

**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.

**MIRROR WORLDS' RESPONSE TO APPLE INC.'S
MOTION TO LIMIT THE NUMBER OF ASSERTED CLAIMS**

Mirror Worlds, LLC (“Mirror Worlds”) submits the following response to Apple Inc.’s Motion to Limit the Number of Asserted Claims (D.I. 309).

As an initial matter, Apple’s motion was addressed by the Court at the Pretrial Conference held on August 26, 2010, at which time the Court ordered Mirror Worlds to identify the claims that it intends to pursue at trial. In response, Mirror Worlds filed a Notice (D.I. 348) identifying twelve such claims from three of the four Mirror Worlds patents-in-suit. With respect to the fourth patent-in-suit, U.S. Patent Number 6,768,999 (“the ‘999 patent”), Mirror Worlds excluded the sole asserted claim from that patent, thus effectively withdrawing that

patent from the case. That should greatly simplify the issues for trial since the asserted claim of the '999 contained many unique terms that are not used in the claims of the other patents-in-suit.¹

Apple's motion seeks to limit Mirror Worlds to "no more than four" asserted claims. Such a limitation, however, would severely limit and adversely affect Mirror Worlds' ability to enforce its patent rights. The twelve claims that Mirror Worlds has selected vary in scope and are directed to different aspects of the invention. They provide separate and independent bases for Mirror Worlds' infringement contentions against Apple's products. Even if Apple should prevail on one or more of those claims, it would still be the case that other claims among the twelve are infringed by Apple. The claims were selected to ensure that Mirror Worlds is afforded the full scope of its patents at trial. Apple's artificially low number is nothing more than an attempt by Apple to escape liability for infringing Mirror Worlds' patents.

There is no bright-line rule regarding how many claims can be asserted at trial. Indeed, as Apple acknowledges, courts within the Eastern District of Texas have allowed assertion of multiple claims per patent. *See e.g., Accolade Sys. LLC v. Apple Sys., Inc.*, No. 6:07-cv-00048-LED, Order, Dkt. No. 195 (E.D. Tex. May 11, 2009) (refusing to further limit fourteen asserted claims); *Hearing Components, Inc. v. Shure, Inc.*, No. 9:07- CV-104, 2008 WL 2485426, at *1 (E.D. Tex. June 13, 2008) (limiting plaintiff to three claims per patent); *Sky Tech's LLC v. SAP AG*, No. 2:06-CV-440-DF, 2007 WL 5731923, at *5 (E.D. Tex. November 13, 2007) (limiting plaintiff to ten claims).

For the foregoing reasons, Apple's motion to limit the number of asserted claims should be denied.

¹ Mirror Worlds understood that, at the Pre-Trial Conference, the Court also ordered Apple to identify the alleged prior art that it would assert a trial. Apple's alleged prior art now stands at 41 references and hundreds (or more) combinations of references. Mirror Worlds has not received any such identification of alleged prior art for trial from Apple.

Dated: September 2, 2010

Respectfully submitted,

By: */s/ Alexander Solo*

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ATTORNEYS FOR PLAINTIFF,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document this 2nd day of September, 2010, via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ Alexander Solo
