

03-1615

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IN THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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NTP, INC.,

*Plaintiff-Appellee,*

v.

RESEARCH IN MOTION, LTD.,

*Defendant-Appellant.*

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Appeal from the United States District Court for the Eastern District of  
Virginia in Case No. 01-CV-767,  
Judge James R. Spencer

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**COMBINED PETITION BY RESEARCH IN MOTION, LTD.  
FOR PANEL REHEARING AND REHEARING *EN BANC***

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January 11, 2005

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## Certificate Of Interest

NTP, Inc. v. Research In Motion, Ltd., No. 03-1615

Counsel for Defendant-Appellant, RESEARCH IN MOTION, LTD., certifies the following:

1. The full name of every party represented by us is RESEARCH IN MOTION, LTD.
2. The name of the real party in interest represented by us is RESEARCH IN MOTION, LTD.
3. No parent corporations nor any publicly held companies own 10 percent or more of the stock of RESEARCH IN MOTION, LTD.
4. The names of all law firms and the partners or associates that appeared for RESEARCH IN MOTION, LTD. in trial court or are expected to appear in this court are:

Henry C. Bunsow, Robert C. Laurenson, R. Scott Wales, Celine T. Callahan, David W. Long, and David Makman of HOWREY SIMON ARNOLD & WHITE, LLP.

Thomas R. Goots, Robert C. Kahrl, Robert L. Canala, Kenneth R. Adamo, Donald B. Ayer, Charles R. A. Morse, Sheryl Love, of JONES DAY.

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January 11, 2005

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| Bl. Br. x.....  | RIM’s Principal Brief (Blue Brief) at x      |
| Gr. Br. x.....  | RIM’s Reply Brief (Grey Brief) at x          |
| JAxxxxx.....    | Joint Appendix at xxxxx                      |
| NTP .....       | Plaintiff-Appellee NTP, Inc.                 |
| Op. x .....     | Panel Opinion (Addendum) at x                |
| Patent c:l..... | ‘960 Patent at column c, line l              |
| Red. Br. x..... | NTP’s Principal Brief (Red Brief) at x       |
| RIM .....       | Defendant-Appellant Research In Motion, Ltd. |

## Statement Of Counsel For *En Banc* Petition

Based on my professional judgment, I believe this appeal requires answer to the following precedent-setting questions of exceptional importance:

1. Whether a defendant is directly liable for patent infringement under 35 U.S.C. § 271(a) if it is not the “whoever” that “makes, uses, offers to sell, or sells” the components of the patented invention?

2. Whether use of a patented invention occurs “within the United States” under 35 U.S.C. § 271(a) if necessary components (or steps) of that invention are located (or performed) outside of the United States?

Based on my professional judgment, I also believe that the panel’s claim construction is contrary to multiple precedents, and should be reheard *en banc* with or following *Phillips v. AWH Corp.*, Nos. 03-1269, -1286 (Fed. Cir.).

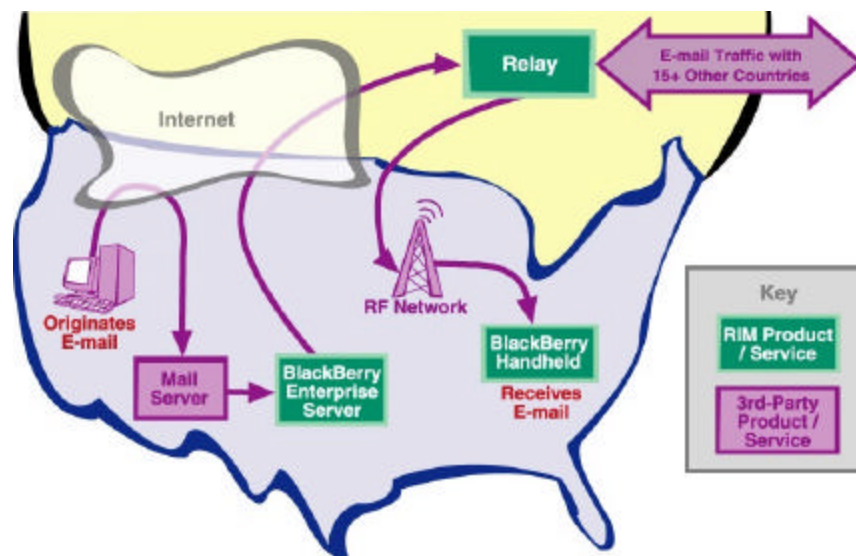
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### I. Introduction

As illustrated below, the accused infringing system in this case includes a Relay alleged to satisfy the “interface” and other limitations required by NTP’s asserted claims. Op. 50. That Relay, which makes the accused system operational, is located entirely in Canada. Op. 49-50 & n.9. Thus, a key component of the accused infringing system is not “within the United States” as expressly required by § 271(a). Accordingly, the district court originally and correctly held that direct infringement under § 271(a) required all steps of the patented invention to be performed in the U.S. But the court later reversed itself and instructed the jury that “the location of RIM’s Relay in Canada does not preclude infringement.” Op. 50.

In affirming RIM’s liability under § 271(a), the panel’s analysis ignores the plain meaning of the statute, and creates an unworkable and misguided standard on a complex extraterritoriality issue of exceptional importance. The panel committed

two plain errors of statutory construction with respect to the meaning of 35 U.S.C. § 271(a) that should each be reheard by the Court *en banc*. First, by holding RIM directly liable for someone else’s “beneficial use” of the system, the panel ignored that liability under § 271(a) only can be imposed on the “whoever” that “uses” the patented invention. Second, the panel refused to accord the separate statutory phrase “within the United States” its plain and ordinary meaning, and thus upheld RIM’s § 271(a) liability even though a necessary component of the accused system alleged to meet material limitations is located outside the United States.



## II. The Panel Misinterpreted And Misapplied §271(a) By Ignoring That RIM Does Not “Use” Any Asserted Claim

On its face, the panel’s opinion seriously misconstrues and distorts § 271(a). As selectively quoted by the panel, § 271(a) provides that “‘use[]’ of ‘any patented invention[] within the United States ... during the term of the patent therefore, infringes the patent.’” Op. 51-52. The panel, however, ignored plain statutory language that limits direct infringement liability under §271(a) to the “whoever” that “uses” the patented invention.

Simply put, for purposes of § 271(a), RIM is not the “whoever” that “uses” any patented invention at issue. Ignoring that statutory requirement, the panel held



RIM liable under § 271(a) because, “when two domestic users communicate via their BlackBerry devices, their use of the BlackBerry system occurs ‘within the United States,’ regardless of whether the messages exchanged between them may be transmitted outside the United States at some point along their “wireless journey.” Op. 52. The panel’s reliance on “use” by hypothetical domestic U.S. users to affirm that RIM directly infringed under § 271(a) is plain legal error.

Under a proper infringement analysis, the “construed claims are compared to the allegedly infringing device.” *Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). The panel failed to do that step or separately analyze the asserted system and method claims. The proper inquiry would have confirmed that RIM is not the “user” of any patented invention in this case.

The panel stated that “[t]he claims are directed to systems and methods for sending e-mail messages between two subscribers; the transmission is made between an originating processor and destination processor.” Op. 55. Even under that perfunctory view of the claims, the panel failed to appreciate that RIM is not the one “us[ing]” the method or system and, therefore, RIM cannot be the “whoever” liable under § 271(a). For example, RIM does not use any method of “transmitting the originated information originated from the one of the plurality of originating processors to a gateway switch within the electronic mail system.” *See* Blue Br. A-2. All asserted method claims have multiple limitations like this that are performed by someone other than RIM. RIM similarly does not “use” any recited system “for transmitting originated information” or which “transmit[s] electronic mail.” *See id.* A-1-13.

If allowed to stand, the panel’s § 271(a) theory imposes direct infringement liability not authorized by Congress and never before upheld by the courts. Under this new theory, any company (foreign or domestic) may be held liable for direct infringement under § 271(a) based on someone else’s use of their product. A

foreign company operating wholly outside the United States would now face § 271(a) liability whenever its system is operated for the “beneficial use” of U.S. customers. Until this decision, that unquestionably has never been the law.

Properly applying the statutory language to this case, use of the accused system by or between any e-mail users cannot constitute direct infringement under § 271(a) by RIM – as a matter of law. Regardless of where the system components are located, and regardless of whether U.S. users are involved, RIM cannot infringe any asserted claims under the “use” prong of § 271(a). The panel’s holding to the contrary should not become binding precedent of this Court.

By relying solely on the “use” prong, the panel did not reach whether RIM could infringe under § 271(a) by alleged “sales” of the accused system within the United States. Op. 52 n.10. RIM does not sell any claimed system because the Canadian Relay in Canada is not sold, and because RIM does not sell other necessary claim components such as “RF information transmission networks,” mail servers or desktop computers to originate e-mail. Further, RIM’s sales of some system components cannot infringe any method claim because “[t]he sale or manufacture of equipment to perform a claimed method is not direct infringement within the meaning of 35 U.S.C. § 271(a).” *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1313 (Fed. Cir. 2003). NTP did not argue that RIM “makes” an infringing system. *See* Red Br. 51. Thus, § 271(a) does not apply to RIM’s activities, and the panel plainly erred in holding RIM liable under that provision.

### **III. The Panel Should Have Entered Judgment For RIM By Upholding The Express Statutory Requirement That Infringing Activity Must Occur “Within The United States”**

The panel mischaracterized the extraterritoriality issue as being “whether the location of a component of an accused system abroad, where that component facilitates operation of the accused system in the United States, prevents the

application of section 271(a) to that system.” Op. 51. To be clear, the Relay in Canada does more than “facilitate” – without it, the accused system does not work. Moreover, where the “operation of the accused system” occurs is the dispute, not a predicate fact that the panel could assume from the outset.

The panel held that “the plain language of section 271(a) does not preclude infringement where a system such as RIM’s ... is used within the United States even though a component of that system is physically located outside the United States.” Op. 52. Inexplicably, the panel never interpreted the statutory phrase “within the United States.” Instead, discerning allegedly “close parallels” in *Decca Limited v. United States*, 544 F.2d 1070 (Ct. Cl. 1976), the panel upheld § 271(a) liability on RIM by assuming that “the location of the beneficial use and function of the whole operable system assembly is the United States.” Op. 54. In doing so, the panel fundamentally misconstrued both *Decca* and § 271(a).

**A. *Decca*, when properly understood and applied, confirms that the accused system cannot be “within the United States”**

*Decca* involved alleged infringement by the U.S. government’s “Omega” navigation system, comprised of one “master” control station in the United States and several transmitter stations, including one in Norway. Op. 54 (citing *Decca* at 1074, 1081). The government relied on *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518 (1972), to argue that the transmitter station outside the United States precluded infringement. But, in this panel’s words, the Court of Claims “soundly rejected this argument, finding that the ‘Omega’ navigation system was an infringing ‘use’ under section 271(a).” Op. 54.

Of course, the relevant statute in *Decca* was 28 U.S.C. § 1498(a), not 35 U.S.C. § 271(a). Under § 1498(a), the issue is whether the alleged infringement is “by or for the United States” while the phrase “within the United States” does not even appear. Even ignoring that basic distinction, it cannot be ignored that the

defendant in *Decca*, the United States, was the actual “user” of the accused system, which is not the case here. For that reason alone, the panel plainly erred in relying on the “use” analysis in *Decca* as being controlling or even supportive of a finding that RIM directly infringed under § 271(a) in this case.

To the extent that *Decca* is instructive, the panel opinion misunderstands and misapplies its teachings. In *Decca*, the entire operable system was assembled in the United States. *Decca* at 1082. The Norway equipment was purchased, installed, and operated by the United States. *Id.* at 1081. All transmissions from Norway were monitored and controlled from the central transmitter in the United States, and the “beneficial use” of the system was deemed within the United States because it was the United States that was using the accused system. *Id.* at 1083. While the panel recited several of those same facts, it analyzed and applied them to this case from entirely the wrong perspective.<sup>1</sup>

Unlike the central transmitter in *Decca*, the Relay that receives and controls all e-mail messages routed through the accused system was assembled in, installed in, and never left Canada. The Relay was at all times owned by RIM, a Canadian company operating a Canadian business. In the accused system, all e-mail messages are sent to Canada where the Relay translates, monitors, readdresses, and reroutes those e-mail messages to the appropriate wireless system of the destination user. Op. 50. Those critical operations by the Relay, without which the accused system would not work, are entirely located, processed, and managed in Canada. Thus, the Relay in Canada receives, prepares, and controls all

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<sup>1</sup> The trial judge in *Decca* relied on “the combination of circumstances here present.” See Op. 55 (quoting *Decca* at 1082-83). There were no juries in the Court of Claims, so the trial judge was the fact finder. In this jury case, the district court’s instruction plainly erred in taking that disputed infringement issue away from the jury. Op. 50. At a minimum, therefore, this case should be remanded for a new infringement trial on all claims.

transmissions in the accused system, including those from foreign locations in the United States and other countries.

If the accused system is at all “akin to the infringing system in *Decca*” (Op. 55), it would be because the users outside Canada are akin to the foreign stations outside the United States in *Decca*. In *Decca*, the Norwegian station did not prevent the “control and beneficial use” of the accused system from being by and for the defendant United States. Here, the fact that the Relay receives and processes e-mails transmitted by and between U.S. users cannot alter the fact that the accused system is controlled by and through the Relay in Canada. Hence, the proper parallels to *Decca* establish that the control point of the accused system must be in Canada, not “within the United States.”

By looking solely at U.S. end-users, the panel’s analysis of *Decca* plainly fails to recognize that the relevant “uses” under §271(a) must be those of the accused infringer. Op. 55. The existence and activities of U.S. users cannot determine the control point of the “unitary” accused system, which does not and should not vary across national borders based on the shifting location of each particular user. *See Decca* at 1074-75.

Finally, the panel also erred in disregarding the specific claim limitations at issue when analyzing the “uses” relevant under *Decca*. In *Decca*, the claims were to a system in which synchronized signals were received from spaced sources and deemed used “wherever the signals are received.” *Decca* at 1083. If the claims had covered how transmitters generated the signals, however, the Court of Claims agreed that “operation of the Norwegian station would have been beyond the reach of the U.S. patent laws.” *Id.* Here, the “interface” and other claim limitations allegedly met by the Relay concern the Relay’s internal operation, not just its output. JA12449-50; *e.g.*, ‘172 Patent, claim 199. All such limitations are material to the claimed invention. For example, some claims are specifically directed to the

“interface,” such as ‘451 Patent, claim 28 on “an interface comprising: ... .” NTP’s expert also relied on the limitations at issue to distinguish prior art. JA12449-50. Hence, the panel’s vague reliance on “beneficial use” of the overall accused system erroneously assumes the Relay in Canada merely is a conduit for “uses” in the United States, rather than the focal point of the entire system.

**B. The Panel plainly erred by not applying the plain meaning of the phrase “within the United States”**

35 U.S.C. §271(a) unambiguously provides that liability for infringing a U.S. patent must be based on activity “within the United States.” The statute does not impose liability for “control” of a patented invention. The statute does not impose liability for “beneficial use” of a patented invention by others. Moreover, the statute does not impose liability for activities that are “mostly or primarily within the United States.”

As the panel noted, “the *Deepsouth* interpretation of section 271(a) remains binding precedent on the limits of direct infringement liability under that section.” Op. 53 n.11. Though the panel tried to distinguish the facts of *Deepsouth*, its relevance remains in the Supreme Court’s instruction that “[w]hen, as here, the Constitution is permissive, the sign of how far Congress has chosen to go can come only from Congress.” 406 U.S. at 530. In § 271(a), Congress has only enabled the territorial reach of a patent right to be actionable against infringement that occurs “within the United States.” *See* Op. 48 (and case cited).

If Congress intended to expand the reach of this country’s patent laws to include all acts except those performed “wholly” in another country, Congress surely had the legislation drafting skills to do so.<sup>2</sup> It plainly has not done so in

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<sup>2</sup> Citing *Rotec Indus., Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1251 (Fed. Cir. 2000), the panel tried to emphasize that infringement cannot be predicated on acts “wholly” done in a foreign country, but those were the only acts at issue. Op. 48.

§ 271(a).<sup>3</sup> The panel’s disregard of the plain statutory language in § 271(a) is strong confirmation that the patent laws do not cover the extraterritoriality situation posed by this case. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 456 (1984) (“it is not our job to apply laws that have not yet been written”).

As explained in *Deepsouth*, courts should “require a clear and certain signal from Congress” before expanding U.S. patent rights beyond the nation’s borders. 406 U.S. at 531. Although the panel did not reach NTP’s direct infringement assertions based on 35 U.S.C. §§ 271(f) and (g), those subsections contain no such “clear and certain signal” applicable here. As shown by the panel’s summary of those provisions, NTP’s attempts to forcefit RIM’s activities into those subsections – designed for entirely different situations – would necessarily fail if this Court reached such issues. *See Op.* 48-49.

Finally, the panel’s misplaced holding that RIM is liable under § 271(a) cannot be cured merely by rewriting its opinion to reach the same result using § 271(b) or § 271(c). For RIM to have induced or contributed to an act of direct infringement, such an act still is required by § 271(a) to have taken place “within the United States.” Because the Relay is in Canada, no one can be found to have “used” that Relay “within the United States” – as a matter of law.

The reality is that U.S. patent laws do not impose any direct infringement liability where accused activities extend across national borders, and the panel erred in trying to create such liability in § 271(a) under the guise of statutory construction. In extending intellectual property protection to new technologies or

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<sup>3</sup> *See Zoltek Corp. v. United States*, 62 USPQ2d 1366, 1372 (Fed. Cl. 2002), *appeals pending*, Nos. 04-5100, -5102 (Fed. Cir.) (describing the law as being that if one step of a patented process was practiced outside the United States, it avoided infringement liability because § 271(a) “was limited to acts committed *within* the United States”) (citing *Cold Metal Process Co. v. United Eng’g and Foundry Co.*, 132 F. Supp. 597 (W.D. Pa. 1955), *aff’d*, 235 F.2d 224 (3d Cir. 1956)).

unforeseen circumstances, the Supreme Court repeatedly has held that such difficult policy formulations belong exclusively to Congress. *See, e.g., Parker v. Flook*, 437 U.S. 584, 595-96 (1978); *Sony*, 464 U.S. at 456; *United States v. Dubilier Condensor Corp.*, 289 U.S. 178, 198-99 (1933).

As shown by §§ 271(f) and (g), Congress has addressed extraterritoriality issues as necessary and appropriate, not by amending § 271(a), but by crafting new and specific statutory provisions substantively different from § 271(a). Congress also enacted 35 U.S.C. § 105 to provide when inventions made, used, or sold in outer space shall be considered made, used, or sold “within the United States” for purposes of U.S. patent laws. Similarly, it must be Congress who must decide if and when inventions made, used, or sold across multiple countries can be treated as having been made, used, or sold “within the United States.” Absent such legislation, this Court has no basis to uphold any liability on RIM in this case. Thus, for the reasons stated, the panel’s misinterpretations of § 271(a) should be vacated, and final judgment of noninfringement entered for RIM.

#### **IV. The Panel Misconstrued The Specification In Not Requiring The “RF Receiver” And “Destination Processor” To Be Separable And Distinct**

The panel misapprehended the specification and its relationship to 14 asserted claims in ruling that the “RF receiver” need not be separable from the “destination processor.” The panel agreed that “the specification does indicate that [the inventor] contemplated a separate housing as a way of achieving increased mobility and portability.” Op. 41. But the panel apparently thought the specification also disclosed housing an RF receiver in a portable PC, relying on a phrase in the specification that ““a preferred embodiment of the invention is with portable destination processors.”” *Id.* at 41.

Notably, that single phrase concerns an RF receiver used “with” portable PCs, not “in” them. Patent 18:41-60. The phrase is in a paragraph describing “a



typical application with a portable PC functioning as the destination processor” that emphasizes having a separable RF receiver “to eliminate” having the portable PC “turned on and carried” or “drawing of power from the PC battery.” *Id.* The patent teaches that portable PCs with built-in RF capability were known (Patent 1:68-2:4, FIG. 1; Op. 18), but still had “difficult problem[s]” of power consumption and portability that the patent solves with a separate pager-type RF receiver that, unlike a portable PC, can be “carried on” the user for extended and continuous receipt of e-mail while drawing very little power. Patent 18:41-19:10, 23:43-24:8; JA33185. Properly read, the specification confirms that the devices are separable, and teaches away from portable processors with built-in RF, such as the BlackBerry handheld. Indeed, rather than separable devices, RIM invested substantial resources to create a unique, low-power processor that could be carried and kept on at all times to receive e-mails. JA12801-03.

The panel also misapprehended the “textual hook” required by controlling precedent for construing claims in light of the specification. Op. 42. The claim text plainly implicates the physical relationship of the RF receiver/destination processor (and of related terms like wireless receiver/mobile processor): *e.g.*, “[1] a wireless receiver connected to [2] the one mobile processor” in ‘590 patent claims. Under controlling precedent, this physical relationship must be construed in light of the specification, which can expressly or impliedly define how a skilled artisan would understand the claim terms. *See, e.g., C.R. Bard v. U.S. Surgical*, 388 F.3d 858, 860-61 (Fed. Cir. 2004); *Astrazeneca AB v. Mutual Pharmaceutical Co.*, 384 F.3d 1333, 1339-40 (Fed. Cir. 2004).

Just as the specification led to construction of the claim term “plug” as “pleated plug” in *C.R. Bard* and “solubizer” as “surfactants” in *Astrazeneca*, the phrase “a wireless receiver connected to the one mobile processor” (and similar limitations) should have been construed as having a separable connection based on

NTP's specification that (1) only discusses a physically separable connection,<sup>4</sup> (2) expressly states that separability is "[a]n important aspect of the present invention," (Patent 23:48-24:8), and (3) teaches away from any other type of connection. This construction also is consistent with the construction below that "RF receiver" is a device that "can be carried by a person ... and can receive data while being carried," which cannot occur if the RF receiver is built into a desktop or other type of destination processor. JA04722-23.

Even absent a textual hook in the claims, the specification still requires separability. In *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288-89 & n.2 (Fed. Cir. 2004), for example, this Court held that, because the specification plainly described two components as separate, it compelled such a construction even if the claim language did not. *See, Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (claims limited where "unitary" structure described as important, and is the only disclosed embodiment). Here, the panel violated such precedent by not recognizing that the intrinsic evidence defines the recited "RF receiver" and "destination processor" as being physically separable devices.<sup>5</sup>

At a minimum, the panel's remand should be expanded because its opinion confirms that the "RF receiver" and "destination processor" at least must be "distinct." *See* Op. 42 ("transfer" of information between "two entities"); *id.* 43 (the "connection" involves "two devices"). RIM's novel, low-power processor simultaneously runs both the software radio receiver and the e-mail programs, such that its structure alleged to be the "RF receiver" also is the same structure alleged to be the "destination processor." JA33103-110; JA12801-803; JA10129; JA10137-

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<sup>4</sup> The panel properly ignored NTP's argument that claims submitted 7 years after original filing can provide "written description" support for a unitary device.

<sup>5</sup> Further, as illustrated, this case involves several issues already before the full Court in *Phillips v. AWH Corp.*, Nos. 03-1269, -1286 (Fed. Cir.), so the Court should grant rehearing to address those issues properly in this case as well.

140; JA14961-962. This integrated structure cannot be the two distinct structures required by the claims, contrary to the infringement rulings below. *See* JA09265 (summary judgment ruling); JA10111, JA10129 (offer of proof); JA12047-048 (*in limine* ruling excluding RIM’s proof that components not distinct). The infringement rulings on the 14 affected claims at least should have been vacated and remanded, rather than affirmed.

**V. The Panel’s Construction Of The “Originating Processor” Limitations Affects More Claims Than Listed In The Opinion**

The panel properly remanded the case for the district court to apply the proper construction of “originating processor” as a processor “that initiates the transmission of a message into the system.” Op. 21, 23. The panel, however, misapprehended the proper scope of its new construction.

First, the district court incorporated its erroneous construction of “originating processor” into other terms: *e.g.*, “electronic mail system” and “destination processor.” JA04721-22. The panel should have instructed the district court to apply the panel’s new construction to all claims using such terms.

Second, the panel misapprehended the “originated information” dispute, which was not whether the “information” is “the text of an electronic mail message,” (*see* Op. 23), but whether it is the information as “originated.” Gray Br. 13. The panel confirms that “the ‘originated information’ originates from the ‘originating processor.’” Op. 24-26. Remand also should have included further proceedings consistent with that construction of “originated information.”

Finally, the panel erroneously equates the noun “originated information” with the verbs “originating electronic mail” and “originate the electronic mail.” Op. 21 n.6. The latter are used in ‘451 and ‘592 patent claims in a manner similar to “originating processor”: *e.g.*, “originating electronic mail from a processor” or “a programmed processor ... to originate the electronic mail.” The panel similarly

should have construed them to mean “to *initiate* the transmission of the electronic mail into the system,” and remanded accordingly. *See* Gray Br. 13-14.

## **VI. The Panel Erred In Construing “Electronic Mail System” And All Related Terms By Ignoring The Invention’s Purpose And Description**

The panel erroneously held that RIM waived its assertion that NTP limited “electronic mail system” during prosecution to “pull” technology because RIM did not raise that issue in the *Markman* proceedings. Op. 16-17. The panel misapprehended that – after the *Markman* proceeding – NTP repeatedly and successfully advanced that same narrow construction at trial to distinguish prior art for validity purposes. JA12449; JA13994. Any “waiver” from the *Markman* hearing cannot affect RIM’s independent basis for invoking judicial estoppel based on NTP’s subsequent claim construction position. *See* Gr. Br. 15. Thus, the panel plainly erred in allowing NTP to depart from its narrow construction of “electronic mail system” relied on to avoid prior art, not only in the PTO, but again at trial.

Without more, the panel’s “waiver” holding must be vacated and NTP’s correct restriction of “electronic mail system” to using “pull” technology adopted by this Court. *See White v. Dunbar*, 119 U.S. 47, 52 (1886) (claim is not a “nose of wax”). All other constructions tainted by the panel’s mistaken construction of “electronic mail system” similarly should be undone.

Further, the panel misapprehended RIM’s “wireline” argument. The term “wireline” was used by the parties – and the panel itself – as a shorthand reference to “the typical electronic mail system” as shown in Figure 1 of the patent, which had both RF and hard-wire components. Patent 1:52-2:4. The shorthand “wireline” is used to distinguish from the different “RF transmission network” or wireless network – just as the panel does (*see* Op. 2). The panel, therefore, erred in concluding that RIM used the term “wireline” to mean only the hard-wire component of the “wireline” system, and must reconsider its ruling accordingly.

There is nothing unfair about holding NTP to its narrow definition of “electronic mail system” because the broader definition adopted by the panel does not make sense. The panel’s construction of “electronic mail system” cannot be squared with the specification. While that construction purports to comply with the patents’ teaching of integrating an existing electronic mail system with an RF information transmission network, it does not. Patent 18:32-40; Op. 4.

Specifically, the patent contemplates an invention wherein users benefit from both the traditional wireline electronic mail system and receiving email on an RF device via an RF information transmission network. Patent 18:60-65. To enjoy these benefits, users must have access to the email through both their RF receiver and their mailbox in the electronic mail system. The patents teach that emails sent to the RF receiver must be transferred to a destination processor in the email system. However, the panel’s unduly broad construction of “electronic mail system” allows email to be sent to a destination processor that is not in the traditional email system. Under this interpretation, the patents do not disclose how that email would reach the user’s mailbox if sent to the RF receiver.

The panel’s construction is not reflective of a supposedly integrated system at all. Instead it appears to interpret Campana’s invention as a method for redirecting emails destined for an electronic mail system to a RF receiver with a processor capable of electronic mail programming. This is inconsistent with NTP’s assertions that the patents teach an invention “wherein the ‘mobile user obtains the same power and functionality to process pushed email ... as if he or she were sitting at a wired desktop computer.” JA33187. Users of the RF receiver simply do not have access to such functionality if the RF receiver is not connected to a processor in a wireline based email system.

Dated: January 11, 2005

## **Certificate Of Service**

I certify that I cause two copies of this Combined Petition By  
Research In Motion, Ltd. For Panel Rehearing And Rehearing En Banc to be  
served this 11<sup>th</sup> day of January, 2005 on the following:

By Hand:

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