

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN**

APPLE INC., and NEXT SOFTWARE,
INC. (f/k/a NeXT COMPUTER, INC.),

Plaintiffs and
Counterclaim-
Defendants,

v.

Case No. 10-CV-662 (BBC)

MOTOROLA, INC. and MOTOROLA
MOBILITY, INC.

Defendants and
Counterclaim-
Plaintiffs

**APPLE INC. AND NEXT SOFTWARE, INC.'S
MOTION FOR LEAVE TO FILE
SUPPLEMENTAL CLAIMS CONSTRUCTION EVIDENCE**

Apple Inc. and NeXT Software, Inc. ("Apple") respectfully seek leave to submit supplemental evidence pertinent to the construction of a term in Motorola's U.S. Patent No. 5,319,712 (the "'712 patent"). The supplemental evidence consists of additional excerpts from the certified translation of the file history of the Japanese counterpart to the '712 patent. Other excerpts from the Japanese file history are already of record through the Haskett Declaration (Dkt. No. 92), Exs. 10 and 11. The additional excerpts are attached to the Supplemental Taub Declaration, filed with this motion.

The submission of the additional excerpts is necessary now because Motorola, Inc. and Motorola Mobility, Inc. argued in their responsive claim construction brief that statements made by the inventors in the prosecution of the Japanese counterpart to the '712 patent are not relevant to the construction of terms in the claims of the '712 patent because they were made after the '712 patent issued. See Dkt. No. 108 at 87-88.

Apple submits the additional excerpts to establish two points. First, the cover page of the PCT application, read with the cover page of the file history of the Japanese counterpart, demonstrate that the Japanese counterpart claims priority, through the PCT application, to U.S. Patent Application No. 08/112,780, filed on August 28, 1993, which issued as the '712 patent. See Ex. 1 to the Supplemental Taub Decl. Second, claim 9 of the Japanese counterpart is identical to claim 17 of the '712 patent, which is asserted against Apple in this case. See Ex. 2 to the Supplemental Taub Decl. Given that claim 9 of the Japanese counterpart is identical to asserted claim 17 of the '712 patent, and given that the Japanese counterpart claims priority to and includes a disclosure identical to the patent application that led to the '712 patent, the inventors' statements concerning the meaning of the term "transmit overflow sequence number"

during prosecution of the Japanese counterpart are relevant here, and are extrinsic evidence properly considered by the Court.

Accordingly, Apple respectfully requests that the Court allow Apple to submit the additional excerpts attached to the Supplemental Taub Declaration.

Dated: July 19, 2011

Respectfully submitted,

/s/ James D. Peterson

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