

Randall Declaration

Exhibit 11

**UNITED STATES DISTRICT COURT
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.

**EXPERT REPORT OF JOHN LEVY, Ph.D. REGARDING INVALIDITY OF U.S.
PATENT NO. 6,613,101**

I. INTRO

1. I, John Levy, submit this Expert Report in connection with my preparation to testify at the trial in the above-captioned case on issues relating to the invalidity of U.S. Patent No. 6,613,101 (“the ‘101 Patent”) assigned to Apple Inc.

2. This report is based upon information currently known to me and I reserve the right to rely upon any additional information I become aware of after the date of this report and to respond to any arguments or opinions regarding the subject matter of my report raised by Apple or its experts after the date of this report, including at trial.

II. PROFESSIONAL BACKGROUND AND QUALIFICATIONS

3. My professional background, credentials and compensation are set forth in detail in my report regarding infringement of the Mirror Worlds patents (the “Infringement Report”), which is being filed concurrently herewith, and are incorporated herein.

III. INFORMATION CONSIDERED IN FORMING OPINIONS

4. In addition to the information considered in connection with my Infringement Report, I further considered:

- The ‘101 Patent;
- The prosecution file history of the application that issued as the ‘101 Patent, including the references cited therein;
- U.S. Patent No. 6,243,724 patent (“the ‘724 Patent”), which is the parent to the ‘101 Patent;
- The prosecution file history of the application that issued as the ‘724 Patent, including the references cited therein; and
- The Court’s February 16, 2010 Order concerning claim construction of, *inter alia*, the ‘101 Patent (D.E. 178) (The “Preliminary Order”).

IV. BASIS FOR OPINION

A. Claim Construction

5. I have been informed by counsel to Mirror Worlds Technologies, Inc. (“MWT”) that claim construction is a matter of law to be decided by the Court and that the Court has issued a preliminary claim construction of the terms in the ‘101 Patent, which is set forth in the Court’s Preliminary Order, which I have reviewed.

6. In its Preliminary Order, I understand that the Court adopted a meaning of the term “a graphical iconic representation of a collection of said first plurality of documents” that was advanced by Apple, namely “a collection of two or more document icons displayed together.”

B. Prosecution File History of the Application that Issued as the ‘724 Patent

7. I have reviewed the file history of the application that issued as the ‘724 Patent (the parent of the ‘101 Patent).

8. I note, that claim 84 of the application that issued as the ‘724 Patent (“Application Claim 84”), which issued as claim 6 in the ‘724 Patent, and claims 1, 5, and 9 of the ‘101 Patent (all independent claims asserted by Apple) each contain the limitation “displaying a graphical iconic representation of a collection of said first plurality of documents.”

9. At several points during prosecution, Application Claim 84 (like others) was rejected by the USPTO. Specifically, the USPTO rejected this claim over two prior art references: U.S. Patent No. 5,060,135 to Levine (“Levine”) and U.S. Patent No. 5,287,448 to Nicol (“Nicol”).

10. In arguing against these rejections and attempting to distinguish Application Claim 84 (and others) from Levine and Nicol, applicants argued:

Nicol discloses the provision of help information when a graphical object is selected, but Nicol does not disclose that a different help message will be displayed depending on which portion of the graphical object is selected. Therefore, the combination of Levine and Nicol results in the display of help information regarding a stack of stamps when the stack of stamps is selected, and the provision of separate help messages for each stamp within the stack is not taught or suggested.

Appellant’s Appeal Brief, mailed March 12, 1996, p. 33 (emphasis added)(APMW0025611-12).

11. Applicants also admitted that Nicol discloses “a graphical user interface wherein information regarding an icon may be retrieved by pointing a cursor at the icon.” Appellant’s Appeal Brief, mailed March 12, 1996, p. 32 (APMW0025610).

12. Applicants further argued that :

The Nicol reference teaches a help system which displays a help message when an icon is selected. "There is simply no teaching in Nicol that a different help message is displayed when a different position for the same icon is selected. In fact, this would confuse a user and thus is not even conceivable from the teachings of Nicol. Similarly, Levine fails to teach this feature. Thus the combination cannot teach this feature.

Claims 84-86 further amplify the glaring insufficiency of the prior art. These claims require the display of a series of indicia, including a second indicia and a third indicia by positioning the cursor on a second and third position (respectively) on the same icon of the collection. Again, this is taught by neither Levine or Nicol.

Appellant's Reply Brief, mailed June 24, 1996, p.2 (APMW0025673).

V. THE '101 PATENT CLAIMS COVER THE PRIOR ART AND ARE INVALID

13. It is my opinion that independent claims 1, 5 and 9 of the '101 Patent (and the claims that depend from them), as construed by the Court in its Preliminary Order, cover the teachings of Nicol. In other words, Nicol anticipates these claims. The basis for applicants' distinguishing Levine and Nicol from Application Claim 84, which included the same limitation as claims 1, 5 and 9 of the '101 Patent, does not apply to claims 1, 5 and 9 as constructed by the Court because the claim construction of "a collection of two or more document icons displayed together" does not require any specific relationship among the two or more icons.

14. Specifically, applicants overcame the rejection based on Levine and Nicol by arguing that Application Claim 84 was directed to different positions of a cursor on a single icon corresponding to the display of indicia of different documents. As summarized above, applicants characterized the alleged invention as different indicia (or messages) corresponding to different positions of a single graphical object and characterized the prior art as a single indicia (or message) corresponding to the graphical object.

15. However, this distinction does not apply to the ‘101 Patent claims as construed in the Preliminary Order. The Court construed the claim term “a graphical iconic representation of a collection of said first plurality of documents” as “a collection of two or more document icons displayed together.” Preliminary Order at 5. This construction does not require any particular relationship between the recited “two or more document icons” and, as such, it is my opinion that such limitation reads on different positions of the cursor on one or more icons corresponding to different documents, which icons may be displayed together on a screen but may be non-overlapping and/or separate.

16. Consequently, it is my opinion that the basis for the applicants overcoming the rejection of Application Claim 84 does not apply to claims 1, 5 and 9 of the ‘101 Patent. As proposed by Apple and adopted by the Court in its Preliminary Order, the applicants’ distinction made during prosecution does not apply to the limitation “a graphical iconic representation of a collection of said first plurality of documents.”

17. Specifically, Claim 1 of the ‘101 Patent presently reads:

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;

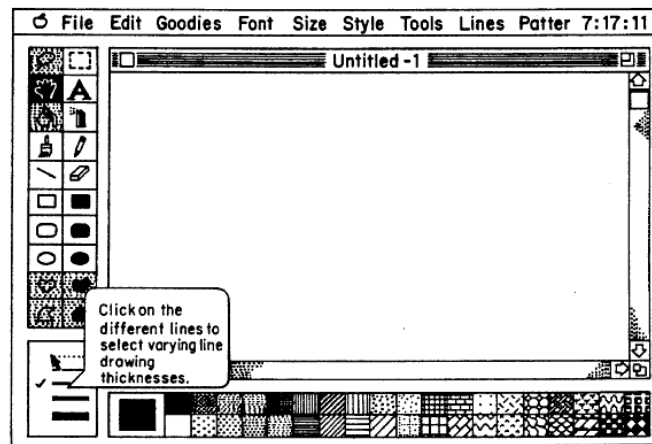
displaying a first indicia of a first document of said collection by selecting a first position from said graphical iconic representation, wherein said first position on said graphical iconic representation is capable of being at any one of a plurality of locations on said graphical iconic representation 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.

18. Due to the interpretation advanced by Apple and accepted by the Court in its Preliminary Order, each of claims 1, 5 and 9 of the '101 Patent is not limited to an individual icon or ones that overlap. Accordingly, as construed, I believe claims 1, 5 and 9 of the '101 Patent are invalid over Nicol.

19. Figure 2 of Nicol shows:

FIG. 2



20. Because claims 1, 5 and 9 of the '101 Patent, as construed, place no real limitations on the arrangement of the icons, the claims cover at least the prior art Nicol. As shown in Fig. 2 of Nicol (reproduced above), the various icons are grouped together, and placing the mouse pointer over various icons displayed would result in various indicia being displayed. Indeed, as noted above, applicants admitted Nicol discloses “a graphical user interface wherein information regarding an icon may be retrieved by pointing a cursor at the icon.”

21. Claims 5 and 9 suffer from the same shortfalls as Claim 1, as they are effectively claim 1 rewritten in an Apparatus and Beauregard format, respectively, and thus, they include the same limitation and are subject to the same construction.

22. Claims 2, 6, and 10, which depend from independent claims 1, 5, and 9, respectively, are invalid as the limitation contained therein relates to adjacent display of the indicia, which is illustrated in Nicol's Fig. 2, above.

23. Claims 3, 7, and 11, which also depend from independent claims 1, 5, and 9, respectively, are invalid as the limitation contained therein relates to displaying indicia concurrently with the display of the icons, which is illustrated in Nicol's Fig. 2, above.

24. Claims 4, 8, and 12, which depend from independent claims 1, 5, and 9, respectively, are also invalid as the limitation contained therein also relates to displaying indicia concurrently with the display of the icons, which is illustrated in Nicol's Fig. 2, above.

VI. CONCLUSION

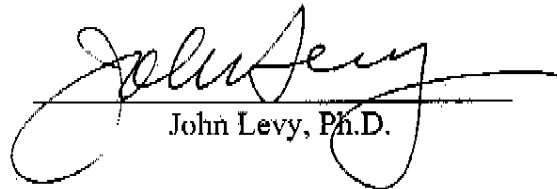
25. For the reasons discussed above, it is my opinion that Claims 1-12 of the '101 Patent, as construed, encompass the prior art of Nicol and are invalid.

26. In addition, I reserve the right to modify and supplement the analysis and conclusions proposed herein based upon any additional fact discovery performed by the parties.

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on May 20, 2010 at Point Reyes Station, California.



John Levy, Ph.D.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document is being served this 20th day of May 2010 via email upon counsel for Apple at the following address:

MirrorWorlds@paulhastings.com.

/s/ Alexander Solo