MIRROR WORLDS, LLC v. APPLE, INC., Appeal No. 2011-1392 (Fed. Cir. September 28, 2012). Before Newman, Lourie, and Prost. Appealed from E.D. Tex. (Judge Davis).

Background:

Mirror Worlds sued Apple for direct and induced infringement of three patents sharing a common written description and directed to searching, displaying, and archiving computer files. After Mirror Worlds' case in chief, the district court granted Apple's motion for judgment as a matter of law that Apple did not induce infringement of any of the asserted claims of the patents because Mirror Worlds did not offer any evidence of actual performance of the patented methods by third parties. However, the jury found Apple liable for direct infringement.

After the trial, the district court vacated the jury verdict and concluded that Mirror Worlds failed to establish infringement of the asserted claims of the first two patents under the doctrine of equivalents (its only theory of liability) because the accused methods did not have the equivalent of a step of sliding a cursor or pointer over the stack of documents. The district court also found that Mirror Worlds failed to establish infringement of the asserted claim of the third patent because they did not offer substantial evidence that each step of the claimed method was performed. Mirror Worlds appealed.

Issues/Holdings:

Did the District Court err in finding that the asserted claims of the first two patents were not infringed under the doctrine of equivalents? No, affirmed. Did the District Court err in finding that the asserted claim of the third patent was not infringed? No, affirmed.

Discussion:

Regarding the first two patents, Mirror Worlds relied on expert testimony concluding that the center area of the screen in Apple's products was equivalent to the claimed "cursor or pointer." The Federal Circuit characterized Mirror World's argument as an argument that the absence of a feature is equivalent to its presence, which is a negation of the doctrine of equivalents.

Regarding the third patent, the Federal Circuit found that direct infringement required at least receiving data from other computer systems (such as receiving email), generating data (such as sending an email or creating a document), and generating a substream (chronological search results). The Federal Circuit determined that Mirror World's video of Steve Jobs demonstrating a search on a prior operating system and evidence of an Apple email search on a prior operating system was insufficient to show that Apple performed all claimed steps with the accused operating system.

As to induced infringement of the third patent's claim, the Federal Circuit found that Mirror Worlds did not present any testimony of customers actually performing each step of the method claim. Instead, Mirror Worlds merely presented software reviews and user manuals which described the various accused method steps but failed to instruct users how to perform the claimed method. The Federal Circuit stated that excerpts from user manuals of products that can be used in a non-infringing manner are by themselves insufficient to show the predicate acts necessary for inducement of infringement. In dissent, Judge Prost argued that the claimed methods were broader and believed that Mirror World's evidence was sufficient to allow a reasonable jury to conclude that Apple's customers infringed.