Randall Declaration

Exhibit 1

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.	**FILED UNDER SEAL**

MIRROR WORLDS TECHNOLOGIES, INC.'S RESPONSIVE CLAIM CONSTRUCTION BRIEF ON U.S. PATENT NO. 6,613,101

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representation." *See, e.g., id.*, col. 37, lines 35-48. Thus, the claims expressly recite selecting various ***positions on a singular graphical iconic representation***—namely, ***the icon of the pile.***

Significantly, other claims are directed to the dynamic graphical representation of a pile embodiment and use different claim language. For example, claim 13 of the '101 patent recites "displaying a graphical representation of said collection of documents"—instead of a "graphical *iconic* representation," as in claims 1, 5 and 9. *id.*, col. 39, lines 4-5. It then recites the process of selecting a particular document to view as "pointing a cursor on said display device ***at a graphical representation of one of said documents in said collection*** . . . ." *id.*, col. 39, lines 10-12. Therefore, in claims directed to the dynamic graphical representation embodiment, the claim recites pointing at a particular graphical representation of a ***document*** in the pile, as opposed to positioning the cursor on the *graphical iconic representation* of the pile, as in claim 1, 5 and 9.

The file history further supports MWT's proposed construction of this term. In particular, during prosecution of the parent application to the '101 patent, Apple clearly defined the claim term "a graphical iconic representation of a collection of said first plurality of documents" as a single icon for the collection. Apple made this clear in the context of distinguishing a claim reciting that term from prior art that disclosed an icon of a collection of documents, but only allowed the user to view the document displayed on the top of the icon:

> The Examiner's Answer newly argues that the combination of Levine and Nicol shows the selection of a document based on which ***portion of a graphical object*** is selected. See the paragraph which bridges pages 26 and 27.
>
> 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 nor Nicol.

See Ex. C to Apple Inc.'s Opening Claim Construction Brief On U.S. Patent No. 6,613,101 (Dkt. 150-11), File History of '724 Patent, at 724 FH 362 (underlining in original).

Thus, the file history of the '101 patent makes crystal clear that the term "a graphical iconic representation of a collection of . . . documents" refers to an "icon of the collection." Indeed, Apple emphasized that point by underlining the phrase "for the same icon" in its arguments distinguishing prior art.

2. **Apple's Proposed Construction is Incorrect**

a. **Apple's Argument Relating to the Exclusion of the Preferred Embodiment is Without Merit**

Apple asserts that MWT's proposed construction "should be rejected because it would improperly exclude the preferred embodiment," citing, *inter alia*, *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1358 (Fed. Cir. 2008), *See* Apple's Opening Brief, pp. 11-12. To the contrary, however, *Helmsderfer* actually supports MWT's position. In *Helmsderfer*, the Federal Circuit explained that "[i]t is often the case that different claims are directed to and cover different disclosed embodiments" and that the "patentee chooses the language and accordingly the scope of his claims." *Id.* at 1383. That is precisely what happened here—Apple chose language for claims 1, 5 and 9 that limited those claims to the *static pile icon* embodiment, as opposed to the *dynamic graphical representation of a pile* embodiment. Both embodiments are described in the specification and, as the Federal Circuit explained is often the case, different claims are directed to different embodiments. Apple simply ignores, and never mentions, the fact that there is a *static pile icon* embodiment described in the '101 patent.

V. CONCLUSION

For the foregoing reasons, MWT respectfully requests the Court to adopt MWT's proposed constructions in their entirety.

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Respectfully submitted,
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