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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

Mformation Techs., Inc.,

NO. C 08-04990 JW

Plaintiff,

**ORDER RE. MOTIONS FOR SUMMARY
JUDGMENT**

v.

Research in Motion Ltd., et al.,

Defendants.

I. INTRODUCTION

Mformation Technologies, Inc. (“Plaintiff”) brings this action against Defendants Research in Motion Limited and Research in Motion Corporation (collectively, “Defendants”) alleging infringement of U.S. Patent No. 6,970,917 (“the ‘917 Patent”). The ‘917 Patent pertains to a method, system and computer program for remote control and management of wireless devices. Plaintiff alleges that Defendants infringe the ‘917 Patent by importing, marketing, manufacturing, using and selling the BlackBerry Enterprise Server (“BES”) software product. Defendants deny infringement and allege that the ‘917 Patent is invalid. After a series of amendments and motions,¹ the patent claims that remain at issue are independent Claim 1 of the ‘917 Patent, as well as dependent Claims 4-6, 21-25 and 27, all of which depend from Claim 1.

¹ On August 31, 2009, Plaintiff filed its Third Amended Complaint for Patent Infringement. (Docket Item No. 71.) On September 15, 2009, Defendants filed their Answer and Counterclaims to the Third Amended Complaint. (Docket Item No. 76.) Defendants counterclaimed for declaratory relief as to: (1) non-infringement; (2) invalidity; and (3) unenforceability due to inequitable conduct. (See *id.*) On September 30, 2009, Plaintiff filed its Answer to the Counterclaims. (Docket Item No. 84.) On November 18, 2010 the Court issued an Order pursuant to an earlier motion for summary judgment by Defendants with respect to Claims 7, 8 and 26. (See Docket Item No. 355.)

1 Presently before the Court are Plaintiff's Motions for Summary Judgment on various
2 affirmative defenses asserted by Defendants,² and Defendants' Motions for Summary Judgment on
3 some of their affirmative defenses.³ The Court conducted a hearing on September 26, 2011. Based
4 on the papers submitted to date and oral argument, the Court GRANTS Plaintiff's Laches Motion;
5 DENIES Plaintiff's Anticipation Motion; GRANTS Plaintiff's Inequitable Conduct Motion;
6 GRANTS in part and DENIES in part Plaintiff's Indefiniteness Motion; DENIES Plaintiff's Public
7 Use Motion; GRANTS Defendants' Damages Motion; GRANTS in part and DENIES in part
8 Defendants' Noninfringement Motion; DENIES Defendants' Equivalents Motion; DENIES
9 Defendants' Invalidity Motion; and DENIES Defendants' Claim Priority Motion.

10 II. STANDARDS

11 The standard for summary judgment does not change in a patent case. Conroy v. Reebok
12 Int'l, Ltd., 14 F.3d 1570, 1575 (Fed. Cir. 1994). Summary judgment is proper when the moving
13 party shows that there is no genuine dispute as to any material fact. Fed. R. Civ. P. 56(a). The
14 purpose of summary judgment "is to isolate and dispose of factually unsupported claims or
15 defenses." Celotex v. Catrett, 477 U.S. 317, 323-24 (1986). The moving party "always bears the
16 initial responsibility of informing the district court of the basis for its motion, and identifying the

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18 ² (Plaintiff's Motion for Summary Judgment of No Laches, hereafter, "Laches Motion,"
19 Docket Item No. 542; Plaintiff's Motion for Summary Judgment of No Anticipation Under 35
20 U.S.C. 102, hereafter, "Anticipation Motion," Docket Item No. 547; Plaintiff's Motion for Summary
21 Judgment of No Inequitable Conduct, hereafter, "Inequitable Conduct Motion," Docket Item No.
22 555; Plaintiff's Motion for Summary Judgment of No Indefiniteness, No Lack of Written
Description, and No Lack of Enablement Under 35 U.S.C. 112, hereafter, "Indefiniteness Motion,"
23 Docket Item No. 557; Plaintiff's Motion for Summary Judgment that U.S. Patent No. 6,970,917 is
24 Not Invalid Due to Public Use, hereafter, "Public Use Motion," Docket Item No. 562.)

25 ³ (Defendants' Motion for Partial Summary Judgment to Limit Pre-Suit Damages, hereafter,
26 "Damages Motion," Docket Item No. 544; Defendants' Motion for Summary Judgment of
27 Noninfringement of U.S. Patent No. 6,970,917, hereafter, "Noninfringement Motion," Docket Item
28 No. 549; Defendants' Motion for Summary Judgment of Noninfringement of U.S. Patent No.
6,970,917 Under the Doctrine of Equivalents, hereafter, "Equivalents Motion," Docket Item No.
552; Defendants' Motion for Summary Judgment That Claims 1, 4-6, 21-25, and 27 of U.S. Patent
No. 6,970,917 are Invalid Under 35 U.S.C. § 112, hereafter, "Invalidity Motion," Docket Item No.
559; Defendants' Motion for Summary Judgment that U.S. Pat. No. 6,970,917 is Not Entitled to
Claim Priority to U.S. Prov. Pat. Appl. 60/251,034 and that Claim 1 of the '917 Patent is Invalid
Under 35 U.S.C. § 102, hereafter, "Claim Priority Motion," Docket Item No. 565.)

1 evidence which it believes demonstrates the absence of a genuine issue of material fact.” Id. at 323.
2 If the moving party meets its initial burden, the “burden then shifts to the nonmoving party to
3 establish, beyond the pleadings, that there is a genuine issue for trial.” Miller v. Glenn Miller
4 Prods., Inc., 454 F.3d 975, 987 (9th Cir. 2006) (citing Celotex, 477 U.S. at 324).

5 When evaluating a motion for summary judgment, the court views the evidence through the
6 prism of the evidentiary standard of proof that would pertain at trial. Anderson v. Liberty Lobby
7 Inc., 477 U.S. 242, 255 (1986). The court draws all reasonable inferences in favor of the non-
8 moving party, including questions of credibility and of the weight that particular evidence is
9 accorded. See, e.g., Masson v. New Yorker Magazine, Inc., 501 U.S. 496, 520 (1992). The court
10 determines whether the non-moving party’s “specific facts,” coupled with disputed background or
11 contextual facts, are such that a reasonable jury might return a verdict for the non-moving party.
12 T.W. Elec. Serv. v. Pac. Elec. Contractors, 809 F.2d 626, 631 (9th Cir. 1987). In such a case,
13 summary judgment is inappropriate. Anderson, 477 U.S. at 248. However, where a rational trier of
14 fact could not find for the non-moving party based on the record as a whole, there is no “genuine
15 issue for trial.” Matsushita Elec. Indus. Co. v. Zenith Radio, 475 U.S. 574, 587 (1986).

16 Although the district court has discretion to consider materials in the court file not referenced
17 in the opposing papers, it need not do so. See Carmen v. San Francisco Unified Sch. Dist., 237 F.3d
18 1026, 1028-29 (9th Cir. 2001). “The district court need not examine the entire file for evidence
19 establishing a genuine issue of fact.” Id. at 1031. However, when the parties file cross-motions for
20 summary judgment, the district court must consider all of the evidence submitted in support of both
21 motions to evaluate whether a genuine issue of material fact exists precluding summary judgment
22 for either party. Fair Housing Council of Riverside Cnty, Inc. v. Riverside Two, 249 F.3d 1132,
23 1135 (9th Cir. 2001).

24 **III. DISCUSSION**

25 **A. Laches**

26 As an affirmative defense, Defendants assert that the lawsuit against them is barred by the
27 doctrine of laches. Plaintiff moves for summary judgment to eliminate the defense of laches on the
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1 ground that based on undisputed evidence with respect to the timing of the filing of this lawsuit,
2 Defendants cannot prove laches as a matter of law. In addition, Plaintiff contends that there is no
3 evidence that the timing of this lawsuit caused Defendants to suffer damages. (Laches Motion at 4-
4 6.) Defendants respond that summary judgment should be denied because: (1) after the '917 Patent
5 was issued, Plaintiff allowed nearly three years to pass before filing this lawsuit; and (2) there is a
6 genuine factual dispute over whether Defendants suffered damages based on the lapse of time
7 between the issuance of the patent and this suit.⁴

8 Under the doctrine of laches, a patent infringement action may be dismissed if the defendant
9 proves by a preponderance of evidence that: (1) “the plaintiff delayed filing suit for an unreasonable
10 and inexcusable length of time from the time the plaintiff knew or reasonably should have known of
11 its claim against the defendant”; and (2) “the delay operated to the prejudice or injury of the
12 defendant.” A.C. Aukerman Co. v. R.L. Chaides Const. Co., 960 F.2d 1020, 1032 (Fed. Cir. 1992).
13 “The length of time which may be deemed unreasonable has no fixed boundaries but rather depends
14 on the circumstances.” Id. “The period of delay is measured from the time the plaintiff knew or
15 reasonably should have known of the defendant’s alleged infringing activities to the date of suit.
16 However, the period does not begin prior to the issuance of the patent.” Id. If a patentee “delays
17 bringing suit for more than six years after the date the patentee knew or should have known of the
18 alleged infringer’s activity,” then a “presumption of laches arises.” Id. at 1028.

19 Although “a determination of what period of time constitutes an ‘unreasonable’ or
20 ‘inexcusable’ delay is a question of fact specific to each case,” courts have “typically found a period
21 of delay ‘unreasonable’ only when it substantially exceeded [four years].” IXYS Corp. v. Advanced
22 Power Tech., Inc., 321 F. Supp. 2d 1156, 1163 (N.D. Cal. 2004). A delay of three or four years has
23 been deemed “unreasonable only when that delay was accompanied by extraneous improper tactics
24 or misleading conduct by the plaintiff.” Id. (citing Federal Circuit cases).

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27 ⁴ (RIM’s Opposition to Mformation’s Motion for Summary Judgment of No Laches at 2-19,
28 hereafter, “Laches Opp’n,” Docket Item No. 587.)

1 Here, the record shows that the '917 Patent was issued on November 29, 2005. Thus, the
2 earliest possible date on which a claim of unreasonable delay could be based is November 29, 2005,
3 the date on which the Patent was issued. A.C. Aukerman Co., 960 F.2d at 1032. Plaintiff filed this
4 lawsuit on October 31, 2008. Accordingly, the time period upon which Defendants must rely to
5 prove unreasonable delay is two years and eleven months. Because this time period is less than six
6 years long, the presumption of laches does not attach. Id. at 1028. Furthermore, courts typically
7 find a period of delay "unreasonable" only when it "substantially exceed[s]" four years. IXYS
8 Corp., 321 F. Supp. 2d at 1163. Although there are patent infringement cases finding "unreasonable
9 delay" based on a time period of fewer than three years, in such cases the courts place an additional
10 burden on the defendant to prove that the delay was "accompanied by extraneous improper tactics or
11 misleading conduct" by the plaintiff. Id.

12 In recognition of this additional burden, Defendants proffer two kinds of evidence: (1)
13 evidence suggesting that Plaintiff's employees "had already developed suspicions" that it had a
14 "potential claim of infringement" against Defendants prior to receiving its Patent; and (2) evidence
15 that Defendants' product was "widely sold and promoted." (Laches Opp'n at 3-6.)

16 As to the first of Defendants' contentions, the evidence proffered by Defendants consists of
17 internal emails sent from certain employees of Plaintiff to other employees of Plaintiff. (See Laches
18 Opp'n, Exs. 2-8.) These emails, Defendants contend, "conclusively demonstrate" Plaintiff's
19 "familiarity" with Defendants' product and thus show that Plaintiff had knowledge of its patent
20 infringement claims as of November 29, 2005, the date when the '917 Patent was issued. (Id. at 3-
21 4.) However, viewed in the light most favorable to Defendants, these internal emails only show that
22 employees of Plaintiff were familiar with Defendants' product and that those employees suspected
23 that Plaintiff had a potential infringement claim. The emails do not constitute evidence of
24 "extraneous improper tactics or misleading conduct" by Plaintiff, and thus do not support
25 Defendants' contention that Plaintiff's delay of two years and eleven months in filing this lawsuit
26 was unreasonable. IXYS Corp., 321 F. Supp. 2d at 1163.

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1 As to the second of Defendants' contentions, the evidence proffered by Defendants shows
2 only that Defendants "widely marketed and sold" their product throughout the United States. (See
3 Laches Opp'n at 5-6; Id., Exs. 9-10, 13.) Again, viewed in the light most favorable to Defendants,
4 this evidence only speaks to whether employees of Plaintiff were familiar with Defendants' product.
5 As discussed above, however, the mere fact that employees of Plaintiff would have been familiar
6 with Defendants' product does not constitute evidence of "extraneous improper tactics or misleading
7 conduct" by Plaintiff of the kind that would be necessary to support Defendants' contention that
8 Plaintiff's delay in filing this lawsuit was unreasonable. IXYS Corp., 321 F. Supp. 2d at 1163.

9 The cases that Defendants rely upon in support of their contention that courts have "held that
10 three-year delays were unreasonable under circumstances analogous to those [in this case]" are
11 inapposite. (Laches Opp'n at 7.) In Odetics, Inc. v. Storage Technology Corp.,⁵ the court found that
12 the "laches period began to run" in 1988, and observed that, because "[m]ore than six years passed
13 between 1988 and the institution of this suit," a presumption of laches had arisen. Id. at 920-21. By
14 contrast, in this case the period of delay was less than three years long, meaning that the
15 presumption of laches does not arise.

16 In Wafer Shave, Inc. v. Gillette Co.,⁶ the court found that the plaintiff's delay in initiating
17 the lawsuit was unreasonable, given the plaintiff's misleading conduct, namely, the fact that the
18 plaintiff had threatened to sue the defendant before "lull[ing]" the defendant into "believing that the
19 threat had been abandoned." Id. at 128-29. By contrast, in this case Defendants present no evidence
20 of misleading conduct on the part of Plaintiff.

21 Finally, in Rosemount, Inc. v. Beckman Instruments, Inc.,⁷ the Federal Circuit upheld a
22 district court's finding that a plaintiff was not entitled to damages for infringement for a certain
23 product, because the plaintiff knew of the defendant's sales of that product during an earlier trial

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25 ⁵ 919 F. Supp. 911 (E.D. Va. 1996).

26 ⁶ 857 F. Supp. 112 (D. Mass. 1993).

27 ⁷ 727 F.2d 1540 (Fed. Cir. 1984).

1 between the two parties, but failed to include that product as an accused product at that trial. Id. at
2 1542. By contrast, in this case there was no earlier trial between the two parties at which it would
3 have been possible for Plaintiff to accuse the product at issue of infringement.

4 Accordingly, the Court GRANTS Plaintiff’s Motion of Summary Judgment with respect to
5 the defense of laches.⁸

6 **B. Anticipation**

7 As an affirmative defense, Defendants contend that Claim 1 of the ‘917 Patent is invalid as
8 anticipated. Plaintiff contends that it is entitled to summary judgment with respect to the defense of
9 anticipation, because none of the cited prior art references satisfy the legal requirements for
10 anticipation. In deciding whether prior art anticipates a patent claim, the Court must examine the
11 scope of the cited reference in light of the scope of the patent claim as construed by the Court.

12 **1. The Scope of Claim 1**

13 Claim 1 provides:

14 A method for remotely managing a wireless device over a wireless network
15 comprising a server and the wireless device, the wireless network operable to
16 communicatively connect the server and the wireless device, the method
comprising the steps of:

17 transmitting registration information relating to the wireless device from the
wireless device to the server;

18 verifying the registration information at the server; and

19 without a request from the wireless device, performing the steps of:

20 establishing a mailbox for the wireless device at the server,
21 placing a command for the wireless device in the mailbox at the
server,

22 delivering the command from the mailbox at the server to the
wireless device by establishing a connection between the wireless
device and the server, transmitting the contents of the mailbox from

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24 ⁸ In general, if a plaintiff objects to a defendant’s affirmative defense, it is proper for that
25 plaintiff to bring a motion to strike the affirmative defense. See, e.g., United States v. Union Gas
26 Co., 743 F. Supp. 1144, 1150 (E.D. Pa. 1990) (explaining that a motion to strike is the “primary
27 procedure” for objecting to “an insufficient affirmative defense”). However, courts have also held
28 that it is permissible for a plaintiff to move for summary judgment on affirmative defenses. See,
e.g., Wimbush v. Wyeth, 619 F.3d 632, 638 (6th Cir. 2010) (stating that “summary judgment is
available on affirmative defenses”).

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the server to the wireless device, and accepting the contents of the mailbox at the wireless device, and executing the command at the wireless device;

wherein the connection is established based on a threshold condition.

(‘917 Patent, Col. 7:22-44.)

On November 20, 2009, the Court held a hearing in accordance with Markman v. Westview Instruments, Inc.⁹ to construe the language of Claim 1. On February 25, 2010, the Court issued its First Claim Construction Order. (hereafter, “Markman,” Docket Item No. 127.) In summary, the Court gave the following construction to the words and phrases in Claim 1:

Disputed Claim Language in Claim 1	Court’s Construction
“remotely managing a wireless device over a wireless network”	“using the server that is physically separate from the wireless device to wirelessly control the functionality of the wireless device”
“server”	“a device or computer in a network that is dedicated to providing resources to the wireless device”
“establishing a mailbox for the wireless device at the server”	“creating an address in memory of the server that can store information intended for delivery to the wireless device”
“placing a command for the wireless device in the mailbox at the server”	“storing at the server in the mailbox associated with the wireless device a code or signal that is intended to cause the wireless device to take or cease an action with respect to its functionality and other data for use by the wireless device”
“transmitting the contents of the mailbox from the server to the wireless device”	“wirelessly sending from the server to the wireless device the contents of the mailbox”
“establishing a connection between the wireless device and the server . . . wherein the connection is established based on a threshold condition”	“establishing a connection between the wireless device and the server based on a predefined state of the server or the wireless device other than solely the elapsing of time”

In addition to the words and phrases that have been construed by the Court, Plaintiff contends that the references do not anticipate Claim 1 because none of the cited references disclose,

⁹ 517 U.S. 370 (1996).

1 *inter alia*, the limitation “without a request from the wireless device, performing the steps of.” In its
2 Claim Construction Order, the Court did not construe this limitation. Therefore, before addressing
3 the anticipation Motion, the Court proceeds to construe this additional limitation.

4 **2. Construction of “without a request from the wireless device, performing the**
5 **steps of”**

6 On August 31, 2011, the Court ordered the parties to submit additional briefing setting forth
7 their proposed definitions of the subject limitation. (Docket Item No. 645.) On September 7, 2011,
8 the parties submitted their proposed constructions.¹⁰ The parties’ supplemental briefing focuses on
9 the meaning of the phrase: “**without a request.**” (See Plaintiff’s Request Brief at 3; Defendants’
10 Request Brief at 4.)

11 The limitation “without a request from the wireless device, performing the steps of” is a
12 Preamble to enumerated steps. Some of the enumerated steps are disclosed as being performed
13 “without a request” from the wireless device “at the server” or “from the server.”¹¹ Some of the
14 enumerated steps implicitly disclose that the server performs the step.¹² Other enumerated steps
15 expressly disclose that the step is performed “at the wireless device.”¹³ However, because the
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18 ¹⁰ (Mformation Technologies, Inc.’s Claim Construction Brief For “Without a Request From
19 the Wireless Device,” hereafter, “Plaintiff’s Request Brief,” Docket Item No. 660; RIM’s Brief
20 Regarding Construction of “Without a Request From the Wireless Device,” hereafter, “Defendants’
Request Brief,” Docket Item No. 661.)

21 ¹¹ For example, “establishing a mailbox for the wireless device **at the server**; placing a
22 command for the wireless device in the mailbox **at the server**; transmitting the contents of the
mailbox **from the server** to the wireless device.”

23 ¹² For example, “delivering the command from the mailbox at the server to the wireless
24 device by establishing a connection between the wireless device and the server, wherein the
25 connection is established based on a threshold condition.” A person of ordinary skill would
26 understand the phrase “mailbox at the server” as a description of the location of the mailbox, and
would understand by implication that the server performs the delivering step and the “establishing a
connection” step.

27 ¹³ For example, “accepting the contents of the mailbox **at the wireless device**; and executing
28 the command **at the wireless device.**”

1 Preamble “without a request” applies to each enumerated step, the language must be construed in a
2 manner that would allow each step to be performed “without a request” from the wireless device.¹⁴

3 Pertinent to the construction of the phrase “without a request from the wireless device,” the
4 written description discusses two types of devices:

5 A pull device is a device that must request data before the data is transmitted
6 to the device. A push device is a device to which data is transmitted without the device
7 requesting the data, but which will nevertheless accept the data. In an embodiment in
8 which remotely managed device 502 is a pull device, the management agent running
9 on device 502 will occasionally connect to management server 508 and request the
10 commands in mailbox 512. In an embodiment in which remotely managed device 502
11 is a push device, management server 508 will occasionally connect to remotely
12 managed device 502 and transmit the commands in mailbox 512 to management agent
13 504.

14 (‘917 Patent, Col. 6:39-50.)

15 Based on the claim language and the written description, the Court finds that a person of
16 ordinary skill in the art would understand that in using the phrase “without a request from the
17 wireless device,” the inventors were referring to functions that are performed as a “push” function.

18 Accordingly, as used in Claim 1 of the ‘917 Patent, the Court construes “without a request
19 from the wireless device, performing the steps of” to mean:

20 **Performing an enumerated step without the transmission from the wireless device of a
21 code, signal or any other form of request that initiates the commencement of the
22 performance of the step.**

23 **3. Anticipation**

24 Having now construed the language of Claim 1, the Court proceeds to consider Plaintiff’s
25 Motion for Summary Judgment that Defendants have insufficient evidence to sustain the defense of
26 anticipation.

27 ¹⁴ The Court notes that two of the steps (accepting the contents of the mailbox at the wireless
28 device, and executing the command at the wireless device) are performed “at” the wireless device.
If the wireless device is the device that performs the step, it is potentially ambiguous to provide that
steps are done “at the [wireless] device” “without a request from the wireless device.” As construed
by the Court, a “request” is directed by one device to another and ordinarily is not used to disclose a
process in which the act that is being requested is performed by the device that is making the
request. The Court reserves this matter for later consideration.

1 An invention claimed in a patent is anticipated under § 102(b) if “the invention was patented
2 or described in a printed publication . . . more than one year prior to the date of the application.”
3 Advanced Display Sys., Inc. v. Kent State Univ., 212 F.3d 1272, 1282 (Fed. Cir. 2000).
4 A determination that a patent is invalid as being anticipated requires a finding that “each and every
5 limitation is found either expressly or inherently in a single prior art reference.” Celeritas Techs.,
6 Ltd. v. Rockwell Int’l Corp., 150 F.3d 1354, 1361 (Fed. Cir. 1998). “Under the principles of
7 inherency, if the prior art necessarily functions in accordance with, or includes, the claimed
8 limitations, it anticipates.” See In re Cruciferous Sprout Litig., 301 F.3d 1343, 1349 (Fed. Cir.
9 2002) (citation omitted). When there is no genuine issue of material fact, a court may resolve a
10 question of anticipation on summary judgment. PowerOasis, Inc. v. T-Mobile USA, Inc., 522 F.3d
11 1299, 1301 (Fed. Cir. 2008) (affirming grant of summary judgment of anticipation under § 102(b));
12 Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1381 (Fed. Cir. 2001). Since an
13 issued patent is presumed to be valid, a party challenging the patent must prove anticipation by clear
14 and convincing evidence. WMS Gaming, Inc. v. Int’l Game Tech., 184 F.3d 1339, 1355 (Fed. Cir.
15 1999).

16 Here, Defendants base their anticipation defense on four separate prior art references: (1)
17 Unicenter; (2) the Howard Patent; (3) Mobitex; and (4) RemoteWare. (Anticipation Motion at 2-4.)
18 Plaintiff does not contend that any of the four alleged prior art references are not, in fact, prior art
19 under § 102(b). However, Plaintiff contends that the evidence is undisputed that none of the
20 references disclose all of the limitations of Claim 1.

21 In reply to Plaintiff’s Motion, as to each of the prior art references Defendants primarily rely
22 on the testimony of their expert, Dr. Anthony Acampora, and other documentary evidence as raising
23 a genuine factual dispute over the scope of the prior art. Having examined the proffered evidence,
24 and without intending to comment on the credibility of Dr. Acampora’s multiple opinions, rather
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1 than recite its analysis of each limitation as applied to each reference,¹⁵ the Court summarily finds
2 that these opinions and documentary evidence create a genuine factual dispute as to whether Claim 1
3 is invalid as anticipated by each of the four references.

4 Accordingly, the Court DENIES Plaintiff’s Anticipation Motion.

5 **C. Inequitable Conduct Motion**

6 As affirmative defenses, Defendants allege that in prosecuting the ‘917 Patent, Plaintiffs or
7 their counsel Michael Schwartz (“Schwartz”) engaged in inequitable conduct by intentionally failing
8 to disclose the following information to the U.S. Patent and Trademark Office (“PTO”): (1)
9 Schwartz failed to disclose a material reference (“Parkinson”) to the PTO; (2) Plaintiff failed to
10 identify Gurinder Johar (“Johar”) as an inventor of the ‘917 Patent; and (3) Schwartz failed to
11 disclose two other material references (“Dimech” and “Geiger”) to the PTO.

12 To prevail on a claim of inequitable conduct, the accused infringer must prove that the
13 patentee acted with the specific intent to deceive the PTO. Therasense, Inc. v. Becton, Dickinson
14 and Co., 649 F.3d 1276, 1290 (Fed. Cir. 2011). “In other words, the accused infringer must prove
15 by clear and convincing evidence that the applicant knew of the reference, knew that it was material,
16 and made a deliberate decision to withhold it.” Id. “[T]o meet the clear and convincing evidence
17 standard, the specific intent to deceive must be ‘the single most reasonable inference able to be
18 drawn from the evidence.’ Indeed, the evidence ‘must be sufficient to *require* a finding of deceitful
19 intent in the light of all the circumstances.’ Hence, when there are multiple reasonable inferences
20 that may be drawn, intent to deceive cannot be found.” Id. at 1290-91 (citations omitted) (emphasis
21 in original).

22 With respect to each of these alleged failures, Plaintiff moves for summary judgment on the
23 ground that there is insufficient evidence that it or Schwartz withheld material information from the
24 PTO or that either of them had a specific intent to deceive the PTO. (Inequitable Conduct Motion at
25 11-23.) The Court considers the evidence with respect to each of these grounds in turn.

26 ¹⁵ The Court observes that a genuine dispute over a single limitation would suffice to require
27 denial of the Motion.

1 **1. The Parkinson Reference**

2 Plaintiff proffers evidence that Schwartz believed that he had disclosed the Parkinson
3 reference to the PTO because he specifically disclosed it in the provisional patent application on
4 which the ‘917 Patent application was based.¹⁶ The Parkinson reference was disclosed (by patent
5 number and title) as one of eight “References” in a table in the provisional patent application. (Id.,
6 Ex. P at 4.) Thus, Plaintiff provides evidence which permits the reasonable inference that Schwartz
7 believed with good faith that he had disclosed the Parkinson reference to the PTO.

8 Accordingly, the evidence is insufficient to require a finding of deceitful intent on the part of
9 Schwartz, which means that intent to deceive cannot be found. Therasense, 649 F.3d at 1290-91.

10 **2. Identification of Johar**

11 With respect to Plaintiff’s alleged failure to identify Johar as one of the inventors of the ‘917
12 Patent, Plaintiff proffers the following evidence to establish that there was no deceitful intent: (1)
13 Johar himself never indicated to anyone at Mformation that he believed he should be named as an
14 inventor on the ‘917 Patent;¹⁷ and (2) the named inventors of the ‘917 Patent provided a copy of the
15 draft application for the Patent to Johar, asking him to review it and inviting him to “add more stuff”
16 to it before it was sent to the PTO. (Id., Ex. J at UBA0006763.) The evidence shows that Johar did
17 not indicate to the named inventors that he too should have been named as an inventor. (Id., Ex. I at
18 236:24-237:22.) Thus, Plaintiff provides evidence which permits the reasonable inference that
19 Plaintiff did not believe that Johar should be regarded as an inventor of the ‘917 Patent.

20 Accordingly, the evidence is insufficient to require a finding of deceitful intent on the part of
21 Plaintiff as to its failure to identify Johar as a named inventor, which means that intent to deceive
22 cannot be found. Therasense, 649 F.3d at 1290-91.

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26 ¹⁶ (See Inequitable Conduct Motion, Ex. O at 143:1-144:7.)

27 ¹⁷ (Inequitable Conduct Motion, Ex. I at 253:3-13.)

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1 **3. The Dimech and Geiger References**

2 In support of its contention that Schwartz acted with deceitful intent, Defendants contend that
3 he “knew of [the Dimech and Geiger references] during prosecution of the ‘917 application and
4 failed to disclose them” to the PTO. (Inequitable Opp’n at 24.) In particular, Defendants contend
5 that: (1) Schwartz was prosecuting both the ‘917 Patent and a second application, the ‘408
6 application, which was a “continuation-in-part of the ‘917 application,” at the same time; and (2)
7 Schwartz disclosed the Dimech and Geiger references as ones “of particular relevance” to the ‘408
8 application, but failed to disclose them during prosecution of the ‘917 application, even though he
9 “both knew of the similarities between the ‘408 and ‘917 applications and was aware of the specific
10 teachings in Dimech and Geiger regarding limitations that appear in both the ‘408 and ‘917
11 applications.” (Id. at 25.) Thus, Defendants contend that the “most reasonable inference” to be
12 drawn is that Schwartz: (1) knew that the Dimech and Geiger references were material to the ‘917
13 Patent, and (2) acted with intent to deceive the PTO by failing to disclose them. (Id.)

14 In response, Plaintiff contends that it would be reasonable to infer that Schwartz either
15 “simply never considered Dimech and Geiger to be material to the ‘917 patent,” or else that he
16 “never made an affirmative decision not to disclose” those references during prosecution of the ‘917
17 Patent, and that it is therefore not the case that the evidence “requires” a finding of deceitful intent.¹⁸
18 In support of this contention, Plaintiff proffers the following evidence: (1) the ‘408 patent and ‘917
19 Patent are directed to different technologies, and for that reason were assigned to “different art units”
20 within the PTO for examination;¹⁹ and (2) although the Dimech and Geiger references were
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24 ¹⁸ (Mformation Technologies, Inc.’s Reply Memorandum in Support of its Motion for
25 Summary Judgment of No Inequitable Conduct at 15, Docket Item No. 620.)

26 ¹⁹ (Compare Inequitable Conduct Motion, Ex. F at RIM-MF1753321 (noting that the ‘408
27 Patent was assigned to “Art Unit 2145”) with id., Ex. D at RIM-MF1753159 (noting that the patent
28 application from which the ‘917 Patent was issued was assigned to “Art Unit 2142”).)

1 disclosed in prosecution of the '408 Patent, the examiner for that patent did not address those
2 references, did not rely on either, and allowed the patent to issue over the references.²⁰

3 Upon review, the Court finds that Defendants do not meet their burden of showing that
4 Schwartz: (1) knew that the Dimech and Geiger references were material; and (2) made a deliberate
5 decision to withhold them. The evidence presented by Plaintiff permits the reasonable inference that
6 Schwartz did not consider the Dimech and Geiger references to be material to the '917 Patent. But
7 if that reasonable inference is drawn, it necessarily leads to the conclusion that Schwartz did not act
8 with the requisite deceitful intent when he failed to disclose the Dimech and Geiger references to the
9 PTO in the prosecution of the '917 Patent. Thus, Defendants have not shown that the evidence
10 "requires" a finding of deceitful intent, which means that intent to deceive cannot be found.

11 Therasense, 649 F.3d at 1290-91.

12 Accordingly, the Court GRANTS Plaintiff's Motion for Summary Judgment against
13 Defendants on the affirmative defense of inequitable conduct on the ground that based on the
14 undisputed evidence, Defendants cannot prove inequitable conduct as a matter of law.

15 **D. Indefiniteness Motion**

16 As an affirmative defense, Defendants contend that all of the Claims of the '917 Patent are
17 invalid because (1) the phrases "the contents of the mailbox" and "enabling/disabling" are indefinite;
18 (2) the phrase "enabling/disabling" lacks written description and is not enabled, rendering claims 5,
19 21 and 22 invalid; (3) the term "mailbox" is indefinite, and the step of "establishing a mailbox" and
20 the term "mailbox" lack written description and are not enabled; and (4) Claim 4 of the '917 Patent
21 contains contradictory elements making it nonsensical, which renders it invalid.²¹

22 Plaintiff moves for summary judgment that Claims 1, 4, 5, 6, 21-25, and 27 of the '917
23 Patent are definite, contain sufficient written description and are enabled, on the grounds that: (1)

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25 ²⁰ (See id., Ex. F. at RIM-MF1753237-3317.)

26 ²¹ (RIM's Opposition to Mformation's Motion for Summary Judgment of No Indefiniteness,
27 No Lack of Written Description, and No Lack of Enablement Under 35 U.S.C. § 112 at 3-13,
hereafter, "Indefiniteness Opp'n," Docket Item No. 593.)

1 each of the three claim terms Defendants contend are indefinite are “amenable to construction,” and
2 the Court has in fact already construed two of them, meaning that the claims are not indefinite as a
3 matter of law; and (2) as a matter of law, Defendants cannot prove that the contested terms are not
4 enabled or lack written description. (Indefiniteness Motion at 3-11.)

5 **1. Standards**

6 “A patent is presumed valid, and the burden of establishing invalidity as to any claim of a
7 patent rests upon the party asserting such invalidity. Clear and convincing evidence is required to
8 invalidate a patent.” Aero Prods. Int’l, Inc. v. Intex Recreation Corp., 466 F.3d 1000, 1015 (Fed.
9 Cir. 2006). Whether a claim is sufficiently definite to satisfy the statutory requirements of patent
10 law is a question of law. See id. “If a claim is amenable to construction, ‘even though the task may
11 be formidable and the conclusion may be one over which reasonable persons will disagree,’ the
12 claim is not indefinite.” Id. at 1016 (citation omitted).

13 Title 35 U.S.C. § 111 provides that an application for a patent must include a “specification”
14 which complies with the requirements of § 112. Section 112 requires, *inter alia*, the specification to
15 conclude with the recitation of one or more claims:

16 The specification shall conclude with one or more claims particularly pointing out
17 and distinctly claiming the subject matter which the applicant regards as his
invention.

18 35 U.S.C. § 112.

19 In addition, § 112 requires that the specification satisfy three separate, but related,
20 requirements: (1) it must contain a “written description” of the invention; (2) it must enable a person
21 of skill in the art to make and use the invention; and (3) if the inventor contemplates one, it must set
22 forth the best mode for carrying out the invention:

23 The specification shall contain a written description of the invention, and of the
24 manner and process of making and using it, in such full, clear, concise, and exact terms
25 as to enable any person skilled in the art to which it pertains, or with which it is most
nearly connected, to make and use the same, and shall set forth the best mode
contemplated by the inventor of carrying out his invention.

26 35 U.S.C. § 112; see also Univ. of Rochester v. G. D. Searle & Co., 358 F.3d 916, 921 (Fed. Cir.
27 2004).

1 Although the three requirements are related, the “written description” requirement is distinct
2 and independent from the “enablement” and “best mode requirement.” Univ. of Rochester, 358 F.3d
3 at 922. There have been cases in which the courts have held that a specification met the written
4 description requirement, but nevertheless found that the description was not “enabling.” Id. (citing
5 In re Alton, 76 F.3d 1168, 1172 (Fed. Cir. 1996)). Similarly, there have been cases holding a
6 specification “enabling” of the invention as disclosed, but holding that it did not contain an adequate
7 “written description” of other parts of the invention. Id.

8 The written description must “clearly allow persons of ordinary skill in the art to recognize
9 that [the inventor] invented what is claimed.” Ariad Pharm., Inc. v. Eli Lilly and Co., 598 F.3d
10 1336, 1351 (Fed. Cir. 2010) (citation omitted). “In other words, the test for sufficiency is whether
11 the disclosure of the application relied upon reasonably conveys to those skilled in the art that the
12 inventor had possession of the claimed subject matter as of the filing date.” Id. (citations omitted).
13 Whether the written description requirement is met is a question of fact. See Martek Biosciences
14 Corp. v. Nutrinova, Inc., 579 F.3d 1363, 1369-70 (Fed. Cir. 2009).

15 To be enabling, “the specification of a patent must teach those skilled in the art how to make
16 and use the full scope of the claimed invention without ‘undue experimentation.’” Genentech, Inc.
17 v. Novo Nordisk A/S, 108 F.3d 1361, 1365 (Fed. Cir. 1997) (citations omitted). Whether the
18 enablement requirement is met is a mixed question of law and fact. See id.

19 **2. Whether “The Contents of the Mailbox” and “Enabling/Disabling” Are**
20 **Indefinite**

21 Here, the Court finds that both of these phrases are amenable to construction, which means
22 that they do not render the claims indefinite. Aero Prods., 466 F.3d at 1016. First, as to “the
23 contents of the mailbox,” the Court construed “transmitting the contents of the mailbox from the
24 server to the wireless device” in its Claim Construction Order. (See Markman at 16-17.) In the
25 course of construing that term, the Court explained that “contents,” in this context, means, for
26 example, a “new program,” as opposed to a “command to store a new program.” (Id. at 16.)
27 Second, as to the phrase “enabling/disabling,” the Court finds that it may be construed to mean
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1 “enabling *or* disabling,” as discussed below. Thus, because the phrases are amenable to
2 construction, they therefore are not indefinite.

3 Accordingly, the Court GRANTS Plaintiff’s Motion as to the non-indefiniteness of the
4 phrases “the contents of the mailbox” and “enabling/disabling.”

5 **3. Whether “Enabling/Disabling” Meets the Written Description and Enablement**
6 **Requirements**

7 Defendants contend that the phrase “enabling/disabling” lacks written description and is not
8 enabled. (Indefiniteness Opp’n at 6-7.) In support of this contention, Defendants offer testimony
9 from their expert, Dr. Acampora, that one of ordinary skill in the art would not understand what this
10 phrase means, and that there is no way to practice the claimed phrase.²² Plaintiff contends that,
11 when the phrase appears in Claim 21, the patent reads “wherein the command comprises
12 enabling/disabling access of the wireless device to the server,” and contends that it “would make
13 little sense” for the phrase to mean “enabling and disabling,” given this context, as “it makes little
14 sense for a command to both enable and disable access of the wireless device to the server at the
15 same time.” (Indefiniteness Motion at 8.) Thus, Plaintiff contends that it is “abundantly clear” that
16 a person of ordinary skill in the art would recognize, given this context, that “enabling/disabling”
17 means “enabling or disabling.” (*Id.*) In support of this contention, Plaintiff offers evidence from its
18 expert, Dr. Vijay Madiseti (“Madiseti”), who testifies that a person of ordinary skill in the art
19 would interpret enabling/disabling to mean “enabling or disabling.”²³ Madiseti further testifies that
20 because one of the described commands includes “enabling/disabling access to the server,” a person
21 of ordinary skill in the art would know that the phrase has to mean “enabling or disabling,” because
22 performing both tasks at once would not make sense. (*Id.*)

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24 ²² (Indefiniteness Motion, Ex. A, Expert Report of Dr. Anthony Acampora Regarding the
25 Invalidity of U.S. Patent No. 6,970,917 at ¶¶ 594, 596, hereafter, “Acampora Report,” Docket Item
26 No. 558-1.)

27 ²³ (See Declaration of Amar L. Thakur in Support of Mformation Technologies, Inc.’s
28 Opposition to RIM’s Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 112, Ex. C,
Expert Report of Vijay Madiseti, Ph.D., Regarding Validity of Patent No. 6,970,917 at ¶ 364,
Docket Item No. 589-3.)

1 Based on the conflicting expert testimony, the Court finds that there is a genuine issue of
2 material fact as to whether one of ordinary skill in the art would find that the phrase
3 “enabling/disabling” has adequate written description. Therefore, summary judgment is
4 inappropriate as to this issue.

5 Accordingly, the Court DENIES Plaintiff’s Motion as to whether the phrase
6 “enabling/disabling” meets the written description and enablement requirements.

7 **4. Whether the Term “Mailbox” Is Indefinite**

8 Here, the Court finds that this phrase is amenable to construction, which means that it does
9 not render the claims indefinite. Aero Prods., 466 F.3d at 1016. In its Claim Construction Order,
10 the Court construed several phrases pertaining to the “mailbox,” including, *inter alia*, “establishing a
11 mailbox for the wireless device at the server.” (See Markman at 12-13.) In the course of construing
12 that phrase, the Court found that, in the field of electronics, the word “mailbox” is “commonly used
13 to refer to a storage location for information intended for a particular addressee.” (Id. at 12.) The
14 Court construed the phrase to mean “creating an address in memory of the server that can store
15 information intended for delivery to the wireless device.” (Id. at 13.) In arriving at this
16 construction, the Court necessarily found that the term “mailbox” was amenable to construction.

17 Accordingly, the Court GRANTS Plaintiff’s Motion as to the non-indefiniteness of the term
18 “mailbox.”

19 **5. Whether the Step of “Establishing a Mailbox” and the Term “Mailbox” Meet
20 the Written Description and Enablement Requirements**

21 Defendants contend that the step of “establishing a mailbox” and the term “mailbox” lack
22 written description and are not enabled. (Indefiniteness Opp’n at 9-10.) In support of this
23 contention, Defendants offer testimony from their expert that one of ordinary skill in the art would
24 not understand either this step or this term, and would be unable to practice them. (Acampora
25 Report ¶¶ 580-85.) In response, Plaintiff contends that Defendants’ own expert has stated that one
26 of skill in the art “would understand that there are a limitless number of ways to implement these
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1 elements,” and contends that this means that one of ordinary skill in the art would not “need undue
2 experimentation” to implement them. (Indefiniteness Motion at 10.)

3 Upon review, the Court finds that there is a genuine issue of material fact as to whether one
4 of ordinary skill would know how to implement these elements in the manner claimed in the ‘917
5 Patent. In particular, the Court finds that the testimony from Dr. Acampora, on which both sides
6 rely, states that one of skill in the art “would understand that there are many known algorithms that
7 might be applied to accomplish” the step at issue, and further states that one of skill in the art “would
8 not know whether the claim covers one of these, several of these, or all of these, or whether the
9 patentees had some new algorithm in mind.” (Acampora Report ¶ 580.) Based on this evidence,
10 which is the only evidence presented as to this issue, the Court finds that it is unclear, as a matter of
11 fact, whether the written description and enablement requirements are met here. Accordingly,
12 summary judgment is inappropriate as to this issue.

13 Accordingly, the Court DENIES Plaintiff’s Motion as to whether the step of “establishing a
14 mailbox” and the term “mailbox” meet the written description and enablement requirements.

15 **6. Whether Claim 4 of the ‘917 Patent Is “Impossible and Nonsensical”**

16 Defendants contend that Claim 4 of the ‘917 Patent is “impossible and nonsensical,” because
17 it requires that the connection between the server and wireless device be “established based on both
18 solely the elapsing of time and other than solely the elapsing of time.” (Indefiniteness Opp’n at 11.)

19 Upon review, the Court finds that Claim 4 is not “impossible and nonsensical.” In its claim
20 construction, the Court construed the phrase “establishing a connection between the wireless device
21 and the server . . . wherein the connection is established based on a threshold condition.” The Court
22 found that this phrase means a connection “between the wireless device and the server based on a
23 predefined state of the server or the wireless device other than solely the elapsing of time.” (See
24 Markman at 19.) Thus, the Court only found that conditions that are based “solely” on the “elapsing
25 of time” could not be used to establish a connection between the wireless device and the server.
26 From this, it follows that, for example, conditions that are based on *both* a predefined state of the
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1 server and the elapsing of time are included under the Court’s construal of Claim 4. Because Claim
2 4 may comprise such possible conditions, it is not “impossible and nonsensical.”

3 Accordingly, Plaintiff’s Motion is GRANTED as to whether Claim 4 of the ‘917 Patent is
4 invalid due to containing contradictory elements.²⁴

5 **E. Public Use Motion and Claim Priority Motion**

6 As an affirmative defense, Defendants contend that the ‘917 Patent is invalid because
7 Plaintiff publicly demonstrated and used a prototype that implemented and performed every step of
8 Claim 1 of the ‘917 Patent at a demonstration on July 24, 2000, more than one year before the ‘536
9 Application was filed on August 10, 2001. In conjunction with this contention, Defendants contend
10 that Plaintiff is not entitled to claim priority to Provisional Patent Application 60/251,034 (“the ‘034
11 Provisional Application”), filed on December 5, 2000.²⁵ (Claim Priority Motion at 1, 6, 12.) The
12 parties have made cross-motions for summary judgment on these issues.

13 “A person shall be entitled to a patent unless . . . the invention was patented or described in a
14 printed publication in this or a foreign country or in public use or on sale in this country, more than
15 one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b).
16 “Public use includes ‘any [public] use of [the claimed] invention by a person other than the inventor
17 who is under no limitation, restriction or obligation of secrecy to the inventor.’” Motionless
18 Keyboard Co. v. Microsoft Corp., 486 F.3d 1376, 1384 (Fed Cir. 2007) (quoting In re Smith, 714
19 F.2d 1127, 1134 (Fed. Cir. 1983)). “When the asserted basis of invalidity is prior public use, the
20 party with the burden of proof must show that ‘the subject of the barring activity met each of the
21 limitations of the claim, and thus was an embodiment of the claimed invention.’” Juicy Whip, Inc.
22 v. Orange Bang, Inc., 292 F.3d 728, 737 (Fed. Cir. 2002) (quoting Scaltech Inc. v. Retec/Tetra,

24 ²⁴ In light of the Court’s disposition of this Motion, the Court DENIES Defendants’ Motion
25 for Summary Judgment that Claims 1, 4-6, 21-25, and 27 of U.S. Patent No. 6,970,917 are Invalid
Under 35 U.S.C. § 112. (See Docket Item No. 559.)

26 ²⁵ Because the Court concludes that neither party is entitled to summary judgment on the
27 issue of public use, the Court does not reach whether Plaintiff is entitled to claim priority to the ‘034
Provisional Application.

1 L.L.C., 178 F.3d 1378, 1383 (Fed. Cir. 1999)). Because a patent carries a statutory presumption of
2 validity, a party challenging the validity of a patent on the basis of prior use must show by clear and
3 convincing evidence that the invention was in public use more than one year prior to filing the
4 application. Am. Seating Co. v. USSC Group, Inc., 514 F.3d 1262, 1267 (Fed. Cir. 2008).
5 “Generally, oral testimony of prior public use must be corroborated in order to invalidate a patent.”
6 Juicy Whip, 292 F.3d at 737-38.

7 Here, the Court finds that summary judgment is inappropriate because there is a factual
8 dispute as to whether the invention was in public use before August 10, 2000, one year prior to the
9 filing of the ‘534 Application. Defendants rely exclusively on statements from the deposition of Dr.
10 Rakesh Kushwaha²⁶ to the effect that the July 24, 2000 demonstration included each step and
11 limitation of Claim 1 of the ‘917 Patent. (Claim Priority Motion at 12-13.) However, by itself this
12 uncorroborated deposition testimony is insufficient to establish invalidity due to public use. Juicy
13 Whip, 292 F.3d at 737-38; Finnigan Corp. v. Int’l Trade Com’n, 180 F.3d 1354, 1367 (Fed. Cir.
14 1999). Moreover, Dr. Kushwaha later gave conflicting deposition testimony that the prototype
15 demonstrated on July 24, 2000 did not implement the “wireless registration” or “threshold
16 condition” limitations of Claim 1.²⁷ These statements were corroborated by testimony from Harish
17 Magam, Plaintiff’s Director of Engineering. (Id., Ex. G at 1.) The Court finds that Dr. Kushwaha’s
18 conflicting testimony regarding the July 24, 2000 demonstration raises a disputed issue of material
19 fact that precludes summary judgment.

20 Defendants’ reliance on Radobenko v. Automated Equipment Corp. for the proposition that
21 Dr. Kushwaha’s later conflicting testimony cannot raise a disputed issue of fact is misplaced. 520

23 ²⁶ Dr. Kushwaha is a co-founder and Chief Technology Officer of Plaintiff. (See
24 Declaration of Rakesh Kushwaha, Ph.D., in Support of Mformation Technologies, Inc.’s Opposition
25 to RIM’s Motion for Summary Judgment of Noninfringement of U.S. Patent No. 6,970,917 at ¶1,
Docket Item No. 600.)

26 ²⁷ (Declaration of Amar L. Thakur in Support of Mformation Technologies, Inc.’s
27 Opposition to RIM’s Motion for Summary Judgment that U.S. Pat. No. 6,970, 917 is Not Entitled to
Claim Priority to U.S. Prov. Pat.. Appl. 60/251, 034 and that Claim 1 of the ‘917 Patent is Invalid
under 35 U.S.C. § 102, Ex. E at 198:21-199:7, Docket Item No. 591.)

1 F.2d 540 (9th Cir. 1975). In that case, the plaintiff filed an affidavit that flatly contradicted his
2 previous deposition testimony in an attempt to defeat a motion for summary judgment. Id. at 544.
3 The Ninth Circuit rejected the affidavit on the ground that it was “convinced that the issues of fact
4 created by [Plaintiff] are not issues which this [c]ourt could reasonably characterize as genuine;
5 rather, they are sham issues which should not subject the defendants to the burden of a trial.” Id.
6 The court noted that “[i]f a party who has been examined at length on deposition could raise an issue
7 of fact simply by submitting an affidavit contradicting his own prior testimony, this would greatly
8 diminish the utility of summary judgment as a procedure for screening out sham issues of fact.” Id.
9 (citation omitted). In Kennedy v. Allied Mut. Ins. Co., the Ninth Circuit clarified its holding in
10 Radobenko by stating that “before applying the Radobenko sanction, the district court must make a
11 factual determination that the contradiction was actually a ‘sham.’” 952 F.2d 262, 267 (9th Cir.
12 1991). In this case, Dr. Kushwaha provided the deposition testimony challenged by Defendants
13 months prior to the filing of these Motions. Moreover, in making changes to his prior testimony, Dr.
14 Kushwaha explained that the questions asked at the previous session of his deposition “were
15 confusing” and that he felt that he needed to clarify his answers.²⁸ Based on this evidence, the Court
16 does not find that the contradictory testimony provided by Dr. Kushwaha “was actually a sham” that
17 cannot raise a disputed issue of fact.

18 In light of the evidence presented, the Court finds that there is a triable issue of fact over
19 whether Plaintiff publicly demonstrated the invention claimed in the ‘917 Patent before August 10,
20 2000. Accordingly, the Court DENIES the Public Use Motion and the Claim Priority Motion.

21 **F. Damages Motion**

22 Defendants move for summary judgment limiting Plaintiff’s damages to those that accrued
23 after October 27, 2008. (Damages Motion at 2-8.) The parties agree that Plaintiff did not inform
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26 ²⁸ (Declaration of Amar L. Thakur in Support of Mformation Technologies, Inc.’s Notice of
27 Motion and Motion for Summary Judgment that U.S. Patent No. 6,970,917 is Not Invalid Due to
28 Public Use, Ex. D at 201-202, Docket Item No. 563.)

1 Defendants prior to filing suit that Defendants were infringing the '917 Patent.²⁹ Defendants
2 contend that Plaintiff may not seek damages for any infringement before that date because of their
3 failure to provide notice. (Damages Motion at 4.) Plaintiff responds that because only method
4 claims are at issue in this litigation, the notice provisions of 35 U.S.C. § 287(a) do not apply and it is
5 entitled to damages from the date the '917 patent was issued. (Damages Opp'n at 1.) Because the
6 parties agree that notice was not provided before October 27, 2008, the Court finds that there are no
7 issues of material fact in dispute in regard to Defendants' Damages Motion. Thus, the issue before
8 the Court in determining the damages period is whether, as a matter of law, the notice requirements
9 of § 287(a) apply to Plaintiff's claims.

10 Title 35 U.S.C. § 287(a) limits liability for patent infringement by requiring a patentee to
11 give notice to the public of the patent by marking the patented product with the word "patent" along
12 with the patent number. See, e.g., Devices for Med., Inc. v. Boehl, 822 F.2d 1062, 1063 (Fed. Cir.
13 1987). If the patented product is not labeled as such, damages are recoverable only for the period
14 after the infringer was "notified of the infringement."³⁰ 35 U.S.C. § 287(a). The marking
15 requirements of § 287(a) do not apply to patents containing only method claims. Bandag, Inc. v.
16 Gerrard Tire Co., 704 F.2d 1578, 1581 (Fed. Cir. 1983). Thus, where a patent containing only
17 method claims is at issue, a defendant may be liable for the entire period of infringement, even if it
18 lacked any notice of its alleged infringement. Id.

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22 ²⁹ (Damages Motion, Ex. 2, Deposition of Rakesh Kushwaha at 279:2-279:8, Docket Item
23 No. 545-2 (acknowledging that Plaintiff did not provide Defendants with actual notice prior to filing
24 of lawsuit); Mformation Technologies, Inc.'s Opposition to RIM's Motion for Partial Summary
25 Judgment to Limit Pre-Suit Damages at 1-4, hereafter, "Damages Opp'n," Docket Item No. 581
26 (acknowledging that Plaintiff did not begin marking product until October 27, 2008).)

27 ³⁰ The notice required under § 287(a) "must be an affirmative act on the part of the patentee
28 which informs the defendant of his infringement." Amsted Indus. Inc. v. Buckeye Steel Castings
Co., 24 F.3d 178, 187 (Fed. Cir. 1994). "Actual notice requires the affirmative communication of a
specific charge of infringement by a specific accused product or device." Id. As discussed above,
the parties agree that no such affirmative communication was made by Plaintiff to Defendants before
Plaintiff filed suit.

1 In Hanson v. Alpine Valley Ski Area,³¹ the Federal Circuit expanded the realm of cases to
2 which marking requirements do not apply, holding that even if a patent contains both apparatus and
3 method claims, § 287(a) does not apply if only method claims have been asserted against the
4 defendant. This holding was re-affirmed in Crown Packaging Tech., Inc. v. Rexam Beverage Can
5 Co.,³² where the Federal Circuit reviewed a case involving a plaintiff who had asserted only method
6 claims against an alleged infringer. The court found that because the facts in Crown Packaging were
7 “identical” to those in Hanson, it was “bound” to conclude that § 287(a) did not apply where no
8 apparatus claim had been asserted. 559 F.3d at 1316-17.

9 By contrast, in American Medical Systems, Inc. v. Medical Engineering Corp.,³³ the Federal
10 Circuit made clear that where a patent contains both apparatus and method claims, and both have
11 been asserted against a defendant, a plaintiff may seek pre-notice damages for infringement of the
12 method claim only if the corresponding apparatus has been marked.³⁴ Thus, if a plaintiff chooses to
13 assert both apparatus and method claims under a patent, damages prior to actual notice are available
14 only if the apparatuses have been marked. Id.

15 Here, Plaintiff asserted both the apparatus and the method claims of the ‘917 patent against
16 Defendants.³⁵ Plaintiff also concedes that it could have marked the apparatuses claimed under the
17 ‘917 Patent with the patent numbers for the method claims.³⁶ Plaintiff contends, however, that since
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19 ³¹ 718 F.2d 1075, 1083 (Fed. Cir. 1983).

20 ³² 559 F.3d 1308 (Fed. Cir. 2009).

21 ³³ 6 F.3d 1523 (Fed. Cir. 1993).

22 ³⁴ See Am. Med. Sys., 6 F.3d at 1538-39 (“[T]o the extent that there is a tangible item to
23 mark by which notice of the asserted method claims can be given, a party is obliged to do so if it
intends to avail itself of the constructive notice provisions of [§ 287(a)].”).

24 ³⁵ (See Damages Motion, Ex. 1, Mformation Technologies, Inc.’s Disclosure of Asserted
25 Claims and Infringement Contentions, Docket Item No. 545-1.)

26 ³⁶ (See Damages Motion, Ex. 3, Mformation Technologies, Inc.’s Responses to Research in
27 Motion Limited’s and Research in Motion Corporation’s First Set of Requests for Admission (Nos.
1-25) at 2-3, Docket Item No. 545-3.)

1 the Court has already held all of its apparatus claims invalid, and only the method claims remain at
2 issue, the marking requirements of § 287(a) should not apply. (Damages Opp’n at 4-5.) Plaintiff
3 contends that under Hanson and Crown Packaging, the relevant inquiry should be whether both
4 apparatus and method claims are found infringed, and not which claims are initially asserted in
5 litigation. (Id.) However, the Court finds that Crown Packaging precludes this line of argument.

6 The Crown Packaging court made clear that in finding § 287(a) inapplicable to the facts at
7 bar, it was not overruling or limiting American Medical. 559 F.3d at 1316. In explaining why
8 marking was required in one circumstance and not the other, the court explained that “[i]n this case
9 and Hanson, the patentee *only* asserted method claims despite the fact that the patent contained both
10 method and apparatus claims. In American Medical, in contrast, ‘*both* apparatus and method claims
11 of [the patent] were asserted.’” Id. at 1317 (citation omitted) (emphases added). Thus, in Crown
12 Packaging the Federal Circuit clearly stated that the applicability of § 287(a) turns on which claims
13 were asserted. Therefore, as Plaintiff asserted both apparatus claims and method claims in this
14 litigation, the Court finds that the marking requirements of § 287(a) are applicable.

15 Accordingly, the Court finds that Plaintiff was required to mark its products to claim pre-suit
16 damages. There being no dispute that Plaintiff did not do so prior to October 27, 2008, the Court
17 GRANTS Defendants’ Damages Motion.

18 **G. Noninfringement Motion**

19 In their Noninfringement Motion, Defendants contend that Plaintiff cannot establish that
20 Defendants directly or indirectly infringe any asserted claim of the ‘917 Patent. (Noninfringement
21 Motion at 1-2.) The Court considers Defendants’ Motion with respect to direct infringement and
22 indirect infringement separately.

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1 **1. Direct Infringement**

2 Defendants contend that Plaintiff cannot establish direct infringement of the ‘917 Patent on
3 the following grounds: (1) Plaintiff has no evidence that Defendants used the accused software
4 products in the manner that Plaintiff contends infringes the ‘917 Patent; and (2) Plaintiff has no
5 evidence that Defendants performed the “establishing a mailbox” and “placing a command for the
6 wireless devices in the mailbox at the server” steps of Claim 1 within the United States because each
7 of the data structures used by Defendants that allegedly constitute such a “mailbox” resides on
8 servers outside of the United States. (Noninfringement Motion at 10-12.) Plaintiff responds that:
9 (1) Defendants admit that their employees activate and manage BlackBerry devices using BES
10 software in the United States; and (2) Defendants operate several BES servers in the United States.³⁷

11 Direct infringement of a method claim requires a single party to perform every step of the
12 claim. BMC Res., Inc. v. Paymentech, L.P., 498 F.3d 1373, 1378-79 (Fed. Cir. 2007). “In order to
13 prove direct infringement, a patentee must either point to specific instances of direct infringement or
14 show that the accused device necessarily infringes the patent in suit.” ACCO Brands, Inc. v. ABA
15 Locks Mfrs. Co., 501 F.3d 1307, 1313 (Fed. Cir. 2007). “[A] party that sells or offers to sell
16 software containing instructions to perform a patented method does not infringe the patent under §
17 271(a).” Ricoh Co. v. Quanta Computer Inc., 550 F.3d 1325, 1335 (Fed. Cir. 2008). Instead, a
18 plaintiff must show that the defendant actually carried out the instructions. Id. In addition, the
19 territorial reach of § 271(a) is limited, and is only actionable against patent infringement that occurs
20 within the United States. NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1313-18 (Fed. Cir.
21 2005). In the context of a method claim, the method is not “used ‘within’ the United States as
22 required by section 271(a) unless each of the steps is performed within this country.” Id. at 1318.

23 Here, the Court finds that Defendants are entitled to summary judgment on the issue of direct
24 infringement. First, Defendants cannot be liable for direct infringement based solely on the sale of
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26 ³⁷ (Mformation Technologies, Inc.’s Memorandum in Opposition to RIM’s Motion for
27 Summary Judgment of Noninfringement of U.S. Patent No. 6,970,917 at 23-25, hereafter,
28 “Noninfringement Opp’n,” Docket Item No. 598.)

1 BES software that allegedly practices the method claimed in the '917 Patent. Ricoh, 550 F.3d. at
2 1335. Instead, Plaintiff must show that Defendants actually used the BES software within the
3 United States in a way that directly infringes the patent-in-suit, i.e., in a way that practiced each step
4 of the patented method within the United States. Id. The Court finds that, based on the undisputed
5 facts, Plaintiff cannot establish that Defendants performed either the “establishing a mailbox” or
6 “placing a command for the wireless device in the mailbox at the server” within the United States.
7 In its infringement contentions, Plaintiff contends that the following structures constitute a
8 “mailbox” within the meaning of the '917 Patent: (1) the “ITAdminQueue table of the BlackBerry
9 Configuration Database”; (2) the “User Config Table in the BES”; and (3) individual entries in the
10 ITAdminQueue and BlackBerry Configuration Database.³⁸ It is undisputed that the ITAdminQueue
11 Table and User Config Table are located within the BlackBerry Configuration Database component
12 of the BES system. (Id., Ex. 4 at 131:13-25.) The evidence before the Court from both parties
13 establishes that the BlackBerry Configuration Database component of Defendants’ BES systems is
14 located outside the United States. (Id., Ex. 11 at 100:4-11.) Therefore, because the only alleged
15 “mailbox” resides outside the United States, Defendants do not practice the “establishing a mailbox”
16 or “placing a command for the wireless device in the mailbox at the server” steps of Claim 1 within
17 the United States.

18 Plaintiff’s reliance on the testimony of Keith Bilinsky, Defendants’ Rule 30(b)(6) deponent,
19 is insufficient to raise a disputed issue of material fact. Significantly, Bilinsky testified that all of
20 Defendants’ database servers used to support BES-managed devices in the United States are located
21 in Ontario, Canada.³⁹ Plaintiff’s contention that certain database servers exist within the United
22 States appears to be based solely on Bilinsky’s testimony that “[i]t’s possible on, with development

24 ³⁸ (Declaration of Meredith Zinanni in Support of RIM’s Notice of Motion and Motion for
25 Summary Judgment of Noninfringement of U.S. Patent No. 6,970,917, Ex. 1 at 14-26, Docket Item
No. 550.)

26 ³⁹ (Declaration of Shawn E. McDonald in Support of Mformation Technologies, Inc.’s
27 Opposition to RIM’s Motion for Summary Judgment of Noninfringement of U.S. Patent No.
6,970,917, Ex. BB at 95:15-96:9, 97:20-25, 100:4-11, Docket Item No. 601.)

1 efforts, that there may be something there”—presumably meaning that it is possible that a fully-
2 functional BES server could be established in the United States for development efforts. (See id. at
3 95:25-96:4.) However, given Bilinsky’s testimony that, at present, Defendants’ BlackBerry
4 Configuration Databases are all located outside the United States, this testimony does not establish a
5 disputed issue as to whether the database servers currently used by Defendants are located within the
6 United States.

7 Accordingly, the Court GRANTS Defendants’ Noninfringement Motion with regard to
8 Plaintiff’s direct infringement theory.

9 **2. Indirect Infringement**

10 Defendants contend that they are entitled to summary judgment on Plaintiff’s claims of
11 indirect infringement on the following grounds: (1) Plaintiff does not have adequate evidence to
12 establish that a third party actually used Defendants’ products in a manner that infringes the ‘917
13 Patent; (2) Defendants cannot be liable for contributory infringement because Defendants’ products
14 lack substantial noninfringing uses; and (3) Plaintiff cannot establish that Defendants had knowledge
15 or intent to induce infringement of the ‘917 Patent. (Noninfringement Motion at 13, 20-21.)
16 Plaintiff responds that: (1) Plaintiff has submitted evidence of infringement by multiple third
17 parties—including ISEC7, Informed Medical Communications, EveryNetwork, Inc. and Foley &
18 Lardner LLP—in the form of a declaration by Rakesh Kushwaha and declarations from the third
19 parties regarding their standard use of Defendants’ BES software; (2) the specific features of
20 Defendants’ products that Plaintiff alleges are infringing do not have substantial noninfringing uses;
21 and (3) Defendants had specific intent to infringe the patent because they were aware of the ‘917
22 Patent as a result of meetings in July 2001 and February 2004 and provided users of BES with
23 instructions on how to practice the infringing method. (Noninfringement Opp’n at 3-22.)

24 There are two forms of indirect infringement: induced infringement and contributory
25 infringement. Induced infringement is addressed by § 271(b), which states: “Whoever actively
26 induces infringement of a patent shall be liable as an infringer.” 35 U.S.C. § 271(b). “[I]nduced
27 infringement under § 271(b) requires knowledge that the induced acts constitute patent

1 infringement.” Global-Tech Appliances, Inc. v. SEB S.A., 131 S. Ct. 2060, 2068 (2011).

2 Knowledge can be established through proof of wilful blindness by the defendant, which requires
3 the following: “(1) the defendant must subjectively believe that there is a high probability that a fact
4 exists and (2) the defendant must take deliberate actions to avoid learning of that fact.” Id. at 2070.

5 Liability for contributory infringement is addressed in § 271(c), which states:

6 Whoever offers to sell or sells within the United States or imports into the United
7 States a component of a patented machine, manufacture, combination or composition,
8 or a material or apparatus for use in practicing a patented process, constituting a
9 material part of the invention, knowing the same to be especially made or especially
adapted for use in an infringement of such patent, and not a staple article or commodity
of commerce suitable for substantial noninfringing use, shall be liable as a contributory
infringer.

10 35 U.S.C. § 271(c). “Contributory infringement imposes liability on one who embodies in a non-
11 staple device the heart of a patented process and supplies the device to others to complete the
12 process and appropriate the benefit of the patented invention.” Vita-Mix Corp. v. Basic Holding,
13 Inc., 581 F.3d 1317, 1327 (Fed. Cir. 2009). As with induced infringement, contributory
14 infringement requires that the defendant have knowledge of the existence of the patent that is
15 infringed. Global-Tech, 131 S.Ct. at 2068. In addition, the plaintiff bears the burden of proving that
16 the accused products have no substantial non-infringing uses. Golden Blount, Inc. v. Robert H.
17 Peterson Co., 438 F.3d 1354, 1363 (Fed. Cir. 2006). “[N]on-infringing uses are substantial when
18 they are not unusual, far-fetched, illusory, impractical, aberrant, or experimental.” Vita-Mix, 581
19 F.3d at 1327. A party may not evade liability as a contributory infringer by embedding an infringing
20 device within “a larger product with some additional, separable feature before importing and selling
21 it.” Ricoh Co., Ltd. v. Quanta Computer Inc., 550 F.3d 1325, 1337 (Fed. Cir. 2008). Under either
22 theory of indirect infringement, the plaintiff must prove “that some party amongst the accused actors
23 has committed the entire act of direct infringement.” BMC Res., 498 F.3d at 1379 (citation omitted).

24
25 Here, the Court finds that Defendants are not entitled to summary judgment on the issue of
26 indirect infringement. First, Defendants are not entitled to summary judgment on the ground that
27 Plaintiff cannot establish infringement by a third party. Plaintiff submits a declaration from Dr.

1 Kushwaha stating that he personally observed two third parties, ISEC7 and Informed Medical
2 Communications, Inc., use BES software to perform each step of the ‘917 Patent.⁴⁰ Defendants’
3 contention that such evidence cannot create an issue of fact because those third parties were not
4 “without authority” as required by § 271(a) due to Dr. Kushwaha’s position as co-founder and
5 officer of Plaintiff is misguided.⁴¹ Dr. Kushwaha states that he did not instruct the individuals in the
6 manner in which they should perform any action and asked only to observe their standard practices
7 with regard to Defendants’ BES software. (Kushwaha Noninfringement Decl. ¶¶ 4, 6, 7.) In
8 addition, Plaintiff has submitted declarations from two other third parties stating that they use BES
9 to wirelessly register wireless devices and send commands to those devices.⁴² This evidence is
10 sufficient to raise a material issue of fact as to whether these third parties performed each step of the
11 patented claims.

12 Second, Defendants are not entitled to summary judgment on the ground that the BES
13 software has substantial noninfringing uses and that Plaintiff therefore cannot prevail on a
14 contributory infringement theory. Defendants contend that BES software can be used to perform
15 tasks other than those that are alleged to constitute infringement of the ‘917 patent, e.g., sending and
16 receiving email, placing telephone calls and managing dates. (Noninfringement Motion at 18.)
17 Defendants also contend that the specific BES device management functions targeted by Plaintiff
18 can be performed in ways that do not involve wireless control, such as by using a wired connection
19 to activate a handheld device or issue IT administration commands. (Id.) However, Defendants
20 misstate the inquiry for determining whether a product has substantial noninfringing uses. In cases
21 where the alleged method is embodied in a larger product, the Court must examine whether the

22 ⁴⁰ (Declaration of Rakesh Kushwaha, Ph.D., in Support of Mformation Technologies, Inc.’s
23 Opposition to RIM’s Motion for Summary Judgment of Noninfringement of U.S. Patent No.
24 6,970,917 at ¶¶ 3-7, hereafter, “Kushwaha Noninfringement Decl.,” Docket Item No. 600.)

25 ⁴¹ (RIM’s Reply in Support of its Motion for Summary Judgment of Noninfringement of
26 U.S. Patent No. 6,970,917 at 5-6, Docket Item No. 624.)

27 ⁴² (Declaration of Shawn E. McDonald in Support of Mformation Technologies, Inc.’s
28 Opposition to RIM’s Motion for Summary Judgment of Noninfringement of U.S. Patent No.
6,970,917, Exs. G, H, hereafter, “McDonald Decl.,” Docket Item No. 601.)

1 particular components that allegedly practice the patented method have substantial non-infringing
2 uses, and not the entire product as a whole. See Fujitsu Ltd. v. Netgear Inc., 620 F.3d 1321, 1330-31
3 (Fed. Cir. 2010). Here, Plaintiff has presented evidence that the wireless use of the Enterprise
4 Activation component of Defendants' BES software directly infringes the '917 Patent. As a result,
5 summary judgment on the ground of substantial noninfringing uses is inappropriate.

6 Third, Defendants are not entitled to summary judgment on the ground that Plaintiff cannot
7 establish Defendants' knowledge and specific intent to induce infringement of the '917 Patent.
8 Plaintiff has submitted evidence that certain employees of Defendants had knowledge of the '917
9 Patent as early as July 2001 as part of a series of disclosures made while Plaintiff was pursuing a
10 potential partnership and licence agreement with Defendants. (McDonald Decl., Ex. I ¶¶ 2-4.)
11 Plaintiff has also introduced evidence that an employee of Defendants was present at a working
12 group meeting in 2004 at which Dr. Kushwaha disclosed the '917 Patent application. (Id., Ex. J.)
13 This is sufficient to raise a triable issue of fact with respect to Defendants' knowledge of the '917
14 Patent. In addition, Plaintiff has introduced evidence that Defendants intended to induce third
15 parties to infringe the '917 Patent, including various technical documents that appear to contain
16 instructions to consumers of BES with regard to the wireless registration and management of
17 wireless devices. (Id., Exs. S, T.) Taking this evidence together, the Court finds that there is a
18 triable issue of material fact with regard to Defendants' knowledge and intent to induce infringement
19 of the '917 Patent.

20 Accordingly, the Court DENIES Defendants' Noninfringement Motion with regard to
21 Plaintiff's indirect infringement theory.

22 **H. Equivalents Motion**

23 In their Equivalents Motion, Defendants contend that they are entitled to summary judgment
24 on Plaintiff's theory of infringement under the doctrine of equivalents on the following grounds:
25 (1) Plaintiff's infringement contentions regarding the doctrine of equivalents are conclusory and do
26 not identify differences between the claimed method and the allegedly infringing process or explain
27 why those differences are insubstantial; and (2) Plaintiff does not have sufficient evidence to
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1 establish that any differences between the claimed method and Defendants’ product are
2 insubstantial. (Anticipation Motion at 7-8.) Plaintiff responds that: (1) its infringement contentions
3 adequately set out a “function/way/result” analysis for each of the limitations of the ‘917 Patent and
4 the allegedly infringing product; and (2) its infringement contentions present sufficient evidence to
5 establish that Defendants infringe the ‘917 Patent both literally and under the doctrine of
6 equivalents.⁴³

7 Even where an accused device does not literally infringe, a patentee may prove infringement
8 under the doctrine of equivalents. See Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352,
9 1364 (Fed. Cir. 2000). The doctrine of equivalents prevents a defendant from avoiding infringement
10 by making an insubstantial change to the claimed invention. See Festo Corp. v. Shoketsu Kinzoku
11 Kabushiki Co., 535 U.S. 722, 730-32 (2002); Lear Siegler, Inc. v. Sealy Mattress Co., 873 F.2d
12 1422, 1425 (Fed. Cir. 1989). Under the doctrine of equivalents, a patentee must show that the
13 allegedly infringing device and claimed limitation perform “substantially the same function in
14 substantially the same way to obtain the same result.” Warner-Jenkinson Co. v. Hilton Davis Chem.
15 Co., 520 U.S. 17, 38 (1997) (citation omitted). To oppose a defendant’s motion for summary
16 judgment of non-infringement under the doctrine of equivalents, the plaintiff has the burden of
17 producing “particularized testimony and linking argument on a limitation-by-limitation basis that
18 create[s] a genuine issue of material fact as to equivalents.” AquaTex Indus., Inc. v. Techniche
19 Solutions, 479 F.3d 1320, 1328-29 (Fed. Cir. 2007).

20 Here, the Court finds that Defendants are not entitled to summary judgment on the issue of
21 noninfringement under the doctrine of equivalents. Plaintiff’s infringement contentions set forth, for
22 each limitation of the ‘917 Patent, a “function/way/result” analysis that compares each step of the
23
24
25

26 ⁴³ (Mformation Technologies, Inc.’s Memorandum in Opposition to RIM’s Motion for
27 Summary Judgment of Noninfringement Under the Doctrine of Equivalents at 3, 7-15, Docket Item
28 No. 583.)

1 '917 Patent to particular features of Defendants' BES software.⁴⁴ This is supported by a similarly
2 detailed analysis by Plaintiff's expert, who opines that Defendants' products literally infringe the
3 '917 Patent or, if the products do not literally infringe, infringe under the doctrine of equivalents
4 because any differences are insubstantial. (See *id.*, Ex. B.) Plaintiff's expert relies upon a
5 combination of deposition and documentary evidence that allegedly establishes Defendants'
6 infringement. (*Id.*) This is sufficient to raise a triable issue of fact as to whether Defendants'
7 products infringe the '917 Patent either literally or under the doctrine of equivalents.

8 Accordingly, the Court DENIES Defendants' Motion for Summary Judgment of
9 noninfringement under the doctrine of equivalents.

10 **V. CONCLUSION**

11 The Court GRANTS in part and DENIES in part the parties' various Motions as follows:

- 12 (1) Plaintiff's Laches Motion is granted;
- 13 (2) Plaintiff's Anticipation Motion is denied;
- 14 (3) Plaintiff's Inequitable Conduct Motion is granted;
- 15 (4) Plaintiff's Indefiniteness Motion is granted in part and denied in part;
- 16 (5) Plaintiff's Public Use Motion is denied;
- 17 (6) Defendants' Damages Motion is granted;
- 18 (7) Defendants' Noninfringement Motion is granted in part and denied in part;
- 19 (8) Defendants' Equivalents Motion is denied;
- 20 (9) Defendants' Invalidity Motion is denied; and
- 21 (10) Defendants' Claim Priority Motion is denied.


22 The Court sets a Preliminary Pretrial Conference for **January 30, 2012 at 11 a.m.** to allow
23 the parties sufficient time to assess the status of the case in light of this Order. On or before
24 **January 20, 2012**, the parties shall file a Joint Preliminary Pretrial Statement. The Joint Statement

25 _____
26 ⁴⁴ (Declaration of Amar L. Thakur in Support of Mformation Technologies, Inc.'s
27 Opposition to RIM's Motion for Summary Judgment of Noninfringement Under the Doctrine of
28 Equivalents, Ex. A, Docket Item No. 584.)

1 shall include, among other things, a proposed schedule as to how the case should proceed and an
2 update on any settlement efforts.

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Dated: December 19, 2011



JAMES WARE
United States District Chief Judge

1 **THIS IS TO CERTIFY THAT COPIES OF THIS ORDER HAVE BEEN DELIVERED TO:**

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Dated: December 19, 2011

Richard W. Wieking, Clerk

By: /s/ JW Chambers
Susan Imbriani
Courtroom Deputy