its proposed constructions.⁴ It does not because it cannot – there is *nothing* in the intrinsic record that supports Microsoft’s constructions. Instead, Microsoft attacks Motorola’s construction.

Microsoft first alleges that Motorola improperly imports the language “down event” into the claim from the preferred embodiment. MSFT 6. Not so. As explained in Motorola’s Opening Brief, *all* embodiments in the patent generate a “down event” in response to the activation of a primary or secondary switch. *See* MOTO 84. Microsoft is unable to cite to anything in the patent suggesting that any other definition of “event” is appropriate. Where a patent consistently uses a term in a particular manner, it is appropriate to define that claim term according to such use. *See Bell Atl. Network Servs. v. Covad Communs. Group*, 262, F.3d 1258, 1271 (Fed. Cir. 2001); *Irdeto Access, Inc. v. Echostar Satellite Corp.*, 383 F.3d 1295, 1301-02 (Fed. Cir. 2004) (“Bell Atlantic [held] that terms may be redefined away from their ordinary meaning by their consistent use in the specification.”). Microsoft’s own case citation supports Motorola. In *Teleflex, Inc. v. Ficoso N. Am. Corp.*, the Federal

³ Microsoft’s claim that these terms can be understood and applied based on their plain meaning should be rejected. The meaning of these terms is not apparent, and absent clarification from the Court, the jury will not understand or be able to apply them.

⁴ Microsoft’s substitution of the term “action” for “event” is also inconsistent with the specification, which describes specific pointing device events. *See, e.g.*, Exh. 43 at 6:29-30 (“the computer 201 may generate first a *LeftMouseButtonDown event*”). These events are not merely an “action or occurrence,” as Microsoft suggests.

Circuit noted approvingly that a patentee can define a term “by implication, through the term’s consistent use throughout the [] patent specification.” 299 F.3d at 1327 (citation omitted).

Microsoft also argues that the plain language of claims 14, 16 and 17 require generating only an “action” representing the activation of a pointing device switch, and not generating specific events of a pointing device. *See* MSFT 6. Microsoft’s argument ignores that the specification *repeatedly* states that the event representing the activation of the switch is, in fact, a specific “down event” of the pointing device. *See, e.g.*, Exh. 43 at 6:38-48 (“To simulate a right click of a mouse without dragging . . . the computer 201 may generate first a Microsoft WINDOWS *RightMouseButtonDown event* (step 307) (or other event that *represents the secondary switch of the pointing device being activated*). No other “event” is ever disclosed.

B. U.S. Patent No. 6,897,853

1. **“determining whether the input is a stroke based on a first move threshold”; “determining whether the input is a tap based on a time threshold”; “determining whether the stroke is a hold or a hold and drag . . .”**

The primary disputes between the parties are (1) whether the “move threshold” can be based on something other than distance and (2) whether the claimed thresholds must be predetermined.

Microsoft’s construction is overbroad on its face. Microsoft admits that its construction is so broad that it could encompass just “time” as a determiner of “movement.” MSFT 8. Defining a “*move* threshold” so that it can be based on only time is non-sensical and contradicts the teachings of the patent. The claims, for example, explicitly distinguish between move and time thresholds:

7. A method for classifying a user’s input to a computer comprising the steps of:
receiving a user’s input; and first determining whether the input is a stroke based on a first *move threshold*;
if the input is not a stroke, then second determining whether the input is a tap based on a *time threshold*

Thus, a “move threshold” must be different from a “time threshold.” Microsoft tries to justify its overly broad construction by relying on a single, isolated statement in the specification: “In step 303, the system determines if the stylus has moved beyond a first threshold (time, distance, rate, or acceleration, and the like).” MSFT 8. But the remainder of the specification treats “move threshold” as based on distance (as is logical). The isolated statement Microsoft relies on should not be used as a basis for a construction that contradicts the remainder of the specification and the express claim language. See *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1334-1335 (Fed. Cir. 2001) (basing the claim construction on the entire written description, despite an isolated passage in apparent conflict).⁵

Microsoft also argues that the thresholds are not predetermined. Again, this makes no sense. A threshold must be established in advance in order for the system to later determine whether or not it has been exceeded. Without a predetermined threshold, the system will not have a point of reference to determine if the threshold has been exceeded.

2. “simulating a right mouse click”

The dispute between the parties is whether a right mouse click requires both a down event and an up event. Microsoft’s argument that both are not required ignores the express teachings of the patent and Microsoft’s own Computer Dictionary.

First, Microsoft selectively and inaccurately quotes a portion of the ‘536 patent (which is referenced by the ‘853 patent) in arguing that only a down event is required. But the entire passage is revealing and supports *Motorola’s* construction – not Microsoft’s:

To simulate a right click of a mouse without dragging, if the computer 201 detects that the stylus 204 is not moved either prior to the timeout

⁵ While the specification states that the first move threshold can be, for example, rate or acceleration, see Exh. 48 at 6:3-4, such thresholds necessarily include some distance component. For example, determining whether an acceleration threshold is exceeded necessarily requires determining the distance the stylus has moved.

condition or after the timeout condition (steps 302 and 305), and if the computer 201 further detects that the stylus 204 is not brought up until after the timeout condition (steps 303 and 306), and thus that the stylus 204 has been held down for at least the threshold amount of time, then in response the computer 201 *may generate first a Microsoft WINDOWS RightMouseButtonDown event* (step 307) (or other event that represents the secondary switch of the pointing device being activated). The computer 201 may, further in response, optionally delay for a period of time (step 308), in one embodiment, about 20 milliseconds, and *then generate a Microsoft WINDOWS RightMouseButtonUp event (step 313)* (or other event that represents the secondary switch being deactivated).

Exh. 43 at 6:38-53. As this discussion makes clear, a right mouse click requires “first” a down event and “then” an up event.⁶ In fact, mouse clicks are described throughout the ‘536 patent as requiring a down event followed by an up event. *See, e.g.*, Exh. 43 at 5:54-6:24, 25-37. Microsoft also ignores the provisional patent application that the ‘853 patent incorporates by reference. Figure 3 of that provisional application once again explains that simulating a right mouse click includes generating a “RIGHT_MOUSE_BUTTON_DOWN” event followed by “RIGHT_MOUSE_BUTTON_UP” event. *See* Exh. 49 at 11:7-18.

Microsoft’s proposed construction also ignores its own Computer Dictionary that similarly defines a mouse click as including both a press (i.e., a down event) and release (i.e., an up event) of a mouse button. *See* Exh. 46. Although consultation of a dictionary is unnecessary given the consistent usage of the term throughout the patent, this dictionary definition corroborates and confirms Motorola’s construction. *See Vitronics*, 90 F.3d at 1584 n.6.

Finally, Microsoft appears to argue that Motorola’s construction is limited to Windows-specific down events. That is not the case. Consistent with its usage in the specification, Motorola’s construction requires a “down event and an “up event.” It does not require a “WINDOWS RightMouseButtonDown event” and a “WINDOWS RightMouseButtonUp event.”

⁶ In its brief, Microsoft conveniently omits the word “first” from this quotation.

C. U.S. Patent Nos. 7,024,214 and 7,493,130

1. “synchronization mechanism”

The primary dispute between the parties is whether a “synchronization mechanism” is, as Motorola proposes, limited to just communication channels. Each of Microsoft’s attempts to expand “synchronization mechanism” beyond communication channels falls short.

Microsoft first argues that a virtual private network (VPN) is a type of synchronization mechanism by pointing to certain claims that state that “the plurality of synchronization mechanisms comprises a virtual private network.” MSFT 12. This language, however, does not equate “synchronization mechanisms” with a VPN. Rather, it claims a VPN as a *grouping* (i.e., plurality) of different synchronization mechanisms, not the mechanism itself. Indeed, the patents confirm this where they provide numerous examples of synchronization mechanisms (*see, e.g.*, Exh. 40 at 8:14-20) and *never once* identify a VPN as a synchronization mechanism.

Microsoft next argues that a communication channel cannot be a “synchronization mechanism” because communication channels do not include an element of control or take cost into consideration. MSFT 12. This misses the point. The patents, for example, describe choosing a public switched telephone network or a GSM connection rather than a GPRS connection *based on* cost considerations. *See* Exh. 40 at 8:35-46.⁷ The patent never states that a selected mechanism *includes* cost considerations.

Finally, Microsoft’s citation to the prosecution history supports Motorola’s construction, not Microsoft’s. The prosecution history refers to “a hardwired *connection*” (i.e., a hardwired channel) and a “wireless *connection*” (i.e., a wireless channel) as types of synchronization mechanisms. And, consistent with Motorola’s construction, different types of communication channels have

⁷ Even the very portion of the specification cited by Microsoft goes on to discuss how different “connections” (i.e., channels) can have different associated costs – not that they include them. *See* Exh. 40 at 1:56-2:5.

different inherent levels of security. Exh. 40 at 2:6-13. Therefore, these mechanisms are types of communication connections, not simply “processes or techniques.”

2. “flexible selection rule(s)”

Microsoft alleges that Motorola’s proposed construction is inconsistent with the language of the claims because “Motorola’s proposed construction does not give the flexible rules any ability to govern whether or when synchronization occurs.” MSFT 13-14. But, as explained below, only some of the claims are directed to flexible rules governing whether or when synchronization occurs and nothing in Motorola’s proposed construction precludes the flexible selection rules from determining, in the appropriate context, whether or when to synchronize.

Consistent with Motorola’s construction, every independent claim requires consulting a set of flexible selection rules to select or determine “an available synchronization mechanism appropriate for the data item”. Only some claims further consult the flexible rules to, for example, actually determine *whether* or *when* to synchronize. Thus, the flexible rules *always* determine or select an available synchronization mechanism for a given data item (as required by Motorola), but only *sometimes* determine whether, when or how to synchronize (as required by Microsoft). Because Microsoft’s proposed construction of “whether, when, and/or how” eliminates – or at least confuses – the express requirement of the claims that the flexible rules always select or determine an available synchronization mechanism, Microsoft’s proposed construction should be rejected.

Microsoft appears to concede that the specification teaches that the flexible rules can be changeable. Microsoft argues, however, that flexible rules are defined as “changeable” only in certain dependent claims. Microsoft is wrong. The dependent claims are directed to the actual act of changing the rules (e.g., claim 22 – “*an act* of receiving instructions *to change* the set of flexible selection rules,” not the fact that they are inherently changeable. Thus, the flexible rules are themselves changeable and the dependent claims cover the specific act of changing those rules.

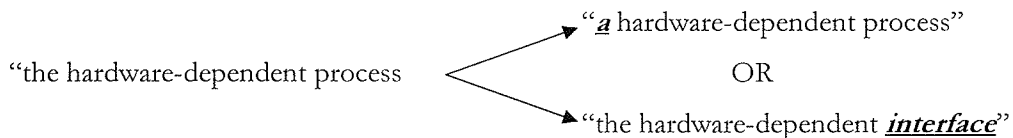
3. “value, from having access to synchronized data”

Microsoft argues that the “value, from having access to synchronized data” is “the value of having access *generally* to synchronized *data*, rather than the value of having access to any *particular data item*.” MSFT 14-15 (emphasis in original). This makes no sense. Every independent claim is directed to selecting or determining an appropriate synchronization mechanism for a given data item by consulting a set of flexible rules. The “set of one or more flexible selection rules tak[e] into consideration *value, from having access to synchronized data*.” Thus, the claims of the Loveland patents are expressly directed to making value assessments of *data items*, and thereby selecting the appropriate synchronization mechanism for the *data item*.⁸

D. U.S. Patent No. 7,383,460

1. “the hardware-dependent process”

Microsoft acknowledges that this term is flawed on its face because of “imperfect claim drafting.” MSFT 16. Microsoft, however, turns a blind eye to the multiple ways this claim can be corrected and, instead, argues there is only one logical correction – substituting the word “process” for the word “interface.” *Id.* This is not the case. There are two equally likely corrections, each of which carries a distinct meaning:



⁸ Microsoft further argues that “value” may be measured from the perspective of “the IT department, the user’s boss, or the wireless service provider.” MSFT 15. But the input from these sources is disclosed as being related to security and/or cost concerns (other limitations of the claims), not value. *See* Exh. 39 at 8:33-9:8.

The first correction – which Microsoft ignores – corrects a lack of antecedent basis for the term “the hardware dependent process” by substituting “a” for “the.”⁹ *See* MOTO 92. Nothing in the intrinsic record favors one correction over the other, and Microsoft provides no reason why the first is any less likely than the second. Further, contrary to Microsoft’s suggestion, nothing in the ‘460 patent mandates that only the hardware-dependent *interface* receive a validated request. MSFT 17. In fact, the language of claim 1 patent makes it clear that this is not the case: “relaying the request to a hardware-dependent *process*.” Therefore, it is certainly possible (even probable) that claim 7 intended the validated request to be relayed to a “process” and not an “interface.” Thus, Microsoft use the *exemplary* embodiment of Fig. 1 to force a particular rewrite is improper.

Microsoft’s reliance on *Masimo Corp. v. Mallinckrodt Inc.*, 18 Fed. Appx. 852 (Fed. Cir. 2001), is misplaced. In *Masimo*, the court was faced with construing “adaptive filter,” “adaptive signal processor,” “adaptive noise canceler,” and “adaptive canceler.” *Id.* at 854-56. Based on the intrinsic record, the court held that the terms were intended to be used interchangeably and that an equivalent construction was appropriate. *Id.* at 855-56. That is not the case here. The intrinsic record here shows that “interface” and “process” are distinct terms. For example, the specification defines program modules as including “routines, subroutines, programs, subprograms, methods, *interfaces, processes*, procedures, functions, components, schema, etc., *that perform particular tasks* or implement particular abstract data types.” Exh. 50 at 11:30-35.¹⁰ Similarly, as discussed above, claim 1 uses the terms distinctly, claiming both an “interface” and a “process.”

⁹ Lack of antecedent basis arises if an element is preceded by a definite article, e.g., “*the* lever,” where there is no prior initial claiming of the element (i.e., *which* lever?). MPEP § 2173.05(e).

¹⁰ This comports with how a person of ordinary skill in the art would have understood the terms “process” and “interface.” *See Microsoft Computer Dictionary, Fifth Edition* 2002 (Exh. 54):

interface: The point at which a connection is made between two elements so that they can work with each other or exchange information.

process: A program or part of a program . . .

Because a person of ordinary skill may reasonably interpret “the hardware-dependent process” in more than one way, the term is insolubly ambiguous and, therefore, indefinite. *See Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1358 (Fed. Cir. 2003).

2. “[a timer] substantially guaranteed to expire at a time certain”

This claim term is indefinite because a person of ordinary skill in the art would not understand what it means to be “substantially guaranteed” to expire at a time certain. Microsoft does not even attempt to address what “substantially” guaranteed means in the context of the patent. This is not surprising since the word “substantial” (or any variant thereof) is *never* mentioned in the intrinsic record. Rather, the ‘460 patent teaches that a hardware timer is “guaranteed” – without qualification – to expire at a specific time:

- “the timer being guaranteed to expire at a specific time . . .” (Exh. 50, Abstract)
- “Timers that are guaranteed to expire at a certain time are typically hardware timers” (*Id.* at 1:23-24)
- “[A]ccess to timers that are guaranteed to expire at a certain time” (*Id.* at 1:44-45)
- “the timer being guaranteed to expire at a specific time” (*Id.* at 1:58-59)
- “timer hardware that is guaranteed to expire at a specified time” (*Id.* at 1:60-62)
- “hardware timers are generally the only timers that are guaranteed to expire at a specified time” (*Id.* at 3:37-39)

There is simply *no* discussion of what it means to have a timer that is only “substantially guaranteed” to expire at a time certain. In cases in which a court has determined that the term “substantially” is not indefinite, it also noted that the intrinsic record provided “at least some guidance” on how the term should be understood. *See, e.g., Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1332-34 (Fed. Cir. 2010) (holding that although a patentee need not define his invention with mathematical precision, the specification must provide “some standard for measuring that degree”). The ‘460 patent provides no such guidance.

Microsoft attempts to shrug off the uncertainty inherent in the claim by reading “or [specific] interval” into the disputed claim term. This is improper. First, the claim language states that the expiration time is a “time certain.” No construction is needed here – plain and ordinary language dictates that this means “a specific time.” And nothing supports broadening “time certain” into “time *or interval* certain.” The term “interval” as used throughout the specification, describes the intervals at which the timer should expire, *not* the interval *within which* the timer may expire.¹¹ For example, a hardware timer may be set to expire at precisely 12:00 P.M., and then every 3 minutes thereafter. The “time certain” that the timer is guaranteed to expire at is 12:00 P.M.; the “interval” would be every 3 minutes thereafter (i.e., 12:03, 12:06, etc.). This does not mean that the timer may expire at any time between 12:00 and 12:03, as Microsoft’s construction implies.

Even assuming, *arguendo*, that Microsoft’s “or interval” construction is correct, this does not answer the question of what it means to “substantially guarantee” expiration at a specific interval. Microsoft’s construction does not address that issue, instead reading out the “substantially” limitation altogether. Because neither the plain language of the claim nor the intrinsic record describes what it means to “substantially guarantee” expiration of a timer at a time certain, this term is insolubly ambiguous, and therefore, indefinite.

3. “high precision event timer (HPET)”

Microsoft is no longer asserting the claim that includes this limitation and, accordingly, the Court no longer needs to construe it.

E. U.S. Patent No. 6,897,904

1. “program content currently being tuned”

Microsoft mischaracterizes Motorola’s construction and the usage of the term “live” in the patent. The patent uses the word “live” three times – each time referring to any content that has not

¹¹ See, e.g., Exh. 50 at 2: 9-11: “In the periodic mode, the timer is guaranteed to expire more than once, at a specified interval.”

been recorded within a given system. *See* Exh. 52 at 2:39-41, 4:67-5:1, 5:29-33. As the patent describes: “when switching back to a channel that is being recorded, the system can begin displaying the program content currently being tuned by the tuner. Alternatively, the system can begin displaying previously recorded program content...” *Id.* at 6:29-32. Claims 19 and 20 cover this scenario – claim 19 requires that the content comes directly from the tuner (thus, “live”) and claim 20 requires that it is previously recorded by the set top box (thus, *not* “live”). Microsoft’s construction fails to address what happens to the content *after* it is received by the tuner.

III. THE DISPUTED TERMS OF MOTOROLA’S ASSERTED PATENTS

A. U.S. Patent No. 5,502,839

Microsoft’s brief does not address each individual claim limitation. Rather, Microsoft makes general arguments about several claim terms that it has grouped together as “similar.” The claim terms are not the same and should thus be treated individually for purposes of claim construction. *See Tandon Corp. v. U.S. Int’l Trade Comm’n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987). Motorola, however, will address each of Microsoft’s proposed “groupings” below, in turn.

1. **“means for performing processing operations on said virtual input”; “means for accepting said virtual output”; “means for converting said virtual output into at least one physical output”; and “means for performing processing operations on . . . picture elements”**

With respect to the claimed function for each of these separate elements, Microsoft argues that not including the word “said” in Motorola’s proposed constructions for the functions listed above improperly broadens the scope of the claimed functions. Not true. Motorola removed the term “said” from the claim constructions to make the term clearer and simpler for the jury. When these claim limitations are considered in the context of the entire claim, Motorola’s construction does not change the scope of the function in any way.

With respect to the corresponding structure for each element, Microsoft further argues that its limited excerpts from the specification describe complete functionality for the structure

corresponding to each function (namely, the Console Manager, Picture Manager and Output Manager (hereinafter “Managers”)). Motorola disagrees. As set forth in Motorola’s Opening Brief, Microsoft’s construction omits several important parts of the specification that discuss the specific claimed functions performed by these each of these Managers. MOTO at 63-66, 74. As a result, Microsoft’s proposed structures are incomplete. Indeed, Microsoft’s limited definitions do not reference any figures or source code in the patent that a person of ordinary skill in the art would understand help define these structures. *See, e.g., AllVoice Computing PLC v. Nuance Commc’ns, Inc.*, 504 F.3d 1236, 1245 (Fed. Cir. 2007).

Microsoft also argues that because Motorola’s construction references exemplary sections of the specification, it encompasses any theoretical structure for performing the function. Not so. Motorola cites to “at least” the portions of the specification that describe corresponding structure – in other words, the cites may not be an exhaustive list, but are sufficient to describe the structure.¹²

2. **“means responsive to one of said physical input devices for generating a picture,” and “means responsive to ... processed picture elements for coupling ... processed picture elements to one of said physical output devices.”**

Microsoft argues that Motorola’s proposed function for the term “means responsive to one of said physical input devices for generating a picture” should be rejected for including “a user’s interaction with a physical input device.” MSFT 24-25 (citing *Credo Prods., Inc. v. Prestek, Inc.*, 305 F.3d 1337, 1344 (Fed. Cir. 2002)). *Credo*, however, does not support Microsoft’s position. The claim language recites the function of “generating a picture,” and the patent expressly states that “all input from a user to the [system] is stored as pictures.” Exh. 32 at 14:4-5. Motorola’s reference to

¹² Microsoft further criticizes Motorola’s definition for the corresponding structure of each of these claims because they define each Manager as “any process that may perform” the particular function. Microsoft, however, misstates Motorola’s definition for the Managers, each of which explicitly defines the corresponding structure for each Manager based on the specification (*e.g.*, Exh. 35 at FIGs. 8, 9, 12, 13; 15:30-17:17, 24:49-26:24, 27:5-28:17, 29:65-30:48, 55-70). Thus, a Manager is not *any* process that performs the claimed function.

the user's interaction merely provides context for the claimed function. By contrast, Microsoft's proposed function slips in the new requirement of "input" which directly comes from a physical device – found nowhere in the claim language.

Microsoft injects a requirement of "sending" to the function of "means responsive to said one or more processed picture elements for coupling said one or more processed picture elements to one or more of said physical output devices" that is nowhere in the claim language. And, contrary to Microsoft's argument, the specification does not *require* that "coupling" be limited to sending; rather, coupling *may include* sending among other means of establishing a relationship between the processed picture elements and a physical input device. Furthermore, the language from the patent Microsoft relies on for this argument discusses coupling among processes and has nothing to do with picture elements.

With respect to the corresponding means for these limitations, Microsoft's proposed constructions are defective for the same reasons as discussed above – namely, they improperly limit the Managers to small portions of the specification and omit others without explanation.

3. Proposed Construction Of Disputed "Wherein" Clauses That Microsoft Contends Are "Means-Plus-Function" Limitations

Microsoft argues that these five claim limitations should be construed as means-plus-function limitations simply because they use the word "means." However, a cursory review of claims 10-12, 22 and 23 reveal that the term "means" in these limitations is used only to refer back to means-plus-function limitations in other claims and is not used to claim an additional means-plus-function limitation. This is readily shown from the claim language. For example, claim 10 states: "wherein said virtual output accepting means comprises a picture manager process for controlling said plurality of related picture elements." The "virtual output accepting means" of this dependent claim refers to the "virtual output accepting means" described in claim 9, which the parties agree should be construed according to 35 U.S.C. §112, ¶ 6. The remaining language – "comprises a

picture manager process for controlling said plurality of related picture elements” – merely describes additional structure for the accepting means; there is no new “means” introduced. *See* MOTO 68. This is also true for the remaining four limitations above. *See id.* at 70-72 and 76-77. Thus, the presumption on which Microsoft relies is inapplicable. *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259 (Fed. Cir. 2008).

Microsoft argues that none of the recited structures “have a readily understandable meaning when read simply as part of the claim language.” MSFT 28. This is incorrect. One of ordinary skill when reading the claim language in light of the specification would readily be able to ascertain the structure recited in the claim language itself – picture manager process, window manager process, virtual input manager process and virtual output manager process. Indeed, the parties agree that such “Manager” processes provide corresponding structure for the recited means. In other words, a person of skill would not be left to guess or conjecture what is the appropriate structure for the limitation as it is spelled out in the claim. *Personalized Media Communs., L.L.C. v. ITC*, 161 F.3d 696, 704-705 (Fed. Cir. 1998) (finding a term is not a means-plus-function limitation because the term itself was sufficient structure: “even though the term [] does not specifically evoke a particular structure, it does convey to one knowledgeable in the art a variety of [known] structures.”).

4. “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”

Microsoft repeatedly asserts that a picture element *must* include a common header data structure because it is supposedly expressly defined as such in the specification of the ‘839 patent. Microsoft is wrong – various parts of the specification describe the term “picture element” without referring to such a common header data structure. For example, the patent expressly defines the term picture element as “a device-dependent abstraction of a displayable object (line, text, etc.)”, as Motorola has proposed in its construction. Exh. 30 at 30: 51-57. This definition is consistent with

column 11, lines 63-66, where the term “picture element” is described for the first time as “a line, arc and text, which can be stored compactly and transferred efficiently between processes.” The fact that these two examples do not require a common header data structure demonstrates that Microsoft’s construction should be rejected. The common header data structure refers to a single embodiment and does not restrict the “picture element” claim term. *See, e.g., Phillips*, 415 F.3d at 1314; *Comark Commc’ns, Inc.*, 156 F.3d at 1187.

5. “virtual input” and “virtual output”

Microsoft again attempts to read limitations into the terms “virtual input” and “virtual output” based on exemplary language in the specification. Nothing in the specification requires limiting these terms to device-independent abstraction of physical input/output represented as “standard messages” as proposed by Microsoft. Again, Microsoft focuses on a single embodiment – “standard messages” – that might be construed as one form of virtual input or output.

Microsoft contends that Motorola focuses on the term “picture element” without tying this term to input or output. MSFT 30. This is simply not true. Consistent with the specification, Motorola’s definition for virtual input requires one or more picture elements ***generated from user input***. *See, e.g., Exh. 39* at 14:3-7 (“all input from a user ... is stored as pictures.”). In addition, Motorola’s definition for virtual output refers to picture elements of a picture because the specification teaches that virtual output is via pictures. *Id.* (“All output ... to a user is via pictures”) Moreover, the term “virtual output” appears in claim 9 for the first time in the “means for processing operations on said virtual input and for generating virtual output” limitation. Looking at this term in context of the entire claim is instructive: at this point in the claim the picture elements which will eventually comprise the virtual output are not yet accepted by a picture manager (*e.g.*, as a stored picture) or converted for use on a physical output device, as described by the remaining claim limitations. *See, e.g., Id.* at FIG. 12; 25:32-56; 43:56-65. Once a picture element is part of a

picture it may be tied to output. Microsoft's construction, by contrast, completely ignores the central concept that input and output is via pictures (or picture elements).

6. "source of virtual input"

Motorola's proposed construction is consistent with all the embodiments described in the patent. *See* MOTO 60. The specification expressly states that "virtual input may take any of several forms, such as a keystroke, cursor position, action, function key, menu, etc." *See* Exh. 33 at 44:7-9 (discussing Fig. 13). In addition, the claims themselves show that "virtual input" may be in several forms, including in the form of "user-defined functions" or "menu selections" (*see id.* at 225:1-35 (claim 1)). Microsoft's construction, in contrast, improperly focuses on only one embodiment described in the patent – event-driven input initiated by a user interacting with an external device (*see id.* at 27:67-28:3) – and does not allow for sources of virtual input that do not originate from a physical input device, such as an application function or menu (*see id.* at 27:45-55, 28:4-6) or a method (*see id.* at 28:6-8).

Microsoft argues that "[n]othing in the '839 patent suggests that virtual input can be generated from anything other than real world user input on a physical device." MSFT 32. For support, it relies on one (of many) of the stated purposes of the alleged inventions, while completely ignoring others, such as "perform[ing] input/output operations in an abstract sense, ***independent of any particular I/O devices.***" Exh. 33 at 2:23-26. Moreover, Figures 8 and 9 of the patent, which Microsoft claims support its construction, actually demonstrate that the invention is not limited by physical input or output devices. These figures show that the underlying architecture of the human interface allows the data processing system to operate on any number of devices because of its fundamental use of pictures. *See, e.g., id.* at FIG. 8, 9. The fact that physical input devices and output devices appear in the figures does not compel Microsoft's construction; rather, in certain

embodiments, they are interfaces to the claimed invention as demonstrated by their exclusion from the dotted-line architecture, for example in Fig. 9.

7. “picture manager process”

Microsoft argues that its definition for “picture manager process” is taken directly from the patent specification and incorporates explicit definitions of terms provided by the specification. MSFT 32. The same can be said of Motorola’s construction. The difference is that the process definition relied on by Microsoft is taken out of context and does not define the picture manager process. The process described at column 5, lines 20-46 relates to the background of the underlying data processing system on which the claimed output interface operates and has nothing whatsoever to do with the picture manager process of claim 10. Furthermore, the lone requirement of one process per picture is arbitrary considering it is but one sentence among dozens of other descriptions about the Picture Manager singled out by Microsoft. It is simply not appropriate to restrict a claim limitation to exemplary language from the specification absent the patentee’s clear intent so to do. *See Phillips*, 415 F.3d at 1316.

8. “window manager process”

Similar to “picture manager process,” Microsoft urges the Court to adopt a definition that adds more to the “window manager process” than is warranted. Again, Microsoft has no justification for limiting the definition to the process at column 5, lines 20-46. As discussed *supra*, this discussion of a process is by way of background only and is not connected at all to the “window manager process” of claim 11. Also, Microsoft’s additional requirement of “virtual pixels” is illogical considering the dozens of lines of text discussing the window manager process functionality.

B. U.S. Patent No. 5,764,899

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

Microsoft incorrectly argues that the preamble of claim 1 should be construed as a limitation. In general, a claim’s preamble is not a limitation. *See Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1358 (Fed. Cir. 2010). In an attempt to overcome this presumption, Microsoft argues that this preamble is a limitation because the term “the communication unit” in the body of the claim derives necessary antecedent basis from the term “a communication unit” in the preamble. MSFT 35 (citing *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1306 (Fed. Cir. 2005)). Microsoft is wrong. The Federal Circuit in *NTP* made clear that the preamble *may* be a limitation when it provides an antecedent basis for a “*necessary*” component of the claimed invention. *Id.* at 1305-06. Here, the communication unit is not a necessary component of the claimed invention. In fact, it is not even part of the claimed system – at most, it is merely part of the environment in which it can operate. *See Advanced Software Design Corp. v. Fiserv, Inc.*, 641 F.3d 1368, 1374 (Fed. Cir. 2011) (holding that a claim limitation in the preamble does not necessarily limit the apparatus or process claimed, but can instead limit the environment in which the method or apparatus operates).

The claims are directed to “a system” with two principle components: the “communication server” and the “host server.” The “communication unit” in the body of the claim is independent of and separate from these two limitations and is, therefore, not part of the claimed system. As the preamble makes clear, the communication device is what communicates with the claimed system: “A system for communicating reply data with a communication unit comprising.” Thus, the inclusion of a “communication unit” only provides context to the claim. When, as here, the preamble does not provide a *necessary* antecedent basis for the claim, the preamble is not a limitation. *See Am. Med. Sys.*, 618 F.3d at 1358-59.

Even if the Court finds that the preamble is a limitation, Microsoft's definition introduces extraneous limitations and will be confusing to the jury. First, Microsoft substitutes "transmitting or receiving" for the term "communicating." In doing so, Microsoft replaces a common term the jury will readily understand with a phrase that creates potential confusion – does the system need to only transmit or receive, or must it do both? Further, Microsoft's construction requires that the reply email be "formulated on the communication unit *before* optimization." This requirement improperly imports a limitation from a one particular embodiment in the patent's specification – nothing in the claim itself or the specification requires that the reply email be formulated before optimization. As Motorola stated in its opening brief, the preamble need not be construed – its plain and ordinary meaning should be applied and will be easily understood by a jury.

After arguing that the preamble of claim 1 is limiting, and that its construction should be adopted, Microsoft then presents the apparent alternative argument that the preamble is actually indefinite. This argument makes no sense.¹³ Microsoft itself acknowledges that this term can be construed, stating that the patent specification and claim "clarifie[d]" and "defined" the words in preamble. MSFT 36. Therefore, the term is "amenable to construction" and not indefinite. *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783 (Fed. Cir. 2010).

Further undercutting its argument, Microsoft states that "there is no definition for this term [presumably, the preamble] that acknowledges to one of ordinary skill in the art that the 'reply email of the communication unit' is different from the optimized reply." MSFT 37. The claim language says otherwise. Even a cursory review of, for example, claim 1, demonstrates that the optimized

¹³ And as a preliminary matter, it is too late for Microsoft to raise this argument. Microsoft did not disclose this contention in either its invalidity contentions or in its claim construction exchange with Motorola, despite addressing indefiniteness for other claim terms in those submissions.

reply is “a first data unit identifier and further data,” while “reply data is [a] reply email of the communication unit.” These limitations are not indefinite, nor are they mutually exclusive.¹⁴

2. “a host server”/“a host server in communication with the communication server”

Microsoft’s argument that the host server and communication server must be physically separate components ignores the specification of the ‘899 patent. According to the patent, the host server can be either “another program running *on the same communications server* or located on another server....” Exh.30 at 4:58-5:13. In an attempt to circumvent this plain language, Microsoft argues that “the embodiment in Motorola’s definition of different programs on the same processing device is simply not enabled.” MSFT 38. But Microsoft fails to provide any support for its argument; there is no doubt that one of ordinary skill would understand that the communication server and host server roles could be performed on one or more servers, so long as the various components are in “communication” with one another.¹⁵

Similarly, Microsoft’s arguments regarding the prosecution and reexamination of the ‘899 patent fail to support its construction. Microsoft states that Motorola somehow conceded that the host server and communication server must be *physically* separate when distinguishing the Morgan reference. *See* MSFT 39. But none of the statements Microsoft points to establish that Motorola argued the servers must be *physically* separate; the servers could, instead, be *logically* separate, so

¹⁴ Microsoft further argues that the communication unit must send *both* optimized replies and normal replies. There is no such requirement in the claims or the specification.

¹⁵ Microsoft’s “bandwidth” discussion similarly fails to support its claim construction. *See* MSFT 38. The patent’s ability to conserve bandwidth focuses on optimizing server-client – not server-server – communications. In fact, the specification clearly states that the optimized reply invention may *increase* processing and communication between the host server and communication server, with the understanding that this increase is minimal compared to the “savings achieved by using an optimized reply over the tariffed network between the communication *server* and the *client*.” Exh. 30 at 12: 62-67.

long as they both existed.¹⁶ And none of the statements are a clear disavowal of claim scope. *See Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325 (Fed.Cir.2003) (“To balance the importance of public notice and the right of patentees to seek broad patent coverage, we have thus consistently rejected prosecution statements too vague or ambiguous to qualify as a disavowal of claim scope.”).

Finally, Microsoft’s argument that the language “in communication with” requires an act of “transmitting” or “receiving” also fails. Regardless of whether “communication” requires over-the-air transmission, or mere electronic signaling, Microsoft’s construction would transform this system claim, which does not require actual performance of any “step,” into a method claim – this is improper. *See Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1204 (Fed. Cir. 2010) (“Here, the claims at issue are ‘system’ ... claims, which do not require the performance of any method steps.”)

3. “email,” “e-mail”

Microsoft’s construction of email takes a term the jury will readily understand and injects into it terminology (e.g., text and header information) that the jury will not understand and that is not required by the intrinsic evidence.

As an initial matter, Microsoft’s construction of “email” is unnecessarily narrow and ignores many forms of communication that a person of ordinary skill in the art would understand to be “email.” For example, Microsoft’s construction would exclude electronic mail that contains a picture rather than text. And it is unclear from Microsoft’s construction whether its proposed “text” information must be in the subject line and/or in the body of the email. A sender may choose to include only subject-line text of “Meet me at home at 8 PM,” rather than body text with the same

¹⁶ The term “logically” in this context refers to the functional relationship between the servers. As shown in, for example, Figure 2 (block diagram of a communications system), the only remote, physically separate components are the communication units. Communications to or from these devices are shown using radio waves. In contrast, connections between the host server and communications server are shown using hard lines (described in the patent as being “coupled locally”). The patent makes clear that the type of connection between these local elements is irrelevant, so long as they can communicate with one another.

content, but his message would be understood by the recipient just the same. Microsoft's construction does not take this into account.¹⁷

In support of its convoluted construction, Microsoft states that Motorola provided a "definition" of "email" during the reexamination of the '899 patent. D.I. 135 at 40-41. These general statements, however, related to the understanding of a person of ordinary skill regarding the "host server" (or mailbox) claim element, not the construction of "email" generally. In fact, as part of this submission, Motorola acknowledged that "[t]he definition of email and the use of mailboxes in combination with email is well known in the art..." MSFT Exh. 904 at MS-MOTO_SDFLA_00000014447. SMTP was used as a commonly understood example of email in distinguishing other aspects of the cited prior art, not as a way to limit explicitly the type of email that could be incorporated into the '899 patent.¹⁸

4. "forwarding"; "forwards"; "forwarded"; "forward"

This is another term the Court need not construe. For the reasons discussed above with respect to the term "host server," Microsoft's arguments that the host server and communication server must be physically separate fail. As a result, and because the host server is described as "forwarding the first data unit to the communication server," the plain meaning of "forwarding" does not require transmission from one processing device to a physically separate processing device – logical communication is enough.

¹⁷ Microsoft argues that claim 15, which requires "[t]he system of claim 1, where in the first e-mail sent to the communication unit includes a textual message and is accompanied by a file attachment" somehow supports its construction requiring that "email" always include text. Microsoft misunderstands the doctrine of claim differentiation in making its assertion – in fact, the doctrine of claim differentiation makes clear that a "textual message" is *not* a requirement of independent claim 1, since it is a requirement of the more narrow dependent claim 15.

¹⁸ Even relying on Motorola's SMTP citation would not support Microsoft's construction of "email," as SMTP did not require an author address; Microsoft's only "evidence" regarding author information being a necessary component of email comes from the patent's description of an *example* of what email header information *may include*.

5. **“a determination is made whether to forward the optimized reply”**

Motorola is no longer asserting the claim that includes this limitation and, accordingly, the Court no longer needs to construe it.

C. **U.S. Patent No. 5,784,001¹⁹**

1. **“A method for displaying messages in a data communication receiver”; “A data communication receiver for presenting information”**

Microsoft’s statement that “the only real dispute ... is whether the method steps in claim 1 must all be performed on a data communication receiver” is incorrect. The dispute here is whether the data communication receiver must be “mobile” as Microsoft’s construction requires. Microsoft provides no support for its inclusion of the term “mobile,” quite simply because no support can be found. In fact, the specification teaches that the data communication receiver can be programmed via controls and a data port, such as those found on a desktop computer. In such an embodiment, the data communication receiver does not receive over-the-air programming or demodulate radio signals and, therefore, is not necessarily a mobile, or wireless, device. *See* MOTO 37-38.

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

Microsoft claims that “the database is described as included *on* the data communication receiver.” MSFT 46. Not so. The portions of the specification identified by Microsoft do not require the database to be “on” the data communication receiver. Figure 1, for example, is an “electrical block diagram,” which simply shows the electrical relationship between the parts of the data communication receiver. This does not require the database to be in physical proximity to or physically part of the data communication receiver, so long as they are connected electrically to the

¹⁹ Microsoft argues that “the claimed invention is mainly described in 6:1-50.” MSFT 44. Microsoft is wrong. As discussed in Motorola’s Opening Brief, the ‘001 patent discloses a data communication receiver that may display an image, a message, or a combination of an image and a message, and is not limited to the embodiment disclosed at 6:1-50. MOTO 36. Microsoft’s attempt to limit the invention to just 6:1-50 permeates Microsoft’s proposed constructions.

other parts of the receiver. Microsoft's remaining citations all reference Figure 1 and, therefore, similarly do not require the database to be "on" the data communication receiver.

Microsoft also attempts to limit "alphanumeric" to only numbers and alphabet characters (not symbols like #, *, or -) despite the fact that the specification explicitly teaches otherwise. Indeed, the specification discloses that "#07TOM?" is "alphanumeric" even though it includes "#" and "?". *See* Exh. 20 at Fig. 8; 3:51-67 ("#07TOM?" or "TOM?#07" results in the presentation of the image ... as well as the presentation of any additional alphanumeric or numeric characters included in the message."). Indeed, Microsoft's own published definition of "alphanumeric" ("... including control characters, space characters, and other special characters") confirms this fact. *See* MOTO 39. Microsoft ignores this evidence in arguing that the claims' use of the term "word" precludes the use of symbols. This is nonsense; words can include symbols. For example, words like "twenty-three," "all-inclusive," or "cross-reference" include symbols ("-") and yet are readily understood to be "words."

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

Once again, Microsoft attempts to limit the asserted claims to the embodiment disclosed in Column 6, even though the intrinsic evidence does not require such a limitation. Figure 8 discloses an embodiment where an image is displayed with a portion of a received message. This disclosure flies in the face of Microsoft's argument that "[t]here is no language allowing for substitution of the key word with the image or for displaying only a part of the alphanumeric message."²⁰

That the applicant amended the claims to reflect "key words" instead of "codes" does not render portions of the specification discussing "codes" irrelevant. Far from it, "codes" and "key

²⁰ *See* MOTO 39-40 for additional disclosures in the '001 patent that teach displaying "a portion of" the alphanumeric message.

words” reflect the same concept – a sequence that is associated with image data.²¹ As is clear from the prosecution history, the applicant made these amendments to clarify the invention and not to differentiate the disclosed codes from key words. Specifically, the Examiner had identified lone numbers, *e.g.*, “1” as a “code.” Exh. 55 at 17225-258 (*see, e.g.*, 17227 where the Examiner states “a sender presses a one on the telephone keypad, the one is converted to a code which the receiver receives”). The applicant clarified that a number like “1” is not a “code” as claimed by the patent. In this context, the term “key word” more accurately reflected the applicant’s invention. *Id.* at 17247-258.

Microsoft mistakenly suggests that the claim language “accompanied by” requires that an image “supplement the entire alphanumeric message.” Not so. Had the applicant intended to require a “supplemental image,” the applicant surely could have amended the claims to reflect that. The applicant did not. The plain language of this phrase is clear: a graphic message (an image) must be presented along with an alphanumeric message. As shown in Figures 8 and 15, either a portion *or* the entirety of the message may be displayed – in both cases, the message to the recipient is clear. Discounting this disclosure, Microsoft selectively identifies excerpts of the prosecution history to support its argument, yet ignores that the import of these statements concerns the display of an image and/or a message by virtue of a *match* – the *content* of any displayed message is irrelevant to that discussion. *See* MOTO 40-42.

4. “programming means . . .”; “storing means . . . “

As an initial matter, Microsoft relies on the presumption that a term using the word “means” is subject to 35 U.S.C. §112, ¶ 6. Microsoft, however, fails to acknowledge that the presumption can

²¹ *See* Exh. 20 at 3:18-30 (describing “codes” and stating that “[i]t will be appreciated, though, that any combination of any number of characters could be utilized to designate graphic messages”); 6:19-36 (describing “key words” and stating that “key words such as “CALL” and “PHONE” can be associated with the image”).

be rebutted if the claim element (1) “uses the word ‘means’ but recites no function” or (2) “specifies a function, [but] also recites sufficient structure or material for performing that function.” *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1347 (Fed. Cir. 2002) (internal quotation marks omitted). Here, any presumption has been rebutted because the “programming means” recites sufficient structure – a receiver, a memory, and a computer program for storing data – and has a well understood meaning in the art. *Id.*; see also MOTO 45.

If the Court decides that 35 U.S.C. §112, ¶ 6 applies, Microsoft’s argument that the patent does not disclose sufficient structure for the “storing means” is based on a misreading of the claim. Microsoft points to the language that provides that the storage is done “in response to determining that the programming message includes the programming word” and argues that the algorithm disclosed in Figure 13 fails to disclose how to make this determination. First, Microsoft is focusing on the wrong language in the claim. The function of the “storing means” is, obviously, to store – the “in response to” language merely sets forth the context and timing in which the storing function occurs. Thus, the “in response to” language is not part of the function. Second, even if it was part of the function, step 355 of Figure 13 clearly discloses an algorithm for performing this function.²² Knowing full well that this function is disclosed in step 355, Microsoft complains that this step only shows that a determination should be made and not *how* to make it. Not so. A processor simply needs to look at the programming message to see if it includes a programming word (in whatever form the system designer wishes) – nothing more is disclosed because nothing more is needed.²³

²² If the Court decides that the “in response to” language is part of the function, Motorola does not object to step 355 being included in the corresponding structure.

²³ Microsoft is correct that a patentee cannot avoid providing specificity as to structure simply because one of skill in the art *would be able to devise a means* to perform the claimed function. This is different, however, from a case – like here – where a person of skill in the art *would recognize structure* implicit in the patent’s disclosure. See *Creo Prods., Inc. v. Presstek, Inc.*, 305 F.3d 1337, 1347 (Fed. Cir. 2002) (“To the extent that Creo contends that additional structure is required for completely performing the function of ‘rotating each cylinder,’ *we consider such structure to*

With respect to the longer phrase “programming means...,” Microsoft incorrectly criticizes Motorola of indentifying less than the entire function. But the claim language clearly establishes that the function of “programming means” is “programming the database” (as Motorola proposes), whereas the subsequent functions in the claim are related to component elements of structure.²⁴

Microsoft also argues that it is unclear how the programming means can be both coupled to the processor and include the processor. Microsoft misunderstands the claim. Claim 4 requires that the programming means (which includes a storing means) be coupled to the processor. That the storing means includes a *program* for operating that coupled processor is clear. Microsoft’s statement that “[b]oth parties agree that the shorter phrase ‘storing means ...’ appears to disclose a processor performing an algorithm” appears to be the cause of confusion. As explicitly laid out in Motorola’s proposed construction, the storing means comprises *a program*, not a processor.

5. “programming message”

Nothing in the intrinsic record requires the “programming message” and the “alphanumeric message” to be distinct. While these are separate claim limitations, the express claim language does not preclude these messages from being in the same transmission. Moreover, Microsoft’s statement that specification requires that the programming message and the alphanumeric message be distinct is demonstrably wrong. MSFT 54. The portions cited by Microsoft (as well as the remainder of the patent) do not require distinct messages. And contrary to Microsoft’s statement that a combined alphanumeric/programming message would be non-enabled, Figure 13 discloses that a combined

be implicit in the disclosure of the ‘368 patent. Under our case law interpreting § 112, P 6, knowledge of one skilled in the art can be called upon to flesh out a particular structural reference in the specification for the purpose of satisfying the statutory requirement of definiteness.”).

²⁴ Even if this element is construed to require the functions appearing after “comprising,” the claim (and the patent) identifies sufficient structure for performing these functions. A receiver performs the function of “receiving a programming message including a key word and image data;” a memory performs the function of “storing a programming word;” and a program for operating a processor according to Figure 13, as discussed below, performs the function of “storing the key word and image data in the database”

message can be used. Specifically, at step 355, the processor determines whether a message includes a programming word, showing that a programming portion of a received message can be distinguished by its programming word.

Microsoft's argument that a programming message necessarily includes a programming word is incorrect. While Microsoft points to an example of a programming message that includes a programming word (Figure 12), Microsoft conspicuously ignores the '001 patent's disclosure that programming information *may also be* provided by controls (140) or a data port. *See* Exh. 20 at 5:41-47. In this embodiment, the programming message would not include a programming word.

Microsoft criticizes Motorola's construction, arguing that the programming message does not "execute any program or take any actions to create or modify anything." This argument fails. Motorola's construction does not require execution. Rather, it identifies that the data contained in a programming message is used by the processor to create or modify an association between the message's key word and the message's data, as shown in Figure 13. *See* MOTO 42-43.

Finally, in arguing that a programming message includes an "image," Microsoft flatly disregards the claim language, which requires "image data," and the specification, which states that "image data [is] representative of a particular image."²⁵ Exh. 20 at 3:29-30. Despite Microsoft's protestations that "[y]ou need the file" to drive the display, the patent provides no suggestion that an image file is included in the programming message. The patent and claims just require "image data."

6. Claim 6 Is Not Indefinite

Microsoft's argument that Claim 6 is indefinite reflects Microsoft's fundamental misunderstanding of the claim. When read in light of the specification, it is clear to one of skill in

²⁵ "Image data" is digital information that makes up the pixels which form the image. In contrast, the "image" is the actual visual representation that a person sees. Motorola also notes that there is a mistake in its Opening Brief. The statement on page 44 that reads "it is a technical possibility" should read "it is a technical *im*possibility."

the art that Claim 6 presents an “either/or” alternative. When a word from the message matches a key word, a corresponding image is presented. When the word from the message does not match a key word, a corresponding image is not presented. Taking Microsoft’s example, if key word A appears in the database, image A is displayed. Although key word B also appears in the message, it does not appear in the database and thus no image B is displayed. The claim requires presenting “the message unaccompanied by any graphic message” “when at least one alphanumeric word does not match at least one key word.” Here, at least one word did match (key word A), thus, the claim element is met. In other words, an image must be displayed “unaccompanied by any graphic messages” only in one instance – that where no key words are contained in the message.

D. U.S. Patent No. 6,272,333

1. “data”

As discussed in Motorola’s opening brief, the ‘333 patent repeatedly uses the term “data” consistent with its broad, general meaning: information transported over a digital network. MOTO 9. Despite this, Microsoft concludes incorrectly that “data” is a mutually exclusive term from “applications” and “updates” (two types of data that are described in the patent) because the specification and claims refers to these terms separately. Microsoft is wrong. Although these terms are used in different places in the patent’s specification, they need not be mutually exclusive. Rather, applications and updates are well known to be species of “data,” used and claimed in specific ways throughout the ‘333 patent. For example, the specification discloses that “updates” are delivered to the subscriber unit, consistent with the patent’s stated purpose to “control[] the delivery of data.” Exh. 4 at 4:54 – 5:23. Nothing in the specification suggests that the generic term “data” was intended to exclude any particular species or subset of data or that “data” is intended to be used in a way inconsistent with its general definition.

Microsoft's argument that data must be "processed by an application" divorces the term "data" from its use in Claim 12, the only asserted independent claim. Claim 12 requires "a processing system coupled to the receiver for processing the data." By using this language, Claim 12 expressly states what structure – a processing system (as opposed to an application) – must process the received data. Microsoft's argument that data must be "processed by an application" is in conflict with the plain language of the claim and results in an overly narrow and complex construction (that includes negative terms) that will confuse the jury.²⁶

2. "controlling delivery of data"

The parties' dispute is two-fold: first, whether the preamble is a limitation and second, if so, whether elements of unasserted Claims 1 and 7 can be imported into the preamble of unrelated Claim 12. As to the first issue, Microsoft's analysis of the phrase "controlling a delivery of data" is flawed because Microsoft ignores the context in which it appears. The preambles of Claims 1, 7 and 12 recite a method, a controller and a subscriber unit in "*a wireless communication system for controlling a delivery of data,*" respectively. In this context, it is clear that the preamble need not be construed because it merely establishes the environment in which the claim operates and the intended use or purpose of the disclosed system. See *Advanced Software Design*, 641 F.3d at 1374.

If the Court decides to construe the preamble, however, Microsoft's construction should be rejected. In support of its construction, Microsoft argues that the specification requires the "fixed portion" to accomplish the act of "controlling delivery of data by "checking" for application

²⁶ Microsoft's citation to the prior art does nothing to change this fact. Microsoft relies on U.S. Patent No. 5,974,085, which issued to the same inventor as the '333 Patent. That inventor, however, testified that the '085 Patent concerned a "different aspect" of his work than the '333 patent. Exh. 56, MOTM_24603_0083298 at 248:25-249:2. Specifically, the '085 patent related to a wireless modem and a method for routing data to an application or to storage. Therefore, to the extent Microsoft believes that patent somehow limits the scope of "data" in a way that is inconsistent with its usage in the '333 patent itself, Microsoft is incorrect – that unrelated prior art patent simply provides no basis to limit the scope of the term "data."

compatibility. In doing so, Microsoft relies on one embodiment disclosed by the specification in which the fixed portion does, in fact, control the delivery of data. *See* Exh. 2 at 1:43-58. What Microsoft fails to point out is that this is “*an aspect* of the present invention” – and *only one* aspect– and is directed to unasserted Claim 1. Microsoft ignores the patent’s discussion of “*another aspect* of the *present invention*” – that directed to asserted Claim 12 – which does *not* require the fixed portion to control the delivery of data. *Id.* at 2:10-24. Tellingly, this discussion is the only portion of the “Summary of the Invention” that Microsoft *does not* cite. Because the patent uses the phrase “aspect of the present invention” in reference to several different embodiments, the claims should not be limited to any one of them.

Microsoft’s argument that the applicant distinguished all the claims from the prior art by arguing that “controlling a delivery of data” meant “delivering data only after checking” is flatly wrong. In the applicant’s first response, the applicant mentioned “controlling a delivery of data” only in the context of the preamble of unasserted claim 1 – not with respect to “all” claims.²⁷ Indeed, at no time during prosecution did the applicant state that all claims require the fixed portion of the system to “check” anything. In fact, in the applicant’s second response, the applicant provided a claim-by-claim analysis of the prior art. Prior to this analysis, the applicant noted that the prior art taught “check[ing] whether the subscriber unit is authorized,” while the ‘333 Patent “checks for compatible application software.” This difference was used to distinguish unasserted claims 1 and 7 and the applicant then went on to distinguish claim 12 *on different grounds* related to the “application registry” claim limitation.²⁸

²⁷ *See* MSFT Exh. 1102 at 1396 (“the Examiner wrote ‘Smith teaches *claim 1* ...’ Applicant respectfully disagrees ... Smith does not teach controlling a delivery of data from the fixed portion to the wireless modem” and then goes on to discuss the elements of Claim 1).

²⁸ *Id.* at 1419, 1421, 1422.

3. “fixed portion of a/the wireless communication system”

The primary dispute between the parties is whether the “fixed portion...” is limited to the disclosure of Figure 1. It is not. Microsoft’s construction is primarily based on the improper assumption that claims are limited to the system shown in Figure 1. The patent states that the structure in Figure 1 as *merely an example* of a wireless system. 2:43-46 (“Fig. 1 ... an exemplary wireless communication system”). Accordingly, it is improper to limit “fixed portion” to that example. The claims also do not require a public switched telephone network (“PSTN”) and Microsoft’s attempt to read a PSTN limitation into the claims through claim construction is improper. Similarly, characteristics of “subscriber units” – such as portability – should be considered in the context of that claim term, not this one.

4. “subscriber unit”

The primary dispute between the parties is whether a “subscriber unit” is a portable device. Microsoft’s position that it is not portable is completely inconsistent with its own claim construction for the term “fixed portion...” On the one hand, Microsoft argues that the patent does not show a “portable” subscriber unit; on the other, Microsoft’s own construction of “fixed portion ...” recognizes that, in fact, the ‘333 patent *does* require portable subscriber units.²⁹ Indeed, this is precisely how subscriber units are described repeatedly in the patent and the prior art cited on the face of the patent. *See, e.g.*, Exh. 6 at Fig. 1; 2:61-67; 3:1-17; 3:25-33; MSFT Exh.1116 at 2:35 (“portable subscriber units”); 2:38 (“subscriber units”). Indeed, one of skill in the art would recognize that the patent’s reference to this obviously portable device as simply a “subscriber unit” (rather than, for example, a “portable subscriber unit”) demonstrates that it is inherently a portable device.

²⁹ *See* Microsoft’s construction of “fixed portion ...” as “...distinct from the *portable* portion that includes subscriber units ...”

Microsoft's citation to inventor testimony does not change this fact. *See Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 1194 (Fed. Cir. 2003).

5. **“application registry comprising a list of all software applications that are currently accessible to the subscriber unit”**

The primary dispute between the parties is whether the application registry includes “applications that can be downloaded over the air,” as proposed by Microsoft. It does not.

Microsoft argues that the application registry includes applications that can be downloaded over the air by pointing to language in the specification that shows applications can be external to the device. MSFT 62. But these portions make clear that the applications are only “accessible” when the subscriber unit is *actively connected* to the external device. *See, e.g.*, Exh. 7 at 4:2-4 (“The applications can reside either internal or external to the subscriber unit 122, e.g., in a personal computer *to which the subscriber unit is connected*”); 5:30-37 (describing changes in application accessibility as “e.g., through the installation of a new application, or through *coupling the subscriber unit 122 to a previously uncoupled external device*”). Thus, applications external to the subscriber unit are only “accessible” when they are coupled the device and nothing in the patent remotely suggests that applications that can be downloaded over the air are “*currently accessible*.”

Microsoft's prosecution history “support” is similarly unpersuasive. The inventor did not state that all available over-the-air applications must be included in the application registry. Instead, in response to a rejection, the inventor stated that because the prior art allowed execution (*i.e.*, immediate use) of over-the-air applications without registering those over-the-air applications in the alleged application registry, the registry did not include *all* applications – *i.e.*, it did not *include in its list of authorization records* those over-the-air applications that were available for immediate use. *See* MSFT Exh 1102 at 1420. This argument is consistent with the invention's requirement that all currently accessible applications (*i.e.*, those immediately available for use) must be included in the application registry; it does not suggest that over-the-air applications be included.

E. U.S. Patent No. 6,408,176³⁰

1. “extracts”; “extracting”; and “extraction”

The parties agree that “extracting” requires “selecting,” but disagree as to whether it further requires “removing,” as Microsoft contends. It does not.

In support of its construction, Microsoft cites to portions of the patent that purportedly show that “extracting” includes “removing.” MSFT 63-64. But *none* of these portions require – or even suggest – that “extracting” includes “removing.” In fact, “removing” does not appear in these sections of the patent (or anywhere else in the patent). If anything, these portions describe “extracting” as the selection of caller-related information so that it can be used at a later time to initiate a communication with a target device. MSFT 63. This confirms *Motorola’s* construction.³¹

Similarly, statements made during prosecution regarding the Agraharam patent fail to show that “extracts” claim term requires both selection *and removal*. The Agraharam patent was distinguished because it does not teach extracting caller-related information from a stored voicemail. Instead, it teaches converting an entire message to text. MSFT 64; MSFT Exh. 1302 at 4. Because no extraction is performed, this portion of the file history has nothing to do with the meaning of “extraction” and does not support Microsoft’s “removal” requirement

³⁰ Contrary to Microsoft’s description, the Urs ‘176 patent is not simply a “limitation of a conventional voice mail system.” MSFT 63. As its title confirms, the patent relates to a method and apparatus for initiating a communication using caller-related information in *any communication system*. Exh. 9. Microsoft’s repeated attempts to limit the asserted claims exclusively to a voicemail system that performs standard speech recognition steps in a specific order is improper and should be rejected by the Court.

³¹ Contrary to Microsoft’s argument, the fact that caller-related information is “stored” does not mean that it must be selected “and removed” from the audio message. There is nothing in the patent that requires that caller-related information be stored in only one location – the extracted information can be stored separate from the original message information (which may be preferable if a user wishes to reference the original message at a later point in time). Furthermore, there is no requirement that “caller-related information” be “separated” from the audio message in order to facilitate the initiation of a communication. MSFT 64-65. Mere selection of a portion of an audio message would allow the initiation of a communication in accordance with the invention.

Finally, Microsoft’s reliance on dictionary definitions for its construction is inappropriate. *See* MSFT 64, n.14. In situations – like this one – in which the intrinsic evidence is sufficient to construe a term, it is improper to rely on extrinsic dictionary evidence. *See Vitronics*, 90 F.3d at 1583. This is especially true – as here – when the extrinsic evidence is inconsistent with the intrinsic record. *See Bell Atl. Network Servs.*, 262 F.3d at 1269.³²

2. “order of the “extraction”/”conversion” operation (claims 1, 8 and 11)

The parties dispute whether the “conversion” step of the claims must necessarily follow the “extraction” step. Microsoft’s three arguments that allegedly show that “extracting” must precede “converting” fail to show that any particular order is required.

First, Microsoft argues that claims 1 and 8 require “converting” follow “extracting” because “caller-related information” is **created** during the “extracting” operation. But neither Motorola’s nor Microsoft’s proposed constructions – nor the claim language itself – require that the “caller-related information” be “created” during extraction. Indeed, both constructions make clear that caller-related information is simply “information” in a message; there is no “creation” limitation.

Microsoft next argues that the “receiving” step of claim 11 requires that conversion follow extraction. MSFT 66. But the claim language does not require this result. The entire “receiving” step of claim 11 is instructive: “**receiving the caller-related information** in an alpha-numeric string format resulting from a voice-to-alpha-numeric-string-format conversion **after extraction** from stored voicemail...” This limitation requires only that the “caller-related information” be **received** in an alpha-numeric string format after **extraction** has occurred – certainly conversion must occur before reception, but no further order is required by the claim. Therefore, contrary to

³² With regard to the “extracts the caller-related information from the voice mail; extracting the caller-related information from the stored voice mail; receiving the caller-related information ... after extraction from stored voice mail” limitation, Motorola maintains its position that this limitation does not require construction and hereby incorporates its arguments regarding the “extraction” and “caller-related information” terms.

Microsoft's grammar-based arguments, this limitation has nothing to do with the order of the conversion and extraction steps.

Finally, Microsoft cites, with no analysis, to Fig. 2 in support of its construction, ostensibly because it shows a flow diagram for an embodiment in which extracting takes place before converting. *See* MSFT 66. But this Figure, along with Microsoft's other specification citations, do not mandate any particular order of operation. In fact, the patent discloses an embodiment in which a converter device may "extract and convert the caller-related information in real-time..." Exh. 12 at 3:66-4:2. Thus, the patent makes clear that these steps can effectively occur simultaneously. The lack of any order requirement is further confirmed by the identification of the IBM ViaVoice speech recognition software as an example of the converter device 112. Exh. 9 at 2:67-3:4. This software operates to *first convert* and *then extract* the speech. *See* Exh. 53 at 95-96.

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

The parties dispute whether this limitation requires that a request be received from "a user" or a "communication unit." The plain language of the claim requires that a request is received "from a user." Microsoft tries to read out this language by misconstruing the intrinsic record.

In support of its construction, Microsoft cites to portions of the specification, claiming that in certain embodiments, the fixed network equipment and communication system infrastructure receive a request from the communication unit. But Microsoft ignores *other* portions of the specification that show that a request may also be received from a user: "Upon receiving a request *from a user* of the communication unit to initiate a communication using the stored caller-related information." Exh. 9 at 2:35-36. Not surprisingly, the patent includes separate claims that are directed to each of these embodiments. *Compare* claim 8 ("receiving a request *from the communication unit* to use the caller-related information . . .") with claim 11 ("receiving a request *from a user* of the communication unit to use the stored caller-related information . . .").

Nothing in the patent’s file history requires that Microsoft’s construction be adopted. Contrary to Microsoft’s argument, the applicant did not amend claim 12 (now 11) to remove “from a user,” nor did the applicant discuss or distinguish the substance of this element in the Remarks of the Amendment. Exh. 1302 at 4. Instead, the applicant simply made a summary statement to describe the general contours of claims 1, 9, and 12 (“receiving a request from the communication unit...”) and to provide context for a discussion about the prior art. The applicant’s statement does not contain the type of clear and unmistakable language that is required for a disclaimer of claim scope. *See Purdue Pharma L.P. v. Endo Pharms. Inc.*, 438 F.3d 1123, 1136 (Fed. Cir. 2006).

4. “fixed network equipment” or “FNE”

Motorola’s construction for the term “fixed network equipment” (“FNE”) is unnecessarily complex and confusing. Microsoft attempts to justify the importation of unnecessary language (e.g., “routes,” “installation,” “target”) into its construction for FNE by pointing to language in other portions of the claim. This is improper. First, the claim language does not require or provide that the FNE be an “installation” that “routes ... voice calls ... and data” – it need only provide communications services to a communication unit. *See, e.g.*, Exh. 9 at 6:28-31. Assuming that Microsoft is correct that this functionality is required by other claim elements (which Motorola disputes), importing those limitations into this claim element is unnecessary – the duplicative limitations would be completely superfluous and potentially confusing to the jury.³³

Microsoft complains that Motorola’s construction of “communication system infrastructure component” is not a term in claim 1. Motorola’s construction, however, comes straight from the

³³ To the extent the specification does state that 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” (Exh. 9 at 3:31-41), nothing in the specification describes the “fixed network equipment” as “a telecommunication equipment installation” that “*routes* ... voice calls ... and data.” If anything, the specification only requires that the FNE “provide telephony services.” Exh. 13 at 1:11-14.

patent's specification: "The FNE **108**, the converter device **112**, and the voice mail device **114** may be collectively referred to as the *communication system infrastructure*."³⁴ Exh. 13 at 3:4-6. Thus, the "FNE" is simply a "communication system infrastructure" component.

5. "caller-related information" or "CRI"

The parties dispute whether "caller-related information" must be contained in a "stored audio message," or more specifically in a "stored voice mail."³⁵ In support of its construction, Microsoft cherry-picks portions of the patent that relate to a particular embodiment and argues that "caller-related information" is limited to information in a voicemail. MSFT 68. But as discussed in Motorola's opening brief, the intrinsic record does not limit "CRI" to "information present in a stored voicemail," instead describing and claiming a communication system that provides for initiation of a communication using CRI in an "audio message." MOTO 14-15. This is consistent with the specification and the prosecution history. *See* Exh. 9 at 1:6-9 (describing that the invention "relates *generally* to communication systems and, in *particular*, to initiating communication using caller-related information obtained from voicemail"). As this statement makes clear, the invention relates to "communication systems" and, therefore, is not limited to just "voicemail" systems.

F. U.S. Patent No. 6,757,544³⁶

1. "specific location information of the communication device"

³⁴ This is in contrast to the fact that the terms "routes" and "installation" of Microsoft's construction are not present in the Urs '176 patent anywhere.

³⁵ Motorola does not dispute Microsoft's statement that the specification describes CRI as "enabl[ing] the communication unit to initiate a communication." MSFT 68. But the corresponding portion of Microsoft's construction is already part of the claim language and is, therefore, superfluous to the construction of this term. *See* Exh. 9 at 6:45-47.

³⁶ Microsoft improperly limits the '544 patent to "solv[ing] the problem of accurately locating the position of a communication device." MSFT 68. Even a quick glance at the title of the patent – "System and Method for *Determining a Location Relevant to* a Communication Device and/or Its Associated User" – shows that the invention is about determining a relevant location to the device (e.g., a point of interest) and not just its precise location. As discussed, Microsoft's incorrect understanding of the patent permeates its claim construction arguments.

The parties dispute whether “specific location information of the communication device” must be determined in a particular way – through user input. The intrinsic record does not support such a limitation. First, nothing in the express claim language requires it to be input by a user. And, contrary to Microsoft’s assertion that “every embodiment in the specification requires a user to input a specific location” (MSFT 69), the specification (and file history) discuss how this information can also be determined *without* user input, using technology like GPS. MOTO 50-51.

Microsoft also argues that because block 325 of Figure 2 is labeled “receive user specified location information,” it shows that “specific location information” must be input by a user. To the contrary, it demonstrates that “user specified location information” and “specific location information” are distinct concepts. And Figure 2 “shows a flow diagram of *one embodiment* of a method for determining the *location of a communication device or its associated user.*” Exh. 26 at 4:40-43. The patent claims, which are directed to “a method of determining a *location relevant to a user* of a communication device,” are broader than this. “User-specified location information” may be an example of “specific location information,” but it is not the *only* example.³⁷

2. “general location information of the location relevant to the user”

As discussed in Motorola’s Opening Brief, Microsoft’s construction is improper because it excludes non-geographic information, is circular when read in the context of the entire claim element, and has no basis in the claim language or the specification. MOTO 49-50. Microsoft’s

³⁷ Microsoft contends that under *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351 (Fed. Cir. 2008), the Court must resolve the parties’ dispute by construing this claim term rather than by adopting its plain and ordinary meaning. *O2 Micro* does not require the Court to construe every disputed term. Rather, it requires the Court to resolve the parties’ dispute. *Id.* at 1362. Here, both parties acknowledge that the primary dispute is about whether the “specific location information of the communication device” must be input by the user. The Court can resolve this dispute simply by rejecting Microsoft’s proposed construction. See *Finjan, Inc. v. Secure Computing Corp.*, 626 F.3d 1197, 1207 (Fed. Cir. 2010) (explaining that a district court’s adoption of a term’s plain and ordinary meaning did not violate the principles of *O2 Micro*).

opening brief also makes it clear that Microsoft's proposed construction is based on nonexistent "inconsistencies" in the use of "general location information" in Examples A and B.

The specification of the '544 patent contains a thorough discussion of "general location information." *See* Exh. 26 at 6:5-53. This discussion first describes ways in which "general location information" can be determined, including through the use of automatic position determination technologies, such as cell and sector identification, triangulation and GPS. *Id.* at 6:14-37. The patent then gives examples of "general location information," including ZIP code and city. *Id.* at 39-42. Nowhere does the patent mention that the general location information is "determined by the nature of the service request of a user," as Microsoft proposes.

Similarly, Examples A and B fail to provide Microsoft with support for its construction. Example A describes using cell and sector identification to determine Bob's general location. *See id.* at 10:4-6. Example B uses GPS to determine Sunil's general location. *See id.* at 10:60-63. There is nothing inconsistent about these examples – they simply use two different types of automatic position determination technologies described previously in the patent to determine the general location information. They are, in short, "examples" of the prior discussion of "general location information"; once again, there is no "service request" requirement, as proposed by Microsoft.

Microsoft also argues that if Motorola's construction is adopted, claims 9 and 10 would be "indefinite for failure to interrelate essential claim elements." MSFT 71. But Microsoft's argument and the cases and section of the Manual of Patent Examining Procedure ("MPEP") it cites for support are all "based on an incorrect interpretation of [*In re*] *Collier*," 397 F.2d 1003 (C.C.P.A. 1968). *Vertical Doors Inc. v. Howitt*, No. 06-CV-00984, slip. op at 2 (C.D. Cal. Oct. 4, 2010) (Order Granting Motion for Reconsideration) (attached as Exh. 57). As the court in *Vertical Doors* explained, "[t]he reason that the *Collier* claim's lack of structural relationships violated § 112, ¶ 2 was because the patent applicant insisted in his brief that his invention contained structural relationships,

not because of an inherent requirement that the lack of structural relationships automatically renders a claim indefinite.” *Id.* at 3; *see also id.* at 5 (declining to follow MPEP § 2172.01).³⁸ In other words, the patent applicant failed to claim structural relationships that he regarded as part of his invention. *See Collier*, 397 F.2d at 1005. Here, there is nothing to indicate that claims 9 and 10 fail to claim what the inventors regarded as their invention.³⁹ Accordingly, Microsoft’s attempt to improperly “interrelate” the elements of claims 9 and 10 through its proposed construction should be rejected.

3. “determining the location relevant to the user by comparing the list of location parameters with the specific location information”

The parties dispute whether this element is limited to the determination of the location of a communication device. As described above, Microsoft improperly limits the scope of the ‘544 patent, and as a result, construes this term too narrowly. As Motorola described in its Opening Brief, the “determin[ation]” of this claim element is actually performed twice in Example A. MOTO 51-52. Microsoft completely ignores the second performance of this step, where the application “compares Bob’s location to the list of ATMs” to determine the closest ATMs – a point of interest to Bob, but not his current location.⁴⁰ Exh. 26 at 10:26-28. Because Microsoft’s proposed

³⁸ The Board of Patent Appeals and Interferences also recently iterated that “it is not essential to a patentable combination that there be interdependency between the elements of the claimed device or that all the elements operate concurrently toward the desired result.” *Ex parte Chen*, Appeal No. 2009-004408, 2009 WL 4702364, at *4 (Bd. Pat. App. & Interf. Nov. 23, 2009) (quoting *Ex parte Nolden*, 149 U.S.P.Q. 378, 380 (Bd. Pat. App. & Interf. 1965)).

³⁹ Moreover, a proper indefiniteness analysis involves determining whether the boundaries of a claim are “discernible to a skilled artisan based on the language of the claim, the specification, and the prosecution history, as well as her knowledge of the relevant field of art.” *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343, 1350 (Fed. Cir. 2010). A person of ordinary skill in the art would be able to discern the scope of claims 9 and 10, and Microsoft has not suggested otherwise.

⁴⁰ In addition, one of the “examples” of this step cited by Microsoft is not an example at all. Microsoft cites a step in Example B in which the “application compares ‘O’Hare’ to the selected list of airports.” Exh. 26 at 11:8-10. But the “specific location information” referred to in this claim element is that of the communication device, as determined in the previous claim element. In Example B, Sunil is not at O’Hare, so O’Hare is not the specific location information of his communication device.

construction is premised on an incorrect reading of the patent and would exclude one of the preferred embodiments, it should be rejected.

G. U.S. Patent No. 6,983,370

1. “messaging session”

Microsoft defines a “messaging session” as a “communication connection.” The ‘370 patent, however, repeatedly and unambiguously distinguishes a “messaging session” from a “communication connection.” For example, the claims themselves make clear that a “communication connection” and a “messaging session” are two different things:

22. 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

Second, none of the portions cited by Microsoft to support its construction describe the messaging session as a “communication connection.” MSFT 74-75. In fact, the specification makes it clear that a “communication connections” can exist independently of a “messaging session”: “The second messaging client 20 can establish the second communication connection 22 *but not yet be participating in a messaging session.*” Exh. 14 at 24:29-31.

Microsoft further confuses the definition of “messaging session” by requiring that the communication connection be “active.” Microsoft justifies this requirement by pointing to examples in the patent in which a messaging session is described as being “in progress.” First, the fact that the patent describes some – but not all – messaging sessions as being “in progress” does not require importing this limitation into the definition of messaging session in all circumstances. Second, “in progress” does not necessarily mean “active.” An “active” messaging session is one in which messages are constantly being exchanged between participants. An “in progress” messaging session simply means the session has not yet been terminated, even if long periods of delay may

occur between messages. For example, a person may walk away from an IM chat to eat dinner without terminating the session. The session is still “in progress,” but it is certainly not “active.”

Microsoft argues that the prosecution history requires that a messaging session be an “active connection.” It does not. In fact, the prosecution history supports Motorola’s construction. The applicants argued that – unlike the prior art – the ‘370 patent allows connections to be established, terminated and re-established within a single messaging session. Exh. 14 at 5:5-6; 24:29-31. In doing so, the applicants differentiated “session” from a “connection.”

Microsoft’s construction is also deficient because it ignores that the messaging takes place in “real-time.” As discussed in Motorola’s Opening Brief, the ‘370 patent consistently describes a messaging session as including “real time electronic messaging.” MOTO 22. In fact, the very portion of the specification quoted by Microsoft in its brief describes “messaging sessions” as including substantially real-time communication.

Finally, Microsoft criticizes Motorola for not providing a definition of “session.” The term “session,” however, has a well understood meaning and will readily be understood by the jury. Indeed, Microsoft’s inclusion of the superfluous and unnecessary language “with a defined beginning and end” in its construction demonstrates that session does not need to be defined.⁴¹

2. “session data”

Microsoft proposes that “session data” means data relating to *each* session the user has ever or will ever participate in. In doing so, Microsoft relies on one description of “session data” in the specification. But, as set forth in Motorola’s Opening Brief, Microsoft’s construction ignores the clear statements in the ‘370 specification that session data can be data about only *one* session and not *each* session. MOTO 26-27.

⁴¹ Microsoft’s extrinsic evidence should be disregarded. First, the claim term in dispute in “messaging session” and the dictionary definitions for the generic term “session” are of little to no value. Second, Mr. Mock never testified that a messaging session requires an “active” connection.

3. “providing continuity between a plurality of messaging clients”⁴²

Microsoft does not provide a construction for this element and instead argues that it is indefinite. Microsoft’s brief, however, makes clear that the claim term “providing continuity” is *not* indefinite. And, as explained below, the crux of Microsoft’s argument is not directed to indefiniteness, but rather the separate issue of enablement. *See, e.g., Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1358 n.2 (Fed. Cir. 1999) (“We note, however, that definiteness and enablement are analytically distinct requirements . . .”).

“Claims need not be plain on their face in order to avoid condemnation for indefiniteness; rather, claims must only be amenable to construction. Because claim construction frequently poses difficult questions over which reasonable minds may disagree, proof of indefiniteness must meet ‘an exacting standard.’” *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1366 (Fed. Cir. 2011) (citations and internal quotations omitted). “Indefiniteness requires a determination of whether those skilled in the art would understand what is claimed.” *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1346 (Fed. Cir. 2007). “To comport with § 112’s definiteness requirement, the boundaries of the claim . . . must be discernible to a skilled artisan based on the language of the claim, the specification, and the prosecution history, as well as her knowledge of the relevant field of art.” *See Halliburton Energy Servs., Inc. v. M-1 LLC*, 514 F.3d 1244, 1249-51 (Fed. Cir. 2008).

Motorola’s Opening Brief describes in chapter and verse that “providing continuity” means “allowing an account user to continue at least one messaging session on different messaging clients.” Microsoft’s arguments in its brief, ironically, demonstrate that it has the same understanding of the term “providing continuity.” For example, in its initial description of the ‘370 patent, Microsoft states that “the ‘370 patent purports to claim a method, system, and plurality of messaging clients

⁴² As an initial matter, Microsoft addresses an incorrect construction for Motorola. While Motorola’s initial proposed construction did refer to mention “user preferences,” Motorola subsequently dropped that phrase from its proposed construction.

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 as in progress on the first messaging client.” MSFT 73-74.

Microsoft also concedes that the patent suggests that continuity relates “to the maintenance of connections and the transfer of data between messaging clients” and 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.” *Id.* at 81, 82. Microsoft even goes so far as to include an entire section titled “‘continuity’ is the allegedly inventive concept of the ‘370 Patent.” MSFT 79-80. Microsoft must understand the meaning of the term “continuity” for it to conclude that it is the inventive concept.

All of Microsoft’s descriptions are consistent with Motorola’s construction, show that Microsoft knows precisely what the term “providing continuity” means, and establish that the term is amenable to construction. Because Microsoft is able to identify and neatly summarize the concept of “providing continuity” as disclosed in the ‘370 patent, the term can hardly be said to be “insolubly ambiguous” and is, therefore, not indefinite.⁴³

The vast majority of Microsoft’s indefiniteness arguments relate to the patent supposedly failing to explain *how* to provide continuity. *See, e.g.*, MSFT 81 (“the patentees repeatedly and succinctly refer to ‘seamless’ transfer of uninterrupted connections . . . without ever describing *how* this is accomplished . . .); at 82 (“the specification never explains *how* the user’s open connection is maintained it never discloses *how* the user ‘can pass the current messaging session’ the

⁴³ Where claim terms are unambiguous and amenable to construction, there is no need to resort to extrinsic evidence. *See Vitronics Corp.*, 90 F.3d at 1583. Microsoft’s reliance on inventor testimony and irrelevant dictionary definitions is therefore improper. *See Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379 (Fed. Cir. 2000) (“[I]nventor testimony, obtained in the context of litigation, should not be used to invalidate issued claims under section 112, paragraph 2.”). In any event, Mr. Mock’s testimony describes non-limiting embodiments of providing continuity that fall squarely within the claims, demonstrating that the claims are sufficiently definite.

patentees provide an explanation of *how* the transfer of uninterrupted connections . . . is accomplished . . .). First, as Motorola explained in its opening brief, the '370 patent does explain how to provide continuity. MOTO 25. Second, as explained below, Microsoft's arguments are actually directed to the issue of enablement – not indefiniteness.

As explained above, indefiniteness is directed to whether one of skill in the art would understand what is claimed. In contrast, “to meet the enablement requirement, the specification of a patent must teach those skilled in the art *how* to make and use the full scope of the claimed invention without undue experimentation.” *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363, 1378 (Fed. Cir. 2009). Microsoft appears not to appreciate the difference. *See, e.g., Lacks Indus., Inc. v. McKechnie Vehicle Components USA, Inc.*, 55 F. Supp. 2d 702, 727 (E.D. Mich. 1999) (“Defendants’ argument confuses the validity issues of indefiniteness and enablement. The former focuses on the precision and definiteness of the claim language in light of its subject matter, while the latter examines the adequacy of the specification’s disclosure of the claimed invention.”).

The issue of enablement typically requires expert testimony and other factual support and is only properly decided on either summary judgment or at trial. *See Liquid Dynamics Corp. v. Vaughn Corp.*, 449 F.3d 1209, 1224 (Fed. Cir. 2006) (“Enablement is a question of law [that] we ultimately review *de novo*, but it is based on factual findings that are reviewed for clear error.”); *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F. 3d 1367, 1376 (Fed. Cir. 2002) (“Whether a claim is enabled under 35 U.S.C. § 112, first paragraph is a question of law, although *based upon underlying factual findings.*”). As such, enablement cannot be decided as part of claim construction.⁴⁴

⁴⁴ Similarly, Microsoft’s discussion of the prior art (MSFT 79-80) is directed to the issue of invalidity and have little relevance to *Markman* proceedings.

4. “transfer the at least one messaging session . . .”

Motorola is no longer asserting the claim that includes this limitation and, accordingly, the Court no longer needs to construe it.

5. “adding the second messaging client”

Motorola is no longer asserting the claim that includes this limitation and, accordingly, the Court no longer needs to construe it.

6. “first messaging client”; “second messaging client”

Motorola’s proposed construction of the terms “first/second messaging client” is entirely “consistent with the intrinsic evidence” and “accurate,” as Microsoft admits. MSFT 87. Microsoft, however, inexplicably adds the extra requirement that a messaging client must “include software capability for transferring client data.” In support of this extra language, Microsoft points to a statement in the patent providing that messaging clients can contain a software capability for transferring client data, but then ignore the portion of the specification that directly follows which states that such capability *need not be contained in messaging clients*.

As illustrated in FIG. 5, the software capability for transferring and/or the capability for receiving the plurality of client data 25 can be incorporated into the fixed messaging client 84, *or alternatively can be contained within a separate data transfer application 83*.

Exh. 17 at 10:19–23. In view of this disclosure, Microsoft’s construction should be rejected.

Microsoft also argues that the Court should decide during claim construction whether “messaging clients” can be operated by the same or different users, because this question is “relevant to validity issues for the ‘370 patent.” First, nothing in the intrinsic record demands the inclusion of such a requirement. Second, Microsoft is effectively asking the Court to make a factual invalidity determination (a question for the jury) as part of the legal determination of what the claims mean. This is completely improper. *See Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (noting that anticipation is question of fact, and obviousness is a legal conclusion based on

factual determinations, both of which occur *after* claim construction); *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002) (“Obviousness is a legal conclusion based on underlying **facts** of four general types, all of which must be considered by the trier of fact”).

7. The “messaging client” limitations

Because the “messaging client” limitation do not use the word “means,” there is a heavy presumption that these terms are not in means-plus-function format. *See Lighting World*, 382 F.3d at 1358. In an attempt to overcome this presumption, Microsoft argues that software is not structure, and thus that means plus function must apply. Microsoft is wrong – the Federal Circuit has repeatedly held that software is structure and, accordingly, these claim limitations are not in means-plus-function format. *See AllVoice Computing PLC v. Nuance Commc’ns, Inc.*, 504 F.3d 1236, 1242 (Fed. Cir. 2007); *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1366-67 (Fed. Cir. 2003).

Even if the Court concludes that the claim is written in means-plus-function format, Microsoft’s argument that the structure for the term “messaging client” is sufficiently disclosed in the specification is at odds with Microsoft’s own arguments. Microsoft points out that “connecting messaging clients to servers and the transfer of data” was well-known by those having skill in the art at the time of the invention. This is all that is necessary. When a limited set of possibilities for performing a function are known to one having ordinary skill in the art, the Federal Circuit has stated unambiguously that a patent need not recite **specific** portions of software in order to disclose **sufficient** structure. *See AllVoice Computing*, 504 F.3d at 1242; *Intel Corp.*, 319 F.3d at 1366-67.

And, contrary to Microsoft’s arguments, the specification **does** disclose precisely how to “establish[] a first communication connection” and “receiv[e] the plurality of client data. For example, the specification discloses that messaging clients can utilize the TCP/IP protocol. Exh. 14 at 8:11-14, 16:43-45. It also discloses that the communication connection can involve client-server arrangement where a client’s connection utilizes an IP address and a port number assigned to the

client. *Id.* at 23:6-15. One having ordinary skill in the art would understand how a messaging client could establish a communication connection within, for example, a TCP/IP network.

Finally, the specification discloses that transferring (or receiving, which is merely the other side of the same operation) client data can be achieved using a wireless system, e.g., “Bluetooth,” or “via a network connection.” *Id.* at 24:16-18, 28:49-56. A person of ordinary skill in the art would understand how to achieve a transfer of data between clients that use such well-known protocols as TCP/IP or Bluetooth. The disclosure of these specific, exemplary protocols –in conjunction with the act of transferring and receiving of client data – provides more than sufficient structure pursuant to the requirements of § 112, ¶6. *See AllVoice Computing*, 504 F.3d at 1242.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on August 8, 2011, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF filing system. I also certify that the foregoing document is being served this date on all counsel of record or pro se parties on the Service List below in the manner specified, either via transmission of Notices of Electronic Filing generated by the CM/ECF system or; in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

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Case No.: 1:10-CV-24063-MORENO/TORRES
United States District Court, Southern District of Florida

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TAB A

Motorola Patent No. 6,272,333

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Microsoft term: "data"	12	Digital information	Information to be processed by an application, not an application or a software update for an application
Microsoft term: "controlling a delivery of data"	12	Managing whether and when data is delivered	delivering data only after checking in the fixed portion whether an application compatible with the data is accessible to the subscriber unit
Microsoft term: "fixed portion of [a/the] wireless communication system"	12	The stationary portion of the wireless communication system that includes base stations and a controller	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
Motorola term: "subscriber unit"	12-13	A portable device for use in a wireless communication system	a device that can receive data from the fixed portion of the wireless communication system
Motorola term: "application registry comprising a list of all software applications that are currently accessible to the subscriber unit"	12-13	A portion of memory that includes a list of all software applications that are immediately available for use by the subscriber unit	one official list of all applications currently accessible to the subscriber unit, including applications that can be downloaded over the air

Motorola Patent No. 6,408,176

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Microsoft term: “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”</p>	<p>1,8,11</p>	<p>See constructions for “extracts / extracting / extraction” and “caller-related information”</p>	<p>“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.”</p>
<p>Microsoft term: Order of the functional operation (Claim 1 - extracts caller-related 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 alphanumeric 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-</p>	<p>1,8,11</p>	<p>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.</p>	<p>The functional operation (Claim 1 - extracts caller-related 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).</p>

format conversion).				
Microsoft term: “fixed network equipment”	1		Communication system infrastructure component.	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.
Microsoft term: “receiving a request from a user of the communication unit”	11		This element requires no construction and should be accorded its plain and ordinary meaning.	The communication system infrastructure is receiving a request from the communication unit.
Motorola term: “caller-related information”	1,8,11		Information provided by a caller in a stored audio message.	Information present in a stored voice mail that enables a communication device to initiate a communication to a target device.
Motorola term: “extracts” / “extracting” / “extraction”	1,8,11		Selecting.	To select and remove from a group of items those which meet specific criteria.

Motorola Patent No. 6,983,370

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: "messaging session"	22, 29, 36, 42, 46, 59	A session of real time electronic messaging, between two or more messaging clients.	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.
Motorola term: "providing continuity between a plurality of messaging clients"	2, 6, 9, 10, 11, 12, 13, 18, 19, 20, 29, 33, 42, 45, 59	See construction for "for providing continuity."	Indefinite.
Microsoft term: "for providing continuity"	1, 6, 9, 10, 11, 12, 13, 15, 18, 19, 20, 22, 29, 33, 36, 42, 45, 46, 50, 59	Allowing an account user to continue at least one messaging session on different messaging clients.	Indefinite.
Motorola term: "session data"	22, 29, 33	Data relating to one or more of the messaging sessions in which the account user is participating, has previously participated, or plans to participate, using the messaging client.	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.
Microsoft term: "adding the second messaging client to the at least one messaging session using the session identifier"	46	This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should	Indefinite.

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
		<p>be given the following meaning:</p> <p>“using the session identifier to allow the second messaging client to participate in the at least one messaging session.”</p>	
<p>Microsoft terms:</p> <p>“transfer the at least one messaging session from the first messaging client to the second messaging client using the session identifier”</p>	<p>59</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning.</p> <p>If this element is construed, it should be given the following meaning:</p> <p>“Using the session identifier to transfer the at least one messaging session from the first messaging client to the second messaging client.”</p>	<p>Indefinite.</p>
<p>Microsoft term:</p> <p>first / second messaging client</p>	<p>1, 2, 6, 9, 10, 11, 12, 15, 22, 36, 46, 50, 51, 52, 54, 59, 61</p>	<p>First client software to interface a user's device within a messaging communication system</p> <p>Second client software to interface a user's device within a messaging communication system</p>	<p>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.</p>
<p>Microsoft Means-Plus-Function Term</p> <p>“a first messaging client, for establishing a first communication connection including a plurality of</p>	<p>50-52, 54</p>	<p>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</p>	<p>Indefinite.</p> <p>Function: establishing a first communication connection including a plurality of client data with a message</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
client data with a message server"		<p>entirety.</p> <p>This element requires no construction and should be accorded its plain and ordinary meaning.</p> <p>To the extent that this element is construed according to 35 U.S.C. § 112, ¶ 6:</p> <p><u>Claimed function:</u></p> <p>“establishing a first communication connection including a plurality of client data with a message server.”</p> <p><u>Corresponding structure:</u></p> <p>“first messaging client”</p>	<p>server.</p> <p><u>Structure:</u> none.</p> <p>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.”</p>
<p>Microsoft Means-Plus-Function term:</p> <p>“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”</p>	50-52, 54	<p>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.</p> <p>This element requires no construction and should be accorded its plain and ordinary meaning.</p> <p>To the extent that this element is</p>	<p>Indefinite.</p> <p><u>Function:</u> 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</p> <p><u>Structure:</u> none.</p> <p>The claims are indefinite for failing to</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: "client data"	1, 6, 9, 10, 13, 15, 18, 20, 36, 42, 45, 46, 50, 52, 54, 59	<p>construed according to 35 U.S.C. §112, ¶ 6:</p> <p><u>Claimed function:</u></p> <p>“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</p> <p><u>Corresponding structure:</u></p> <p>“second messaging client”</p>	<p>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.”</p>
		<p>Motorola agrees with Microsoft’s proposed construction.</p>	<p>Data associated with the messaging client and data associated with each messaging session for which die messaging client is currently participating, has participated in, or plans to participate in.</p>

Motorola Patent No. 5,784,001

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Microsoft proposed term: “A method for displaying messages in a data communication receiver; A data communication receiver for presenting information”</p>	<p>1, 4, 6</p>	<p>The preamble is a limitation that should be construed according to its plain and ordinary meaning.</p>	<p>The preamble is limiting. All claim elements are a part of or performed on the mobile communication device receiving the message.</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Microsoft proposed term: “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” / “determining whether at least one alphanumeric word included in the message matches at least one key word included in the database”</p>	<p>1, 4, 6</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning.</p>	<p>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.</p>
<p>Microsoft proposed term: “graphic message that is accompanied by the alphanumeric message” / “graphic message accompanied by the alphanumeric message” / “graphic message accompanied by the message”</p>	<p>1, 4, 6</p>	<p>At least one image is displayed along with a portion of, or the entire, alphanumeric message.</p>	<p>At least one supplemental image is displayed along with the entire alphanumeric message.</p>
<p>Motorola proposed term: “programming message”</p>	<p>1, 3, 4</p>	<p>A message that creates or modifies an association between a key word and image data.</p>	<p>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</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Microsoft proposed Means-Plus-Function term:</p> <p>“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”</p>	<p>4</p>	<p>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.</p> <p>To the extent that this element is construed according to 35 U.S.C. § 112:</p> <p>Claimed function: “programming the database”</p> <p>Corresponding structure: the Receiver, the Decoder, the Memory, and a program for operating the Processor according to the algorithm of Figure 13.</p>	<p>word.</p> <p>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</p> <p>Structure: none.</p> <p>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.</p>
<p>Microsoft proposed Means-Plus-Function term:</p> <p>“storing means for storing the key word and image data in the database in response to determining that the programming message includes the</p>	<p>4</p>	<p>This is a means-plus function element that should be construed according to 35 U.S.C. § 112, ¶ 6.</p> <p>Claimed function:</p> <p>“storing the key word and the image data in the database in response to determining that the programming</p>	<p>Function: storing the key word and image data in the database in response to determining that the programming message includes the programming word</p> <p>Structure: none.</p> <p>The claim is indefinite for claiming processor 120, programmed to perform</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
programming word”		<p>message includes the programming word.”</p> <p>Corresponding structure: A program for operating the Processor according to steps 360, 370, 375, and 380 of the algorithm of Fig. 13.</p>	<p>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.</p>

Motorola Patent No. 6,757,544

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Microsoft term: “general location information of the location relevant to the user”</p>	<p>1, 3, 9, 10</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: “Information about the general area of a location relevant to the user.”</p>	<p>A geographic area that is determined by the nature of the service request of a user.</p>
<p>Microsoft term: “specific location information of the communication device”</p>	<p>1, 3</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: “Information about the specific location of the communication device.”</p>	<p>“Location information input by the user to indicate the location of the communication device.”</p>
<p>Microsoft & Motorola term: “determining the location relevant to a user by comparing the list of location parameters with the specific location information”</p>	<p>1, 3</p>	<p>“Identifying the location relevant to the user by selecting from the list of location parameters based on the specific location information.”</p>	<p>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.</p>

Motorola Patent No. 5,764,899

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Microsoft proposed term: A system for communicating reply data with a communication unit comprising	1	The preamble is not limiting and should be construed according to its plain and ordinary meaning.	The preamble is limiting. The term means "A system for transmitting or receiving the reply email composed on the communication unit before optimization."
Microsoft proposed term: a host server, in communication with the communication server	1	A computer or a program that operates as an e-mail post office, which can exchange data with the communication server.	The host server and the communication server are separate processing devices (e.g., computers) transmitting to or receiving from each other over a network.
Microsoft proposed term: email; e-mail	1, 15, 18	This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: "electronic 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.
Microsoft proposed term: "forwarding" / "forward" / "forwards" / "forwarded"	1, 14, 16, 17	This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: "Forwarding from one computer or program to another."	Sending [send, sends, sent] from one processing device (e.g., computer) to a separate processing device (e.g., computer).

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Microsoft proposed term: a determination is made whether to forward the optimized reply or a replica reply</p>	<p>14</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: “the communication server decides whether to forward the optimized reply or the replica reply.”</p>	<p>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.</p>

Motorola Patent No. 5,502,839

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: “source of virtual input”	9-14	A process which generates one or more picture elements from user input.	a physical input device corresponding to a virtual input device.
Microsoft term: “virtual output”; “virtual input”	9-13, 22-23	“virtual input” means one or more picture elements generated from user input. “virtual output” means one or more picture elements of a picture.	“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.
Microsoft term: “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	9-12, 15-16, 18-21, 23	A device-independent abstraction of a displayable object (e.g., line, text, etc.).	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.
Microsoft and Motorola Means- Plus - Function term: “means for performing processing operations on said virtual input	9-14	Function: performing processing operations on virtual input and generating virtual output Corresponding structure: Console	Function: performing processing operations on said virtual input and generating virtual output Structure: the operations performed by

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
and for generating virtual output”		<p>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.</p>	<p>the Console Manager process as explicitly defined at 44:6-34 and 5:20-46.</p>
<p>Microsoft and Motorola Means-Plus -Function term: “means for accepting said virtual output”</p>	9-14	<p><u>Function</u>: accepting virtual output <u>Corresponding structure</u>: 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; 17:23-25; 17:63-18:23; 25:44-56; 30:51-33:5; 43:60-65; 44:35-39; 145-150.</p>	<p><u>Function</u>: accepting said virtual output <u>Structure</u>: the operations by which a Picture Manager process receives and processes incoming requests related to picture elements, as explicitly defined at 17:23-25, 17:63-18:10, and 5:20-46.</p>
<p>Microsoft and Motorola Means-Plus -Function term: “means for converting said virtual output into at least one physical output suitable for use by at least one physical output device”</p>	9-14	<p><u>Function</u>: converting picture elements into output suitable for use by a particular hardware device. <u>Corresponding structure</u>: 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.</p>	<p><u>Function</u>: converting said virtual output into at least one physical output suitable for use by at least one physical output device <u>Structure</u>: the operations performed by the Output Manager process as defined at 19:32-20:64 and 5:20-46.</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: “picture manager process”	10-11	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.	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.
Motorola term: “window manager process”	11	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.	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.
Microsoft Means-Plus -Function term: “wherein said virtual output accepting means comprises a picture manager process for controlling said plurality of related picture elements”	10	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)	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.
Microsoft Means-Plus -Function term: “wherein said virtual output accepting means further comprises a window manager process for controlling the display of said	11	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.	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

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
plurality of related picture elements on said display device ²		(see Window Manager Process above)	said display device. Structure: the operations performed by the Window Manager process, 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.
Microsoft Means-Plus -Function term: “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”	12	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.	Function: coupling ¹ 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 ¹ 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
Microsoft and Motorola Means-Plus -Function term: “means responsive to one of said physical input devices for generating a picture”	15-16, 18-23	Function: generating a picture comprising one or more picture elements responsive to a user’s interaction with a physical input device. Corresponding structure: Input Manager and Console Manager processes	Function: generating a picture from the input from a physical input device ² 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-

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
		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.	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
Microsoft and Motorola Means-Plus -Function term: "means for performing processing operations on said one or more picture elements"	15-16, 18-23	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	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.
Microsoft and Motorola Means-Plus -Function term: "means responsive to said one or more processed picture elements for coupling said one or more processed picture elements to one physical output device"	15-16, 18-23	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;	Function: sending one or more processed picture elements to one or more said physical display devices ³ for display. Structure: the operations performed by the virtual output manager process as described at 20:4-42 and 5:20-46. ³ as the term "said physical output devices" has no antecedent basis other

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
		26:33-43; 43:58-65.	than in the preamble, this term becomes indefinite unless the preamble to Claim 15 is limiting.
Microsoft Means-Plus -Function term: “wherein said means responsive to one of said physical input devices comprises a virtual input manager process”	22	“Virtual input manager process” means the process by which input from a physical device is converted into virtual form.	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.
Microsoft Means-Plus -Function term: “wherein said means responsive to said one or more processed picture elements comprises a virtual output manager process”	23	“Virtual output manager process” means the process by which virtual output is converted into real output on a particular physical device.	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.

Microsoft Patent No. 7,024,214

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: “synchronization mechanism”	1, 3-6, 10, 14, 17, 19, 22-29, 32-34, 38, 39, 41-44, 46-52, 54-56	A communication channel used for synchronization.	Plain and ordinary meaning, or alternatively: “process or technique for synchronization”
Motorola term: “flexible selection rule(s)”	1, 3-6, 10, 14, 17, 19, 22-29, 32-34, 38, 39, 41-44, 46-52, 54-56	Changeable rule(s) which specify which synchronization mechanisms can be used for synchronizing certain types of data	Plain and ordinary meaning, or alternatively: “rules for selection to determine whether, when, and/or how”
Motorola term: “value, from having access to synchronized data”	1, 3-6, 10, 14, 17, 19, 22-29, 32-34, 38,39, 41-44, 46-52, 54-56	Importance to the user of having access to the synchronized data item.	Plain and ordinary meaning, or alternatively: “value associated with obtaining synchronized data”

Microsoft Patent No. 7,493,130

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: “synchronization mechanism”	1-2, 4-8, 10-11, 13-19	A communication channel used for synchronization.	Plain and ordinary meaning or alternatively: “process or technique for synchronization”
Motorola term: “flexible selection rule(s)”	1-2, 4-8, 10-11 13-19	Changeable rule(s) which specify which synchronization mechanisms can be used for synchronizing certain types of data.	Plain and ordinary meaning, or alternatively: “rules for selection to determine whether, when, and/or how”
Motorola term: “value, from having access to synchronized data”	1-2, 4-8, 10-11, 13-19	Importance to the user of having access to the synchronized data item.	Plain and ordinary meaning, or alternatively: “value associated with obtaining synchronized data”

Microsoft Patent No. 6,791,536

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: “generating at least one event representing an activation of the primary switch of the pointing device”	14, 16, 17	Generating at least one down event 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.”
Motorola term: “generating at least one event representing an activation of the secondary switch of the pointing device”	14, 16, 17	Generating at least one down event 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.”

Microsoft Patent No. 6,897,853

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
<p>Motorola term: “determining whether the input is a stroke based on a first move threshold”</p>	<p>7-11</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: “determining that the input is a stroke if the input exceeds a first predetermined distance.”</p>	<p>“determining that the input is a stroke if the input exceeds a first threshold based upon movement of the input”</p>
<p>Motorola term: “determining whether the input is a tap based on a time threshold”</p>	<p>7-11</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: “determining that the input is a tap if the input does not exceed a predetermined amount of time.”</p>	<p>“determining that the input is a tap if the input does not exceed a threshold dependent on time”</p>
<p>Motorola term: “determining whether the stroke is a hold or a hold and drag”</p>	<p>7-11</p>	<p>This element requires no construction and should be accorded its plain and ordinary meaning. If this element is construed, it should be given the following meaning: “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</p>	<p>“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</p>

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
		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”	movement of the input”
Motorola term: “simulating a right mouse click”	11	Generating a down event followed by an up event of a right mouse button.	Plain and ordinary meaning or alternatively: “generating an action that represents an activation of a secondary switch of a pointing device”

Microsoft Patent No. 7,383,460

Claim Term/ Identified By	Claims	Motorola Proposed Construction	Microsoft Proposed Construction
Motorola term: high precision event timer (HPET)	8, 9	A hardware timer that operates in accordance with the “ <i>Intel Architecture/ Personal Computer (IA/PC) HPET (High Precision Event Timers) Specification.</i> ”	“the combination of a counter, comparator, and match register”
Microsoft term: “the hardware-dependent process”	7	Indefinite.	“the hardware-dependent interface”

Microsoft Patent No. 6,897,904

Claim Term/ Identified By	Claims	Microsoft Proposed Construction	Motorola Proposed Construction
Motorola term: “program content currently being tuned”	19	Plain and ordinary meaning or alternatively: “the program content that a tuner is currently receiving”	“live program content”

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF FLORIDA

CASE NO. 10-24063-CIV-MORENO

MOTOROLA MOBILITY, INC.,
Plaintiff / Counterclaim Defendant,

v.

MICROSOFT CORPORATION,
Defendant / Counterclaim Plaintiff.

CONTAINS CONFIDENTIAL
BUSINESS INFORMATION
SUBJECT TO PROTECTIVE ORDER

FILED UNDER SEAL

DECLARATION OF LESLIE M. SPENCER IN SUPPORT OF
MOTOROLA MOBILITY, INC.'S RESPONSIVE CLAIM
CONSTRUCTION BRIEF