

IN THE UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

NXP B.V.,

Plaintiff,

vs.

BLACKBERRY LIMITED AND
BLACKBERRY CORPORATION,

Defendant.

6:12-CV-498-YK-TBS

**Includes Confidential – Attorney
Eyes Only Information**

BLACKBERRY'S TRIAL BRIEF

TABLE OF CONTENTS

	Page
I. I. INTRODUCTION.....	1
II. SUMMARY OF APPLICABLE LAW	2
III. THE EVIDENCE WILL DEMONSTRATE THAT BLACKBERRY SHOULD PREVAIL ON THE REMAINING PATENTS.....	6
A. BlackBerry Should Prevail on Issues Related to The '455 Patent.....	6
1. BlackBerry Does Not Infringe The '455 Patent	6
2. The '455 Patent is Anticipated and/or Obvious.....	7
3. NXP Has Not Met Its Burden of Proving Damages for The '455 Patent.....	8
B. BlackBerry Should Prevail on Issues Related to The '420 Patent.....	9
1. BlackBerry Does Not Infringe The '420 Patent	10
2. The '420 Patent is Invalid for Lack of Written Description and Prior Art Patentability Requirements.....	12
a. Invalidity of The '420 Patent: Lack of Written Description.....	12
b. Invalidity of The '420 Patent: Prior Art.....	13
3. NXP Has Not Met Its Burden of Proving Damages for The '420 Patent.....	14
C. BlackBerry Should Prevail on Issues Related to The '654 Patent.....	15
1. BlackBerry Does Not Infringe The '654 Patent	16
a. No Direct Infringement.....	16
b. No Induced Infringement.....	18
2. The '654 Patent is Anticipated and/or Obvious.....	19
3. NXP Has Not Met Its Burden of Proving Damages for The '654 Patent.....	20
IV. CONCLUSION.....	22

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Abbott Labs. v. Dey L.P.</i> , 287 F.3d 1097 (Fed. Cir. 2002).....	20
<i>Applied Med. Res. Corp. v. Tyco Healthcare Group LP</i> , 534 Fed. Appx. 972 (Fed. Cir. 2013).....	17
<i>Ariad Pharms., Inc. v. Eli Lilly & Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010).....	2, 12
<i>CLS Bank Int’l v. Alice Corp. Pty. Ltd.</i> , 717 F.3d 1269 (Fed. Cir. 2013), <i>cert. granted</i> , 571 U.S. __ (2013).....	3, 7
<i>Commil USA v. Cisco Sys., Inc.</i> , 720 F.3d 1361 (Fed. Cir. 2013).....	18
<i>Decisioning.com, Inc. v. Federated Dep’t Stores, Inc.</i> , 527 F.3d 1300 (Fed. Cir. 2008).....	17
<i>DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.</i> , 567 F.3d 1314 (Fed. Cir. 2009).....	20
<i>Fuji Photo Film Co., Ltd. v. Jazz Photo Corp.</i> , 394 F.3d 1368 (Fed. Cir. 2005).....	18
<i>Global-Tech v. SEB</i> , 131 S. Ct. 2060 (2011).....	18
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	3
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	4
<i>Lampi Corp. v. Am. Power Prods., Inc.</i> , 228 F.3d 1365 (Fed. Cir. 2000).....	12
<i>LaserDynamics, Inc. v. Quanta Computer, Inc.</i> , 694 F.3d 51 (Fed. Cir. 2013).....	6, 21
<i>Lucent Techs., Inc. v. Gateway, Inc.</i> , 580 F.3d 1301 (Fed. Cir. 2009).....	5, 21

Monolithic Power Sys. Inc. v. O2 Micro Int’l Ltd.,
726 F.3d 1359 (Fed. Cir. 2013).....1

Moore U.S.A., Inc. v. Standard Register Co.,
229 F.3d 1091 (Fed. Cir. 2000).....16

Motionless Keyboard Co. v. Microsoft Corp.,
486 F.3d 1376 (Fed. Cir. 2007).....5

Network Commerce, Inc. v. Microsoft Corp.,
422 F.3d 1353 (Fed. Cir. 2005).....17

Novo Nordisk A/S v. Caraco Pharm. Labs., Ltd.,
719 F.3d 1346 (Fed. Cir. 2013).....2

Oakley, Inc. v. Sunglass Hut Int’l.,
316 F.3d 1331 (Fed. Cir. 2003).....3

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) (en banc).....3

Stumbo v. Eastman Outdoors, Inc.,
508 F.3d 1358 (Fed. Cir. 2007).....5

Suffolk Techs. LLC v. AOL Inc.,
No. 1:12cv625, at *3-4 (E.D. Va. Apr. 12, 2013).....15

Texas Instruments Inc. v. Cypress Semiconductor Corp.,
90 F.3d 1558 (Fed. Cir. 1996).....5

TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.,
529 F.3d 1364 (Fed. Cir. 2008).....4

Uniloc USA, Inc. v. Microsoft Corp.,
632 F.3d 1292 (Fed. Cir. 2011).....5, 6, 15, 21

Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.,
520 U.S. 17 (1997).....4, 11

Wavetronix LLC v. EIS Elec. Integrated Sys.,
573 F.3d 1343 (Fed. Cir. 2009).....4

Defendants BlackBerry Limited and BlackBerry Corporation (“BlackBerry”) hereby submit this Trial Brief, pursuant to paragraph III.D.1 of the Court’s Case Management and Scheduling Order (Doc. 58).

I. INTRODUCTION

The operative pleadings cast this litigation as a patent infringement action. The allegations of patent infringement suggest a case about technology; complex details; and the bargain that the patent owner, at some point, made with the public to secure an exclusive monopoly. This case, however, is not about a patent holder trying to protect its rights—it is about the pursuit of revenue by any available means.

Contrary to NXP’s suggestions, this case is not about an aggrieved innovator; it is a stale effort to obtain a patent for miniscule embellishments that are not new, not useful, and not practiced in BlackBerry devices. NXP’s case lacks merit and is getting progressively weaker. At the outset of this case, there were six asserted patents. Today there are only three. NXP dropped one patent early and has dismissed another two—U.S. Patent Nos. 5,597,668 and 5,639,697—without prejudice, conceding non-infringement.¹ Of the remaining three, NXP conceded in response to a motion for summary judgment that it cannot maintain literal infringement claims for U.S. Patent No. 6,434,654, and now relies only on an assertion under the doctrine of equivalents. *See* Joint Pre-Trial Statement (filed contemporaneously herewith). The winnowing of the case reflects the weakness of NXP’s allegations and the recognition that its patents lack both substance and value.

¹ This type of behavior is precisely the type of vexatious litigation that courts do not tolerate. *See Monolithic Power Sys. Inc. v. O2 Micro Int’l Ltd.*, 726 F.3d 1359 (Fed. Cir. 2013). NXP knows, and has known, that BlackBerry’s products do not infringe. Notwithstanding, NXP continues to tax the Court’s resources and the jury’s time in the pursuit of allegations that never should have been brought.

BlackBerry submits this brief to assist the Court in understanding what the evidence will show and demonstrate why application of the law compels the following conclusions:

- BlackBerry's accused smartphones and tablet computers do not practice any of the patents asserted in this case. Indeed, NXP has made this case about discrete features/components that NXP did not independently invent and which BlackBerry does not use.
- The remaining patents share a common theme of embellishing existing technology rather than contributing something critical or new. The prior art, the testimony of the inventors/NXP representatives, and the disclosures in the patents themselves, warrant a finding that each of the asserted claims are invalid under 35 U.S.C. §§ 102, 103, and/or 112. For example, the '420 patent inventors do not even recall making any technical contributions to claimed technology.
- Finally, even if NXP could establish the validity and infringement of the patents-in-suit, NXP has not established by a preponderance of the evidence that it is entitled to any sum of money, let alone the excessive damages NXP seeks. NXP ignores its own licensing history and the lack of utility of the alleged inventions. Instead, NXP relies on unproven accounting methods to exaggerate the alleged worth of the patents-in-suit. To the extent the jury concludes that NXP is entitled to some amount of damages and NXP has met its burden of proof, the figure would be ten to one hundred times less than the damages NXP seeks. Furthermore, industry standards and the testimony of NXP's own witnesses limit any royalty to fair, reasonable and non-discriminatory ("FRAND") rates for the '455 and '654 patents.

II. SUMMARY OF APPLICABLE LAW

A patent is a government-granted monopoly of limited duration. In exchange for this monopoly, the patentee must make a full and complete disclosure of the claimed invention, in order to further the ultimate practical goal of the patent system: "[t]o promote the Progress of Science and useful Arts." *Novo Nordisk A/S v. Caraco Pharm. Labs., Ltd.*, 719 F.3d 1346, 1365 (Fed. Cir. 2013) (citing U.S. CONST., art. I, § 8, cl. 8). This *quid pro quo*, embodied in the patent statutes, requires "disclosure of a process or device in sufficient detail to enable one skilled in the art to practice the invention once the period of the monopoly has expired." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1364 (Fed. Cir. 2010).

A patent's "claims" define the scope of the invention entitled to this monopoly protection. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). Claims take two forms: "independent" or "dependent." Independent claims stand on their own; a dependent claim refers back to another claim and must further limit the scope of the independent claim from which it depends. *See* 35 U.S.C. § 112(d). Because a claim is considered an invention, each claim must be supported by an adequate written description in the patent specification. *See* 35 U.S.C. § 112; *Ariad*, 598 F.3d at 1358.

Claims must meet statutory requirements for patentability: invention, novelty, and non-obviousness. 35 U.S.C. §§ 101, 102, 103. The invention requirement, embodied in 35 U.S.C. § 101, requires a genuine human contribution to the claimed subject matter. *See CLS Bank Int'l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1283 (Fed. Cir. 2013), *cert. granted*, 571 U.S. __ (2013). Abstract ideas and scientific principles do not meet this requirement. *Id.* Section 102's novelty requirement requires the invention be new, *i.e.*, not previously patented, known, published, sold, or disclosed. Where "each and every [claim] limitation is found either expressly or inherently in a single prior art reference," a claim is invalid by anticipation. *See Oakley, Inc. v. Sunglass Hut Int'l.*, 316 F.3d 1331, 1339 (Fed. Cir. 2003). At the same time, section 103 requires that claimed inventions be non-obvious, meaning that the differences between the claimed invention and the prior art are such that the subject matter as a whole would not have been obvious to a person of ordinary skill in the art at the time the invention was made. This evaluation is made against the background provided by the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent art. *See Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). Critically, "the combination of

familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

Even where a patent claim is valid, whether an accused product infringes is a two-step inquiry: “the court first determines the meaning of disputed claim terms and then compares the accused device to the claims as construed.” *Wavetronix LLC v. EIS Elec. Integrated Sys.*, 573 F.3d 1343, 1354 (Fed. Cir. 2009). The accused device must contain each and every claim limitation to be infringing. *See TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1379 (Fed. Cir. 2008) (quoting *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1358 (Fed. Cir. 2005)). Thus, if any single element of an asserted patent claim is missing, an accused product cannot infringe that claim or any claim dependent on that claim.

Here, as explained below, NXP has conceded that at least one element of each of the asserted claims in ’420 and ’654 patents is not literally present in BlackBerry’s products. Thus, for those patents, NXP must rely on the “doctrine of equivalents.” Under that doctrine, “a product or process that does not literally infringe . . . may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997).

However, the Supreme Court has recognized several “legal limitations” on the application of the doctrine of equivalents. *See id.* at 39 n.8. For instance, the doctrine cannot run afoul of the “all-elements rule.” That is, a plaintiff cannot prove infringement by “a theory of equivalen[ce] [that] would entirely vitiate a particular claim element.” *Id.* Infringement by equivalents may be possible where the difference between the claim element and the accused product is a “subtle difference in degree,” but it is impermissible where there exists “a clear,

substantial difference or difference in kind.” *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1361 (Fed. Cir. 2005) (quoting *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1321 (Fed. Cir. 1998)).

In addition, given the risk that loose application of the doctrine of equivalents will render patent claims meaningless, the Federal Circuit requires that a patentee asserting infringement under the doctrine of equivalents “present particularized evidence that links the accused products to the patent on a limitation by limitation basis.” *Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, 1383 (Fed. Cir. 2007). Mere conclusory statements by expert witnesses are inadequate to satisfy this burden. *See Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1365 (Fed. Cir. 2007). “These evidentiary requirements assure that the fact-finder does not, ‘under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement.’” *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1566-67 (Fed. Cir. 1996).

Finally, if (and only if) the jury finds that an asserted patent claim is both valid (under §§ 101, 102, 103, and 112) and infringed (under § 271), the patentee is entitled to damages “adequate to compensate for the infringement, but in no event less than a reasonable royalty.” 35 U.S.C. § 284. A reasonable royalty is typically determined through the lens of a “hypothetical negotiation.” *Uniloc USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1312 (Fed. Cir. 2011). This hypothetical negotiation, also called the “willing licensor-willing licensee” approach, “attempts to ascertain the royalty upon which the parties would have agreed had they successfully negotiated an agreement just before infringement began.” *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1324 (Fed. Cir. 2009) (internal citations and quotations omitted).

The patentee bears the burden to prove damages by a preponderance of evidence, and the Federal Circuit strictly requires that the damages evidence is tied closely to the facts of the case and not mere speculation. *Uniloc*, 632 F.3d at 1315 (“If the patentee fails to tie the theory to the facts of the case, the testimony must be excluded.”). As Magistrate Judge Smith explained in connection with NXP’s Motion to Compel, “[i]n a typical case, damages evidence must be carefully tied to the claimed invention’s footprint in the marketplace. In other words, damages are generally based on the smallest saleable patent product unit and not the entire product.” (Doc. 157 at 8:7-11); *see also LaserDynamics, Inc. v. Quanta Computer, Inc.*, 694 F.3d 51, 67 (Fed. Cir. 2013).

III. THE EVIDENCE WILL DEMONSTRATE THAT BLACKBERRY SHOULD PREVAIL ON THE REMAINING PATENTS

A. BlackBerry Should Prevail on Issues Related to The ’455 Patent

The ’455 patent is directed to an approach for managing expanded data rates used in wireless communication. The first named inventor on the patent made a proposal to the standards body (the “IEEE 802.11g”) within a few weeks after filing his patent application. The proposal was rejected and was not adopted by the IEEE 802.11g standards body. Rather, the IEEE 802.11g adopted a much simpler approach which had been known in the prior art and had been suggested by at least two others well before the inventor filed his patent application. Here, NXP claims infringement based on its assertion that BlackBerry complies with the standard—the same standard which was rejected, and thus does not include, the asserted NXP invention.

1. BlackBerry Does Not Infringe The ’455 Patent

The Court’s construction of “permissible value range” as “the set of values that are implemented in a version of the standard” is dispositive of NXP’s ’455 patent allegations. The asserted claims require that “the first data transmission rule defines a permissible value range for the element identification part.” For this requirement, NXP’s infringement expert states “the

permissible value range is 1.” No reasonable jury could find that “1” is a “set of values,” as NXP contends.² BlackBerry has moved for summary judgment on this issue. *See* (Doc. No. 205 at 10-11).

Should the Court deny summary judgment, BlackBerry will present rebuttal evidence to prove non-infringement, including testimony from BlackBerry’s technical expert, Dr. Christopher Heegard, and from BlackBerry engineer Michael Montemurro. The evidence will show that the accused BlackBerry devices do not infringe the ’455 patent for at least the following reasons:

- As argued in the motion for summary judgment, “1” is not a “set of values” and there for is not a permissible value range as required in all claims.
- All asserted claims require that there be a “first” and a “second” data transmission rule. There is no “first” and “second” data transmission rules in the BlackBerry devices or in the IEEE 802.11g standard.
- Claim 15 requires that the device “switch between the first and second data transmission rules in response to the reception of information elements during transmission.” Neither the accused BlackBerry devices nor the IEEE 802.11g standard are configured to do such switching.

2. The ’455 Patent is Anticipated and/or Obvious³

The ’455 patent is invalid because its alleged invention was well known in the wireless networking community prior to the ’455 patent application. BlackBerry will present expert testimony from Dr. Heegard explaining how the asserted claims are invalid as anticipated and/or

² BlackBerry recently filed a Motion for Clarification (Doc. No. 325) in order to confirm that the claim construction refers to the “permissible value range” of element IDs, not data transmission rates. That issue does not impact whether “1” is a range.

³ BlackBerry also intends to argue to the Court that the asserted claims in the ’455 patent are invalid under 35 U.S.C. § 101 as ineligible subject matter. BlackBerry submits that this issue should be decided by the Court independently of the issues tried to the jury. *See CLS Bank Int’l*, 717 F.3d at 1283 (reiterating that patent eligibility is an issue of law to be determined by the Court).

obvious in light of certain prior art, including prior versions of the IEEE 802.11 standard and various prior proposals from IEEE 802.11 committee members.

NXP disputes whether some of these references meet the standard for “printed publication” prior art (under § 102(b)) in its summary judgment motion. The testimony will demonstrate that indeed the references were printed publications. Moreover, these references may also be prior art under public use or knowledge theories, which are independent bases to establish prior art under 35 U.S.C. § 102(a), 102(f) or 102(g) and not part of NXP’s summary judgment motion. Thus, regardless of the Court’s summary judgment ruling, this prior art will still be at issue at trial. Dr. Heegard will testify as to the motivations of a person of ordinary skill in the art to combine these references and testimony rebutting alleged secondary considerations of non-obviousness which NXP may present.

3. NXP Has Not Met Its Burden of Proving Damages for The ’455 Patent

NXP has not met its burden of proving that it is entitled to any damages for the ’455 patent for at least the following reasons:

- NXP’s damages expert, Roy Weinstein, ignores established royalty rates by the [REDACTED] for IEEE 802.11g standard essential patents. The evidence will demonstrate that the claimed technology is not standard essential because it was not incorporated into industry standards. However, to the extent NXP builds its infringement case on the notion that compliance with IEEE 802.11g infringes the ’455 patent, NXP cannot escape its FRAND obligations with the [REDACTED].
- Instead, Mr. Weinstein relies on non-comparable [REDACTED]. The licenses upon which Mr. Weinstein relies are not comparable to the hypothetical negotiation because they include a different royalty payment structure and non-comparable technology.⁴

⁴ For the reasons stated in its *Daubert* Motion, BlackBerry again re-urges its argument that Mr. Weinstein’s damages opinions based on non-comparable licenses should be excluded as unreliable and unduly prejudicial under F.R.E. 702 and 403. *See* (Doc. Nos. 203, 242) (BlackBerry’s *Daubert* Motion and Reply in support thereof).

- Mr. Weinstein also disregards the minimal utility and value, if any, of the claimed invention, contrary to the *Georgia Pacific* factors required to determine the reasonable royalty.
- Mr. Weinstein inflates the damages by including [REDACTED].

Should NXP establish infringement and somehow adduce reliable and sufficient evidence of any damages for the '455 patent, the damages at most would be commensurate with NXP's licensing history, [REDACTED].

B. BlackBerry Should Prevail on Issues Related to The '420 Patent

The '420 patent involves powering up a mobile phone's GPS receiver in response to a user selecting a particular website only when a request for GPS location is anticipated, but not yet required. Both the '420 patent, and its inventors, acknowledge that mobile phones with GPS were well known by the time the '420 patent was filed. These "prior art" phones commonly saved power by turning on the GPS receiver only when a GPS location was needed. For example, the prior art taught that powering up the GPS receiver upon of a mobile phone upon dialing 9-1-1. In contrast, in the embodiment described in the patent,⁵ the GPS receiver of a mobile phone would be configured to be powered up after dialing "9" and "1" "in anticipation" of a future need for location information in the event the user finishes by dialing an additional "1."

NXP asserts claim 3, which is directed to powering up the GPS receiver in response to the user selecting a particular website in anticipation of a need for location information. Claim 3 recites:

⁵ The bare description in the specification is a near-copy of the claim language. NXP does not assert the claims relating to dialing mobile phones. NXP only asserts claim 3, which is directed to the user selecting a particular website.

An internet enabled, mobile cellular telephone comprising a communications transmitter and receiver arranged for two-way communication with a base station, and a GPS receiver, wherein the GPS receiver *is arranged to power up in response to a user selecting a particular website.*

'420 Patent col. 4 ll. 61-65 (emphasis added). The term “the GPS receiver is arranged to power up in response to a user selecting a particular website” has been construed as “in response to a user selecting a particular website, the GPS receiver is arranged to power up in anticipation of a need for location information.” (Doc. No. 307 at 19). “Power up” has been construed as “switch from inoperative to operative.” *Id.* at 18. And the Court concluded that the term “website” was *not* “any resource accessible through the world wide web,” and defined a “website” according to a layperson’s plain and customary understanding of the term. *Id.* at 20.

1. BlackBerry Does Not Infringe The '420 Patent

NXP knows that BlackBerry does not infringe claim 3 of the '420 patent, the only asserted claim. First, NXP previously conceded that under the plain and customary meaning of “web site” it would have to pursue infringement under the doctrine of equivalents. (Doc. 213 at 30, n.120). Second, in response to BlackBerry’s motion for summary judgment that NXP cannot prove infringement under the doctrine of equivalents, NXP did *not* oppose as to “user selecting a particular website” and, thus, has conceded that there is no infringement under the doctrine of equivalents.⁶ *Cf.* (Doc. 205 at 35 (BlackBerry’s Motion for Summary Judgment), *with* (Doc. 229 at 25) (NXP’s Response). Indeed, for the term “selecting a particular web site,” NXP’s expert offered at most two sentences of support for infringement under the doctrine of equivalents.⁷

⁶ NXP similarly did not contest BlackBerry’s motion as to inducement of the '420 patent. *See* (Doc. 229 at 25). NXP cannot show induced infringement of the '420 patent under either 35 U.S.C. § 271(b) or (c).

⁷ There are only three sentences in paragraph 113 of Dr. Alpert’s Expert Report Concerning Infringement of U.S. Patent No. 6,501,420. The first and last sentences merely assert that the limitation “selecting a particular website” is met under the Doctrine of Equivalents. Thus, the

(Doc. 205, Ex. 17 ¶ 113). In summary, NXP has conceded that under the plain and customary meaning of “web site,” BlackBerry does not infringe.

Nevertheless, if the Court denies summary judgment, BlackBerry will present rebuttal expert testimony from Dr. William R. Michalson.

NXP accuses software applications such as Facebook App, BlackBerry Maps, and BlackBerry Travel, to meet the “user selecting a particular website” limitation, but use of these Apps does not match an ordinary understanding of “a user selecting a particular website.” NXP’s doctrine of equivalents theory is flawed and conclusory, and the differences between the asserted claim and the accused products are substantial when evaluated under the proper “function, way, result” test. *See Warner-Jenkinson*, 520 U.S. at 39-40.

Further, NXP cannot show that the GPS receiver powers up “in anticipation” of need for location information because the accused software makes a request for location information when it is needed. Moreover, the term “power up” has been construed as reflecting a change in the GPS receiver from inoperative to operative. (Doc. No. 307 at 18). Thus, to prove infringement, NXP must show that BlackBerry’s accused devices switch from inoperative to operative in response to a user selecting a particular website in anticipation of a need for location information. There is a complete failure of proof on this point. NXP’s expert neither did testing nor provided testimony with regard to an operative or inoperative GPS receiver. NXP’s expert attempts to navigate around the claim requirement by analyzing the accused devices according to different “power states,” but the Court rejected this characterization as lacking intrinsic support.

BlackBerry, during its rebuttal case, may present evidence, including documents, computer software source code, fact testimony from BlackBerry engineers, and expert testimony

second sentence is the entirety of Dr. Alpert’s analysis.

from Dr. Michalson, collectively demonstrating BlackBerry's accused smartphones are missing one or more of the claim limitations.

2. The '420 Patent is Invalid for Lack of Written Description and Prior Art Patentability Requirements

a. Invalidity of The '420 Patent: Lack of Written Description

BlackBerry moved for summary judgment of invalidity of claim 3 of the '420 patent because the '420 patent lacks any description of the claimed invention to prove that the inventors actually possessed the claimed invention at the time they filed their application, as the law requires. *See Ariad*, 598 F.3d at 1351. Only a single sentence of the '420 patent relates to the alleged invention of claim 3—*i.e.*, powering up a GPS receiver upon a user selecting a particular web site. And, the sentence itself does nothing more than mirror what is recited in the claim, offering no context or details that would indicate that the inventors had possession of the claimed invention as of 2000, such as how the user would “select[] a particular website” on a telephone, how the telephone would detect the “user selecting a particular website,” how the telephone would determine whether the “particular website” is one that may result in the need for location information. *Compare with Ariad*, 598 F.3d at 1351 (explaining that the statute demands that the inventor of the claim actually possess the claimed invention at the time of filing the application); *see also Lampi Corp. v. Am. Power Prods., Inc.*, 228 F.3d 1365, 1378 (Fed. Cir. 2000).

The remainder of the '420 patent, including unasserted claims 1 and 2, does not adequately support claim 3. Rather, the remainder of the patent reflects the idea Iwo Mergler submitted to his company's patent department as it related to powering up the GPS receiver before all the digits of a telephone number have been entered. The other named inventor, Stephen Townsend (a patent attorney), then reviewed the disclosure and joined as an inventor because he had “independently” come up with the same idea when working on another patent

application. Neither Mr. Townsend nor Mr. Mergler believes he came up with the idea for claim 3 or recalls adding the one sentence to the patent. Mr. Mergler believes it was Mr. Townsend's idea. But, Mr. Townsend disagrees, saying: "I don't recall contributing it. It got contributed in the course of drafting the patent application. I couldn't tell you who contributed it." *Exhibit A*, Townsend Depo. Tr. at 125:16-19; *see also Exhibit B*, Mergler Depo. Tr. at 52:2-23, 102:13-104:3, 110:18-111:9, 111:10-15 (Mr. Mergler agreeing that claim 3 was Mr. Townsend's contribution). Absent critical details that would show *actual possession* of the claimed invention, the '420 patent lacks an adequate written description according to § 112 and claim 3 is thus invalid.

b. Invalidity of The '420 Patent: Prior Art

While the '420 patent does not describe how to practice the asserted claim, the claimed idea of powering up a GPS receiver in anticipation of a GPS location request was well known. In fact, the '420 patent's named inventors acknowledged that nearly all of claim 3 was established in the prior art, including mobile phones with GPS receivers and the idea of saving power by only turning on a GPS receiver when the phone's location is needed. The prior art demonstrates that the remainder of claim 3's supposed invention—*i.e.*, the user selecting a particular web site and powering up a GPS receiver in anticipation of a need for location information—was also well-known. To that end, BlackBerry will present expert testimony from Dr. William R. Michalson, explaining how the '420 patent is invalid as anticipated and obvious in light of prior art patents and publications, such as U.S. Patent No. 7,330,883 (Jessup), U.S. Patent No. 6,731,612 (Koss), U.S. Patent No. 6,343,317 (Glorikian), U.S. Patent No. 6,838,998 (Brown), U.S. Patent No. 6,141,570 (O'Neill), U.S. Patent No. 6,314,308 (Sheynblat), and the Lettieri IEEE publication, as well as the '420 patent's admitted prior art. Dr. Michalson will also

provide testimony regarding the motivations of a person of ordinary skill in the art to combine references.

3. NXP Has Not Met Its Burden of Proving Damages for The '420 Patent

NXP has not met its burden of proving that it is entitled to any damages for the '420 patent for at least the following reasons:

- NXP's damages expert, Mr. Weinstein, bases his damages opinion on the erroneous assumption that the '420 patent is about power savings. The evidence at trial will establish that the purpose of the '420 patent is not related to power savings. Thus, the entire premise of Mr. Weinstein's damages opinion for the '420 patent is false and must be disregarded in its entirety.⁸
- Mr. Weinstein provided no analysis regarding the Facebook app, BlackBerry Maps app, and BlackBerry Travel app in certain accused devices that allegedly infringe the '420 patent. Moreover, he calculated damages from the earliest date possible under the patent laws, April 2006, and ignored the fact that these accused apps were not available on the accused devices until several years later.
- Mr. Weinstein further [REDACTED]. Specifically, NXP did not comply with the marking requirements of 35 U.S.C. § 287, which limits damages to the date of actual notice of the asserted patents where the patentee or its licensees sell product that embodies the asserted patents. In this case, NXP has admitted that it has licensees to the patents-in-suit.
- Mr. Weinstein also inflates the damages by [REDACTED].
- Further compounding the unreliability of his damages opinions, Mr. Weinstein relies on unproven accounting methods and flawed math to [REDACTED].
- Lastly, Mr. Weinstein improperly relies on the 50% rule of thumb rejected by courts to [REDACTED].⁹

⁸ For the reasons stated in its *Daubert* Motion, BlackBerry again re-urges its argument that Mr. Weinstein's damages opinions based on his factually incorrect premise and judicially rejected 50% rule of thumb should be excluded as unreliable and unduly prejudicial under F.R.E. 702 and 403. *See* (Doc. Nos. 203, 242) (BlackBerry's *Daubert* Motion and Reply in support thereof).

⁹ The Eastern District of Virginia previously excluded Mr. Weinstein's reliance on the Nash Bargaining Solution as an arbitrary 50% Rule of Thumb. *See Suffolk Techs. LLC v. AOL Inc.*, No. 1:12cv625, at *3-4 (E.D. Va. Apr. 12, 2013) (Doc. No. 518) (relying in *Uniloc*, 632 F.3d at

Should NXP establish infringement and somehow adduce reliable and sufficient evidence of any damages for the '420 patent, the damages at most would be commensurate with NXP's licensing history and/or the values [REDACTED]

C. BlackBerry Should Prevail on Issues Related to The '654 Patent

The '654 patent relates to the use of data buses to communicate between a host processor and a "companion," such as a memory component. *See* (Doc. 307 at 9). Well before the '654 patent, such data communications occurred over buses, which are physical connections (often metal traces) between the components. *See* '654 Patent col. 1 ll. 12-15; *Exhibit C*, Story Depo. Tr. at 93:15-19 (testimony of the inventor of the '654 patent). In prior art systems, different types of data were sent in parallel over different types of buses. For example, a command would be sent over a command bus, an address would be sent over an address bus, and other data would be sent over a data bus. But the '654 patent focused on reducing the number of signal lines between components using serialized communication.¹⁰ In particular, the patent describes sending the commands, addresses and data over a single data bus. The Court has construed the term "serialized data blocks" to mean "variable sized blocks for transmitting commands, addresses, and data." The claim calls for "serialized data blocks" to travel over one "variable-width data bus."

1315).

¹⁰ Each bus requires one or more pins. And the Abstract of the '654 patent states that "[o]ne feature of the present invention is that the pin count requirement for the present invention is low: only four control pins are required for controlling the data transfer mechanisms of the data bus." This is achieved by not having "command" and "address" buses, which would require additional pins. *Exhibit C*, Story Depo. Tr. at 82:10-17; *Exhibit D*, Alpert Depo. Tr. (9/10/13) at 168:16-21.

In addition, the patent requires the host and companion to jointly determine the width of the data bus (*e.g.*, 1 bit, 4 bits, 8 bits, or 16 bits) between them. That is, the components jointly determine the highest width that both components can support. The Court’s Claim Construction Order makes clear that the process of determining an effective bus width must involve some interaction between the host and companion. (Doc. No. 307 at 14) (acknowledging that “the method requires interaction between the host and companion interfaces”).

1. BlackBerry Does Not Infringe The ’654 Patent

a. No Direct Infringement

NXP admits that BlackBerry does not literally infringe the ’654 patent since BlackBerry’s accused products do not satisfy the “serialized data blocks” requirement present in all asserted claims. In response to BlackBerry’s summary judgment motion, NXP argued only that BlackBerry infringes by equivalents under the Court’s construction, thereby conceding that BlackBerry does not literally infringe. (Doc. 229 at 15-17).

As a matter of law, BlackBerry’s products cannot infringe under the doctrine of equivalents either. The Court construed “serialized data blocks” as “variable-sized blocks for transmitting commands, addresses, and data.” (Doc. No. 307 at 13). The accused products do not use “variable-sized blocks” to transmit commands and addresses. Instead, commands and addresses are transmitted using fixed-width transfers over separate fixed-width buses. Furthermore, the asserted claims require the “serialized data blocks” to be transmitted over a “variable width data bus.” But the alleged “variable-width data buses” in the accused products only transmit data, not commands and addresses. Using separate buses to transmit commands, addresses, and data—just as prior art systems did—is the very antithesis of transmitting commands, addresses, and data over the same bus. *See Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed. Cir. 2000) (holding no reasonable jury could conclude a

“minority” is the equivalent of a “majority” because a “minority” is the antithesis of a “majority”). In addition, the accused products transmit commands and addresses using fixed-width transfers over a seaparte, fixed-width bus, which is substantially different from transmitting the commands and addresses in the same serialized data block over the data bus. This is not a “subtle difference in degree;” it is “a clear, substantial difference or difference in kind.” *Freedman Seating*, 420 F.3d at 1361. In light of those substantial differences, allowing NXP to “to capture the accused [product] through the doctrine of equivalents would vitiate the claim limitation requiring [“serialized data blocks].” *Applied Med. Res. Corp. v. Tyco Healthcare Group LP*, 534 Fed. Appx. 972, 978-79 (Fed. Cir. 2013); *see also Decisioning.com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1315 (Fed. Cir. 2008).

Should the Court nevertheless permit NXP to rely on the doctrine of equivalents, BlackBerry may present additional evidence at trial rebutting NXP’s allegations of infringement by equivalence. At trial, BlackBerry will present rebuttal expert testimony, showing that Dr. Alpert’s analysis is flawed, conclusory, and lacks the necessary particularized testimony and linking argument as to the insubstantiality of the differences to meet NXP’s burden. *Network Commerce, Inc. v. Microsoft Corp.*, 422 F.3d 1353, 1363 (Fed. Cir. 2005) (finding no issue of material fact where the expert did not provide “particularized testimony” linking equivalence arguments on a limitation-by-limitation basis) (citing *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1364 (Fed. Cir. 2005)). BlackBerry will also present evidence, including admissions from the lead inventor, admissions from NXP’s expert (Dr. Alpert), and expert testimony from BlackBerry’s expert (Brian Berg), demonstrating that the accused products do not infringe for other reasons. For example, the Court has held that the host bridge and companion bridge must interact in order to “determine[] an effective width.” The accused

products do not have a host bridge and companion bridge that interact to “determine an effective width” of the eMMC or SDIO data buses. Instead, the alleged host bridge simply sets the eMMC and SDIO data bus width to a fixed value, without interacting with the companion bridge. Furthermore, the alleged host bridge does not send a “bus width inquiry” to the accused eMMC devices, as the Court has construed that term (“a request for a bus width”). *See* (Doc. No. 307 at 15). In addition, the accused products do not include a “control bus.” NXP points to a single “clock” line in the accused products as the alleged “control bus,” but a control bus requires more than just a clock line.

b. No Induced Infringement

In addition to direct infringement under 35 U.S.C. § 271(a), NXP alleges that BlackBerry indirectly infringes by inducing infringement under 35 U.S.C. § 271(b). Specifically, NXP alleges that BlackBerry induces BlackBerry users to infringe the ’654 patent by inserting MicroSD memory cards into their phones. To meet its burden on inducement, NXP must first prove that a BlackBerry user directly infringed the ’654 patent. For the same reasons that BlackBerry does not directly infringe—*e.g.*, BlackBerry’s products do not transmit “serialized data blocks”—BlackBerry’s customers cannot directly infringe either.

Moreover, for indirect infringement, NXP must additionally prove that BlackBerry had both knowledge of the ’654 patent and the specific intent to infringe. *Global-Tech v. SEB*, 131 S. Ct. 2060, 2064-68 (2011). Intent to induce infringement is an issue of fact for the jury. *Fuji Photo Film Co., Ltd. v. Jazz Photo Corp.*, 394 F.3d 1368, 1378 (Fed. Cir. 2005). A good-faith belief of non-infringement or invalidity is relevant evidence that “tends to show that an accused inducer lacked the intent required to be held liable for induced infringement.” *Commil USA v. Cisco Sys., Inc.*, 720 F.3d 1361, 1367-1368 (Fed. Cir. 2013).

NXP implicitly concedes that it cannot establish induced infringement for the vast majority of BlackBerry's accused products because BlackBerry did not have the requisite knowledge of the '654 patent before this lawsuit was filed. *See* (Doc. 229 at 25). NXP only argues that there are disputed factual issues regarding induced infringement for the "two additional phones" BlackBerry introduced after this lawsuit was filed (the Z10 and Q10). *Id.* But NXP cannot establish indirect infringement for even this limited subset of accused products. As stated in BlackBerry's motion for summary judgment, NXP has not identified any evidence sufficient to establish both knowledge of the patent and specific intent to infringe the '654 patent. (Doc. 205 at 35). Depending on the Court's resolution of that pending summary judgment motion, BlackBerry may present additional evidence rebutting NXP's allegations of inducement for the '654 patent, including the fact that NXP has adduced no evidence as to how many users, if any, installed a MicroSD memory card in the accused products.

2. The '654 Patent is Anticipated and/or Obvious

Like the other patents-in-suit, NXP asserts claims that are encompassed by the prior art. For the '654 patent, prior art systems were transmitting serialized data over different types of buses before the priority date. BlackBerry's expert, Mr. Berg, will detail the anticipation and obviousness evidence, including references related to the SCSI-2 prior art standard, which discloses the communication of commands, addresses, and data over a variable width data bus where the width of the data bus is negotiated between a host and a companion, as well as U.S. Patent Nos. 5,452,420 (Engdahl) and 5,911,053 (Pawlowski). The evidence will further show that the standard-setting body adopted the earlier proposals over the claimed structures in forming the operability rules.

The strength of the SCSI-2 prior art is also significant because it limits the range of permissible equivalents NXP can pursue on the liability side of the case. To determine the scope

of a permissible equivalent in light of the prior art, courts can consider whether the equivalent could have been allowed by the Patent Office over the prior art. *Abbott Labs. v. Dey L.P.*, 287 F.3d 1097, 1105 (Fed. Cir. 2002) (citing *Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677, 683 (Fed. Cir. 1990)). If NXP endeavors to expand the scope of its doctrine of equivalents allegations to include the accused interfaces—*i.e.*, where commands and addresses are transmitted using a fixed width bus and the data is transmitted over a separate line—then the patent holder has lost the argument for patentability because the asserted claim encompasses the prior art. Once the scope of a hypothetical equivalent gets too broad, the claimed technology is no longer a claim that would have been issued. *See DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1323 (Fed. Cir. 2009) (discussing the doctrine of ensnarement, which bars a patentee from asserting a scope of equivalency that would encompass, or “ensnare,” the prior art).

This is certainly the case here, where the use of separate buses to transmit commands, addresses, and data was already known. Faithful adherence to the Court’s claim construction can only lead to one of two results. Either there is a finding of non-infringement because the BlackBerry functionality does not practice the asserted claims, or there is a finding of obviousness because to argue that the separate transmission of commands and addresses is equivalent to using a single line to transmit the commands and addresses with data, blurs any distinction between what was claimed and what was already in the prior art.

3. NXP Has Not Met Its Burden of Proving Damages for The ’654 Patent

NXP has not met its burden of proving that it is entitled to any damages for the ’654 patent for at least the following reasons:

- NXP’s damages expert, Mr. Weinstein, offers two alternative damages opinions for the ’654 patent that are [REDACTED], demonstrating the speculative and unreliable nature of his opinions;

- For his first damages opinion, [REDACTED];
- For his alternative damages opinion, Mr. Weinstein [REDACTED].¹¹
- Mr. Weinstein ignores the fact that NXP has been a long-standing member of JEDEC since 2006. If NXP is using the JEDEC eMMC standard to allege infringement, then it should be using the same eMMC standard to determine a FRAND royalty rate;
- Mr. Weinstein further inflates the damages [REDACTED]. Specifically, NXP is not entitled to pre-suit damages on the '654 patent because it failed to comply with the marking requirements under 35 U.S.C. § 287. It is only entitled to damages from the date that actual notice of the alleged infringement was given to BlackBerry, which is the date the complaint was filed. *See* 35 U.S.C. § 287(a). Despite this fact, [REDACTED].

Should NXP establish infringement and somehow adduce reliable and sufficient evidence of any damages for the '654 patent, the damages at most would be commensurate with NXP's licensing history and/or [REDACTED].

Further, the Court should recognize that the alternative damages opinion suffers from the same methodological flaws as the '455 and '420 patents and limit NXP to seek damages based on a FRAND rate.¹² *See LaserDynamics*, 694 F.3d at 67, 81; *Uniloc*, 632 F.3d at 1315-16; *Lucent Tech.*, 1328 at 1337-39. Yet, even eliminating the alternative approach does not cure Mr. Weinstein's failure to tie his damages opinions to the facts of this case.

¹¹ For the reasons stated in its *Daubert* Motion, BlackBerry again re-urges its argument that Mr. Weinstein's damages opinions regarding his alternative 85¢ royalty rate should be excluded as unreliable and unduly prejudicial under F.R.E. 702 and 403. *See* (Doc. Nos. 203, 242) (BlackBerry's *Daubert* Motion and Reply in support thereof).

¹² For the reasons stated in its motion for summary judgment, BlackBerry again re-urges its argument that NXP is not entitled to pre-suit damages on the '654 patent because it failed to comply with the marking requirements in 35 U.S.C. § 287. *See* (Doc. No. 205 at 24-27).

IV. CONCLUSION

If the Court does not grant BlackBerry's motions for summary judgment and this case proceeds to trial, the evidence will demonstrate that NXP should never have filed this patent infringement case against its former customer BlackBerry. To that end, BlackBerry expects that the jury will find in BlackBerry's favor with respect to all the claims at trial, and further find that NXP should take nothing in damages.

February 21, 2014

/s/ Sarah Chapin Columbia

RICHARD E. MITCHELL, ESQ.
Florida Bar No.: 0168092
rick.mitchell@gray-robinson.com
GRAYROBINSON, P.A.
301 E. Pine Street, Suite 1400
Post Office Box 3068
Orlando, Florida 32802-3068
(407) 843-8880 Telephone
(407) 244-5690 Facsimile

Local Counsel for Defendants
BLACKBERRY LIMITED and BLACKBERRY CORPORATION

SARAH CHAPIN COLUMBIA, ESQ.
Admitted Pro Hac Vice
Massachusetts Bar No.: 550155
solumbia@mwe.com
MCDERMOTT WILL & EMERY LLP
28 State Street
Boston, MA 02109-1775
Telephone: 617-535-4000
Facsimile 617-535-3800

-and-

RUSSELL HAYMAN, ESQ.
Admitted Pro Hac Vice
California Bar No. 110643
rhayman@mwe.com

JON DEAN, ESQ.
Admitted Pro Hac Vice
California Bar No. 184972
jdean@mwe.com
MCDERMOTT WILL & EMERY LLP
2049 Century Park East, Suite 3800
Los Angeles, CA 90067-3218
Telephone: 310-277-4110
Facsimile: 310-277-4730

-and-

JEFFREY GARGANO, ESQ.
Admitted Pro Hac Vice
Illinois Bar No. 6210852
kgargano@mwe.com
MCDERMOTT WILL & EMERY LLP

227 West Monroe Street
Chicago , IL 60606-5096
Telephone: 312-372-2000
Facsimile: 312-984-7700

-and-

MARCOS DANIEL JIMÉNEZ, ESQ.
Florida Bar No. 441503
mjimenez@mwe.com
MCDERMOTT WILL & EMERY LLP
333 Avenue of the Americas,
Suite 4500
Miami, FL 33131-2184
Telephone: 305-358-3500
Facsimile: 305-347-6500

Lead Trial Counsel for Defendants
BLACKBERRY LIMITED and BLACKBERRY CORPORATION

NOAH C. GRAUBART, ESQ.
(Admitted Pro Hac Vice) GA Bar No.: 141862
graubart@fr.com
FISH & RICHARDSON P.C.
1180 Peachtree Street NE, 21st Floor
Atlanta, Georgia 30309
(404) 892-5005 Telephone
(404) 892-5002 Facsimile

Co-Counsel for Defendants
BLACKBERRY LIMITED and BLACKBERRY CORPORATION

CERTIFICATION OF SERVICE

I hereby certify that a copy of the foregoing document was electronically filed with the Clerk of the Courts by using the ECF system. A service copy of the foregoing document was sent my electronic mail to Plaintiff's lead counsel.

Dated: February 21, 2014

/s/ Sarah Chapin Columbia
Sarah Chapin Columbia

DM_US 49870364-1.092211.0016

EXHIBIT A

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Stephen Townsend on 06/14/2013

1 UNITED STATES DISTRICT COURT
2 FOR THE MIDDLE DISTRICT OF FLORIDA
3 ORLANDO DIVISION

4 NXP B.V., :
5 Plaintiff, :
6 vs. : Case No.
7 RESEARCH IN MOTION, LTD AND : 6:12-cv-98-ACC-TBS
8 RESEARCH IN MOTION CORP., :
9 Defendants. :

10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

DEPOSITION UPON ORAL EXAMINATION
OF
STEPHEN TOWNSEND

on

Friday, June 14, 2013
commencing at 9:06 a.m.

Taken at:
Alexander House Hotel and Utopia Spa
Turners Hill
East Grinstead
West Sussex RH10 4QD
United Kingdom

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Stephen Townsend on 06/14/2013

Page 125

1 in a position to be certain.

2 Q If you could take a look and let me
3 know if anything refreshes your recollection?

4 A Well, Mr Mergler's contribution was
5 along the same lines as mine in terms of the '525
6 patent, much more in-depth, and made certain
7 suggestions about alternative ways in which to boot
8 up the GPS receiver, not just in respect of making
9 a specific call but in relation to the interaction
10 of the phone and the user.

11 And then, I suppose, most important
12 to this case is that, in terms of the contribution
13 at lines 40 to 45 in relation to the Internet
14 enabled mobile phone, I don't know. I believe it
15 doesn't appear in the Mergler proposal.

16 I don't recall contributing it. It
17 got contributed in the course of drafting the
18 patent application. I couldn't tell you who
19 contributed it.

20 Q Now, when you mention more details on
21 how to boot up the GPS receiver, are you talking
22 about the detection means 107?

23 A Let me just be precise. (Witness
24 reviewed the document) Yes, there were several
25 things suggested.

http://www.pchawandhelp

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Stephen Townsend on 06/14/2013

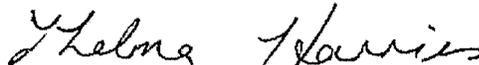
1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

C E R T I F I C A T E

I, THELMA HARRIES, MBIVR, ACR do hereby
certify:

That STEPHEN TOWNSEND, the witness whose
examination is hereinbefore set forth, was duly
sworn by me and the within transcript is a true
record of the testimony given by such witness.

I further certify that I am not related to
any of the parties of this action nor in anyway
interested in the outcome of this matter.



THELMA HARRIES, MBIVR, ACR
Certified Court Reporter

EXHIBIT B

NXP B.V. vs. RESEARCH IN MOTION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 UNITED STATES DISTRICT COURT
2 FOR THE MIDDLE DISTRICT OF FLORIDA
3 ORLANDO DIVISION
4
5 NXP B.V. ,
6 PLAINTIFF ,
7 vs. No. 6:12-CV-498-ACC-TBS
8 RESEARCH IN MOTION, LTD AND
9 RESEARCH IN MOTION CORP. ,
10 DEFENDANTS.

11
12 VIDEOTAPED DEPOSITION OF IWO MERGLER
13 Tuesday, June 18, 2013
14
15
16
17
18
19
20
21
22
23

24 Reported By:
25 KATHLEEN WILKINS, CSR #10068, RPR-RMR-CRR-CCRR-CLR

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 A. Yes. Yes.

2 Q. Okay. Can you tell me what your
3 contribution to Claim 1 was as compared to
4 Mr. Townsend?

5 A. From what I remember -- I'm not quite so
6 familiar with the claim structure in this patent
7 because I haven't read it for many years now. But
8 as far as I remember, Mr. Townsend's contribution
9 was mostly the -- what was it? -- effectively
10 Claim 3 of the U.S. patent. I don't know how that
11 maps to the current list of claims in this one.

12 MR. WIN: Which -- which U.S. patent are
13 you referring to?

14 THE WITNESS: Sorry. The 6,501,420.
15 BY MR. GRAUBART:

16 Q. So with respect to the subject matter of
17 the patent application in the file history that
18 begins on page -756 and goes through -766, you
19 believe Mr. Townsend's contribution was generally
20 that -- that's contained within Claim 3 of the
21 '420 patent?

22 MR. WIN: Objection. Vague.

23 THE WITNESS: Yes. I do -- I do
24 recognize -- in the other claims, I substantially
25 recognize the document I have submitted to the IP

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 Q. Okay. Why don't you go ahead and -- and
2 step back to the previous page or read however
3 much you need to to get the appropriate context.

4 A. Okay.

5 Okay. Could you repeat the question,
6 please.

7 Q. Yes. Sure.

8 So having reviewed the -- this document,
9 do you have an understanding of what the
10 anticipating feature of logging into a particular
11 web site is?

12 MR. WIN: Objection. Vague.

13 THE WITNESS: Okay. I can -- this can
14 only be an opinion. It seems to -- it seems to
15 basically say that the same kind of argument as
16 being anticipatory in the sense that predicting
17 the future, powering on GPS before it is becoming
18 necessary, that -- this effectively says that
19 it -- the same -- the same principle applies to
20 the web site aspect in the sense that the web site
21 is yet another -- another factor which could be
22 used to anticipate the need for a GPS.

23 But, yeah, it's as much as I can make
24 out in that document.

25 BY MR. GRAUBART:

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 Q. And so with that understanding, your
2 understanding of what that means, is that
3 consistent with what you understood Mr. Townsend's
4 contribution to the '420 to be? Does that
5 describe Mr. Townsend's invention?

6 MR. WIN: Objection. Vague.

7 THE WITNESS: It seems to be the case,
8 but it's been -- been a long time. I -- I can't
9 really tell what I thought then.

10 BY MR. GRAUBART:

11 Q. There's nothing about it that -- nothing
12 about that understanding of that anticipating
13 feature or sentence we just discussed, there's
14 nothing about that understanding that strikes you
15 as different from Mr. Townsend's contribution to
16 the '420 patent?

17 MR. WIN: Objection to the form.

18 THE WITNESS: Well, the sentence seems
19 to be about his contribution to the patent, so I
20 don't quite understand.

21 BY MR. GRAUBART:

22 Q. Okay. So the sentence about
23 anticipating feature, you understand that to refer
24 to Mr. -- to the aspect of the invention that was
25 contributed by Mr. Townsend?

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 MR. WIN: Objection. Vague.

2 THE WITNESS: It -- it seems that way,
3 yes.

4 MR. GRAUBART: I'm kind of at a natural
5 breaking point if you want to stop for lunch.

6 MR. WIN: Sure.

7 THE VIDEOGRAPHER: The time is 11:57.
8 We are now off the record.

9 (Whereupon, a lunch recess was taken.)

10 AFTERNOON SESSION

11 THE VIDEOGRAPHER: The time is 12:28,
12 and we are now on the record.

13 MR. GRAUBART: Good afternoon,
14 Mr. Mergler. I'm going to hand you what the court
15 reporter is going to mark Exhibit Number 5. If I
16 can find it.

17 (Whereupon, Deposition Exhibit 5 was
18 marked for identification.)

19 THE WITNESS: Thank you.

20 BY MR. GRAUBART:

21 Q. Have you ever seen this before,
22 Mr. Mergler?

23 A. No, I don't think so.

24 Q. Okay. And I'll just state for the
25 record, the court reporter has handed you what's

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 Q. Sure.

2 So -- but despite that -- it appears to
3 you to look -- to be describing a specific kind of
4 GPS receiver. It is describing a GPS receiver,
5 right?

6 A. It's specifically describing a different
7 kind of GPS receiver than we were using.

8 Q. But it's a GPS receiver?

9 A. Yes, correct.

10 Q. Okay. And it -- and as described in the
11 O'Neill patent, the GPS receiver powers up in
12 response to a user select -- pressing a key?

13 MR. WIN: Objection. Vague. Objection.
14 Calls for a legal opinion. Expert testimony.

15 THE WITNESS: Yes. That -- from my
16 reading, that seems to be the case.

17 BY MR. GRAUBART:

18 Q. Okay. If I turn your attention back to
19 Exhibit 2, which is the '420 patent.

20 So we talked earlier, I know, about the
21 various contributions between you and
22 Mr. Townsend, and I believe we did so in context
23 of the British application that led to this.

24 And I apologize if we already did this
25 with respect to these claims, but -- so Claim 1 --

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 looking at Claim 1 of the '420 patent, is it
2 correct that that -- that's your contribution --
3 that reflects your technical contribution, not
4 Mr. Townsend's, right?

5 A. I believe so, yes.

6 Q. Okay. And now looking at -- is that the
7 same -- is that true with respect to Claim 2 as
8 well?

9 A. Yes.

10 Q. Okay. And then in contrast, Claim 3,
11 the notion of an Internet-enabled phone, where the
12 GPS receiver is arranged -- where the trigger, as
13 you called it, I think, is the user selecting a
14 web site, that was Mr. Townsend's contribution?

15 A. Yes.

16 Q. Okay. So going back to Claim 1, does it
17 appear that -- what part of Claim 1 haven't you
18 seen in the O'Neill patent?

19 MR. WIN: Objection. Vague.

20 THE WITNESS: Well, I haven't seen any
21 of Claim 1 in the patent as such, as in those
22 words, so -- and for the rest, that's an
23 interpretation.

24 BY MR. GRAUBART:

25 Q. So we established that O'Neill, you

NXP B.V. vs. RESEARCH IN MOION, LTD, ET AL.
Iwo Mergler on 06/18/2013

1 CERTIFICATE OF REPORTER

2

3 I, KATHLEEN A. WILKINS,

4 RPR-RMR-CRR-CCRR-CLR, Certified Shorthand

5 Reporter, hereby certify that the witness in the

6 foregoing deposition was by me duly sworn to tell

7 the truth, the whole truth and nothing but the

8 truth in the within-entitled cause; that said

9 deposition was taken down in shorthand by me, a

10 disinterested person, at the time and place

11 therein stated, and that the testimony of the said

12 witness was thereafter reduced to typewriting, by

13 computer, under my direction and supervision.

14 I further certify that I am not of

15 counsel or attorney for either or any of the

16 parties to the said deposition, nor in any way

17 interested in the event of this cause, and that I

18 am not related to any of the parties thereto.

19

20 DATED: _____, 2013

21

22



23

24 KATHLEEN WILKINS, RPR-RMR-CRR-CCRR-CLR, CSR 10068

25

EXHIBIT C

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Franklyn Hayward Story on 07/12/2013

1 UNITED STATES DISTRICT COURT
2 FOR THE MIDDLE DISTRICT OF FLORIDA
3 ORLANDO DIVISION
4
5 NXP B.V.,)
6)
7 Plaintiff,)
8 vs.) Case No. 6:12-CV-498-ACC-TBS
9 RESEARCH IN MOTION, LIMITED)
10 and RESEARCH IN MOTION CORP,)
11)
12 Defendants.)
13 _____)

12
13
14
15 Videotaped Deposition of FRANKLYN HAYWARD STORY,
16
17 taken on behalf of Defendants, pursuant to the
18
19 stipulations agreed to herein, before KATE E. ROUNDY, CSR
20
21 No. 50582, a Certified Shorthand Reporter, at Hampton Inn
22
23 Mesa, 1563 South Gilbert Road, Mesa, Arizona 85204, on
24
25 Friday, July 12, 2013, commencing at 9:04 a.m.

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Franklyn Hayward Story on 07/12/2013

1 Q. So going to line 25, which is under the
2 subsection, description of the related art, do you see
3 that?

4 A. Yes.

5 Q. You will agree with me that in 1994, as the
6 size of these systems shrinks, the pin count on their
7 components becomes a significant limiting factor?

8 A. Again, in 1994, I believe that that was my
9 truthful understanding.

10 Q. And you agree with me that in 1994, many
11 systems are conserving pins by taken certain functions
12 that used to occur in parallel format and implementing
13 these functions instead in serial format; right?

14 MR. WIN: Objection to the form; calls for an
15 expert opinion.

16 THE WITNESS: In 1994, I believe that I
17 viewed that as a truthful statement.

18 BY MR. REGER:

19 Q. And you will agree with me that in 1994,
20 electronic systems that have components that communicate
21 via serial bus are well known in the prior art?

22 MR. WIN: Objection; calls for a legal
23 conclusion; calls for expert opinion.

24 THE WITNESS: I think that in 1994, I viewed
25 that as a truthful statement.

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Franklyn Hayward Story on 07/12/2013

1 Do you see that?

2 A. I do.

3 Q. If you could take a moment to review --
4 withdrawn.

5 If you could take a moment to read the
6 background of the invention section and let me know when
7 you are finished.

8 A. Okay.

9 Okay.

10 Q. Sitting here today are you aware of any
11 untruthful statements from 1999?

12 MR. WIN: Objection to the form.

13 THE WITNESS: I am not.

14 BY MR. REGER:

15 Q. So you would agree with me that in 1999 one
16 or more busses were used to connect a central processing
17 unit to a memory and to input/output elements; right?

18 A. In 1999 I viewed that as a truthful
19 statement.

20 Q. And you agree with me that in many computer
21 system architectures in 1999 the peripheral component
22 interconnect, or PCI, bus is commonly used to achieve
23 high bandwidth connectivity; correct?

24 A. I believe that in 1999 I viewed that as a
25 correct statement.

NXP B.V. vs. RESEARCH IN MOTION, ET AL.
Franklyn Hayward Story on 07/12/2013

1 STATE OF ARIZONA)
) ss.
2 COUNTY OF MARICOPA)

3 BE IT KNOWN that the foregoing deposition was
4 taken by me pursuant to stipulation of counsel; that I was
5 then and there a Certified Court Reporter of the State of
6 Arizona, and by virtue thereof authorized to administer an
7 oath; that the witness before testifying was duly sworn by me
8 to testify to the whole truth; pursuant to request,
9 notification was provided that the deposition is available
10 for review and signature; that the questions propounded by
11 counsel and the answers of the witness thereto were taken
12 down by me in shorthand and thereafter transcribed into
13 typewriting under my direction; that the foregoing pages are
14 a full, true, and accurate transcript of all proceedings and
15 testimony had and adduced upon the taking of said deposition,
16 all done to the best of my skill and ability.

17 I FURTHER CERTIFY that I am in no way related to
18 nor employed by any of the parties hereto nor am I in any way
19 interested in the outcome hereof.

20 DATED at Phoenix, Arizona, _____ day of _____,
21 2013.

22
23 _____
Kate E. Roundy, RPR
24 Certified Reporter #50582

25

EXHIBIT D

NXP B.V., vs. RESEARCH IN MOTION, LTD., ET AL.

Attorneys Eyes Only

Donald Alpert, Ph.D. on 09/10/2013

Page 1

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION

---o0o---

NXP B.V.,

Plaintiff,

vs.

Case No.

6:12-cv-00498-ACC-TBS

RESEARCH IN MOTION, LTD. and
RESEARCH IN MOTION, CORP.,

Defendant.

_____ /

Deposition of

DONALD ALPERT, Ph.D.

Volume I, Pages 1-294

Tuesday, September 10, 2013

ATTORNEYS' EYES ONLY - COMPUTER SOURCE CODE

REPORTED BY: JOHN WISSENBACH, RDR, CRR, CBC, CCP,
CLR, CSR 6862

NXP B.V., vs. RESEARCH IN MOTION, LTD., ET AL.

Attorneys Eyes Only

Donald Alpert, Ph.D. on 09/10/2013

Page 168

1	(Recess taken.)	14:10:35
2	THE VIDEOGRAPHER: This now marks the	14:16:30
3	beginning of tape labeled number 3 of the videotaped	14:16:41
4	deposition of Donald Alpert. We're now going back	14:16:43
5	on the record. The time is 2:16.	14:16:46
6	BY MR. REGER:	14:16:49
7	Q. Dr. Alpert, tell me if you agree or	14:16:49
8	disagree with this statement: In 1995, many systems	14:16:51
9	were conserving pins by taking certain functions	14:16:54
10	that used to occur in parallel format and	14:16:57
11	implementing these functions instead in serial	14:17:00
12	format."	14:17:02
13	A. I have to say I don't -- I don't have an	14:17:10
14	opinion. And, you know, I'm sure some were.	14:17:11
15	Whether that was many or not, I don't know.	14:17:14
16	Q. Do you agree that by serializing functions	14:17:23
17	that were previously done in parallel, you can	14:17:26
18	conserve pins?	14:17:29
19	A. Yes, that would be, yeah, one -- one	14:17:34
20	possible consequence of -- of going from parallel to	14:17:39
21	serial.	14:17:42
22	Q. Sure. Because if you do it in parallel,	14:17:43
23	you require a pin for each function, correct?	14:17:45
24	A. That's certainly one way you could do	14:17:52
25	things, yes, in parallel.	14:17:55

1 CERTIFICATE OF REPORTER

2 I, JOHN WISSENBACH, a Certified Shorthand
3 Reporter, hereby certify that the witness in the
4 foregoing deposition was by me duly sworn to tell
5 the truth, the whole truth, and nothing but the
6 truth in the within-entitled cause;

7 That said deposition was taken down in
8 shorthand by me, a disinterested person, at the time
9 and place therein stated, and that the testimony was
10 thereafter reduced to typewriting by computer under
11 my direction and supervision and is a true record of
12 the testimony given by the witness;

13 That before completion of the deposition,
14 review of the transcript [] was [X] was not
15 requested. If requested, any changes made by the
16 deponent (and provided to the reporter) during the
17 period allowed are appended hereto.

18 I further certify that I am not of counsel
19 or attorney for either or any of the parties to the
20 said deposition, nor in any way interested in the
21 event of this cause, and that I am not related to
22 any of the parties thereto.

23 DATE: 

24
25 JOHN WISSENBACH, CSR No. 6862