

**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 REPLY IN SUPPORT OF ITS  
MOTION TO LIMIT THE NUMBER OF ASSERTED CLAIMS**

In response to Apple’s Motion, Mirror Worlds argues that if the court limits the number of claims to be asserted at trial to one claim per patent then it would “severely limit and adversely affect Mirror Worlds’ ability to enforce its patent rights,” as its presently elected claims “are directed to different aspects of the invention.” (D.I. 360 at 2.) Mirror Worlds exaggerates its alleged prejudice and ignores the relationship between the asserted claims. All of the asserted patents relate to a “document stream operating system,” claim priority to the ’227 patent, and share the same written description. Not surprisingly, there are several common elements between the asserted claims, as the following chart demonstrates:

	<b>'227</b>		<b>'427</b>					<b>'313</b>				
Limitation Summary	<u><b>13</b></u>	22	<u><b>1</b></u>	<u><b>8</b></u>	<u><b>16</b></u>	18	<u><b>25</b></u>	<u><b>1</b></u>	2	3	<u><b>9</b></u>	11
“timestamp to identify”	X	X										
“stream / main stream substream”	X	X	X	X*	X*	X*	X	X	X	X	X*	X
“persistence”	X	X										
“receding, foreshortened stack”			X			X	X	X	X	X	X	X
“generating glance view”			X	X	X	X	X	X	X	X	X	X
“two operating systems”			X	X	X	X	X	X	X	X		
“archiving”		X	X	X				X			X	

\*Mirror Worlds disputes the existence of the starred limitations. (See D.I. 354.) Independent claims are underlined.

Mirror Worlds recognized this overlap in the patents when it requested, without citing authority, that Apple reduce the number of prior art references to be asserted at trial to one primary reference per patent “due to the commonality of disclosure among the Mirror Worlds’

patents.”<sup>1</sup> (Supplemental Declaration of Jeffrey G. Randall filed herewith (“Randall Supp. Decl.”), Ex. I.) In light of this recognized overlap, it is unreasonable for Mirror Worlds to maintain its presently elected claims, and should be required to limit its asserted claims to one per patent to streamline the upcoming trial.

Both the Federal Circuit and this Court have recognized the appropriateness of limiting claims that substantially overlap, as here. 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. 30, 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); *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 from sixty-five to five); *Ameranth, Inc. v. Menusoft Sys. Corp.*, No. 2:07-cv-00271-TJW-CE, slip op. (E.D. Tex. Aug. 23, 2010) (Randall Suppl. Decl., Ex. J) (granting *sua sponte* motion to limit number of asserted claims to seven claims total from three related patents).

The Court should accordingly order Mirror Worlds to further limit its claims, particularly under the circumstances here. Apple repeatedly requested that Mirror Worlds limit its 50-plus asserted claims so that the parties could effectively narrow the issues in the case and prepare for trial. While Mirror Worlds represented time and again that it was willing to do so, it continued to stall until Apple was forced to seek relief from the Court on August 13, 2010. (D.I. 309.)

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<sup>1</sup> In view of Mirror Worlds’ present election of 12 claims, Apple has limited the prior art to be asserted at trial. (D.I. 365.) If the Court grants Apple’s pending motion, then Apple is also willing to consider further reducing its asserted prior art.

After being admonished to reduce its claims by the Court in the pre-trial conference, Mirror Worlds unilaterally withdrew one of its patents from the case and elected to assert 12 claims from the remaining three related patents.<sup>2</sup> (D.I. 348.) The number of claims remains unreasonable and will result in an unnecessarily duplicative set of claims being presented to the jury.

For the foregoing reasons, Apple respectfully requests that the Court grant its motion and require Mirror Worlds to further limit the number of claims to be asserted at trial.

Dated: September 13, 2010

Respectfully submitted,

*/s/ Jeffrey G. Randall*

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<sup>2</sup> By analogy, because the patent-in-suit share an identical written descriptions and priority, MW is asking the court to allow it to assert 12 claims from, in essence, a single patented concept.

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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 September, 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*  
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