

**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 OPPOSITION TO MIRROR WORLDS TECHNOLOGIES INC.'S  
MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF  
U.S. PATENT NO. 6,613,101**

**TABLE OF CONTENTS**

	<b>Page</b>
I. INTRODUCTION AND SUMMARY OF ARGUMENT .....	1
II. BACKGROUND .....	3
A. Apple’s Piles Patent .....	3
B. The Asserted Claims and Claim Construction of the Piles Patent.....	4
C. Nicol and Levine.....	5
III. LEGAL STANDARD.....	5
IV. ARGUMENT .....	7
A. Nicol And Levine Do Not Disclose “A Collection Of Two Or More Document Icons Displayed Together” That Can Be Browsed In Series To Display Indicia Of The Documents In The Collection .....	7
1. Levine Does Not Disclose A Collection Of Document Icons Wherein Indicia Of The Document Icons Are Displayed In Series.....	7
2. “A Collection Of Two Or More Document Icons Displayed Together” Means That The Document Icons Are Displayed In A Pile Or Stack .....	8
3. Nicol Does Not Teach A Pile Of Document Icons Wherein Different Indicia Are Displayed Based On Which Document Icon Is Selected .....	10
B. Even If Nicol Was Found To Disclose “Two Or More Document Icons Displayed Together,” The Combination With Levine Does Not Invalidate Because Nicol Does Not Disclose Displaying Indicia Of Documents .....	11
C. One Of Ordinary Skill In The Art Would Not Be Motivated To Combine Nicol With Levine.....	12
D. Secondary Considerations Of Non-Obviousness, Including Long-Felt Need And Praise, Require The Denial Of MWT’s Motion .....	13
V. CONCLUSION.....	15

## TABLE OF AUTHORITIES

	<b>Page(s)</b>
<b>CASES</b>	
<i>Abbott Labs. v. Sandoz, Inc.</i> , 544 F.3d 1341 (Fed. Cir. 2008).....	6, 12
<i>Eli Lilly &amp; Co. v. Barr Labs., Inc.</i> , 251 F.3d 955 (Fed. Cir. 2001).....	5, 12
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	6
<i>Hewlett-Packard Co. v. Bausch &amp; Lomb Inc.</i> , 909 F.2d 1464 (Fed. Cir. 1990).....	5
<i>J.T. Eaton &amp; Co. v. Atlantic Paste &amp; Glue Co.</i> , 106 F.3d 1563 (Fed. Cir. 1997).....	14
<i>KSR Int’l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007).....	6, 13
<i>Schumer v. Lab. Computer Sys., Inc.</i> , 308 F.3d 1304 (Fed. Cir. 2002).....	5
<i>Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.</i> , 492 F.3d 1350 (Fed. Cir. 2007).....	6
<i>Windsurfing Int’l, Inc. v. AMF Inc.</i> , 782 F.2d 995 (Fed. Cir. 1986).....	6
<b>STATUTES</b>	
35 U.S.C. § 282.....	5

## I. INTRODUCTION AND SUMMARY OF ARGUMENT

Apple respectfully requests that the Court deny Mirror Worlds Technologies Inc.’s (“MWT”) motion for summary judgment that claims 1-12 of Apple’s U.S. Patent No. 6,613,101 (the “Piles patent”) are obvious, because there are fundamental issues of fact that need to be decided by the jury.<sup>1</sup> These issues include the differences between the claimed invention and the prior art, the motivation to combine prior art references, and whether secondary considerations support a finding of non-obviousness. Under the basic standards of obviousness set forth in *Graham v. John Deere* and *KSR*, factual issues abound and MWT’s motion should be denied.

First, MWT misinterprets the Court’s preliminary claim construction order in arguing that U.S. Patent No. 5,287,448 to Nicol (“Nicol”), in view of U.S. Patent No. 5,060,135 to Levine (“Levine”), renders the asserted claims of the Piles patent obvious. Nicol, alone or in combination with Levine, cannot display “indicia” of different documents based on selecting different positions on “a collection of two or more document icons displayed together.” In the context of the Piles patent and as Apple argued during claim construction, the term “displayed together” means that the document icons are displayed together in a “pile” or stack. Nicol does not display document icons, let alone in a pile or stack. Levine also does not disclose displaying different “indicia” depending on the selection of different document icons in a collection. Therefore, the alleged combination of Nicol and Levine cannot render the asserted claims of the Piles patent obvious.

---

<sup>1</sup> MWT’s surprise invalidity defense is unfairly prejudicial and has required Apple and its expert, Dr. Steven K. Feiner, to prepare a response with limited time and virtually no discovery. (See Apple’s Motion To Strike the Surprise Expert Reports of John Levy (Docket No. 205).) Apple, therefore, reserves its right to supplement its position on the validity of the Piles patent, if MWT is permitted to proceed with this defense.

Further, MWT’s motion rehashes an argument that MWT made during claim construction and which was rejected by this Court. MWT argued during claim construction that Apple had defined the claim term “graphical iconic representation of a collection . . . of documents” as a single icon representing the collection of documents. (Ex.<sup>2</sup> 1 at pp. 8-9.) MWT asserted that Apple had adopted this definition by distinguishing the prior art on the basis that the prior art did not teach the display of different indicia by selecting different positions on the same icon. (*Id.*) Apple successfully argued, however, that the distinction made during prosecution *also applied to its proposed construction*, which was adopted by the Court—“a collection of two or more document icons displayed together.” (See Ex. 2 at pp. 5-6; Docket No. 178 (preliminary order adopting Apple’s proposed construction).) MWT’s second shot at this issue should again be denied.

*Second*, MWT’s motion should be denied because Nicol does not display “indicia” of documents, as required by the asserted claims. MWT admits as much by recognizing that Nicol does not even display document icons. (MWT’s Motion at p. 12.) Thus, Nicol necessarily does not display indicia of documents. In this way, Nicol in combination with Levine would not invalidate the asserted claims even if Nicol was found to display “a collection of two or more document icons displayed together.”

*Third*, one of ordinary skill in the art would not be motivated to combine Nicol with Levine. Nicol and Levine are directed to unrelated subject matter and the references teach away from any possible combination.

*Lastly*, objective evidence supports the non-obviousness of the asserted claims of the Piles patent. For example, before the invention disclosed in the Piles patent and its parent, U.S.

---

<sup>2</sup> “Ex.” refers to the Exhibits to the Declaration of Jeffrey G. Randall except as noted otherwise.

Patent No. 6,243,724 (the “’724 patent”), there was a long-felt need for an improvement to the existing hierarchical and flat file systems for document organization. The Piles patent addressed this long-felt need by describing a new “piles” metaphor for organizing and searching for documents in intuitive piles or stacks.

For these reasons and the reasons outlined below, MWT’s motion should be denied because genuine issues of material fact preclude an order of summary judgment that the asserted claims of the Piles patent are obvious over Nicol in view of Levine.

## **II. BACKGROUND**

The application that led to the ‘724 patent—the parent of the Piles patent—was subject to close scrutiny during prosecution by the Examiner at the United States Patent and Trademark Office (“PTO”) and the PTO’s Board of Patent Appeals and Interferences. (*See, e.g.*, Ex. 3 at APMW0025579-636.) The Piles patent issued as a continuation of the application that led to the ‘724 patent. (Ex. 4 at APMW0010191.)

### **A. Apple’s Piles Patent**

The Piles patent describes an improved file-organizing interface. The improved user interface is based on a “piles” metaphor, which facilitates organizing and browsing through files. (*Id.* at 2:58-62.) The user interface of the Piles patent displays “piles” using a graphical iconic representation of a stack of documents. (*Id.* at, *e.g.*, 2:65-3:1, 3:13-18.)

In the Piles interface, a user can place a cursor over a document in a pile to preview that document in a “view cone” next to the pile. (*Id.* at 3:22-25.) The Piles patent defines the preview as an “indicia,” which is an item “indicating the content of the document, thereby providing the user with information concerning what the representation represents (i.e. what is contained within the document).” (*Id.* at 7:10-14.) The Piles patent further explains that examples of “indicia” include “the first page of a document” (*id.*), a “full-size reproduction of

the document” (*id.* at 12:67-13:2), the size of the document (*id.* at Fig. 4e), and “the most characteristic words” in the document (*id.* at 10:50-55).

**B. The Asserted Claims and Claim Construction of the Piles Patent**

Apple has accused MWT’s Scopeware products of infringing claims 1-12 of the Piles patent. The three independent asserted claims—claims 1, 5, and 9—all share the same basic elements, and all relate to an interface that allows users to browse through a collection of documents (*e.g.*, a pile) by allowing the user to scan through the collection by passing a cursor over the documents to obtain a display of an “indicia.” For example, claim 1 recites (with the operative terms for purposes of this opposition highlighted):

1. A method for organizing and viewing information in a computer filing system having a display device and a first plurality of documents, said method comprising:

displaying *a graphical iconic representation of a collection of said first plurality of documents*;

*displaying a first indicia of a first document* of said collection by selecting a first position from said graphical iconic representation, wherein said first position on said graphical iconic representation is capable of being at any one of a plurality of locations on said graphical iconic representation and wherein said selecting from said graphical iconic representation comprises positioning a cursor on said graphical iconic representation; and

*displaying in series a second indicia of a second document and a third indicia of a third document* by positioning said cursor first on a second position on said graphical iconic representation next on a third position on said graphical iconic representation.

(Ex. 4 at 37:30-48.)

The Court has adopted Apple’s proposed construction of the phrase “a graphical iconic representation of a collection of . . . documents” as “a collection of two or more document icons displayed together.” (Docket No. 178.) Apple’s proffered construction for this term was based,

in part, on the fact that document icons are “displayed together” in a “pile” or stack. (Ex. 5 at pp. 6, 10-15; Ex. 2 at pp. 2-3.)

### **C. Nicol and Levine**

Both Nicol and Levine were considered by the PTO Examiner during prosecution of the parent application of the Piles patent. (*E.g.*, Ex. 6 at APMW0025565-566.) Nicol discloses the separate display of individual icons. (Ex. 7 at Figs. 2 and 3; *see also* MWT’s Motion at pp. 7-8.) The icons in Nicol represent tasks or commands. (Ex. 7 at 3:27-30, 7:15-20.) When an icon in Nicol is selected by a user, help information from a stored database of help messages explains the function performed by the command that is represented by the icon. (*Id.* at 2:15-31, 4:36-42, 6:23-28, 8:2-11 and Fig. 2.)

Levine discloses using an image of a stack of document representations (called “stamps” in Levine) to represent a collection of documents. (Ex. 8 at Fig. 3.) However, only the top document on the stack can be viewed. (*E.g.*, *id.* at Fig. 3, 4:41-45, 12:45-53.) Specifically, only the top document in the stack can be selected for a full-screen view: “The stamp **75** on top of the aligned stack **70** is the only stamp in that stack which may be selected and/or removed from the aligned stack[.]” (*Id.* at 12:50-53.)

### **III. LEGAL STANDARD**

MWT must satisfy a high burden to invalidate the asserted claims of the Piles patent, particularly on summary judgment. *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1316 (Fed. Cir. 2002) (“The burden of proving invalidity on summary judgment is high”). An issued patent is presumed to be valid. 35 U.S.C. § 282. Invalidity must be demonstrated by clear and convincing evidence. *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 962 (Fed. Cir. 2001). The Federal Circuit has stated that the burden is more difficult to carry when relying on prior art that was considered by the examiner. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d



1464, 1467 (Fed. Cir. 1990) (reiterating that meeting the clear and convincing evidence standard is especially difficult when relying on PTO-considered art). This burden is even greater with respect to a patent that has been scrutinized by the Board of Patent Appeals and Interferences. *Windsurfing Int'l, Inc. v. AMF Inc.*, 782 F.2d 995, 998 (Fed. Cir. 1986). Here, given the multiple layers of scrutiny that the Piles patent received in the PTO and the fact that MWT is relying on prior art that was extensively considered by the PTO, the burden on MWT is extremely high.

Further, courts have long recognized the need to “guard against slipping into use of hindsight” when considering whether an invention would have been obvious at the time of the invention. *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (internal quotations omitted). To combat the tendency towards hindsight, the Supreme Court has enumerated four factors to be considered by courts to assess whether an invention is obvious. *See Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1356-57 (Fed. Cir. 2007) (citing *Graham*, 383 U.S. at 17-18). The four factors are: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed subject matter and the prior art; and (4) secondary considerations, or “objective indicia of non-obviousness.” *Takeda Chem. Indus., Ltd.*, 492 F.3d at 1363; *see also KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 405 (2007).

The law of obviousness has not substantially changed in the wake of *KSR*. 550 U.S. at 406; *Takeda Chem. Indus., Ltd.*, 492 F.3d at 1356-57. *KSR* acknowledged that evaluations of teaching, suggestion, and motivation remain relevant, if not rigidly applied. *KSR*, 550 U.S. at 406. Issues of teaching, suggestion, and motivation provide helpful insight to an obviousness inquiry. *Id.* Just because art exists, there is not an automatic motivation to combine that art without a showing that a practitioner would have some reason to do so. *Abbott Labs. v. Sandoz, Inc.*, 544 F.3d 1341, 1352 (Fed. Cir. 2008).

#### IV. ARGUMENT

##### A. Nicol And Levine Do Not Disclose “A Collection Of Two Or More Document Icons Displayed Together” That Can Be Browsed In Series To Display Indicia Of The Documents In The Collection

MWT’s motion should be denied because Nicol and Levine, alone or in combination, do not disclose “a collection of two or more document icons displayed together” that allows a user to “display[] in series” indicia of the different document icons in the collection. Each of the asserted independent claims—claims 1, 5 and 9—require these limitations. As such, Apple respectfully requests that MWT’s motion be denied in full.

##### 1. Levine Does Not Disclose A Collection Of Document Icons Wherein Indicia Of The Document Icons Are Displayed In Series

Levine does not disclose the “displaying in series” of different indicia based on the selection of different document icons in “a collection of two or more document icons displayed together,” as required by the claim language of the Piles patent. (Feiner Decl.<sup>3</sup> at ¶¶ 16 & 17.) Instead, Levine discloses using an image of a stack of document representations (called “stamps” in Levine) to represent a collection of documents. (Ex. 8 at Fig. 3.) Apple explained to the PTO that, unlike the system described in the Piles patent, which allows the user to rifle through the documents icons in the pile, the stacks in Levine are “dumb” because only the top document on the stack can be viewed, and all the documents in the stack are treated as a whole. For example, Apple argued to the PTO the following points:

In many ways, the Levine system with its stack of stamps represents nothing more than a “dumb” collection of documents without the features of the present invention. . . . [T]here is no disclosure or suggestion in Levine that any of the documents in a collection of documents may be viewed by displaying an indicia of

---

<sup>3</sup> “Feiner Decl.” refers to the Declaration of Steven K. Feiner, Ph.D. Dr. Feiner is a Professor of Computer Science at Columbia University and has been retained by Apple as an expert in this case.

the document. Rather, in Levine, only the document which is the top stamp on the top of a stack can be viewed in a full screen mode by selecting it.

(Ex. 9 at APMW0025490.) Apple contrasted the invention of the Piles patent accordingly:

[T]he graphical representation of a collection of document comprises a ‘pile’ of documents that is dynamically altered as documents are added to or removed from the pile, and the icon for each document in the pile may be selected by positioning the cursor over the icon in the pile. . . . A user may ‘ruffle’ through the documents of the pile and display indicia of the documents as the user ‘ruffles’ by moving the cursor from document to document within the pile.

(Ex. 3 at APMW0025585-586.)

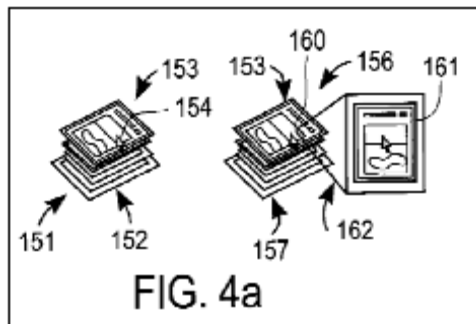
Indeed, the PTO Board of Patent Appeals and Interferences accepted Apple’s position and found that neither Nicol or Levine disclose the browsing functionality that is described and claimed in the Piles patent. (*See* Ex. 10 at APMW0025709-710 (“With respect to claim 84, it calls for “displaying in series a second indicia . . . and a third indicia . . . representation” (claim 84, lines 4 to 7). We have reviewed the Examiner’s position . . . and find that the Examiner has not established a prima facie case to reject this claim.”).) Thus, another prior art reference would need to be combined with the “stack of stamps” disclosed in Levine to teach the claimed browsing functionality because Levine does not disclose the display of different “indicia” depending on the selection of different document icons in a stack or pile of document icons. (*See* Feiner Decl. at ¶¶ 16 & 17.)

**2. “A Collection Of Two Or More Document Icons Displayed Together” Means That The Document Icons Are Displayed In A Pile Or Stack**

MWT appears to argue that Nicol discloses the browsing functionality required by the Piles patent, but which is missing from Levine. (*See* MWT’s Motion at pp. 11-17.) MWT has ignored, however, a fundamental tenet of the Piles patent in arguing that Nicol discloses “a collection of two or more document icons displayed together.” The Piles patent describes a user

interface for a computer system where documents are organized in “piles” or stacks. Apple’s proposed construction of the phrase “graphical iconic representation of a collection . . . of documents” as “a collection of two or more document icons displayed together” was informed and compelled by this “piles” metaphor. Thus, when the Court adopted Apple’s proposed construction, one of ordinary skill in the art would understand that “displayed together” means that the document icons are displayed together in a “pile” or stack. (Feiner Decl. at ¶¶ 10 & 11.) Apple’s proposed construction was explicitly premised on this fact.

Specifically, the user interface of the Piles patent displays “piles” using a graphical iconic representation of a stack of documents. (Ex. 4 at 2:65-3:1; 3:13-18.) In fact, the only disclosure in the Piles patent of a collection of documents that can display indicia in series is in a pile or stack. (See Ex. 4; Feiner Decl. at ¶ 11.) The figure below shows examples of a collection of two or more document icons displayed together in a pile or stack:



(*Id.* at Fig. 4a.)

During claim construction, Apple expressly grounded its proposed construction of the phrase “graphical iconic representation of a collection . . . of documents” on the display of documents in a pile or stack. For example, Apple argued that this claim limitation “requires displaying a graphical iconic representation of a collection of documents, *e.g.*, **displaying a ‘pile.’**” (Ex. 5 at p. 6 (emphasis added).) Further, Apple stated that its construction

is based [on] statements such as this one: “The graphical representation 55 of Fig. 2b includes a collection of document icons which have *been stacked together . . . to represent a pile or collection of documents.*” Piles patent at 7:16-22. As this passage shows, the graphical representation of the collection is made up of *multiple smaller icons stacked together.*

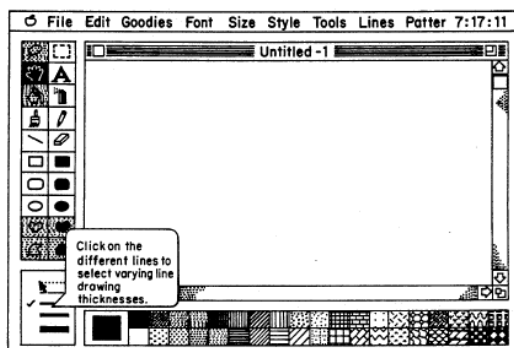
(Ex. 2 at p. 3 (emphasis added).)

The Court has adopted Apple’s construction of the phrase “graphical iconic representation of a collection . . . of documents” to mean “a collection of two or more document icons displayed together.” (Docket No. 178). As such, it is clear that displaying a collection of two or more document icons means that the document icons are “displayed together” in a pile or stack. (See Feiner Decl. at ¶¶ 10 & 11.)

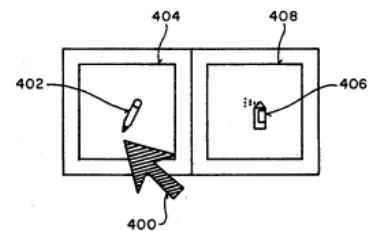
### 3. Nicol Does Not Teach A Pile Of Document Icons Wherein Different Indicia Are Displayed Based On Which Document Icon Is Selected

This fact is fatal to MWT’s motion because Nicol does not disclose a stack or pile of document icons and therefore cannot display different indicia based on selecting different positions on “a collection of two or more document icons displayed together,” as MWT argues. (MWT’s Motion at pp. 11-17.) Instead, Nicol discloses the separate display of individual icons:

**FIG 2**



**FIG 3**



(Ex. 7 at Figs. 2 and 3; see also Feiner Decl. at ¶ 18.)

Indeed, MWT’s expert implicitly recognized in his previously-served expert report<sup>4</sup> that overlapping or stacked document icons are not disclosed in Nicol and that overlapping or stacked document icons would distinguish the Piles patent from Nicol and Levine. (See Ex. 11 at, e.g., ¶¶ 15, 18-20.) Thus, even if the document icons of Levine were combined with the iconic layout and help messages of Nicol, as MWT suggests, the combination would not render the asserted claims of the Piles patent obvious because the claims requires the display of different indicia depending on the selection of different document icons in a stack or pile of document icons—*i.e.*, in “a collection of two or more document icons displayed together.” (Feiner Decl. at ¶¶ 18 & 19.)

**B. Even If Nicol Was Found To Disclose “Two Or More Document Icons Displayed Together,” The Combination With Levine Does Not Invalidate Because Nicol Does Not Disclose Displaying Indicia Of Documents**

Even assuming, *arguendo*, that Nicol and Levine disclose “a collection of two or more document icons displayed together,” their combination would not render the asserted claims of the Piles patent obvious. As discussed above, Levine does not teach the claimed browsing function of the Piles patent. Nicol does not fill this hole in Levine because Nicol does not disclose the display of “indicia” *of documents*. Indeed, MWT admits that Nicol does not disclose “document icons.” (MWT’s Motion at p. 12.) MWT fails to bridge the resulting gap in logic and technology, however, to construe Nicol as disclosing “indicia” of documents. Accordingly, moving a cursor along the icons in Nicol would not display a series of “indicia” of documents as required by the claim language of the Piles patent. (Feiner Decl. at ¶¶ 20 & 21.)

---

<sup>4</sup> Apple has moved to strike Dr. Levy’s expert report on the validity of the Piles patent because it was procedurally improper. (Docket No. 205.)

Specifically, the Piles patent defines “indicia” as an item “indicating the content of the document, thereby providing the user with information concerning what the representation represents (i.e. *what is contained within the document*).” (Ex. 4 at 7:10-14 (emphasis added).) The Piles patent further explains that examples of “indicia” include “the first page of a document” (*id.*), a “full-size reproduction of the document” (*id.* at 12:67-13:2), the size of the document (*id.* at Fig. 4e), and “the most characteristic words” in the document (*id.* at 10:50-55).

In contrast, Nicol discloses icons that represent functions or commands. (Ex. 7 at 3:27-30, 7:15-20.) When an icon in Nicol is selected by a user, *help information from a stored database of help messages* explains the function performed by the command that is represented by the icon. (*Id.* at 2:15-31, 4:36-42, 6:23-28, 8:2-11 and Fig. 2.) As such, Nicol cannot teach the display of “indicia” of documents because it does not disclose the display of document contents. (Feiner Decl. at ¶¶ 20 & 21.) Therefore, Nicol does not disclose the “displaying in series” of different indicia as argued by MWT. (See MWT’s Motion at pp. 13, 15-16).

**C. One Of Ordinary Skill In The Art Would Not Be Motivated To Combine Nicol With Levine**

MWT merely states that there is a motivation to combine Nicol with Levine because the Examiner did so. (MWT’s Motion at p. 2.) This does not satisfy MWT’s burden to prove invalidity by clear and convincing evidence. *Eli Lilly*, 251 F.3d at 962; *see also Abbott Labs.*, 544 F.3d at 1352 (holding that, to show *prima facie* obviousness, there must be a showing that a practitioner would have some reason to make the alleged combination).

Indeed, one of ordinary skill in the art would have no reason to combine the Levine and Nicol patents. (Feiner Decl. at ¶¶ 22 & 23.) Nothing in either patent would direct one to consider the other reference and they involve disparate subject matter. (*Id.* at ¶ 22.) Specifically, Nicol and Levine are directed to different applications. (*Id.*) Levine describes an apparatus for

manipulating documents in a data processing system. (*Id.*) In contrast, Nicol describes a method and apparatus for providing help messages to computer users. (*Id.*) Levine does not even remotely address the display of help messages associated with applications represented by icons. (*Id.*)

In addition, the teachings of Nicol and Levine are at odds with one another. For example, Nicol teaches that when a visible icon is selected, a help message is displayed “so as to not overlap the icon about which more help is requested.” (Ex. 7 at 2:25-30.) In contrast, Levine teaches that when a fully-visible document stamp is selected, “a full screen view of the document represented by the stamp” is provided. (Ex. 8 at 12:28-36, 11:47-49.) This discrepancy between the teachings of Levine and Nicol begs the question: would selecting an icon cause a message to fully overlap the icon as in Levine or not overlap the icon at all as in Nicol? In this way, Nicol and Levine teach-away from each other, such that one of ordinary skill in the art would not be motivated to combine Nicol with Levine. (Feiner Decl. at ¶ 23.) *See also KSR*, 550 U.S. at 416 (holding that if the prior art teaches away from combining certain elements, discovery of a successful means of combining them is more likely to be non-obvious).

**D. Secondary Considerations Of Non-Obviousness, Including Long-Felt Need And Praise, Require The Denial Of MWT’s Motion**

There is significant and objective evidence supporting the non-obviousness of the Piles patent. As the Piles patent recognizes upfront in its specification, traditional file-organizing systems use a hierarchy of folders or subdirectories to organize documents. (Ex. 4 at 1:39-49.) These hierarchical systems, however, were rigid and offered “little assistance in [the] often tedious task” of categorizing, filing and searching for documents. (*Id.* at 2:34-42.) Further, the existing flat file systems, wherein all documents are stored on the same level in the file system, become increasingly burdensome as the number of stored documents grows. (Feiner Decl. at



¶ 27.) In this way, the new “piles” metaphor disclosed in the Piles patent for organizing and searching for documents addressed a long-felt, but unmet, need in the computing industry for an improvement to the existing hierarchical and flat file systems. (Feiner Decl. at ¶¶ 24-30.)

Indeed, MWT’s expert has relied on the same long-felt need in arguing for the validity of the Mirror Worlds patents asserted against Apple. (Ex. 12 at 21-22.) MWT’s expert recognized that “conventional systems, which require users to access stored information through filenames and folders, become unwieldy when the amount of information stored on a computer becomes large, and that a new paradigm is needed for accessing and managing that information.” (*Id.* at 21.) MWT’s expert also cites to industry observers in support of the long-felt need for an alternative to the hierarchical system: ““In regard to the file-folder[,] reporters generally acknowledge that **it is in desperate need of an overhaul.**”” (*Id.* at 21-22 (emphasis in original).) To the extent the Court accepts this evidence, it supports the non-obviousness of the Piles patent.<sup>5</sup>

Similarly, MWT’s expert has sought to support the validity of the Mirror Worlds patents by citing to industry praise for Mirror Worlds’ Scopeware software. (*Id.* at p. 23.) Apple disputes this evidence, but, to the extent it is accepted by the Court, any praise for Scopeware supports the non-obviousness of the Piles patent because Scopeware infringes the asserted claims of the Piles patent. In fact, MWT’s expert cites evidence of praise for Scopeware’s graphical user interface (*i.e.*, its display of a stack of document icons that can be previewed in series), which is an infringing feature of the Piles patent. (*Id.*)

---

<sup>5</sup> Further, the long-felt need for a new document organization paradigm supports the validity of the Piles patent, but not necessarily the Mirror Worlds patents because the ‘724 patent—the parent of the Piles patent—is prior art to the Mirror Worlds patents. *Cf. J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (commercial success “must be due to the merits of the claimed invention beyond what was readily available in the prior art.”).

In sum, the objective evidence supporting the non-obviousness of the Piles patent creates a genuine dispute of fact, such that MWT's motion should be denied.

**V. CONCLUSION**

For the reasons stated above, Apple respectfully requests that the Court deny Mirror Worlds Technologies Inc.'s Motion for Summary Judgment of Invalidity of U.S. Patent No. 6,613,101.

Dated: July 22, 2010

Respectfully submitted,

PAUL, HASTINGS, JANOFSKY, AND WALKER LLP

*/s/ Jeffrey G. Randall*

---

Jeffrey G. Randall

Lead Attorney

PAUL, HASTINGS, JANOFSKY, AND WALKER LLP

1117 S. California Avenue

Palo Alto, California 94304-1106

Telephone: (650) 320-1850

Facsimile: (650) 320-1950

[jeffrandall@paulhastings.com](mailto:jeffrandall@paulhastings.com)

Allan M. Soobert

PAUL, HASTINGS, JANOFSKY, AND WALKER LLP

875 15th Street, N.W.

Washington, DC 20005

Telephone: (202) 551-1822

Facsimile: (202) 551-0222

[allansoobert@paulhastings.com](mailto:allansoobert@paulhastings.com)

S. Christian Platt

PAUL, HASTINGS, JANOFSKY, AND WALKER LLP

4747 Executive Dr., 12th Floor

San Diego, CA 92121

Telephone: (858) 458-3034

Facsimile: (858) 458-3005

[christianplatt@paulhastings.com](mailto:christianplatt@paulhastings.com)

Eric M. Albritton  
Texas State Bar No. 00790215  
ALBRITTON LAW FIRM  
P.O. Box 2649  
Longview, Texas 75606  
Telephone: (903) 757-8449  
Facsimile: (903) 758-7397  
[ema@emafirm.com](mailto:ema@emafirm.com)

COUNSEL FOR APPLE INC.

**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 July, 2010. As of this date, all counsel of record had 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/ Jeffrey G. Randall* \_\_\_\_\_  
Jeffrey G. Randall