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 TO LIMIT THE NUMBER OF ASSERTED CLAIMS

I. INTRODUCTION

Apple respectfully requests an Order limiting the number of claims that Mirror Worlds may assert and present at trial. Mirror Worlds currently asserts fifty-five claims from four patents against Apple, with 22 claims from the '227 patent; 24 claims from the '427 patent; 8 claims from the '313 patent and one claim from '999 patent.[1] For purposes of an orderly and efficient trial, Apple requests the Court order Mirror Worlds to limit its asserted claims to no

[1] The '227, '313 and '427 patents share an identical specification, and the '999 patent claims priority to the '227 patent and concerns almost identical subject matter.

more than four—one claim per patent. Such a limitation would ensure a manageable presentation of the parties' claims and defenses at trial to the jury—all of which is impossible with Plaintiff's fifty-five current asserted claims. Limiting the asserted claims is also reasonable given that the claims and patents overlap substantially. Under these circumstances, Mirror Worlds should be limited to no more than one claim per patent (four), as has been done in other cases. Apple, therefore, respectfully requests that its motion be granted.

II. STATEMENT OF FACTS

On June 24, 2010, in an effort to focus dispositive motions and trial, Apple's counsel sent a letter to Mirror Worlds' counsel asking for an agreement to limit the number of patent claims to be tried. (Declaration of Jeffrey G. Randall in Support of Apple Inc.'s Motion To Limit the Number of Asserted Claims ("Randall Decl."), Ex. A.) The letter cited authority supporting the common practice of limiting the number of claims before trial and informed Mirror Worlds that Apple would need to move for relief if an agreement could not be reached soon, requesting a prompt response. *Id*. ("[I]n light of upcoming dispositive motions and preparations for trial, Apple would appreciate your response to these issues by close of business tomorrow."). Mirror Worlds did not respond.

On June 25, 2010, during a telephonic meet and confer between the parties on other matters, Apple again raised the immediate need to limit the number of asserted claims, with Mirror Worlds taking the issue under advisement.

On June 30, 2010, having not received a response to these requests, Apple again asked Mirror Worlds to respond to the June 24 letter and June 25 request to limit the number of claims. (Randall Decl., Ex. B.) In light of dispositive motions being due the following day, Apple requested that Mirror Worlds respond to the issue that day. *Id*. A few hours later, having heard

nothing, Apple followed-up, and reiterated the need to resolve this issue before filing dispositive motions:

> With motions for summary judgment due tomorrow (July 1), we need to know if Mirror Worlds is willing to limit the number of claims that it intends to pursue going forward, given that the present number (approx. 50 claims) is unwieldy and inappropriate, as explained in Jeff's [June 24] letter.

(*Id.*, Ex. C.)

In response, Mirror Worlds' counsel acknowledged the need to reduce the number of claims eventually, but stated that it was "premature at this stage" and would be wiling to "revisit" the issue after it reviewed Apple's dispositive motions. (*Id.*, Ex. D.) The following day, on July 1, the parties filed their dispositive motions.

On July 7, Apple's counsel again asked Mirror Worlds' counsel to respond to the June 24 letter in preparation to meet and confer the following day on the issue of limiting the claims. (*Id.*, Ex. E.) In response, Mirror Worlds' counsel again stated that it would consider cutting down the claims but only after reviewing the summary judgment briefs, which was also reiterated in the meet and confer the following day. *Id*. On July 21, the parties filed their responses to dispositive motions, thus satisfying Mirror Worlds' unilateral pre-condition.

During the following weeks, the parties met and conferred to resolve myriad discovery disputes, while at the same acknowledging that Mirror Worlds failure to limit its claims was preventing the parties from streaming the case for trial. For example, Apple agreed to limit the number of prior art references it would assert at trial but could not present a final list because of Mirror Worlds has yet to limit its claims as agreed. (*Id.*, Ex. F.)

Finally, on August 9, after meeting and conferring several times on this issue raised initially by Apple on June 24 and with the pretrial conference fast approaching, Apple asked Mirror Worlds to identify by the close of business the claims it planned to assert at trial. (*Id.*,

Ex. G.) Mirror Worlds responded that it would get back to Apple by August 12, but failed to do so. The following day, Apple called Mirror Worlds' counsel who said that although they were still willing to limit the number of asserted claims they could not presently commit to a number, but wanted to continue discussing the matter on August 16. Apple's counsel then explained that with trial just weeks away it could not continue delaying this issue and must file its present motion.

III. ARGUMENT

The Federal Circuit has recognized a need to limit the number of claims to make cases efficient and manageable and the district court's authority to do so. *See ReRoof Am., Inc. v. United Structures of Am., Inc.*, Nos. 98-1378, 98-1430, 215 F.3d 1351 (table), 1999 WL 674517, at *4 (Fed. Cir. Aug. 03, 1999) (affirming district court's limitation of claims from eighteen to five—one representative claim per patent—and noting the "claims of the five patents-in-suit overlap very substantially"); *Kearns v. Gen. Motors Corp.*, No. 93-1535, 31 F.3d 1178 (table), 1994 WL 386857, at *1 (Fed. Cir. July 26, 1994) (affirming an order enforcing a prior ruling requiring plaintiff to select one representative claim per patent-in-suit).

Limiting the number of claims to be tried to one (or a few) per patent is also a common practice in the Eastern District of Texas. *See, e.g., Widevine v. Verimatrix*, 2:07-cv-321, slip op. at *2 (E.D. Tex. Dec. 28, 2009) (Rader, J.) (Randall Decl., Ex. H) (limiting the number of claims asserted form sixty-five to five); *Hearing Components, Inc. v. Shure, Inc.*, No. 9:07CV104, 2008 WL 2485426, at * 1 (E.D. Tex. June 19, 2008) (Clark, J.) (limiting the asserted claims to three per patent).

Here, the parties cannot reasonably litigate all fifty-five claims Mirror Worlds has asserted. Even if the Court and parties had unlimited time and resources, trial of so many claims would be a gargantuan, if not impossible, undertaking. The parties' infringement and invalidity

theories would be impossible to present to the jury in an efficient and understandable way. Mirror Worlds knows all of this. Its failure to reduce the number of claims, even though it knows full well it will never assert all of them, is unreasonable. Despite its alleged willingness to limit its claims, Mirror Worlds has failed to do so even though it has had weeks to review Apple's dispositive motions, as it demanded. In light of this behavior, the only reasonable conclusion is that Mirror Worlds is stalling to keep Apple and the Court preparing for issues that it knows will not be relevant at trial.

IV. CONCLUSION

For the foregoing reasons, Apple respectfully requests the Court order Mirror Worlds to reduce its asserted claims to no more than one claim per patent (four).

Date: August 13, 2010

Respectfully submitted,

/s/ Jeffrey G. Randall

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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 13th day of August, 2010. 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/ *Jeffrey G. Randall*
Jeffrey G. Randall

CERTIFICATE OF CONFERENCE

I hereby certify that counsel for Apple Inc. has satisfied the "meet and confer" requirements of Local Rule CV-7(h), and that opposing counsel of record in this matter are opposed to the relief sought in this Motion. Counsel for Apple, Christian Platt, conferred telephonically with counsel for Mirror Worlds, LLC and Mirror Worlds Technologies, Inc. ("Mirror Worlds"), Alex Solo, on August 13, 2010, and the discussions ended in an impasse for the reasons described herein, leaving the issue open for the Court whether Mirror Worlds should limit its number of asserted claims to be presented at trial.

/s/ *Jeffrey G. Randall*
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