

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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August 16, 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:

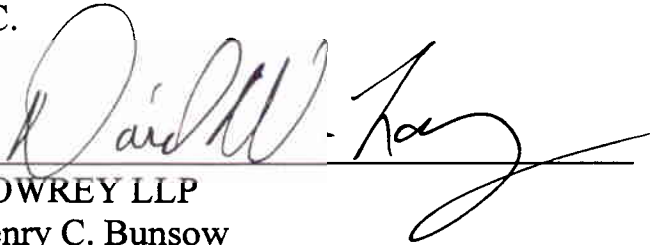
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August 16, 2005

  
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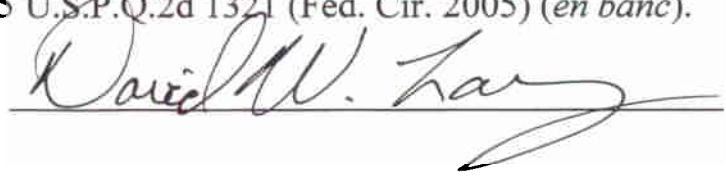
Bl. Br. x .....	RIM's Principal Brief (Blue Brief) at x
Gr. Br. x .....	RIM's Reply Brief (Grey Brief) at x
JAxxxxx .....	Joint Appendix at xxxxx
NTP .....	Plaintiff-Appellee NTP, Inc.
Op. at x .....	Panel Opinion (Addendum) at x
Col. c, line 1 .....	'960 Patent at column c, line 1
Red. Br. x .....	NTP's 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 answers to the following precedent-setting questions of exceptional importance:

1. Whether “use” of a “patented invention” occurs “within the United States” under 35 U.S.C. § 271(a) if significant components or acts specified by the claims are outside of the United States?

2. Whether the Panel’s claim construction is contrary to precedents, including *Phillips v. AWH Corp.*, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005) (*en banc*).



### I. Introduction.

The Panel’s reissued opinion in this case correctly holds that one cannot be held liable for direct infringement under 35 U.S.C. § 271(a) for using a *method* when one or more steps is performed outside the United States. Yet, in the same opinion, the Panel concludes that one *can* be held liable for direct infringement under § 271(a) for using a *system* even when one or more components is located outside the United States. The panel provides no explanation or support for this distinction and its conflicting conclusions are irreconcilable.

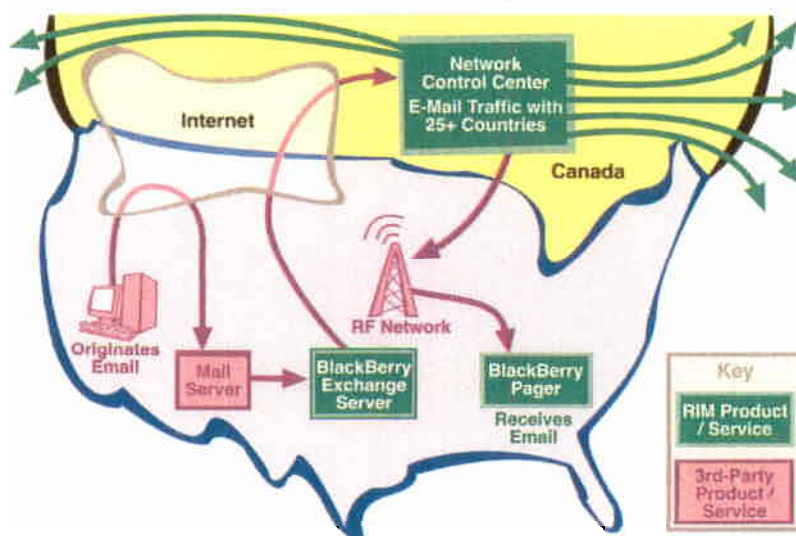
In reaching its untenable conclusion in relation to *system* claims, which improperly expands the reach of U.S. patent law, the Court applied to § 271(a) an analysis developed by the Court of Claims to determine the government’s liability under 28 U.S.C. § 1498. Specifically, the Panel ruled that for *system* (but not *method*) claims, “use” of the claimed invention occurs “where control of the system is exercised and beneficial use of the system obtained.” There is no precedent for the application of this new test for “use” under § 271(a) or the creation of this dichotomy in the law. The Panel or the Circuit *en banc* should

grant this petition and correct the erroneous ruling that § 271(a) can be applied to conduct that does not occur “within the United States.”

Finally, the Panel fails to follow *Phillips v. AWH Corp.*, 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005) (*en banc*), under which claims plainly require a separable and distinct RF receiver and destination processor—or at least a remand for jury trial on this issue.

## II. The Panel Erroneously Finds § 271(a) Direct Infringement For System Components And Acts Located Outside The United States.

This is not a case—as NTP has sought to characterize it—about a company attempting to evade U.S. patent law or to exploit “loopholes” by locating some minor part of its operations outside the United States. RIM is a Canadian company, with its headquarters in Waterloo, Ontario. RIM’s BlackBerry products are available in more than 25 countries, including the United States.



Importantly, RIM’s BlackBerry system includes a Network Control Center,<sup>1</sup> which controls the routing of e-mail to these countries. This Network Control Center, which is accused of having the structure and performing certain acts required by

<sup>1</sup> JA12791-92. The Network Control Center also is called the “Relay” for short.



NTP's patent claims, is not surprisingly located and operated at RIM's headquarters in Canada.<sup>2</sup>

The Panel erred on multiple grounds. First, the Panel fails to follow the plain statutory language extraterritorially limiting § 271(a) liability to “uses ... within the United States.” As a result, the Panel makes an unsupported distinction between *method* claims and *system* claims creating a generic rule for all system claims that fails to consider the nature of the actual patented invention. Second, the Panel ignores basic canons of statutory construction that forbid extending the patent statute extraterritorially absent clear Congressional direction. Third, the Panel erroneously finds § 271(a) liability based on *Decca*, a case decided under 28 U.S.C. § 1498, the statutory language and purpose of which are entirely different from § 271(a).<sup>3</sup> Fourth, the Panel misapplied that analysis and decided fact issues that should be left for the jury.

**A. Many components and acts of the “patented invention” are within Canada, not “within the United States” as required by § 271(a).**

Direct infringement under § 271(a) is limited to “whoever ... uses ... any patented invention, *within the United States*.” This is consistent with the fundamental tenet that “the U.S. patent laws ‘do not, and were not intended to, operate beyond the limits of the United States.’”<sup>4</sup> A “patented invention” is not merely some—or substantially all—of its claimed components, but is the complete “assembled or functioning whole.”<sup>5</sup> Thus, under its plain language, § 271(a)

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<sup>2</sup> Op. at 6-7, 50 n.11; JA12792.

<sup>3</sup> The Panel's opinion is focused entirely on whether RIM's *customers* directly infringe. Clearly RIM itself does not directly infringe.

<sup>4</sup> *Pellegrini v. Analog Devices, Inc.*, 375 F.3d 1113, 1117 (Fed. Cir. 2004) (quoting *Brown v. Duchesne*, 60 U.S. 183 (1857)).

<sup>5</sup> *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 528 (1972).

applies only to uses of the entire invention within the United States, not just parts of it, and cannot extend to cover the Network Control Center in Canada.

The Panel properly ruled that “a process cannot be used ‘within’ the United States as required by section 271(a) unless each of the steps is performed within this country.”<sup>6</sup> It held that the asserted method claims are not infringed here because certain steps are performed by the Network Control Center outside the United States.<sup>7</sup> But the Panel erred by reaching a different conclusion as to “system” claims even though substantial portions of the accused systems—*e.g.*, the Network Control Center—also are not “within the United States.”

Reviewing the actual claims at issue reveals the clear inconsistency between the Panel’s disparate rules for system and method claims, an inconsistency Congress never could have intended. The Panel held that method claims are comprised of a “sequence of actions,” and that all such actions must be “performed within this country” for use to be “within the United States.”<sup>8</sup> But the Panel wholly ignores similar *system* claim limitations requiring components to perform specific acts when used. For example:

- ‘960 Patent, Claim 15 – “at least one interface switch ... transmitting the originated information ...”;
- ‘670 Patent, Claim 8 – “the originated information is transmitted from the one of the at least one interface to the RF information transmission network ...”;
- ‘451 Patent, Claim 28 – the “interface” includes “a processor ... which processes [certain information] to produce the processed output”;
- ‘592 Patent, Claim 278 – “a check is performed ... by a comparison of ...”

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<sup>6</sup> Op. at 58.

<sup>7</sup> Op. at 58.

<sup>8</sup> Op. at 4.

- '592 Patent, Claim 287 – “said location determined from ...”<sup>9</sup>

The Network Control Center performs each of these acts, rendering their use beyond § 271(a) for system claims just as they are for method claims.

**B. This Court should not judicially extend § 271(a) extraterritorially absent a clear signal from Congress.**

It is settled “that legislation of Congress, unless a contrary intent appears, is meant to apply only within the territorial jurisdiction of the United States.”<sup>10</sup>

“Congress legislates against the backdrop of the presumption against extraterritoriality.”<sup>11</sup> The presumption is “doubly fortified” when extraterritorial limits are indicated “by the language of th[e] statute and the legislative purpose underlying it.”<sup>12</sup> This was well-established in patent law when Congress enacted § 271(a) with its express limit to “uses ... within the United States.”<sup>13</sup>

The principle articulated by the Supreme Court in *Deepsouth*—that Congress must give a “clear and certain” signal before extending U.S. patent laws—is wholly consistent with this established principle of statutory

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<sup>9</sup> The Panel wrongly concluded that the '592 Patent claims are not affected by the Network Control Center being outside the United States. Although the '592 Patent claim preambles do not use the term “interface” *per se*, they do include limitations that occur through—and under control of—the Network Control Center. See Bl. Br. at 44; Gr. Br. at 19; FRAP 28(j) Letter of July 20, 2004.

<sup>10</sup> *EEOC v. Arabian American Oil Co. (“Aramco”)*, 499 U.S. 244, 248 (1991) (quoting *Foley Brothers, Inc. v. Filardo*, 336 U.S. 281, 285 (1949)); *Smith v. United States*, 507 U.S. 197, 204 (1993).

<sup>11</sup> *Aramco*, 499 U.S. at 248; accord, *Argentine Republic v. Amerada Hess Shipping Corp.*, 488 U.S. 428, 440 (1989).

<sup>12</sup> *United States v. Spelar*, 338 U.S. 217, 222 (1949).

<sup>13</sup> See e.g., *Dowagiac Manufacturing Co. v. Minnesota Moline Plow Co.*, 235 U.S. 641, 650 (1915) (“right conferred by a patent under our law is confined to the United States and its [T]erritories (Rev. Stat., § 4884)"); *Brown*, 60 U.S. at 195-196 (use of the patented invention outside the United States is not an infringement).

construction.<sup>14</sup> In *Deepsouth*, the Supreme Court considered whether § 271(a) applied to an accused infringer who assembled all but two components of a patented invention within the United States, all of which were shipped overseas for final assembly.<sup>15</sup> Unlike RIM, which is continuing the same business it developed long before this lawsuit, the accused infringer made this minor post-litigation change in its practices to exploit a loophole in § 271.<sup>16</sup> The patent owner responded, as NTP does here, arguing that such a construction “is based upon a hypertechnical reading of the patent code that, if tolerated, will deprive [the patent owner] of its right to the fruits of the inventive genius of its assignors.”<sup>17</sup>

The Supreme Court refused to stray from the plain language of § 271(a), however, which applies to one who “makes”—not “substantially makes”—“any patented invention, within the United States.”<sup>18</sup> The Court rebuffed criticism that its conclusion was “too narrow and technical an interpretation of the statute,” and held that it “require[d] a **clear and certain** signal from Congress” before judicially expanding U.S. patent rights.<sup>19</sup>

Far from being “clear and certain” in this case, however, the Panel candidly admits that “it is **unclear** from the statutory language” whether § 271(a) covers the

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<sup>14</sup> *Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 531 (1972).

<sup>15</sup> *Deepsouth*, 406 U.S. at 527, 523 n.5.

<sup>16</sup> *Id.* at 523 n.5.

<sup>17</sup> *Id.* at 524.

<sup>18</sup> *Deepsouth* at 522, 527-28. It also is no answer to say that *Deepsouth* concerned liability for “makes” and not “uses,” because the Supreme Court equally would not force-fit “substantially uses” or “substantially within the United States” into the statute, as NTP essentially seeks to do here.

<sup>19</sup> *Id.* at 530-531 (emphasis added). The Court’s presumption against extending patent liability was based in part on the “historical antipathy to monopoly.” *Id.* at 530. Even if what constitutes making the patented invention were an issue of first impression (like the issue presented here), the Supreme Court “would still insist on a **clear congressional indication of intent to extend the patent privilege before we could recognize the monopoly here claimed.**” *Deepsouth* at 530, 532.

extraterritorial activity at issue.<sup>20</sup> Indeed, the trial judge and three-judge Panel who addressed this issue here have answered the question differently each time asked.<sup>21</sup>

This issue is exceptionally important. This Court should not do what the Supreme Court has refused to do—unilaterally expand § 271(a) extraterritorially without clear direction from Congress. This is particularly true given the United States’ treaty obligations under the World Trade Organization’s Agreement on Trade-Related aspects of Intellectual Property (“TRIPs”) and other agreements, which mandate multilateral national, and not extraterritorial, application of patent laws.<sup>22</sup> The presumption against extraterritorial application of U.S. laws—including the patent laws—is “particularly appropriate when ‘[i]t serves to protect against unintended clashes between our laws and those of other nations which could result in international discord.’”<sup>23</sup> Under the Panel’s holding, at the whim of a patent attorney drafting “system” rather than “method” claims, Congress’s crucial policy decision of whether and to what extent to extend U.S. patent law can be preempted without any consideration for the international repercussions.<sup>24</sup>

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<sup>20</sup> Op. at 52-53 (emphasis added).

<sup>21</sup> The district judge first ruled there was no liability, but then reached the opposite conclusion the next time asked. Op. 50-51. And the three-judge Panel here withdrew and substantially changed its first decision upon rehearing.

<sup>22</sup> See *Rotec Indus. Inc. v. Mitsubishi Corp.*, 215 F.3d 1246, 1251-53 (Fed. Cir. 2000) (discussing relationship between § 271(a) and TRIPs agreements); see also *Subafilms, Ltd. v. MGM-Pathe Communications Co.*, 24 F.3d 1088, 1097 n. 16 (9th Cir. 1994) (*en banc*) (concern that extraterritorial application of U.S. law would interfere with Congress’s efforts to secure multilateral agreement to the Berne Convention and GATT/TRIPs regimes of intellectual property protection).

<sup>23</sup> *Subafilms*, 24 F.3d at 1096-97 (citing *Aramco*, 499 U.S. at 248).

<sup>24</sup> See *Brown* at 197 (refusing to construe patent statute in manner that would “confer on patentees not only rights of property, but also political power, and enable them to embarrass the treaty-making power in its negotiations with foreign nations ...”).

**C. The Panel’s new *Decca*-based “control and beneficial use” form of § 271(a) direct infringement must be rejected.**

The Panel found § 271(a) direct infringement here by mistakenly adopting the *Decca*<sup>25</sup> standard derived for U.S government liability under an eminent domain statute. This led the Panel to erroneously hold that “the use of a claimed system under section 271(a) is the ... place where control of the system is exercised and beneficial use of the system obtained.”<sup>26</sup>

*Decca* interpreted 28 U.S.C. § 1498, which waives sovereign immunity when “an invention ... is used ... by or for the United States.” This statute is intended to have broad application, reflecting its nature as an exchange of government liability for eminent domain. In contrast, § 271(a) delineates the exclusive rights granted by patents and imposes liability on “whoever ... uses ... any patented invention, within the United States.” Although the Panel acknowledges that “*Decca* was decided within the context of section 1498,” it asserts that the *Decca* analysis is nonetheless instructive because “direct infringement under section 271(a) is a necessary predicate for government liability under section 1498.”<sup>27</sup> The Panel is wrong. Nothing in § 1498 suggests that government liability depends on the government being found a direct infringer under § 271(a). The only case cited by the Panel in support of this proposition, *Motorola, Inc. v. United States*,<sup>28</sup> says nothing of the sort. In *Motorola*, the Court simply noted in *dicta* that the government could only be held liable as a direct infringer and not as a contributory infringer. Indeed, the *Motorola* court stated explicitly, “[a]lthough a section 1498 action may be similar to a Title 35 action, it is nonetheless only parallel and not identical.” The Panel’s new ruling that

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<sup>25</sup> *Decca Ltd. v. United States*, 544 F.2d 1070 (Ct. Cl. 1976).

<sup>26</sup> Op. at 56.

<sup>27</sup> Op. at 54-55.

<sup>28</sup> 729 F.2d 765 (Fed. Cir. 1984). Op. at 54-55.

§ 271(a) liability is a predicate for § 1498 liability contravenes controlling precedent.<sup>29</sup> This alone warrants rehearing to avoid serious repercussions in this and other cases, such as in the *Zoltek* case currently pending before this Court.<sup>30</sup>

Consistent with its objectives, the language in § 1498 is quite different from—and broader than—§ 271(a). First, § 1498 expressly applies when the invention “is used ... **by** ... the United States”—*e.g.*, the United States **controls** the use. And § 1498 also applies when the invention “is used ... **for** the United States”—*e.g.*, the United States **benefits** from the use. Thus § 1498—unlike § 271(a)—expressly applies to the United States’ “control and beneficial use” of an invention. Second, § 1498 is not expressly limited to “uses ... within the United States” as is § 271(a). Rather, the plain language of § 1498 applies broadly both **within and without** the United States except for “any claim arising in a foreign country.”<sup>31</sup> Sections 271(a) and 1498 are simply different statutes having different standards and objectives.

Unlike § 1498, § 271(a) does not apply to “control” of the invention within the United States—*e.g.*, a domestic company is not subject to § 271(a) direct liability because it owns and controls a foreign factory that makes products covered by a U.S. patent. And the statute similarly does not apply to “benefits of use” of the invention being felt within the United States—*e.g.*, § 271(a) direct liability does not arise from the benefit of using an imported product made by a patented machine. Indeed, precedent relied on by the Panel confirms that where

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<sup>29</sup> See *Lemelson v. United States*, 752 F.2d 1538, 1548 (Fed. Cir. 1985) (“a section 1498 action and a title 35 action are only parallel and not identical”).

<sup>30</sup> *Zoltek Corp. v. United States*, 51 Fed. Cl. 829, 836-37 (Fed. Cl. 2002), *appeal docketed*, No. 04-5100, 04-5102 (Fed. Cir. June 3, 2004) (Dyk, Gajarsa, Plager).

<sup>31</sup> 28 U.S.C. § 1498(c); see *Zoltek*, 51 Fed. Cl. at 835 (“section 271 specifically limited infringement to acts occurring ‘within the United States,’ and section 1498 did not provide a similar limitation”).



the “benefits of use” are felt simply is not relevant to § 271(a) liability, because “the ‘tort’ of patent infringement occurs where the offending act is committed and *not where the injury is felt.*”<sup>32</sup>

The *Decca* analysis is simply inappropriate to apply to § 271(a). In fact, the Panel’s new “control and beneficial use” test will have significant unintended and unforeseeable consequences. In a world connected through a dizzying array of increasingly complex global telecommunications systems, such as the Internet, determining who controls or obtains the “beneficial use” of a patented system and where each of these occur opens a Pandora’s Box of indeterminable and boundless patent liability. Managing these problems is best left for Congress through its investigative and policy making powers.

**D. Even if *Decca* is applicable here, the Panel misapplied it and the case must be remanded for additional proceedings.**

Even if *Decca* is applicable in this case, the Panel misapplied it. The *Decca* court found that the invention at issue—a radio navigation system with a transmission station in Norway—was “used ... by or for the United States” based on “the combination of circumstances [there] present, with particular emphasis on [1] ownership of the equipment by the United States, [2] the control of the equipment from the United States and on [3] the actual beneficial use of the system within the United States.”<sup>33</sup>

In this case, ownership and control of the claimed system is in Canada. For example, Claim 28 of the ‘451 Patent is directed to “**an interface** comprising:” multiple components—*i.e.*, “output”, “input”, and “processor”—that perform

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<sup>32</sup> Op. at 55-56 (quoting *N. Am. Philips Corp. v. Am. Vending Sales, Inc.*, 35 F.3d 1576, 1579 (Fed. Cir. 1994)) (emphasis added).

<sup>33</sup> *Decca* at 1083 (emphasis added).



certain acts.<sup>34</sup> NTP argues that this claimed “interface” is the Network Control Center that is located, owned, controlled and operated exclusively in Canada.

Unlike the United States in *Decca*, RIM’s customers only own personal BlackBerry devices; they do not own or control the Network Control Center. The control of the system is not, as the Panel suggests, in the hands of individual consumers (just as it was not on the individual aircraft or ships in *Decca* that activated their on-board radio navigation systems). An e-mail sent by anyone, anywhere through the regular e-mail system will **not** be received by a BlackBerry device unless the Network Control Center in Canada that monitors all e-mail through the system acts to forward the e-mail to that device.<sup>35</sup> Importantly, the *Decca* court concluded that “the location of the whole [accused system] ... is where the ‘master’ station or stations are, which is in the United States of America, and *where all stations are monitored.*”<sup>36</sup> For the same reason, the accused BlackBerry system is located in Canada where the Network Control Center is located and where the system is monitored and controlled.

Further, NTP’s own expert testified that the “e-mail system interface” (alleged to be the Network Control Center) performs key control functions, and such control distinguishes the claimed invention from the prior art: *e.g.*, (1) a “security check” to control who receives an e-mail, and (2) “the use of location information” to control which RF station transmits the e-mail.<sup>37</sup> Importantly, *Decca* held that the accused system would be “beyond the reach of the U.S. patent

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<sup>34</sup> JA12534-12537.

<sup>35</sup> JA12544-12547.

<sup>36</sup> *Decca* at 1074 (emphasis added).

<sup>37</sup> JA12448-12450; JA12544-12546.

laws” when—as here—“the patentee’s contribution” to the art is met by components abroad.<sup>38</sup>

In addition, unlike the *Decca* navigation system used exclusively by the United States, BlackBerry users in over 25 countries send and receive e-mails routed through the Network Control Center in Canada. All of the above factors counsel against liability here, because they show even less contacts within the United States than in *Decca* where liability was “not free from doubt.”<sup>39</sup>

In any event, the jury should have evaluated and considered these factors under a properly articulated legal test. But the jury plainly did not consider or apply the newly adopted “control and beneficial use” form of § 271(a) direct infringement. Although the Panel attempts to buttress its decision by its conclusion that “it was proper for the jury to have found that use of NTP’s asserted system claims occurred within the United States,”<sup>40</sup> the jury did no such thing. Rather, the jury was expressly prohibited from doing so: the district court (1) instructed the jury that “the location of RIM’s Relay in Canada does not preclude infringement,”<sup>41</sup> and (2) excluded all testimony asserting non-infringement based on the Network Control Center being in Canada.<sup>42</sup> At a minimum, therefore, remand is required for the court below to apply and instruct as to the new “control and beneficial use” standard based on a complete and proper record for all system claims at issue here.

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<sup>38</sup> *Decca* at 1083 (“[I]t is clear from both the specification of the patent and the claim that the patentees’ contribution was not in the manner by which a transmitter generated and radiated signals. ... Had it been otherwise, that is, had the invention dealt with the generation of the signals themselves ... operation of the Norwegian station would have been beyond the reach of the U.S. patent laws.”).

<sup>39</sup> *Decca* at 1083.

<sup>40</sup> Op. at 56.

<sup>41</sup> JA14236; *see also*, JA14091

<sup>42</sup> JA12046-47.

### III. The Panel Misapplied *Phillips* In Its Treatment Of The “Connected,” “Coupled” and “Transfers” Claim Terms.

In *Phillips*,<sup>43</sup> this Court rejected undue reliance on dictionary definitions when construing claims, ruling that claims must be construed “in the context of the entire patent, including the specification.” Indeed, as *Phillips* explained, the specification can “define[] terms by implication.”<sup>44</sup> But the Panel failed to follow *Phillips* when it construed limitations using the terms “RF/wireless receiver”, “connected”, “coupled to” and “transfer”—*e.g.*, “a wireless receiver connected to the one mobile processor.” Specifically, the Panel erred by not construing such limitations—as impliedly defined in the specification—to require devices with separable connections with one another (can connect and disconnect).

The NTP patent specification clearly teaches using only separable connections between the “wireless receiver” (or “RF receiver”) and “mobile processor” (or “destination processor”). The Panel agreed that the inventor “contemplated a separate housing as a way of achieving mobility and portability” when the RF receiver is used with a fixed-site destination processor.<sup>45</sup> The specification also clearly states, however, that an RF receiver that is separable from a *portable* destination processor also is needed to “eliminat[e] the requirement that the destination processor [be] turned on and carried with the user of the destination processor” and avoid “the drawing of power from the PC battery” while the separate RF receiver remains turned on to receive e-mails.<sup>46</sup> The specification further requires that information be transferred “**upon connection** of the RF receiver to the destination processor.”<sup>47</sup> A person skilled in the art would conclude

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<sup>43</sup> *Phillips v. AWH Corp.*, 75 U.S.P.Q.2d 1321, 1326 (Fed. Cir. 2005).

<sup>44</sup> *Phillips* at 1332.

<sup>45</sup> *Op.* at 42.

<sup>46</sup> *See Col. 18, lines 41-50; Col. 19, lines 4-10.*

<sup>47</sup> *Col. 18, lines 50-53 (emphasis added).*

that the connection was between separable devices, because an intermittent connection would not be possible were the RF receiver housed with the destination processor. Indeed, the specification confirms that a separable RF receiver and destination processor is “an important aspect of the present invention” that overcomes the problems of prior art for *all embodiments* of destination processors, both fixed and mobile.<sup>48</sup>

There is nothing in the context of the specification to indicate that the patentee contemplated any alternative embodiment to those presented.<sup>49</sup> Transmitting e-mails to a separable RF receiver not connected to a destination processor is just as advantageous for mobile destination processors as for fixed destination processors. It allows users to avoid: (a) the battery drain inherent where any sophisticated processor has to be “turned on” for extended periods of time to receive emails, and (b) the awkwardness in carrying a laptop and having it ready to open up and read emails at all times.

The Panel erred in finding that there was no textual “hook” requiring separability.<sup>50</sup> The claims plainly require the wireless receiver to be “connected to,” “coupled to” or “transfer” information to the mobile processor (or similar limitations). And the specification consistently uses these terms to refer to a separable RF receiver and destination processor for all embodiments.<sup>51</sup> The specification’s “consistent usage” of the terms “RF receiver,” “connect,” “couple” and “transfer” impliedly defines them.<sup>52</sup> Such terms provide the same “textual

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<sup>48</sup> See Col. 23, lines 48-56.

<sup>49</sup> See *Phillips* at 1334.

<sup>50</sup> Op. at 42.

<sup>51</sup> See Col. 21, lines 44-53.

<sup>52</sup> See *Phillips* at 1332, 1334 (specification impliedly defines term when the contextual meaning applies to all embodiments and is not merely exemplary); *AstraZeneca AB v. Mut. Pharm. Co.*, 384 F.3d 1333, 1340 (Fed. Cir. 2004) (mention of feature in summary of invention section coupled with criticism of prior


hook” present in the “definition by implication” cases cited with approval in *Phillips*.<sup>53</sup>

Finally, consistent with the Panel’s ruling,<sup>54</sup> the district court ruled—in a *nunc pro tunc* order **after** trial—that the RF receiver and destination processor must be “distinct” (*i.e.*, have no shared components).<sup>55</sup> The jury’s infringement finding was not based on this new claim construction, which requires a different result because the accused “RF receiver” and “destination processor” structure shared common components—*e.g.*, a modified Intel 386 mobile processor—and were not distinct.<sup>56</sup> Consequently, the Panel should at least vacate and remand the finding of liability under the affected claims for further proceedings.

#### **IV. Conclusion.**

For the foregoing reasons, RIM respectfully requests that the Panel or the Court *en banc* grant this petition for rehearing.<sup>57</sup>

Dated: August 16, 2005



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art lacking this feature and definitive statement characterizing “the invention” as having the feature impliedly defines claim term to include feature); *Bell Atl. Network Servs., Inc. v. Covad Commc’n. Group, Inc.*, 262 F.3d 1258, 1271 (Fed. Cir. 2001) (consistent usage impliedly defines term).

<sup>53</sup> See, *e.g.*, *Bell Atl. Network Svcs.* at 1272-73, 1276 (“plurality of different modes” impliedly defined as any of three “relative bandwidth” modes described in the specification).

<sup>54</sup> Op. at 44 (refer to RF receiver and destination processor as “two devices”).

<sup>55</sup> See JA00014 (“[I]t is clear that Campana envisioned an RF receiver and destination processor that were distinct.”).

<sup>56</sup> JA12801-803; JA10129, JA14961-962[17:4-19:1]; JA14961-962[16:14-23, 17:21-18:12].

<sup>57</sup> The Panel denied RIM’s motion to stay the appeal and remand to the District Court to resolve a settlement dispute. RIM maintains its rights and remedies with respect to the settlement.