

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF FLORIDA  
MIAMI DIVISION

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

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

**MICROSOFT CORPORATION'S OPPOSITION TO MOTOROLA MOBILITY, INC'S  
MOTION FOR SUMMARY JUDGMENT OF INVALIDITY AND NON-  
INFRINGEMENT AND ACCOMPANYING MEMORANDUM OF LAW IN SUPPORT**

## TABLE OF CONTENTS

TABLE OF AUTHORITIES.....	ii
I. INTRODUCTION.....	1
II. LEGAL ARGUMENT.....	1
A. Summary Judgment .....	1
B. Patent Validity .....	1
C. Patent Infringement.....	2
D. The '536 and '853 Patents .....	3
1. The Asserted Claims of Microsoft's '536 Patent Are Not Invalid in View of the Harada '615 Patent. ....	4
2. Taking All Reasonable Inferences in Its Favor, Microsoft Has Presented Sufficient Evidence to Show that Motorola Has Directly Infringed Microsoft's '853 Patent.....	9
E. The '901 and 904 Patents.....	13
1. There Is Sufficient Evidence of Motorola's Infringement of the Method Claims of the '901 Patent.....	14
2. There Is Sufficient Evidence of Motorola's Infringement of the Apparatus Claims of the '901 Patent.....	16
3. There Is Sufficient Evidence of Motorola's Direct Infringement of the '904 Patent. ....	17
4. There Is Sufficient Evidence of Motorola's Indirect Infringement of the '904 Patent. ....	18
III. CONCLUSION.....	18

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>FEDERAL CASES</b>	
<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242 (1986).....	1, 10
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1986).....	1
<i>Cybor Corp. v. FAS Techs., Inc.</i> , 138 F.3d 1448 (Fed. Cir. 1998) (en banc).....	2
<i>DSU Med. Corp. v. JMS Co.</i> , 471 F.3d 1293 (Fed. Cir. 2006).....	3
<i>Ecolochem, Inc. v. S. Cal. Edison Co.</i> , 227 F.3d 1361 (Fed. Cir. 2000).....	8
<i>Embrex, Inc. v. Service Eng'g Corp.</i> , 216 F.3d 1343 (Fed. Cir. 2000).....	15, 17
<i>Golden Blount, Inc. v. Robert H. Peterson Co.</i> , 438 F.3d 1354 (Fed. Cir. 2006).....	15, 16, 18
<i>Joy Techs., Inc. v. Flakt, Inc.</i> , 6 F.3d 770 (Fed. Cir. 1993) .....	3
<i>Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.</i> , 997 F.2d 1444 (Fed. Cir. 1993).....	1, 10
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	2
<i>Linear Tech. Corp. v. ITC</i> , 566 F.3d 1049 (Fed. Cir. 2009).....	3, 15, 17
<i>Liquid Dynamics Corp. v. Vaughan Co.</i> , 449 F.3d 1209 (Fed. Cir. 2006).....	10
<i>Lucent Techs. v. Gateway, Inc.</i> , 580 F.3d 1301 (Fed. Cir. 2009).....	3, 15, 18
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995) (en banc).....	2
<i>MGM Well Servs. v. Mega Lift Sys.</i> , 505 F. Supp. 2d 359 (S.D. Tex. 2007).....	15, 17

<i>Microsoft Corp. v. i4i Ltd. P'ship ("i4i"),</i> 131 S.Ct. 2238 (2011).....	1
<i>Moleculon Research Corp. v. CBS, Inc.,</i> 793 F.2d 1261 (Fed. Cir. 1986).....	10
<i>Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH,</i> 139 F.3d 877 (Fed. Cir. 1998).....	2
<i>Net MoneyIN, Inc. v. VeriSign, Inc.,</i> 545 F.3d 1359 (Fed. Cir. 2008).....	2, 8
<i>Phillips v. AWH Corp.,</i> 415 F.3d 1303 (Fed. Cir. 2005).....	6
<i>S. Bravo Sys. v. Containment Techs. Corp.,</i> 96 F.3d 1372 (Fed. Cir. 1996).....	3
<i>Snuba Int'l, Inc. v. Dolphin World, Inc.,</i> No. 99-1357, 2000 U.S. App. LEXIS 16946 (Fed. Cir. 2000) .....	16, 18
<i>Symantec Corp. v. Computer Assoc. Int'l, Inc.,</i> 522 F.3d 1279 (Fed. Cir. 2008).....	15, 18
<i>Vita-Mix Corp. v. Basic Holdings, Inc.,</i> 581 F.3d 1317 (Fed. Cir. 2009).....	15, 17, 18
<i>Warner-Jenkinson Co. v. Hilton Davis Chem. Co.,</i> 520 U.S. 17, 117 S. Ct. 1040 (1997).....	3
<i>Xerox Corp. v. 3Com Corp.,</i> 458 F.3d 1310 (Fed. Cir. 2006).....	2
<b>FEDERAL STATUTES</b>	
35 U.S.C. § 102(e)(2).....	2
35 U.S.C. § 103(a) .....	2
35 U.S.C. § 271(a) .....	3
35 U.S.C. § 282 (2006) .....	1

## **I. INTRODUCTION**

Defendant and Counterclaim Plaintiff Microsoft Corporation (“Microsoft”) opposes Plaintiff and Counterclaim Defendant Motorola Mobility, Inc.’s (“Motorola”) Motion for Summary Judgment of Invalidity of U.S. Patent No. 6,791,536 (“the ‘536 Patent”). Moreover, Microsoft opposes Motorola’s Motion for Summary Judgment of Non-infringement of U.S. Patent Nos. 6,897,853 (“the ‘853 Patent”), 6,897,904 (“the ‘904 Patent”), and 6,785,901 (“the ‘901 Patent”) (collectively, “Motorola SJ Mot.”). (D.E. 126).

## **II. LEGAL ARGUMENT**

### **A. Summary Judgment**

Summary judgment is only proper if “the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.” Fed. R. Civ. P. 56(c) (2006); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-248, (1986). A genuine issue of material fact exists where the evidence is such that a reasonable jury may find in favor of the nonmoving party. *Id.* at 248. The moving party bears the initial burden of establishing that it is entitled to summary judgment. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324-25 (1986). If the moving party has satisfied this burden, the nonmoving party must present “specific facts” in the record showing that there is a genuine issue for trial. *Id.* at 324. In doing so, “[t]he evidence submitted by the nonmovant, in opposition to a motion for summary judgment, ‘is to be believed, and all justifiable inferences are to be drawn in [its] favor.’” *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1449-50 (Fed. Cir. 1993) (internal citations omitted) (*quoting Anderson*, 477 U.S. at 255).

### **B. Patent Validity**

Congress has expressly established that a patent, once issued, is presumed valid. 35 U.S.C. § 282 (2006); *Microsoft Corp. v. i4i Ltd. P’ship (“i4i”)*, 131 S.Ct. 2238, 2245 (2011). Furthermore, the party challenging a patent’s validity has the burden of proving invalidity. *Id.* The validity of a patent may only be overcome by the presentation of clear and convincing evidence. *i4i* at 2242. This same standard is invariably applied to prior art not previously cited to the U.S. Patent and Trademark Office (“PTO”) during the patent’s prosecution. *Id.* at 2250

(“Nothing in § 282's text suggests that Congress meant to depart from that understanding to enact a standard of proof that would rise and fall with the facts of each case.”).

Invalidity may be proved through anticipation or obviousness. Amongst various approaches, a patent is anticipated where “the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the application for the patent.” 35 U.S.C. § 102(e)(2). A prior art reference may only anticipate where, within the four corners of that document, it discloses each and every element of the claimed invention. *Xerox Corp. v. 3Com Corp.*, 458 F.3d 1310, 1322 (Fed. Cir. 2006). Moreover, each of these disclosed elements must also be *arranged as in the claim*. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

A patent may be rendered obvious where “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). Obviousness is a question of law based on underlying facts. *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998). The factual inquiry requires analysis of four factors: 1) the scope and content of the prior art; 2) the differences between the prior art and the claims at issue; 3) the level of ordinary skill in the art; and 4) the extent of any proffered objective indicia of nonobviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)). This is a necessary analysis in establishing obviousness. *See id.* (“While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls.”).

### **C. Patent Infringement**

Patent infringement invites a two part analysis, presenting a mixed question of law and fact. “First, the court determines the scope and meaning of the patent claims asserted . . . [and secondly,] the properly construed claims are compared to the allegedly infringing device.” *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc) (citations omitted). Claim construction is a question of law. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970 71 (Fed. Cir. 1995) (en banc). The second step—comparison of the claims to the accused

device—is a question of fact. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29, 117 S. Ct. 1040 (1997).

The patentee carries the burden of proving infringement. *S. Bravo Sys. v. Containment Techs. Corp.*, 96 F.3d 1372, 1376 (Fed. Cir. 1996). However, infringement need only be established through a preponderance of the evidence. *Id.* Infringement requires identity between the claims and the accused conduct—i.e., the accused infringer must have practiced every element of the claim. *Linear Tech. Corp. v. ITC*, 566 F.3d 1049, 1060 (Fed. Cir. 2009) Yet, liability may be found from a single incidence of infringement. *Lucent Techs. v. Gateway, Inc.*, 580 F.3d 1301, 1317 (Fed. Cir. 2009). Infringement of a method claim may be proved through evidence of the accused infringer practicing each and every step of the claimed method. *Id.* While sales of a product capable of carrying out a patented method will not infringe the method claims, *Joy Techs., Inc. v. Flakt, Inc.*, 6 F.3d 770, 774-75 (Fed. Cir. 1993), evidence of the accused infringer’s own use of the product may suffice. 35 U.S.C. § 271(a). Furthermore, indirect liability for infringement may arise where the accused infringer contributes to or induces others to infringe. *Id.* at § 271(b)-(c). As such, a supplier of an infringing product may be found liable for the direct infringement of its customers where the supplier knows of and actively induces infringement of a patent. *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1305-1306 (Fed. Cir. 2006) (“[I]f an entity offers a product with the object of promoting its use to infringe, as shown by clear expression or other affirmative steps taken to foster infringement, it is then liable for the resulting acts of infringement by third parties.”).

#### **D. The ‘536 and ‘853 Patents**

The innovations described in the ‘536 Patent and the ‘853 Patent address direct interaction with a touch screen of a computer. In particular, the ‘536 Patent is directed to an apparatus and methods for simulating gestures of a pointing device, such as a left-click or right click of a mouse, using a stylus (such as finger) to interact directly with a touch sensitive display surface.<sup>1</sup> A typical stylus, however, can only perform three types of movements – placing the tip on the screen, moving the stylus across the screen, and removing the stylus from the screen.<sup>2</sup> The ‘536 Patent

---

<sup>1</sup> U.S. Patent No. 6,791,536 at 1:52-58 and 2:60-67 (Ex. 1).

<sup>2</sup> *Id.* at 2:17-21.

provides an intuitive way to simulate mouse gestures using such stylus movements through the use of time and movement thresholds and to optionally provide feedback to the user as an indication that the user has implemented the proper gesture.<sup>3</sup> Meanwhile, the '853 Patent is directed to an apparatus and methods for detecting stylus movements to determine whether a user intends to input a variety of gestures known as a tap, a stroke, a hold or a hold-and-drag.<sup>4</sup> As with the '536 Patent, the '853 patent utilizes thresholds, such as time and movement, to distinguish between gestures.<sup>5</sup> Accordingly, both the '536 and '853 Patents disclose and claim the very type of direct interaction that is *integral* to the touchscreen systems found in today's ubiquitous smartphone and tablet devices, including Motorola devices using the Android operating system.<sup>6</sup>

**1. The Asserted Claims of Microsoft's '536 Patent Are Not Invalid in View of the Harada '615 Patent.**

Motorola argues that U.S. Patent No. 6,657,615 ("Harada") anticipates claims 14, 16, and 37-39 and renders obvious claims 17 and 40 of the '536 Patent.<sup>7</sup>

**a. Claims 14, 16, and 37-39 of the '536 Patent are not anticipated because the Harada reference cannot distinguish between gestures.**

As Microsoft's expert, Dr. Robert Stevenson indicated in his rebuttal report (and as supported by his declaration herein), Harada simply does not disclose each and every element of the claims of the '536 Patent.<sup>8</sup> Unlike the '536 Patent, the Harada reference is an extremely limited reference that at most detects a stylus up and a stylus down event.<sup>9</sup> Accordingly, Harada

---

<sup>3</sup> *Id.* at 2:46-3:40, 5:59-6:16, and Fig.. 3.

<sup>4</sup> U.S. Patent No. 6,897,853 at 2:41-43 (Ex. 2).

<sup>5</sup> Ex. 2 at 2:18-3:12, 6:1-21 and Fig. 3.

<sup>6</sup> Expert Report of Matthew R. Lynde, Ph.D. Pursuant to Rule 26(a)(2)(B) pg. 8. (Ex. 3).

<sup>7</sup> For reasons unrelated to the filing of this Motion, Microsoft has withdrawn claims 16 and 17 in this matter.

<sup>8</sup> Declaration of Dr. Robert L. Stevenson in Support of Microsoft Corporation's Opposition to Motorola Mobility, Inc's Motion for Summary Judgment of Invalidity and Non-Infringement para. 15 (Ex. 4)

<sup>9</sup> Declaration of Dr. Robert L. Stevenson (Ex. 4) para. 20 (citing Rebuttal Expert Report of Dr. Robert L. Stevenson Regarding Validity of U.S. Patent No. 6,791,536, para. 40 (Ex. 5)).



is concerned solely with whether the pointing device is in contact with the touch-sensitive display and cannot sense or detect a stylus that is moving while it is in contact with the display.<sup>10</sup> Accordingly, as set forth in detail below, Motorola has not met its burden of demonstrating that the '536 Patent is anticipated or rendered obvious, particularly on summary judgment where all reasonable inferences must be drawn in favor of Microsoft.

i. **Harada does not disclose the requirement in independent claims 14 and 37 of the '536 Patent that the pointing device be “held against” or “held down” on a touch-sensitive display.**<sup>11</sup>

The '536 Patent is concerned with two distinct steps: 1) detecting that the pointing device is in contact with the display, and 2) detecting that the stylus *has not moved*.<sup>12</sup> Indeed, the '536 patent concerns a system that can determine whether a stylus has been held in place without substantial movement for the threshold period of time.<sup>13</sup> Harada, on the other hand, cannot detect movement while the stylus is in contact with the display.<sup>14</sup> Because Harada cannot detect stylus movement, it does not disclose a processor coupled to a touch sensitive display surface and configured to detect whether a stylus is “held against” the touch-sensitive display surface.<sup>15</sup> Likewise, Harada does not disclose any method to detect whether a stylus is being “held down” on a touch-sensitive display.<sup>16</sup>

The claims of the '536 Patent consistently refer to the term “held”—indicating that a stylus is either “held down” or “held against” a touch sensitive display.<sup>17</sup> The claims of the '536 patent *never* resort to terms such as “touch” or “contact.”<sup>18</sup> In contrast, Harada consistently refers

---

<sup>10</sup> *Id.*; U.S. Patent 6,657,615 Figs. 4, 6 (Ex. 6).

<sup>11</sup> Ex. 1 at col. 10, l. 42-58; col. 12, l. 45-53.

<sup>12</sup> Declaration of Stevenson (Ex. 4), para. 17.; Ex. 1 Fig. 3.

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*, para. 20.

<sup>15</sup> *Id.*, para. 18.

<sup>16</sup> *Id.*, para. 19.

<sup>17</sup> *Id.*, para. 23.

<sup>18</sup> *Id.*

to the term “touch” and never to the term “held.”<sup>19</sup> It is apparent from the claim language that, where Harada is concerned with simple touch/non-touch gestures, the ‘536 Patent is concerned with detecting whether a stylus is held in place without substantial *movement*.

In making this observation, Microsoft is not importing a limitation into the claims from the specification.<sup>20</sup> Here, Motorola’s expert Mr. Ward testified at his deposition to an understanding of the plain meaning of this term in pen computing:

Q. And how about a hold? What is a hold?

A. In pen computing, a hold under different names would be some kind of user input where a user touches a stylus or a finger to a surface and holds it relatively in place for some period of time.<sup>21</sup>

In other words, in order to determine that a gesture is a hold, the device must be able to measure both the time of contact and detect movement of the stylus. As Motorola’s expert Mr. Ward acknowledged, Harada is unable to determine whether the stylus is moving:

Q. My question was whether Harada measures stylus movement while the stylus is in contact with the touchscreen. I believe you said that it does, and referred to Figure 6.

A. No. If that's what I said, I meant to say it does not take into account whether the stylus is moving a substantial or insubstantial amount.<sup>22</sup>

---

<sup>19</sup> *Id.*

<sup>20</sup> The specific language Dr. Stevenson uses to describe the holding gesture is consistent with the way the term is used in the specification. *See* Ex. 1 col. 2, l. 60-65 (“For example, a left click of a mouse may be simulated, e.g., where the user *holds the stylus down on the touch-sensitive display surface without substantial movement* and then removes the stylus from the display surface before the expiration of a threshold amount of time.”) (emphasis added). The Federal Circuit advocates that, notwithstanding the bar on importing limitations from the specification into the claims, it is permissible to use the specification to understand the claim, which is exactly what Dr. Stevenson has done. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (“[T]he best source for understanding a technical term is the specification from which it arose . . .” (citing *Multiform Desiccants, Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998))).

<sup>21</sup> Ward Deposition, 125:14-18 (Ex. 17).

<sup>22</sup> *Id.* at 192:3-9.

(192:3-9) Thus, as described above and admitted by Motorola’s expert, Harada does not teach the “holding” of an input device down or against a touch sensitive screen and cannot identify anything more than a “touch” on the screen.

Accordingly, Harada cannot anticipate independent claims 14 and 37 of the ‘536 Patent or any of their dependent claims (16, 17, or 37-40) and the fundamental differences between Harada and the claims of the patent present genuine issues of fact for consideration by the jury in this action. Moreover, since Motorola asks the Court to ignore this distinction in arguing for anticipation, it failed to present any evidence to support a claim that it would obvious to modify Harada to include such this hold feature – one that Harada is incapable of detecting and, therefore, would have no motivation to use.

- ii. **Harada does not disclose the requirement in independent claim 37 of the ‘536 Patent of “generating a state change indicator responsive to the stylus being held down for at least the threshold amount of time” or any of the specific state change indicators in dependent claims 38-39.**<sup>23</sup>

Claims 37 adds the additional requirement that a state change indicator be generated when the stylus is “held down” on the display.<sup>24</sup> Dependent claims 38 requires that the state change indicator be visual<sup>25</sup> and dependent claim 39 requires that the state change indicator be dependent on the location of the stylus.<sup>26</sup> Once again, these claims include the requirement that the stylus be held down. For all of the reasons discussed in connection with independent claims 14 and 37 above, there is no disclosure in Harada of generating a state change indicator in response to a stylus that is “held down” against the display.

In connection with its argument concerning claim 37, Motorola attempts to bring together a number of disparate and separate parts of the patent using the ‘536 Patent as a roadmap for the combination of elements that it attempts to use to show anticipation. This is impermissible. In order to be anticipatory, it is not enough that a single reference disclose each element of a claim in a piecemeal fashion. Instead, the prior art reference must disclose each and every element of the

---

<sup>23</sup> Ex. 1 at 12:45-63.

<sup>24</sup> *Id.* at 12:48.

<sup>25</sup> *Id.* at 12:54-56.

<sup>26</sup> *Id.* at 12:57-60.

claimed invention as they are arranged in the claim. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). Where the reference does not implicitly or explicitly combine the disparate disclosures, the reference will not anticipate. *Id.* (“In other words, we concluded that although the reference taught all elements of the claim, it did not contain a discussion suggesting or linking hydrazine with the mixed bed in the figure, and thus did not show the invention arranged as in the claim.” (*discussing Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1369 (Fed. Cir. 2000))).

Beyond its preamble, claim 37 is comprised of two claim limitations: 1) “detecting whether a stylus is being held down on a touch-sensitive display surface for at least a threshold amount of time,” and 2) “and generating a state change indicator responsive to the stylus being held down for at least the threshold amount of time.”<sup>27</sup> With respect to the first claim limitation, Motorola indicates that the algorithm shown in Figure 6 of Harada (and its descriptive) text discloses the anticipating element.<sup>28</sup> However, Motorola never again refers to the algorithm of Figure 6 of Harada in its analysis of Claim 37.<sup>29</sup> Instead, as Motorola continues its analysis of the second limitation of claim 37, it indicates that the algorithms displayed in Figures 8 and 9 of Harada (and their descriptive text) disclose the anticipating element.<sup>30</sup> Motorola has not pointed to anything in Harada that links these separate algorithms disclosed in Figures 6, 8, and 9.<sup>31</sup> Effectively, Motorola has combined several unconnected disclosures in Harada and holds out this impermissible combination as anticipating claim 37.

Moreover, other than the mere assertion that the pointer icon in Figure 10 satisfies the limitation, Motorola has provided no indication or linking argument showing how or why the pointer icons in Figure 10 are a state change indicator, as required by the claim, or why Figure 10 is properly combined with the algorithm of Figure 9 and the description of Figure 10.<sup>32</sup> Both the

---

<sup>27</sup> *Id.* at 12:45-53.

<sup>28</sup> Declaration of Stevenson (Ex. 4), para. 25.

<sup>29</sup> *Id.*

<sup>30</sup> *Id.* para. 26.

<sup>31</sup> *Id.* para. 27.

<sup>32</sup> Declaration of Stevenson (Ex. 4), para. 28. On its face, the portion of the description of Figure 10 is directed to behavior that “is to be selected in a non-touching state.”

Court and Microsoft are left to guess at the way in which this feature is implemented and how it allegedly anticipates the claim or renders it obvious. On a motion for summary judgment, with the presumption of validity and taking all justifiable inferences in favor of Microsoft, Motorola has failed to meet its heavy burden in eliminating each and every issue of fact necessary to prevail on its claim that Harada anticipates claim 37 of the '536 patent.

**b. Motorola has failed to provide clear and convincing evidence that Claim 40 of the '536 Patent is obvious.**

With respect to obviousness, neither Motorola or its expert have presented sufficient evidence to fulfill the requirement to show that the claimed invention was obvious. On this point, Motorola acknowledges that, even under its own interpretation of Harada, claim 40 (method claim 37 with an additional step relating to the generation of an animated visual state change indicator) of the '536 Patent is not anticipated. Motorola argues, however, that Harada discloses the display of pointer icons in different colors, thereby making animation of the pointers an obvious next step. Motorola provides no support whatsoever for this conclusion other than some unsubstantiated assumption that it would be obvious to do so since people appreciate flashing colors because they help “discern information more readily.”<sup>33</sup> On a motion for summary judgment, with the presumption of validity and taking all justifiable inferences in favor of Microsoft, Motorola has again failed to meet its burden. Therefore, Motorola has failed to prove that Harada renders obvious claims 17 and 40 of the '536 patent.<sup>34</sup>

**2. Taking All Reasonable Inferences in Its Favor, Microsoft Has Presented Sufficient Evidence to Show that Motorola Has Directly Infringed Microsoft's '853 Patent.**

In its Motion, Motorola argues that Microsoft has not met its burden of proof concerning direct infringement of the method claims 7-11 of the '853 Patent. Specifically, Motorola argues

---

<sup>33</sup> Motorola SJ Mot, p. 10. Motorola does not cite relevant portions of its expert's opinion to arrive at this conclusion.

<sup>34</sup> Moreover, with respect to the remaining claims, claims 14, 16 and 37-39, Motorola and its expert have provided no claim or evidentiary support for obviousness.

that Microsoft has presented “no evidence that Motorola itself directly infringes any of the asserted claims by actually performing the required steps.”<sup>35</sup>

In order to prevail at trial, Microsoft need only present sufficient evidence upon which a jury could reasonably conclude that Motorola practices the claimed invention – for example by using, testing and/or servicing the accused devices. In considering this issue on summary judgment, all justifiable inferences must be drawn in favor of Microsoft. *Keystone Retaining Wall Sys., Inc. v. Westrock, Inc.*, 997 F.2d 1444, 1449-50 (Fed. Cir. 1993) (internal citations omitted) (quoting *Anderson*, 477 U.S. at 255).

Fundamentally, Motorola’s motion is based upon the flawed presumption that evidence of infringement must be *direct* evidence. As the Federal Circuit has repeatedly advised, infringement may be proved by both direct and circumstantial evidence. *Liquid Dynamics Corp. v. Vaughan Co.*, 449 F.3d 1209, 1219 (Fed. Cir. 2006) (citing *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1272 (Fed. Cir. 1986)). In fact, circumstantial evidence “may also be more certain, satisfying and persuasive than direct evidence.” *Moleculon Research*, 793 F.2d at 1272. In the present case, there is ample circumstantial evidence from which a reasonable jury may draw inferences—in the light most favorable to Microsoft—that Motorola directly infringes the ‘853 patent.

In its motion, Motorola argues that there is “no evidence” that it has ever used, tested, or serviced its own devices to confirm that they operate as intended. As set forth below, there is ample evidence to the contrary.

1. Microsoft’s expert Dr. Stevenson reviewed source code for all of the accused Motorola

[REDACTED]

‘853 Patent.<sup>36</sup>

○ [REDACTED]

---

<sup>35</sup> Motorola SJ Mot., p. 11. Motorola does not contest by way of Summary Judgment whether third parties perform the steps accused of infringement.

<sup>36</sup> Exhibit C to Expert Report of Dr. Robert L. Stevenson Regarding Infringement of Claims 7-11 of U.S. Patent No. 6,897,853 pg. 1 (Ex. 8).

- [REDACTED]
- [REDACTED]

2. Stephen Moore, a software developer for Motorola's Android operating system who worked in the User Experience Group, testified as Motorola's corporate designee that:

- [REDACTED]
- [REDACTED]
- [REDACTED]

3. [REDACTED]

---

<sup>37</sup> Expert Report of Dr. Robert L. Stevenson Regarding Infringement of Claims 7-11 of U.S. Patent No. 6,897,853 paras. 79-80 (Ex. 7)

<sup>38</sup> Deposition of Dr. Robert L. Stevenson at 192:10-15 (Ex. 18).

<sup>39</sup> *Id.* at 192:24-193:14.

<sup>40</sup> Deposition of Stephen Moore at 11:12-13:25; 50:21-59:21, 23:20-28:21 (Ex. 19).

<sup>41</sup> *Id.* at 12:23-16:24.

<sup>42</sup> *Id.* at 60:7-65:2.

<sup>43</sup> Ex. 7, para. 73; Ex. 8, p. 1.



4. [Redacted]

<sup>44</sup> [Redacted] MOTO-MS-002021096 to -1124 (Ex. 11)

<sup>45</sup> *Id.* at 5.

<sup>46</sup> *Id.* at 6-11.

<sup>47</sup> [Redacted] MOTO-MS-002517344 (Ex. 12).

<sup>48</sup> [Redacted] MOTO-MS-000054350 (Ex. 13).

<sup>49</sup> *Id.*

<sup>50</sup> [Redacted] MOTO-MS-002021096 to -1124 (Ex. 11), pg. 5.

<sup>51</sup> [Redacted] MOTO-MS-005128693 to MOTO-MS-005128704, pg. 5 (Ex. 14).



[REDACTED]

(SAMF ¶ 75).<sup>52</sup>

5. Motorola's user guides and websites show how these features are used on actual Android phones.
  - As Microsoft's expert Dr. Stevenson explained, the user guide demonstrates to users how to perform gestures on the accused devices.<sup>53</sup>
  - Motorola's website includes "Video Tutorials and Demos" showing Motorola's own use of the of the gestures at issue.<sup>54</sup>

Based on any one of these many examples, a reasonable jury could conclude that Motorola has used its phones in the manner for which they are designed and intended for use.

In light of the foregoing, it defies explanation how Motorola could reasonably argue that there is no evidence upon which a jury could find that it has operated the accused phones in the manner for which they were specifically designed. Indeed, Motorola's own co-CEO, Dr. Sanjay Jha, has been videotaped demonstrating the gestures of the Motorola Android phone at the release of the Droid X in New York City.<sup>55</sup> To the extent that Motorola wishes to challenge this evidence, the facts are uniquely within its possession. Accordingly, Microsoft has produced sufficient evidence – all inferences being taken in its favor – to create a genuine issue of material fact such that a reasonable jury will find that Motorola has directly infringed the '853 patent.

#### **E. The '901 and 904 Patents**

U.S. Patent No. 6,785,901 ("the '901 Patent") is generally directed to systems and methods for locking and unlocking programming content based on data including program ratings, content identifiers, channel and program.<sup>56</sup> The '901 Patent also generally provides that a

---

<sup>52</sup> *Id.*

<sup>53</sup> Exhibit C to Expert Report of Dr. Robert L. Stevenson Regarding Infringement of Claims 7-11 of U.S. Patent No. 6,897,853 pg. 1 (Ex. 8).

<sup>54</sup> [http://www.motorola.com/staticfiles/Support/US-EN/Mobile%20Phones/DROID2/US-EN/Documents/Static\\_Files/DROID2\\_UG\\_US\\_EN\\_VZW\\_68000202881.pdf](http://www.motorola.com/staticfiles/Support/US-EN/Mobile%20Phones/DROID2/US-EN/Documents/Static_Files/DROID2_UG_US_EN_VZW_68000202881.pdf) (particularly, the video entitled "viewing messages and attachments").

<sup>55</sup> <http://www.youtube.com/watch?v=mHAqVZctRw&feature=youtu.be&t=3m14s>

<sup>56</sup> Motorola's Tab 2, the '901 Patent.

record button is not displayed to a user if the programming content is locked.<sup>57</sup> The method claims 1-3, 5, 6, 8, 9, 11, 22, 23 and 25 of the '901 Patent are asserted against Motorola. The apparatus claims 27-29, 31, 33 and 35 of the '901 Patent are also asserted against Motorola.

U.S. Patent No. 6,897,904 ("the '904 Patent") is generally directed to systems and methods for selecting among multiple tuners to tune to a particular channel, for allowing a user to record a program with a tuner while watching a different program with another tuner without requiring any user input concerning selection of tuners, and when the user switches back to a channel that is being recorded, for providing an indication that the user is now watching a recorded program.<sup>58</sup> Microsoft accused Motorola of infringing the method claims 12 and 18-20 of the '904 Patent.

**1. There Is Sufficient Evidence of Motorola's Infringement of the Method Claims of the '901 Patent.<sup>59</sup>**

There is sufficient evidence of Microsoft's infringement—both direct and indirect—of the asserted method claims of the '901 Patent.

**a. Sufficient evidence of direct infringement.**

Motorola's bold assertion (Motorola's SJ Mot., p. 18) that there is no evidence that Motorola has utilized any accused devices that would result in practice of the claimed methods is without any basis. First, Microsoft's expert, Dr. Loren Terveen, showed that Motorola's accused set top boxes necessarily infringe the asserted claims of the '901 Patent.<sup>60</sup> Next, Motorola's own corporate witness, Robert Shuff, testified [REDACTED]

---

<sup>57</sup> *Id.*

<sup>58</sup> Motorola's Kao Ex. 8, (the '904 Patent).

<sup>59</sup> Microsoft is not asserting infringement under the doctrine of equivalents of the asserted claims of the '901 Patent.

<sup>60</sup> Motorola's Hoang Exs. M and N, Terveen Report.

<sup>61</sup> Deposition of Robert Shuff at 45:17-48:4 (Ex. 9).

██████████.<sup>62</sup> Indeed, Mr. Shuff confirmed that Motorola ██████████

██████████<sup>63</sup> Such evidence is sufficient to prove direct infringement by Motorola. *See, e.g., Vita-Mix Corp. v. Basic Holdings, Inc.*, 581 F.3d 1317, 1325-26 (Fed. Cir. 2009) (indicating that testing by an accused infringer's employee can be used to establish the direct infringement by the accused infringer); *MGM Well Servs. v. Mega Lift Sys.*, 505 F. Supp. 2d 359, 373-74 (S.D. Tex. 2007) (finding defendant's operation and testing of infringing systems sold to customers for whom the defendant installed the systems constituted direct infringement by the defendant); *see also Linear Tech. Corp. v. U.S. Int'l Trade Comm.*, 566 F.3d 1049, 1062 (Fed. Cir. 2009); *Embrex, Inc. v. Service Eng'g Corp.*, 216 F.3d 1343, 1347-49 (Fed. Cir. 2000).

Motorola's assertion that there is no evidence that any person (other than Motorola) directly infringes the asserted claims is also without any merit. In addition to showing infringement by analyzing documents regarding the accused products, Dr. Terveen himself used and tested an accused product to confirm his conclusions.<sup>64</sup> Further, Dr. Terveen showed that the user manuals instructing the users how to use the accused set top boxes were readily made available. Dr. Terveen's testimony that he himself performed the patented method using the accused product and the evidence in the form of documents regarding the sales of the accused products and user guides can be sufficient to establish direct infringement by users of the accused products. *Lucent Techs. Inc. v. Microsoft Corp.*, 580 F.3d 1301, 1317-19 (Fed. Cir. 2009). Even without any expert testimony that he himself used the accused product in an infringing manner, the Federal Circuit has found that circumstantial evidence such as sales of the accused products and instruction manuals teaching use of the accused product in an infringing manner can establish direct infringement by the users of accused products, even without direct evidence that any user of the accused products has directly infringed. *See, e.g., Vita-Mix Corp. v. Basic Holdings, Inc.*, 581 F.3d 1317, 1325-26 (Fed. Cir. 2009); *Symantec Corp. v. Computer Assoc. Int'l, Inc.*, 522 F.3d 1279, 1292-93 (Fed. Cir. 2008); *Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1360, 1362-63 (Fed. Cir. 2006).

---

<sup>62</sup> *Id.*

<sup>63</sup> *Id.* at 48:2-4.

<sup>64</sup> Motorola's Hoang Exs. M and N, Terveen Report.

**b. Sufficient evidence of indirect infringement.**

Motorola's contention that there is insufficient proof of indirect infringement is baseless. First, contrary to Motorola's contention, Microsoft's infringement contentions asserted indirect infringement of the '901 Patent against Motorola: "Motorola has infringed, induced infringement of and/or contributorily infringed and continues to infringe, induce infringement of and/or contributorily infringe the Asserted Claims literally and/or under the doctrine of equivalents."<sup>65</sup> Second, as discussed above, there is sufficient evidence that the users of the accused set top boxes are directly infringing the '901 Patent as evidenced by, among other things, the user manuals.<sup>66</sup> *See, e.g., Golden Blount, Inc. v. Robert H. Peterson Co.*, 438 F.3d 1354, 1364-65 n.4 (Fed. Cir. 2006) (concluding that the defendant induced infringement by customers by providing them an instruction sheet directing them to perform specific acts leading to the assembly of infringing devices); *Snuba Int'l, Inc. v. Dolphin World, Inc.*, No. 99-1357, 2000 U.S. App. LEXIS 16946, at \*16, 18 (Fed. Cir. 2000) (deciding that defendants induced infringement by customers through sales of elements of the claimed combination and promotional materials containing instructions for use thereof in an infringing manner). Lastly, for each of the asserted claims, Dr. Terveen pointed to user manuals and instructions that encouraged the users to use the accused set-top boxes in an infringing manner of the '901 Patent.<sup>67</sup>

**2. There Is Sufficient Evidence of Motorola's Infringement of the Apparatus Claims of the '901 Patent.**

Motorola improperly limits the asserted claims to merely claiming "the electronic programming guide (EPG) (aka the interactive programming guide)."<sup>68</sup> Even if Motorola's argument is valid, however, Motorola's argument that there is no sufficient evidence that Microsoft infringes any apparatus claim because it does not make, *use*, sell, offer for sale such software is incorrect. As discussed above, Motorola ignores the evidence [REDACTED]

---

<sup>65</sup> Ex. 10, 04/05/11 Microsoft's Infringement Contentions at 2.

<sup>66</sup> Motorola's Hoang Exs. M and N.

<sup>67</sup> *Id.*

<sup>68</sup> Motorola's SJ Mot., p. 19.

[REDACTED]<sup>69</sup> [REDACTED]  
[REDACTED]

[REDACTED]<sup>70</sup> Thus, there is no question that Motorola *uses* the accused products. Accordingly, there is sufficient evidence of infringement of the asserted apparatus claims of the '901 Patent.

**3. There Is Sufficient Evidence of Motorola's Direct Infringement of the '904 Patent.<sup>71</sup>**

Motorola's argument that there is insufficient evidence of direct infringement of the '904 Patent is similar to the arguments made with respect to the '901 Patent and thus shares the same deficiencies. As in his analysis for the '901 Patent, Microsoft's expert, Dr. Terveen, showed that Motorola's accused set top boxes necessarily infringe the asserted claims of the '904 Patent.<sup>72</sup>

Jeffrey Newdeck, Microsoft's corporate witness, testified that Motorola [REDACTED]

[REDACTED]<sup>73</sup> Accordingly,  
[REDACTED]  
[REDACTED]

[REDACTED]<sup>74</sup> Such evidence is sufficient to prove direct infringement by Motorola. *See, e.g., Vita-Mix Corp.*, 581 F.3d at 1325-26 (indicating that testing by an accused infringer's employee can be used to establish the direct infringement by the accused infringer); *MGM Well Servs.*, 505 F. Supp. at 373-74; *see also Linear Tech. Corp.*, 566 F.3d at 1062; *Embrex, Inc.*, 216 F.3d at 1347-49.

Motorola also has no basis in arguing that there is no evidence that any person (other than Motorola) directly infringes the asserted claims. Dr. Terveen not only analyzed documents regarding the accused products to show infringement, but he also himself used and tested an

---

<sup>69</sup> Deposition of Robert Shuff at 45:17-48:4 (Ex. 9).

<sup>70</sup> *Id.*

<sup>71</sup> Microsoft is not asserting infringement under the doctrine of equivalents of the asserted claims of the '904 Patent.

<sup>72</sup> Motorola's Hoang Exs. M and N, Terveen Report.

<sup>73</sup> Deposition of Jeff Newdeck at 20:14-22:4 (Ex. 15).

<sup>74</sup> *See id.*

accused product to confirm his conclusions.<sup>75</sup> Further, Dr. Terveen showed that the user manuals instructing the users how to use the accused set top boxes were readily made available. As discussed above, such evidence is sufficient to establish direct infringement by users of the accused products. *Lucent Techs. Inc.*, 580 F.3d at 1317-19; *Vita-Mix Corp.*, 581 F.3d at 1325-26; *Symantec Corp.*, 522 F.3d at 1292-93; *Golden Blount, Inc.*, 438 F.3d at 1360, 1362-63.

**4. There Is Sufficient Evidence of Motorola's Indirect Infringement of the '904 Patent.**

Motorola failed to show that there is no genuine dispute of material fact that there is no indirect infringement. First, contrary to Motorola's contention, Microsoft's infringement contentions asserted indirect infringement of the '901 Patent against Motorola: "Motorola has infringed, induced infringement of and/or contributorily infringed and continues to infringe, induce infringement of and/or contributorily infringe the Asserted Claims literally and/or under the doctrine of equivalents."<sup>76</sup> Second, as discussed above, there is sufficient evidence that the users of the accused set top boxes are directly infringing the '901 Patent as evidenced by, among other things, the user manuals.<sup>77</sup> See, e.g., *Golden Blount, Inc.*, 438 F.3d at 1364-65 n.4; *Snuba Int'l, Inc.*, No. 99-1357, 2000 U.S. App. LEXIS 16946, at \*16, 18. Lastly, for each of the asserted claims, Dr. Terveen pointed to user manuals and instructions that encouraged the users to use the accused set-top boxes in a manner that infringes the '901 Patent.<sup>78</sup>

**III. CONCLUSION**

For the foregoing reasons, the Court should deny Motorola's motion for summary judgment that the asserted claims of the '536 patent are invalid; that Motorola does not directly infringe any asserted claim of the '853 Patent; and that Motorola does not directly or indirectly infringe any asserted claim of the '901 and '901 patents, either literally or under the doctrine of equivalents.

---

<sup>75</sup> Motorola's Hoang Exs. M and N, Terveen Report.

<sup>76</sup> 04/05/11 Microsoft's Infringement Contentions (Ex. 10), at 2

<sup>77</sup> Motorola's Hoang Exs. M and N.

<sup>78</sup> *Id.*

DATED this 8th day of August, 2011.

Respectfully submitted,

COLSON HICKS EIDSON  
Roberto Martinez, Esq.  
Curtis Miner, Esq.  
255 Alhambra Circle, Penthouse  
Coral Gables, Florida 33134  
Tel. (305) 476-7400  
Fax. (305) 476-7444

By: /s/Curtis B. Miner  
Curtis B. Miner  
(Fla. Bar No. 885681)  
E-mail: [curt@colson.com](mailto:curt@colson.com)

*Of Counsel:*

David T. Pritikin  
Richard A. Cederoth  
Douglas I. Lewis  
John W. McBride  
SIDLEY AUSTIN LLP  
One South Dearborn  
Chicago, IL 60603  
Tel. (312) 853-7000

Brian R. Nester  
SIDLEY AUSTIN LLP  
1501 K Street NW  
Washington, DC 20005  
Tel. (202) 736-8000

**CERTIFICATE OF SERVICE**

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

Respectfully submitted,

/s/Curtis B. Miner  
Curtis B. Miner, Esq.

**SERVICE LIST**

*Motorola Mobility, Inc. v. Microsoft Corp.*, Case No. 1:10-cv-24063-Moreno

Edward M. Mullins  
emullins@astidavis.com  
Hal M. Lucas  
hlucas@astidavis.com  
ASTIGARRAGA DAVIS  
701 Brickell Avenue, 16th Floor  
Miami, FL 33131  
Tel.: (305) 372-8282

Steven Pepe  
Steven.Pepe@ropesgray.com  
Jesse J. Jenner  
Jesse.Jenner@ropesgray.com  
Leslie M. Spencer  
Leslie.Spencer@ropesgray.com  
ROPES & GRAY LLP  
1211 Avenue of the Americas  
New York, NY 10036-8704  
Tel.: (212) 596-9046

Norman H. Beamer  
Norman.Beamer@ropesgray.com  
Mark D. Rowland  
Mark.Rowland@ropesgray.com  
Gabrielle E. Higgins  
Gabrielle.Higgins@ropesgray.com  
ROPES & GRAY LLP  
1900 University Avenue, 6th Floor  
East Palo Alto, CA 94303-2284  
Tel.: (650) 617-4030

Kevin J. Post  
kevin.post@ropesgray.com  
Megan F. Raymond  
megan.raymond@ropesgray.com  
ROPES & GRAY LLP  
One Metro Center  
700 12th Street NW, Suite 900  
Washington, DC 20005-3948  
Tel.: (202) 508-4600

*Counsel for Plaintiff Motorola Mobility, Inc.*