IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

MIRROR WORLDS, LLC,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 6:08-CV-88 LED

JURY TRIAL DEMANDED

APPLE INC.,

Counterclaim Plaintiff,

v.

MIRROR WORLDS LLC,
MIRROR WORLDS TECHNOLOGIES, INC.,

Counterclaim Defendants.

APPLE INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF INVALIDITY FOR INDEFINITENESS UNDER 35 U.S.C. § 112 ¶ 2

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I. INTRODUCTION AND SUMMARY OF ARGUMENT

Defendant and Counterclaim Plaintiff Apple Inc. ("Apple") hereby respectfully moves for partial summary judgment of invalidity for indefiniteness. This motion presents the simple legal question of whether Mirror Worlds LLC's ("Mirror Worlds") means-plus-function claims in the '227 and '427 patents satisfy 35 U.S.C. § 112, ¶ 6. They do not.

Although Mirror Worlds' patents include many means-plus-function claims, their specifications generally fail to disclose the required corresponding structure to support those claims. This failure to disclose adequate corresponding structure results in indefiniteness for two independent reasons. First, for several claim limitations, the patents-in-suit fail to disclose and clearly associate any corresponding structure for actually performing the claimed function.[1] Second, for other claim limitations, the patents-in-suit do disclose corresponding structure as identified in Apple's proposed claim constructions, but Mirror Worlds has disregarded that corresponding structure in favor of generic "computer hardware" and/or "executable code" for performing the claimed function.[2] In both cases, the claims are indefinite as a matter of law.

Mirror Worlds attempts to avoid the consequences of this fatal omission of corresponding structure by pointing to the opinion of its claim construction expert that persons of ordinary skill

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[1] Apple's motion for summary judgment of indefiniteness on this first ground applies to independent claims 1 and 25 of the '227 patent, independent claims 1, 8, 16 and 25 of the '427 patent, and associated asserted dependent claims 2-6, 9-12, and 26-29 of the '227 patent and claims 2, 5, 7, 9-10, 13, 15, 17-19, 22, 24, 26, 29 and 31 of the '427 patent. Because these dependent claims incorporate the requirements of the independent claims from which they depend, indefiniteness of the independent claims infects the corresponding dependent claims. *See, e.g., Fargo Elecs., Inc. v. Iris Ltd., Inc.*, 2005 WL 3241851, at *6 (D. Minn. Nov. 30, 2005) (Exh. A) (holding that indefiniteness of independent claim fatally infected dependent claims).

[2] Apple's motion for summary judgment of indefiniteness on this second ground applies to claims 1, 6, 9, 10, 11, 12 and 25 of the '227 patent and associated asserted dependent claims. Here, summary judgment is appropriate in the event the Court adopts Mirror Worlds' proposed corresponding structure of generic "computer hardware" and/or "executable code" for performing the function recited in thirteen disputed limitations in those claims. Should the Court adopt Apple's proposed corresponding structure for those limitations, this second basis for summary judgment would be moot.

in the art could come up with possible ways to implement the claimed functions. He contends that a person of skill in the art could infer possible configurations of computer hardware and/or software that might be implemented to somehow perform the claimed functions. But none of these possible configurations is disclosed in the specifications nor does Mirror Worlds suggest that they are. Of course, expert speculation as to the different ways in which the claimed functions ***might*** be performed or generic hardware and/or software ***might*** be implemented to perform those functions is no substitute for an actual disclosure of adequate corresponding structure. The claims at issue here are indefinite under Section 112, ¶ 2 as a matter of law.

II. STATEMENT OF THE ISSUES TO BE DECIDED

The issues presented by this motion are whether: (1) independent claims 1 and 25 of the '227 patent, independent claims 1, 8, 16 and 25 of the '427 patent and all associated asserted dependent claims are invalid for indefiniteness because they include (or depend on a claim that includes) a means-plus-function limitation for which no corresponding structure is disclosed in the specification; and (2) claims 1, 6, 9, 10, 11, 12 and 25 of the '227 patent and all associated asserted dependent claims are invalid for indefiniteness under Mirror Worlds' proposed claim constructions because Mirror Worlds' identification of generic corresponding structure for performing the claimed function is insufficient as a matter of law.

III. STATEMENT OF UNDISPUTED MATERIAL FACTS

The following material facts are undisputed:

1. If the limitation is governed by Section 112, ¶ 6,[3] Mirror Worlds' proposed corresponding structure for the "means for selecting a timestamp to identify each data unit"

[3] Mirror Worlds contends that these limitations are not subject to Section 112, ¶ 6 as a threshold matter. As will be addressed in detail in Apple's Claim Construction Brief Re Mirror Worlds' Patents, there is not sufficient structure recited in the claims to remove them from the ambit of Section 112, ¶ 6. Thus, Apple respectfully requests that the Court consider the inadequacy of the disclosure of corresponding structure raised in this motion.

limitation of claim 1 of the '227 patent is "executable code that selects the timestamp for a data unit based on the present time or a time designated by the user, and equivalents thereof."

2. If the limitation is governed by Section 112, ¶ 6, Mirror Worlds' proposed corresponding structure for the "means for associating each data unit with at least one chronological indicator having a respective timestamp which identifies the data unit" limitation of claim 25 of the '227 patent is "executable code implementing the main stream, and equivalents thereof."

3. If the limitation is governed by Section 112, ¶ 6, Mirror Worlds' proposed corresponding structure for the "means for selecting for which data units are represented on the display device by selecting one of the document representations and displaying document representations corresponding to data unit having timestamps within a range of a timepoint" limitation of claim 25 of the '227 patent is "the graphical stream view, and equivalents thereof."

4. If the limitation is governed by Section 112, ¶ 6, Mirror Worlds has not identified any proposed corresponding structure for the "document organizing facility" limitation of claims 1, 8 , 16 and 25 of the '427 patent.

5. For each of thirteen means-plus-function limitations of the '227 patent,[4] Mirror Worlds' proposed corresponding structure is "computer hardware and executable code" or "executable code" for performing the claimed function.

IV. ARGUMENT

A. Summary Judgment of Indefiniteness Is Appropriate Where Means-Plus-Function Limitations Lack Adequate Supporting Disclosure

The law is clear that, for means-plus-function limitations, a patent must disclose and clearly link or associate meaningful corresponding structure for performing claimed function.

[4] A complete list of these limitations is provided in Section IV.C *infra*.

See Biomedino, LLC v. Waters Techs. Corp., 490 F.3d 946, 950 (Fed. Cir. 2007); *Maurice Mitchell Innov., L.P. v. Intel Corp.*, 2006 WL 3447632, at *22 (E.D. Tex. Nov. 22, 2006) (Exh. B), *aff'd*, 2007 WL 2777968 (Fed. Cir. Sept. 24, 2007) (Exh. C). This disclosure must be in the patent specification itself. "It is not proper to look to the knowledge of one skilled in the art apart from and unconnected to the disclosure of the patent" for the identification of corresponding structure. *Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1212 (Fed. Cir. 2003). Moreover, "[i]n a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1349 (Fed. Cir. 1999).

Where an applicant fails to disclose adequate corresponding structure for performing the claimed function ***and*** clearly link or associate that structure to the function, the claim is invalid as indefinite. *Default Proof Credit Card Sys., Inc. v. Home Depot, Inc.*, 412 F.3d 1291, 1298 (Fed. Cir. 2005). In such cases, summary judgment of invalidity under 35 U.S.C. § 112, ¶2 is appropriate as a question of law "drawn from the court's performance of its duty as the construer of patent claims." *Id.*; *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008); *Maurice Mitchell*, 2006 WL 3447632, at *2-*5 (Exh. B). This is precisely such a case.

B. Claims 1 And 25 Of The '227 Patent And Claims 1, 8, 16 And 25 Of The '427 Patent And All Associated Dependent Claims Are Indefinite

1. The '227 Patent Fails To Disclose Structure For The "Means For Selecting A Timestamp To Identify" And "Means For Associating … Timestamp Which Identifies" ('227 claims 1 & 25)

As will be explained in more detail in Apple's Claim Construction Brief Re Mirror Worlds' Patents, a person of ordinary skill reviewing the '227 patent would understand that the phrase "timestamp to identify" refers to "a date and time value that ***uniquely*** identifies each

document." Mirror Worlds' own claim construction expert Dr. Levy admits that, in the claimed system, a timestamp "needs to be ***unique*** for the documents to be placed in the mainstream." Exh. D [Levy Tr.] at 109:21-110:14.[5]

It is undisputed that a "timestamp" consisting of a date and time value is a well-known and commonly-used computer software structure but, alone, will not uniquely identify documents. As Dr. Levy explains, "one of ordinary skill in the art would understand that, while the timestamp is based on time, it may be unsuitable as an identifier based on its date and time value alone." Exh. E [Levy Rpt.] at 12. This makes sense. There can of course be instances in which documents will have the exact same date and time value—for example, if two emails are received at the same time or if a new document is created at the same time an email is received. In such circumstances, no matter how granular a date-and-time timestamp, it would not alone be enough to distinguish between the two documents. To account for this, Dr. Levy explains that "further information must [be] used in addition to the date and time in order to identify data units." Exh. D [Levy Tr.] at 110:15-112:3. And as Apple's expert Dr. Feiner explains, "the function of 'selecting a timestamp to identify each data unit' is not performed with just a 'timestamp.'" Exh. F [Feiner Rpt.] at 8-12. In other words, both parties' experts ***agree*** that there needs to be something more than just a date-and-time timestamp to ensure that each document is uniquely identified.

Here, that something more is not just a technological requirement, but a legal one. In drafting the '227 patent, Mirror Worlds purposely availed itself of Section 112, ¶ 6 functional claiming. Yet Mirror Worlds has not fulfilled the legal requirements for claiming in that format. The '227 patent does not disclose any structure for the unique identification of documents, let

[5] All exhibit citations herein are to the Declaration of Sonal N. Mehta in Support of Apple Inc.'s Motion For Partial Summary Judgment Of Invalidity For Indefiniteness Under 35 U.S.C. § 112, ¶ 2. Unless otherwise noted, all emphases to quoted text are added.

alone clearly link and associate such structure with that function. *Id.* (opinion of Apple's expert that "there is not sufficient structure disclosed" in the '227 patent). Nor has Mirror Worlds' pointed to any disclosure of such structure in the patent. *See* Joint Claim Construction Statement ("JCCS") at Exhibit B, pp. 6-7 (identifying only generic "executable code" for selecting a timestamp but failing to identify any structure for ***uniquely*** identifying documents); *see also* Exh. E [Levy Rpt.] at 26-27 (identifying structure for selection of timestamp but not the "further information" that must be used in addition to the date and time in order to identify data units uniquely). The '227 patent is simply silent on this critical issue.

Unable to point to the required structure in the patent itself, Mirror Worlds relies on its expert Dr. Levy to try to plug the holes in its patent disclosure. Dr. Levy contends that "one of ordinary skill in the art would also understand that timestamps, as frequently used in various software applications, identify data items on the basis of timestamps based on the date and time ***plus additional information***." Exh. E [Levy Rpt.] at 12. But Dr. Levy never explains what this additional information is or where it is disclosed in the '227 patent. *Id.* To the contrary, Dr. Levy acknowledges that there is no explicit recognition in the '227 patent that something more than date and time is necessary to uniquely identify documents. Instead, the patent "simply leave[s] one of ordinary skill in the art to understand that when the date and time values are not sufficient to create a unique identifier, that ***something in addition will be needed.***" Exh. D [Levy Tr.] at 111:4-112:9.

According to Dr. Levy, he (and presumably others of ordinary skill in the art) can imagine a number of possible scenarios for "something in addition" to a timestamp to uniquely identify documents. *Id.* at 112:4-119:9 (admitting that there is no disclosure in the specification regarding what fields or values would constitute such additional information; but arguing that one of ordinary skill would understand that additional information "needed to be used," and

identifying examples of what additional information could be used).[6] Apple's expert agrees. Exh. F [Feiner Rpt.] at 11-12 ("Various solutions occur to me. … [Any o]ne of the approaches that I have outlined above would allow the creation of timestamps that uniquely identify documents. However, none of these solutions is disclosed in the Mirror Worlds patents, nor is any other solution disclosed."). In other words, both sides' experts **agree** that one could imagine a number of ways to uniquely identify documents, but that none is actually disclosed.

Of course, "[t]hat ordinarily skilled artisans could carry out the recited function in a variety of ways is ***precisely why*** claims written in 'means-plus-function' form ***must disclose the particular structure*** that is used to perform the recited function." *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371, 1385 (Fed. Cir. 2009). The indefiniteness inquiry asks "whether one of skill in the art would understand the specification itself to disclose the structure [clearly linked to the function], not simply whether that person would be capable of implementing that structure." *Biomedino,* 490 F.3d at 951. Because the applicant bears the burden to "clearly link and associate corresponding structure with the claimed function," it is simply not relevant whether one of skill in the art could create structure sufficient to perform the recited function. *Touchcom, Inc. v. Dresser, Inc.*, 427 F. Supp. 2d 730, 736 (E.D. Tex. 2005); *see also Maurice Mitchell*, 2006 WL 3447632, at *2 (Exh. B).

In sum, the '227 patent specification contains no description of the structure or process used to ***uniquely*** identify documents in the claimed system. "'[T]he testimony of one of ordinary skill in the art cannot supplant the total absence of structure from the specification.'" *Biomedino*, 490 F.3d at 950 (quoting *Default Proof*, 412 F.3d at 1302). The limitation is thus indefinite.

[6] Dr. Levy was unable to identify any real-world applications where such hypothetical "additional information" is actually employed. Exh. D [Levy Tr.] at 112:25-118:17.

2. The ‘227 Patent Provides No Structure For The “Means For Selecting…Within A Range Of A Timepoint” (‘227 claim 25)

As will be explained in more detail in Apple’s Claim Construction Brief Re Mirror Worlds’ Patents, the “means for selecting which data units are represented on the display device by selecting one of the document representations and displaying document representations corresponding to data units having timestamps within a range of a timepoint” limitation of claim 25 of the ‘227 patent should be construed to be governed by Section 112, ¶ 6 because the limitation does not itself disclose sufficient structure to remove it from the ambit of that section. Instead, the claim includes the purely functional requirement that the system permit a user to select a specific set of documents to be displayed based on a desired time range (e.g., that the user can select a date and display documents within *x* days that date).

Mirror Worlds asserts that the specification’s disclosure of a “graphical stream view” is structure corresponding to this claimed function. *See* JCCS at Exhibit B, pp 14; Exh. E [Levy Rpt.] at 36-37. But that is insufficient to satisfy Section 112, ¶ 6 because the claim language requires enabling the user to select a set of documents based on a desired time range. All that the patent discloses—and that Mirror Worlds points to—is the selection of a particular document. Although additional documents are displayed to fill the screen, there is no indication that these documents are within a specified range of the selected document, let alone a structure for how such a selection process would be implemented. The limitation is thus indefinite.

3. The ‘427 Patent Does Not Disclose Structure For The “Document Organizing Facility” (‘427 claims 1, 8, 16 & 25)

As will be explained in more detail in Apple’s Claim Construction Brief Re Mirror Worlds’ Patents, the “document organizing facility” limitation of claims 1, 8, 16 and 25 of the ‘427 patent should be construed to be governed by Section 112, ¶ 6 because a person of ordinary skill in the art would not understand “document organizing facility” to refer to a particular

structure or class of structures, but rather as any generic structure for organizing documents.

Apple respectfully submits that, if the limitation is construed to be subject to Section 112, ¶ 6, as it should be, it is indefinite as a matter of law. Neither Mirror Worlds nor its expert Dr. Levy has identified any structure corresponding to the "document organizing facility" limitation, nor does the '427 patent disclose any. Instead, Mirror Worlds simply argues that the "document organizing facility" of the claims is any "software that organizes documents." *See* JCCS at Exhibit B, pp. 15-17; Exh. E [Levy Rpt.] at 38-39 ("[I]n the software context, one of ordinary skill in the art would understand that the term 'facility' refers to a software module or set of modules."). Of course, as described in Section IV.C *infra*, the recitation of generic "software" or "software modules" as purported corresponding structure is legally inadequate. This is especially true here, where Mirror Worlds does not even argue that the "software that organizes documents" is linked or associated to the function of the "document organizing facility" as required under Section 112, ¶ 6. The limitation is accordingly indefinite.

C. Claims 1, 6, 9, 10, 11, 12 and 25 Of The '227 Patent And All Associated Dependent Claims Are Indefinite Under Mirror Worlds' Proposed Constructions

A second independent basis for summary judgment exists for thirteen limitations of the '227 patent[7] for which Mirror Worlds has disregarded the patent's disclosure of corresponding

[7] The limitations at issue are:

- "means for generating a main stream of data units...the main stream for receiving each data unit received by or generated by the computer system" ('227 claims 1 & 25)
- "means for generating … at least one substream" ('227 claims 1 & 25)
- "means for receiving data units from other computer systems" ('227 claim 1)
- "means for generating data units by the computer system" ('227 claim 1)
- "means for associating each data unit with at least one chronological indicator having the respective timestamp" ('227 claim 1)
- "means for including [each data unit according to the timestamp in the respective chronological indicator in the main stream]" ('227 claims 1 & 25)
- "means for maintaining the main stream and the substreams as persistent streams" ('227 claims 1 & 25)

structure and instead identified only generic "executable code" or "computer hardware and executable code" for performing the claimed function. *See* JCCS at Exhibit B, pp. 7-17.

Both the Federal Circuit and this Court have flatly (and repeatedly) rejected this sort of approach to corresponding structure as flying in the face of the definiteness requirement for computer-implemented means-plus-function claims. For such claims, the specification must disclose not merely the existence of a computer or generic software on a computer, but also the ***specific algorithm*** used to perform the function. *See, e.g., i4i Ltd. Partnership v. Microsoft Corp.*, No. 6:07CV113, slip op. at 18-19 (E.D. Tex. Apr. 10, 2008) (Exh. G) ("[I]f the specification merely states a computer or microprocessor performs the claimed function, the specification does not disclose adequate structure and the claim is indefinite. … Similarly, the specification does not disclose sufficient structure if it simply describes the outcome of the claimed function and does not disclose a computer programmed to execute a particular algorithm."); *Aristocrat Techs. Ltd. v. Int'l Game Tech.*, 521 F.3d 1328, 1333 (Fed. Cir. 2008) (holding disclosure of a general purpose computer programmed to perform "very different tasks in very different ways" as corresponding structure "amounts to pure functional claiming").

Notwithstanding this clear and binding precedent, Mirror Worlds' proposed construction fails to identify ***any*** specific algorithm for performing the claimed function. Nowhere in Mirror Worlds' proposed constructions is there any identification of how generic executable code is to

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- "means for displaying alternative versions of the content of the data units" ('227 claim 6)
- "means for archiving a data unit associated with a timestamp older than a specified time point while retaining the respective chronological indicator and/or a data unit having a respective alternative version of the content of the archived data unit" ('227 claim 9)
- "means for operating on any of the streams using a set of operations selected by a user" ('227 claim 10)
- "means to generate substreams from existing substreams" ('227 claim 11)
- "means for generating a data unit comprising an alternative version of the content of another data unit" ('227 claim 12)
- "means for associating the alternative version data unit with the chronological indicator of the another data unit" ('227 claim 12)

perform the claimed functions, let alone any specific algorithm. To the contrary, Mirror Worlds' expert Dr. Levy admits that the specification provides no specific executable code for performing the claimed functions and, at best, requires one of ordinary skill in the art to infer that executable code could be written to perform some sort of algorithm to achieve the claimed function under Mirror Worlds' constructions. Exh. D [Levy Tr.] at 224:9-11 ("Q. But the executable code itself isn't disclosed in the '227 application, is it? A. Only by inference."); *see also id.* at 224:12-226:25, 229:3-230:16, 237:12-241:12 (testimony of Mirror Worlds' expert that '227 patent does not explicitly disclose executable code for the means-plus-function limitations at issue).

Thus, insofar as the Court does not adopt Apple's proposed constructions in the parallel claim construction proceedings, Apple respectfully submits that it should enter partial summary judgment of indefiniteness under Mirror Worlds' construction. *See, e.g., i4i*, slip op. at 21-22 (Exh. G) (granting summary judgment of indefiniteness of independent claim and all claims that depend on it where "[i]n total, the specification does not disclose any algorithm, as it merely states that a computer programmed to 'provid[e] a menu of metacodes to said metacode storage means' is capable of 'providing a menu of metacodes to said metacode storage means'" and did not disclose any algorithm); *see also Computer Acceleration Corp. v. Microsoft Corp.*, 516 F. Supp. 2d 752, 766 (E.D. Tex. 2007) (rejecting patent holder's proposed corresponding structure as "software that" performs the claimed function because "[t]his merely restates the function" and thus "is not sufficient disclosure of structure"); *Finisar Corp. v. DirecTV Group, Inc.*, 416 F. Supp. 2d 512, 519 (E.D. Tex. 2006) (rejecting patent holder's citation to "software 132" as corresponding structure because it was merely a box labeled with the function to be performed by the software and thus "nothing more than a restatement of the function, as recited in the claim"). Mirror Worlds' proposed constructions simply do not identify the requisite corresponding structure for the claims to be definite.

V. CONCLUSION: RELIEF REQUESTED

For the foregoing reasons, Apple respectfully requests that the Court enter partial summary judgment of invalidity of independent claims 1 and 25 of the '227 patent, independent claims 1, 8, 16 and 25 of the '427 patent and all associated dependent claims for indefiniteness. In addition, Apple respectfully requests that, if the Court were to adopt Mirror Worlds' proposed constructions, the Court should also enter partial summary judgment of invalidity of claims 1, 6, 9, 10, 11, 12 and 25 of the '227 patent and all associated asserted dependent claims for indefiniteness under Mirror Worlds' proposed corresponding structure of generic "computer hardware" and/or "executable code" for performing the claimed functions.

Dated: December 22, 2009

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on this 22nd day of December, 2009. As of this date, all counsel of record have consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A).

/s/ *Steven C. Cherensky*
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