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Applicant : Campana, Jr. et al.

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Title : ELECTRONIC MAIL SYSTEM WITH RF COMMUNICATIONS  
TO MOBILE PROCESSORS AND METHOD OF OPERATION  
THEREOF

TC/Art Unit : 2645

Examiner: : Scott L. Weaver

Docket No. : 49671.000006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO FINAL OFFICE ACTION OF FEBRUARY 24, 2006**

Sir:

In response to the Final Office Action dated February 24, 2006, Patent Owner remarks as follows:

**IN THE CLAIMS:**

A listing of the status of claims 1-233 under reexamination is provided below:

1. (Original Patent Claim) A system for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

at least one gateway switch in the electronic mail system, one of the at least one gateway switch receiving the originated information and storing the originated information prior to transmission of the originated information to the at least one of the plurality of destination processors;

a RF information transmission network for transmitting the originated information to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors;

at least one interface switch, one of the at least one interface switch connecting at least one of the at least one gateway switch to the RF information transmission network and transmitting the originated information received from the gateway switch to the RF information transmission network; and wherein

the originated information is transmitted to the one interface switch by the one gateway switch in response to an address of the one interface switch added to the originated information at the one of the plurality of originating processors or by the electronic mail system and the originated information is transmitted from the one interface switch to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information added at the originating processor, or by either the electronic mail system or the one interface switch; and

the electronic mail system transmits other originated information from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network.

2. (Original Patent Claim) A system in accordance with claim 1 wherein:

the one interface switch removes from the originated information information added by the electronic mail system and adds information, used by the RF information transmission network during transmission of the originated information through the RF information transmission network to the at least one RF receiver in the RF information transmission network, to the originated information.

3. (Original Patent Claim) A system in accordance with claim 1 wherein:

the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the one interface switch stores the originated information, assembles the originated information with additional originated information received from a plurality of the originating processors into a packet and transmits the packet to the RF information transmission network.

4. (Original Patent Claim) A system in accordance with claim 3 wherein the RF information transmission network comprises:

an RF information transmission network switch, the RF information transmission network switch receiving the packet from the one interface switch disassembles the packet into disassembled information including the originated information and the identification number of the at least one RF receiver in the RF information network; and wherein

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

5. (Original Patent Claim) A system in accordance with claim 2 wherein:

the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the one interface switch stores the originated information, assembles the originated information with additional originated information received from a plurality of the originating processors into a packet and transmits the packet to the RF information transmission network.

6. (Original Patent Claim) A system in accordance with claim 5 wherein the RF information transmission network comprises:

an RF information transmission network switch, the RF information transmission network switch receiving the packet from the one interface switch disassembles the packet



into disassembled information including the originated information and the identification number of the at least one RF receiver in the RF information network; and wherein

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

7. (Original Patent Claim) A system in accordance with claim 2 wherein:

the wireline transmitting the other originated information between the one of the plurality of originating processors and the at least one of the plurality of destination processors is one of either a public or private switch telephone network with the at least one destination processor being addressed during transmission of the other originated information to the at least one destination processor when using the public or private switch telephone network with a different address than the address used during transmission of the originated information to the at least one of the plurality of destination processors by the RF information transmission network.

8. (Original Patent Claim) A system in accordance with claim 1 wherein:

the address of the one interface switch is added to the originated information by the one gateway switch.

9. (Original Patent Claim) A system in accordance with claim 1 wherein:  
the address of the one interface switch is added by the one originating processor.

10. (Original Patent Claim) A system in accordance with claim 1 wherein:  
the address of the at-least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one originating processor.

11. (Original Patent Claim) A system in accordance with claim 1 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one gateway switch.

12. (Original Patent Claim) A system in accordance with claim 1 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one interface switch.

13. (Original Patent Claim) A system in accordance with claim 10 wherein:  
the identification number is added to the originated information by inputting the identification number to the one originating processor.

14. (Original Patent Claim) A system in accordance with claim 10 wherein:

the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

15. (Original Patent Claim) A system in accordance with claim 11 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

16. (Original Patent Claim) A system in accordance with claim 12 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

17. (Original Patent Claim) A system in accordance with claim 1 wherein:  
the address of the one interface switch and the address of the at least one of the plurality of destination processors to receive the originated information is added by the one gateway switch.

18. (Original Patent Claim) A method for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

transmitting the originated information originating from the one of the plurality of originating processors to a gateway switch within the electronic mail system;

transmitting the originated information from the gateway switch to an interface switch;

transmitting the originated information received from the gateway switch from the interface switch to a RF information transmission network;

transmitting the originated information by using the RF information transmission network to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors; and

transmitting other originated information with the electronic mail system from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network; and wherein

the originated information is transmitted to the interface switch by the gateway switch in response to an address of the interface switch which has been added to the originated information at the one of the plurality of originating processors or by the electronic mail system and the originated information is transmitted from the interface switch to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information which has been added at the originating processor or by either the electronic mail system or the interface switch.

19. (Original Patent Claim) A method in accordance with claim 18 wherein:

the interface switch removes from the originated information information added by the electronic mail system and adds information, used by the RF information transmission network during transmission of the originated information to the originated information to the at least one RF receiver in the RF information transmission network, to the originated information.

20. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the interface switch stores the originated information, assembles the originated information with additional originated information received from a plurality of originating processors into a packet and transmits the packet to the RF information transmission network.

21. (Original Patent Claim) A method in accordance with claim 20 wherein:  
an RF information transmission network switch receives the packet from the interface switch and disassembles the packet into disassembled information including the originated information and the identification number of the at least one RF receiver in the RF information transmission network; and

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and

adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

22. (Original Patent Claim) A method in accordance with claim 19 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the interface switch stores the originated information, assembles the originated information with additional originated information received from a plurality of originating processors into a packet and transmits the packet to the RF information transmission network.

23. (Original Patent Claim) A method in accordance with claim 22 wherein:  
an RF information transmission network switch receives the packet from the interface switch and disassembles the packet into disassembled information including the originated information and the identification number of the at least one RF receiver in the RF information transmission network; and

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and

adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

24. (Original Patent Claim) A method in accordance with claim 19 wherein:  
the transmission of the other originated information between the one of the plurality of originating processors and the at least one of the plurality of destination processors by the wireline is through either a public or private switch telephone network with the at least one of the plurality of destination processors being addressed during transmission of the other originated information to the at least one of the plurality of destination processors when using the public or private switch telephone network with a different address than the address used during transmission of the originated information to the at least one of the plurality of destination processors by the RF information transmission network.

25. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the interface switch is added to the originated information by the gateway switch.

26. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the interface switch is added by the one originating processor.

27. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and

transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one originating processor.

28. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the gateway switch.

29. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the interface switch.

30. (Original Patent Claim) A method in accordance with claim 27 wherein:  
the identification number is added to the originated information by inputting the identification number to the one originating processor.

31. (Original Patent Claim) A method in accordance with claim 27 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

32. (Original Patent Claim) A method in accordance with claim 28 wherein:



the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

33. (Original Patent Claim) A method in accordance with claim 29 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

34. (Original Patent Claim) A method in accordance with claim 18 wherein:  
the address of the interface switch and the address of the at least one of the plurality of destination processors to receive the originated information is added by a gateway switch.

35. (Original Patent Claim) A system for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

a RF information transmission network for transmitting the originated information to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors;

at least one interface switch, one of the at least one interface switch connecting the electronic mail system to the RF information transmission network and transmitting the

originated information received from the electronic mail system to the RF information transmission network; and wherein

the originated information is transmitted to the one interface switch by the electronic mail system in response to an address of the one interface switch added to the originated information at the one of the plurality of originating processors or by the electronic mail system and the originated information is transmitted from the one interface switch to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information added at the originating processor, or by either the electronic mail system or the one interface switch; and

the electronic mail system transmits other originated information from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network.

36. (Original Patent Claim) A system in accordance with claim 35 wherein:

the one interface switch removes from the originated information information added by the electronic mail system and adds information, used by the RF information transmission network during transmission of the originated information through the RF information transmission network to the at least one RF receiver in the RF information transmission network, to the originated information.

37. (Original Patent Claim) A system in accordance with claim 35 wherein:

the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the one interface switch stores the originated information, assembles the originated information with other originated information received from a plurality of the originating processors into a packet and transmits the packet to the RF information transmission network.

38. (Original Patent Claim) A system in accordance with claim 37 wherein the RF information transmission network comprises:

a RF information transmission network switch, the RF information transmission network switch receiving the packet from the one interface switch disassembles the packet into disassembled information including the originated information and the identification number of the at least one RF receiver in the RF information network; and wherein

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

39. (Original Patent Claim) A system in accordance with claim 36 wherein:

the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the one interface switch stores the originated information, assembles the originated information with other originated information received from a plurality of the originating processors into a packet and transmits the packet to the RF information transmission network.

40. (Original Patent Claim) A system in accordance with claim 39 wherein the RF information transmission network comprises:

RF information transmission network switch, the RF information transmission network switch receiving the packet from the one interface switch disassembles the packet into disassembled information including the originated information and the identification number of the at least one RF receiver in the RF information network; and wherein

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

41. (Original Patent Claim) A system in accordance with claim 36 wherein:  
the wireline transmitting the other originated information between the one of the plurality of originating processors and the at least one of the plurality of destination processors is one of either a public or private switch telephone network with the at least one of the plurality of destination processors being addressed during transmission of the other originated information to the at least one of the plurality of destination processors when using the public or private switch telephone network with a different address than the address used during transmission of the originated information to the at least one of the plurality of destination processors by the RF information transmission network.

42. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the address of the one interface switch is added to the originated information by the one gateway switch.

43. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the address of the one interface switch is added by the one originating processor.

44. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one originating processor.

45. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and

transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one gateway switch.

46. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and is added to the originated information by the one interface switch.

47. (Original Patent Claim) A system in accordance with claim 44 wherein:  
the identification number is added to the originated information by inputting the identification number to the one originating processor.

48. (Original Patent Claim) A system in accordance with claim 44 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

49. (Original Patent Claim) A system in accordance with claim 45 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

50. (Original Patent Claim) A system in accordance with claim 46 wherein:

the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

51. (Original Patent Claim) A system in accordance with claim 35 wherein: the address of the one interface switch and the address of the at least one of the plurality of destination processors to receive the originated information is added by a gateway switch.

52. (Original Patent Claim) A method for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

transmitting the originated information originating from the one of the plurality of originating processors from the electronic mail system to an interface switch;

transmitting the originated information received from the electronic mail system from the interface switch to a RF information transmission network;

transmitting the originated information by using the RF information transmission network to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors; and

transmitting other originated information with the electronic mail system from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network; and wherein

the originated information is transmitted to the one interface switch by the electronic mail system in response to an address of the interface switch added to the originated information at the one of the plurality of originating processors or by the electronic mail system and the originated information is transmitted from the interface switch to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information added at the originating processor or by either the electronic mail system or the interface switch.

53. (Original Patent Claim) A method in accordance with claim 52 wherein:

the interface switch removes from the originated information information added by the electronic mail system and adds information, used by the RF information transmission network during transmission of the originated information through the RF information transmission network to the originated information to the at least one RF receiver in the RF information transmission network, to the originated information.

54. (Original Patent Claim) A method in accordance with claim 52 wherein:

the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the interface switch stores the originated information, assembles the originated information with other originated information received from a plurality of originating processors into a packet and transmits the packet to the RF information transmission network.

55. (Original Patent Claim) A method in accordance with claim 54 wherein:

RF information transmission network switch receives the packet from the interface switch and disassembles the packet into disassembled information including the originated



information and the identification number of the at least one RF receiver in the RF information transmission network; and

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

56. (Original Patent Claim) A method in accordance with claim 53 wherein:  
the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver in the RF information transmission network; and

the interface switch stores the originated information, assembles the originated information with other originated information received from a plurality of originating processors into a packet and transmits the packet to the RF information transmission network.

57. (Original Patent Claim) A method in accordance with claim 56 wherein:  
a RF information transmission network switch receives the packet from the interface switch and disassembles the packet into disassembled information including the originated

information and the identification number of the at least one RF receiver in the RF information transmission network; and

the RF information transmission network transmits the originated information and the identification number from the RF information transmission network switch to another RF information transmission network switch in the RF information transmission network storing a file containing the identification number and any destination of the at least one RF receiver in the RF information transmission network to which the originated information and identification number is to be transmitted by the RF information transmission network and adds any destination of the at least one RF receiver stored in the file containing the identification number to the originated information and the RF information transmission originated information and the RF information transmission network in response to any added destination transmits the originated information and identification number to any destination of the at least one RF receiver for RF broadcast to the at least one RF receiver.

58. (Original Patent Claim) A method in accordance with claim 53 wherein:

the transmission of the other originated information between the one of the plurality of originating processors and the at least one of the plurality of destination processors by the wireline is through either a public or private switch telephone network with the at least one of the plurality of destination processors being addressed during transmission of the other originated information to the at least one of the plurality of destination processors when using the public or private switch telephone network with a different address than the address used during transmission of the other information to the at least one of the plurality of destination processors by the RF information transmission network.

59. (Original Patent Claim) A method in accordance with claim 52 wherein:

the address of the interface switch is added to the originated information by a gateway switch.

60. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the address of the interface switch is added by the one originating processor.

61. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the address of the at least one of the plurality of destination processors is an  
identification number of the at least one RF receiver receiving the originated information and  
transferring the information to the at least one of the plurality of destination processors and is  
added to the originated information by the one originating processor.

62. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the address of the at least one of the plurality of destination processors is an  
identification number of the at least one RF receiver receiving the originated information and  
transferring the information to the at least one of the plurality of destination processors and is  
added to the originated information by the gateway switch.

63. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the address of the at least one of the plurality of destination processors is an  
identification number of the at least one RF receiver receiving the originated information and  
transferring the information to the at least one of the plurality of destination processors and is  
added to the originated information by the interface switch.

64. (Original Patent Claim) A method in accordance with claim 63 wherein:  
the identification number is added to the originated information by inputting the  
identification number to the one originating processor.

65. (Original Patent Claim) A method in accordance with claim 63 wherein:

the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

66. (Original Patent Claim) A method in accordance with claim 54 wherein:  
the identification number is added to the originated information by matching an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and adding an identification number stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

67. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the address of the interface switch and the address of the at least one of the plurality of destination processors to receive the originated information is added by a gateway switch.

68. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the at least one RF receiver transfers the originated information from storage to the at least one of the plurality of destination processors in the electric mail system at a time subsequent to reception of the originated information by the at least one receiver.

69. (Original Patent Claim) A method in accordance with claim 68 wherein:  
the at least one RF receiver is portable.

70. (Original Patent Claim) A method in accordance with claim 68 wherein:  
the at least one RF receiver and the at least one of the plurality of destination processors in the electronic mail system are portable.

71. (Original Patent Claim) A method in accordance with claim 68 wherein:  
the transfer of the originated information occurs after the at least one RF receiver is connected to the at least one of the plurality of destination processors in the electronic mail system.

72. (Original Patent Claim) A method in accordance with claim 69 wherein:  
the transfer of the originated information occurs after the at least one RF receiver is connected to the at least one of the plurality of destination processors in the electronic mail system.

73. (Original Patent Claim) A method in accordance with claim 70 wherein:  
the transfer of the originated information occurs after the at least one RF receiver is connected to the at least one of the plurality of destination processors in the electronic mail system.

74. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the transfer occurs under control of a program stored by the at least one of the plurality of destination processors of the electronic mail system and makes the originated information accessible to application programs stored within the at least one of the plurality of destination processors of the electronic mail system.

75. (Original Patent Claim) A method in accordance with claim 71 wherein:  
the transfer occurs under control of a program stored by the at least one of the plurality of destination processors of the electronic mail system and makes the originated information accessible to application programs stored within the at least one of the plurality of destination processors of the electronic mail system.

76. (Original Patent Claim) A method in accordance with claim 52 wherein:

the transmission of the originated information between the one of the plurality of originating processors and the interface switch is through a host computer, a telephone network and a gateway switch.

77. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the transmission of the originated information between the one of the plurality of originating processors and the interface switch is through a private automatic branch exchange, a telephone network and a gateway switch.

78. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the transmission of the originated information between the one of the plurality of originating processors and the interface switch is through a local area network, a telephone network and a gateway switch.

79. (Original Patent Claim) A method in accordance with claim 52 wherein:  
the transmission of the originated information between the one of the plurality of originating processors and the interface switch is through a modem, a telephone network and a gateway switch.

80. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the electronic mail system comprises a private automatic branch exchange.

81. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the electronic mail system comprises a local area network.

82. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the electronic mail system comprises at least one gateway switch.

83. (Original Patent Claim) A system in accordance with claim 82 wherein:  
the electronic mail system further comprises a telephone network.

84. (Original Patent Claim) A system in accordance with claim 83 wherein:  
the telephone network is a public switch telephone network.

85. (Original Patent Claim) A system in accordance with claim 35 wherein:  
the electronic mail system comprises a host central processing unit.

86. (Original Patent Claim) A system for transmitting originated information from  
one of a plurality of originating processors in an electronic mail system to at least one of a  
plurality of destination processors in the electronic mail system comprising:

at least one gateway switch in the electronic mail system, one of the at least one  
gateway switch receiving the originated information and storing the originated information  
prior to transmission of the originated information to the at least one of the plurality of  
destination processors;

a RF information transmission network for transmitting the originated information to  
at least one RF receiver which transfers the originated information to the at least one of the  
plurality of destination processors;

at least one interface switch, one of the at least one interface switch connecting at least  
one of the at least one gateway switch to the RF information transmission network and  
transmitting the originated information received from the gateway switch to the RF  
information transmission network; and wherein

the originated information is transmitted to the one interface switch by the one  
gateway switch in response to an address of the one interface switch added to the originated  
information and the originated information is transmitted from the one interface switch to the  
RF information transmission network with an address of the at least one of the plurality of  
destination processors to receive the originated information; and

the electronic mail system transmits other originated information from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network.

87. (Original Patent Claim) A method for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

transmitting the originated information originating from the one of the plurality of originating processors to a gateway switch within the electronic mail system;

transmitting the originated information from the gateway switch to an interface switch;

transmitting the originated information received from the gateway switch from the interface switch to a RF information transmission network;

transmitting the originated information by using the RF information transmission network to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors;

transmitting other originated information with the electronic mail system from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network; and wherein

the originated information is transmitted to the interface switch by the gateway switch in response to an address of the interface switch which has been added to the originated information and the originated information is transmitted from the interface switch to the RF



information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information.

88. (Original Patent Claim) A system for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

a RF information transmission network for transmitting the originated information to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors;

at least one interface switch, one of the at least one interface switch connecting the electronic mail system to the RF information transmission network and transmitting the originated information received from the electronic mail system to the RF information transmission network; and wherein

the originated information is transmitted to the one interface switch by the electronic mail system in response to an address of the one interface switch added to the originated information and the originated information is transmitted from the one interface switch to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information; and

the electronic mail system transmits other originated information from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network.

89. (Original Patent Claim) A method for transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system comprising:

- transmitting the originated information originating from the one of the plurality of originating processors from the electronic mail system to an interface switch;
- transmitting the originated information received from the electronic mail system from the interface switch to a RF information transmission network;
- transmitting the originated information by using the RF information transmission network to at least one RF receiver which transfers the originated information to the at least one of the plurality of destination processors;
- transmitting other originated information with the electronic mail system from one of the plurality of originating processors in the electronic mail system to at least one of the plurality of destination processors in the electronic mail system through a wireline without transmission using the RF information transmission network; and wherein
- the originated information is transmitted to the one interface switch by the electronic mail system in response to an address of the interface switch added to the originated information and the originated information is transmitted from the interface switch to the RF information transmission network with an address of the at least one of the plurality of destination processors to receive the originated information.

90.-182. (Canceled)

183. (Previously Presented) A system in accordance with claim 15, further comprising:

a communication system including said electronic mail system, having said originating processors, said destination processors, and the at least one gateway switch, and a processor which is not included in said electronic mail system and which transmits further other information being information other than electronic mail including originated information, wherein:

the at least one gateway switch transmits said originated information inputted to said electronic mail system to the at least one interface switch,

said processor sends said further other information to the at least one of the plurality of destination processors using the RF information transmission network but not using the at least one gateway switch.

184. (Previously Presented) A system in accordance with claim 183, wherein said further other information is transmitted to the at least one of the plurality of destination processors via the at least one interface switch.

185. (Previously Presented) A system in accordance with claim 15, wherein:  
after reception of electronic mail including said originated information from the electronic mail system, information is deleted from the electronic mail prior to transmission by the RF information transmission network.

186. (Previously Presented) A system in accordance with claim 185, wherein the information is deleted by the at least one interface switch.

187. (Previously Presented) A system in accordance with claim 186, wherein:  
the at least one RF receiver receives the originated information transmitted from the at least one interface switch via the RF information transmission network,

the at least one RF receiver is coupled to a memory which stores the originated information received by the RF receiver, and

the at least one of the plurality of destination processors processes the originated information, after the originated information has been output from the memory, by executing an application program.

188. (Previously Presented) A system in accordance with claim 187, wherein:  
after reception of the originated information, a security check is performed to determine if the originated information should be transmitted by the RF information transmission network to the at least one of the plurality of destination processors.

189. (Previously Presented) A system in accordance with claim 188, wherein:  
the at least one RF receiver, which is coupled to the at least one of the plurality of destination processors, receives the originated information transmitted from the at least one interface switch via the RF information transmission network, and

said security check is performed by comparing an identification of the at least one RF receiver with identifications of permissible RF receivers in the RF information transmission network that are permitted to receive RF transmissions and supplying the originated information to the RF information transmission network for transmission to the at least one RF receiver if the identification of the at least one RF receiver matches one of the identifications of the permissible RF receivers.

190. (Previously Presented) A system in accordance with claim 189, wherein said comparing is performed by the at least one interface switch.

191. (Previously Presented) A system in accordance with claim 189, wherein:

the at least one gateway switch receives the originated information from the originating processor, and causes the originated information to be transmitted to the at least one of the plurality of destination processors via the at least one interface switch and the RF information transmission network.

192. (Previously Presented) A system in accordance with claim 191, wherein the at least one gateway switch adds an address of the at least one interface switch.

193. (Previously Presented) A system in accordance with claim 192, wherein the at least one gateway switch optionally initiates transmission of the originated information to the at least one of the plurality of destination processors via the at least one interface switch and the RF information transmission network based on at least one of an address of the originated information and information pre-stored in a memory of the at least one gateway switch or initiates transmission of the originated information to a destination processor through the wireline without using the RF information transmission network based on at least one of an address of the electronic mail and the information pre-stored in the memory of the at least one gateway switch.

194. Canceled.

195. (Previously Presented) A system in accordance with claim 193, wherein:  
the at least one interface switch receives the originated information from the at least one originating processor, processes the originated information, and supplies processed originated information to said RF information transmission network for transmission to the at least one of the plurality of destination processors.

196. (Previously Presented) A system in accordance with claim 195, wherein said processes performed by the at least one interface switch includes varying the electronic mail including the originated information.

197. (Previously Presented) A system in accordance with claim 196, wherein said varying includes one of encoding the content of the originated information, adding information to the electronic mail including the originated information and the deleting of information from the electronic mail including the originated information.

198. (Previously Presented) A computer program stored on a storage medium when executed by the at least one interface switch as set forth in claim 197 causes the at least one interface switch to perform:

the receiving of the originated information from the at least one originating processor;  
and

the supplying of the originated information and an identification of the at least one of the plurality of destination processors to the RF information transmission network which thereafter broadcasts the originated information to the at least one of the plurality of destination processors.

199. (Previously Presented) A computer program in accordance with claim 198, wherein said computer program when executed by the at least one interface switch further causes the at least one interface switch to perform:

wherein the originated information forms a part of electronic mail to be transmitted from the originating processor and the electronic mail is transmitted to the at least one interface switch,

the deleting, after reception of the electronic mail by the at least one interface switch, of the information from the electronic mail; and

the not transmitting of the deleted information by the RF information transmission network.

200. (Previously Presented) A computer program stored on a storage medium when executed by the one gateway switch as set forth in claim 193, causes the one gateway switch to perform:

the receiving of the originated information from the at least one originating processor; and

the causing of the originated information to be transmitted to the at least one of the plurality of destination processors via the one interface switch and the RF information transmission network which thereafter broadcasts the originated information to the at least one of the plurality of destination processors.

201. (Previously Presented) A system in accordance with claim 185, wherein:  
the deleting of information from the electronic mail includes deleting header information of the electronic mail.

202. (Previously Presented) A system in accordance with claim 197, wherein:  
the deleting of information from the electronic mail includes deleting header information of the electronic mail.

203. (Previously Presented) A system in accordance with claim 15, wherein the at least one interface switch couples a plurality of said electronic mail systems to one another such that electronic mail transmitted from an originating processor in one electronic mail system can be received by a destination processor in another of said electronic mail systems.

204. (Previously Presented) A system in accordance with claim 185, wherein the at least one of the plurality of destination processors processes said originated information of the

electronic mail excluding the deleted information that was not transmitted by the RF information transmission network.

205. (Previously Presented) A system in accordance with claim 197, wherein the at least one of the plurality of destination processors processes said originated information of the electronic mail excluding the deleted information that was not transmitted by the RF information transmission network.

206. (Previously Presented) A system in accordance with claim 204, wherein: the deleting of information from the electronic mail includes deleting header information of the electronic mail.

207. (Previously Presented) A system in accordance with claim 205, wherein: the deleting of information from the electronic mail includes deleting header information of the electronic mail.

208. (Previously Presented) A method in accordance with claim 32, wherein said electronic mail system, having said originating processors, said destination processors, and said gateway switch, is provided in a communication system having said electronic mail system and a processor which is not included in said electronic mail system and which transmits further other information being information other than electronic mail including originated information, wherein:

said gateway switch transmits said originated information inputted to said electronic mail system to said interface switch,

said processor sends said further other information to the at least one of the plurality of destination processors using the RF information transmission network but not using said gateway switch.



209. (Previously Presented) A method in accordance with claim 208, wherein said further other information is transmitted to the at least one of the plurality of destination processors via said interface switch.

210. (Previously Presented) A method in accordance with claim 32, wherein:  
after reception of electronic mail including said originated information from the electronic mail system, information is deleted from the electronic mail prior to transmission by the RF information transmission network.

211. (Previously Presented) A method in accordance with claim 210, wherein the information is deleted by said interface switch.

212. (Previously Presented) A method in accordance with claim 211, wherein:  
the at least one RF receiver receives the originated information transmitted from the interface switch via the RF information transmission network,

the at least one RF receiver is coupled to a memory which stores the originated information received by the RF receiver, and

the at least one of the plurality of destination processors processes the originated information, after the originated information has been output from the memory, by executing an application program.

213. (Previously Presented) A method in accordance with claim 212, wherein:  
after reception of the originated information, a security check is performed to determine if the originated information should be transmitted by the RF information transmission network to the at least one of the plurality of destination processors.

214. (Previously Presented) A method in accordance with claim 213, wherein:

the at least one RF receiver, which is coupled to the at least one of the plurality of destination processors, receives the originated information transmitted from the interface switch via the RF information transmission network, and

said security check is performed by comparing an identification of the at least one RF receiver with identifications of permissible RF receivers in the RF information transmission network that are permitted to receive RF transmissions and supplying the originated information to the RF information transmission network for transmission to the at least one RF receiver if the identification of the at least one RF receiver matches one of the identifications of the permissible RF receivers.

215. (Previously Presented) A method in accordance with claim 214, wherein said comparing is performed by the interface switch.

216. (Previously Presented) A method in accordance with claim 214, wherein:  
the gateway switch receives the originated information from the originating processor, and causes the originated information to be transmitted to the at least one of the plurality of destination processors via the interface switch and the RF information transmission network.

217. (Previously Presented) A method in accordance with claim 216, wherein the gateway switch adds an address of the interface switch.

218. (Previously Presented) A method in accordance with claim 212, wherein the gateway switch optionally initiates transmission of the originated information to the at least one of the plurality of destination processors via the interface switch and the RF information transmission network based on at least one of an address of the originated information and information pre-stored in a memory of the gateway switch or initiates transmission of the originated information to a destination processor through the wireline without using the RF

information transmission network based on at least one of an address of the electronic mail and the information pre-stored in the memory of the gateway switch.

219. (Previously Presented) A method in accordance with claim 218, wherein:  
the interface switch receives the originated information from the at least one originating processor, processes the originated information, and supplies processed originated information to said RF information transmission network for transmission to the at least one of the plurality of destination processors.

220. (Previously Presented) A method in accordance with claim 219, wherein said processes performed by the interface switch includes varying the electronic mail including the originated information.

221. (Previously Presented) A method in accordance with claim 220, wherein said varying includes one of encoding the content of the originated information, adding information to the electronic mail including the originated information and the deleting of information from the electronic mail including the originated information.

222. (Previously Presented) A computer program stored on a storage medium when executed by the interface switch as set forth in claim 221 causes the interface switch to perform:

the receiving of the originated information from the at least one originating processor; and  
the supplying of the originated information and an identification of the at least one of the plurality of destination processors to the RF information transmission network which thereafter broadcasts the originated information to the at least one of the plurality of destination processors.

223. (Previously Presented) A computer program in accordance with claim 222, wherein the originated information forms a part of electronic mail to be transmitted from the originating processor and the electronic mail is transmitted to the interface switch, and

wherein said computer program when executed by the interface switch further causes the interface switch to perform:

the deleting, after reception of the electronic mail by the interface switch, of the information from the electronic mail; and

the not transmitting of the deleted information by the RF information transmission network.

224. (Previously Presented) A computer program stored on a storage medium when executed by said gateway switch as set forth in claim 218, causes said gateway switch to perform:

the receiving of the originated information from the at least one originating processor; and

the causing of the originated information to be transmitted to the at least one of the plurality of destination processors via the interface switch and the RF information transmission network which thereafter broadcasts the originated information to the at least one of the plurality of destination processors.

225. (Previously Presented) A method in accordance with claim 210, wherein:

the deleting of information from the electronic mail includes deleting header information of the electronic mail.

226. (Previously Presented) A method in accordance with claim 221, wherein:

the deleting of information from the electronic mail includes deleting header information of the electronic mail.

227. (Previously Presented) A method in accordance with claim 32, wherein the interface switch couples a plurality of said electronic mail systems to one another such that electronic mail transmitted from an originating processor in one electronic mail system can be received by a destination processor in another of said electronic mail systems.

228. (Previously Presented) A method in accordance with claim 210, wherein the at least one of the plurality of destination processors processes said originated information of the electronic mail excluding the deleted information that was not transmitted by the RF information transmission network.

229. (Previously Presented) A method in accordance with claim 221, wherein the at least one of the plurality of destination processors processes said originated information of the electronic mail excluding the deleted information that was not transmitted by the RF information transmission network.

230. (Previously Presented) A method in accordance with claim 228, wherein:  
the deleting of information from the electronic mail includes deleting header information of the electronic mail.

231. (Previously Presented) A method in accordance with claim 229, wherein:  
the deleting of information from the electronic mail includes deleting header information of the electronic mail.

232. (Previously Presented) A system in accordance with claim 15, further comprising:

a communication system including said electronic mail system, having said originating processors, said destination processors, and the at least one gateway switch, and another

processor which is not included in said electronic mail system and which transmits information including originated information, wherein:

the at least one gateway switch transmits said originated information inputted to said electronic mail system to the at least one interface switch, and

said processor sends said information to the at least one of the plurality of destination processors using the RF information transmission network but not using the at least one gateway switch.

233. (Previously Presented) A method in accordance with claim 32, wherein said electronic mail system, having said originating processors, said destination processors, and said gateway switch, is provided in a communication system having said electronic mail system and another processor which is not included in said electronic mail system and which transmits information including originated information, wherein:

said gateway switch transmits said originated information inputted to said electronic mail system to said interface switch, and

said processor sends said information to the at least one of the plurality of destination processors using the RF information transmission network but not using said gateway switch.

## **REMARKS**

The Final Office Action dated February 24, 2006, has been received and carefully considered. Reconsideration of the outstanding rejections in the reexamination proceeding of U.S. Patent No. 5,436,960 (the '960 Patent) is respectfully requested based on the following remarks.

### **I. PENDING CLAIM REJECTIONS**

Claims 1-3, 5, 7-13, 15-20, 22, 24-30, 32-37, 39, 41-47, 49-54, 56, 58-64, 66-89, 183-193, and 195-233 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by a collection of documents referred to in the Office Action as MDN '89, but referred to herein as the ("Telenor documents")

Claims 1-2, 8-14, 16-19, 25-31, 33-36, 42-48, 50-53, 59-65, 67-76, 78-79, 81-89, 203 and 227 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by "PHASE, A Portable Host Access System Environment" Richard D. Verjinski, published October 18, 1989; IEEE pp. 0806-0809 ("Verjinski").

Claims 1-2, 8-19, 25-36, 42-53, 59-65, 67-75, 81-82, 85-89, 203 and 227 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Perkins (U.S. Patent No. 5,159,592) in view of Hortensius (US Patent No. 5,917,629).

Claims 7, 24, 41 and 58 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Perkins in view of Hortensius, in view of the Alleged Admission of Prior Art, and further in view of Quarterman ("Notable Computer Networks," Communications of the ACM, October 1986, Vo. 29, No. 10).

Claims 3, 5, 20, 22, 37, 39, 54, 56, 66, 76-77, 80, and 83-84 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Perkins in view of Hortensius, and further in view of the Alleged Admission of Prior Art.

Claims 7, 24, 41 and 58 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Verjinski in view of Quartermann.

Claims 3-6, 20-23, 37-40, 54-57 and 66 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Verjinski in view of Alleged Admissions of the Prior Art.

Claims 183-184 and 232 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Verjinski further in view of “The KA9Q Internet Software Package” by Bdale Garbee, May 8, 1989 (“Garbee”).

Claims 183-193, 195-202, 204-226 and 228-233 stand rejected under 35 USC §112, first paragraph as allegedly failing to comply with the written description requirement.

Claims 183-193, 195-202, 204-226 and 228-233 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

Claims 183-193, 195-202, 204-226 and 228-233 stand rejected under 35 USC §305 as allegedly enlarging the scope of the claims of the patent being reexamined.

Claims 203, 227, and 232-233 stand rejected under 35 USC §112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as their invention.

## **II. REMARKS**

### **A. Incorporation of Previous Arguments**

Patent Owner previously provided responses to Office Actions on July 19, 2005 and February 15, 2006 (“Previous Responses”) in connection with the above-referenced reexamination proceeding and the ‘960 Patent. The arguments and statements made in the Previous Responses are hereby incorporated herein by reference to avoid duplication. Accordingly, Patent Owner respectfully traverses the above rejections on the bases set forth in the Previous Responses.



## **B. Patent Owner's Statement of the Substance of the Interview**

Patent Owner traverses the pending claim rejections for the reasons provided in the Examiner Interview held on April 6, 2006, which are set forth below in Patent Owner's statement of the substance of the interview in response to the Patent Office's Ex Parte Reexamination Interview Summary dated April 6, 2006.

### **1. Summary Of Discussion With PTO Regarding 1.131 Affidavits.**

Patent Owner noted that the previous Office Actions in all of the cases had contained two separate objections of the Rule 1.131 affidavits submitted by Patent Owner: (1) a procedural objection as to "who" submitted the affidavits and (2) a substantive evaluation of the information disclosed and discussed in the affidavits.

Patent Owner had previously submitted responses to both types of objections. In response to objection #1 (the procedural objection), Patent Owner submitted an affidavit from the Patent Owner obviating the "who" rejection. In response to objection #2, Patent Owner submitted a lengthy, detailed rebuttal to the PTO's substantive evaluation of the evidence regarding a priority determination.

In the '960 Office Action dated 2/27/2006, the PTO dropped and apparently withdrew its analysis of the substance of the affidavits (#2 above). See page 100. Patent Owner interprets this as a withdrawal by the Office of this form of rejection and a concession that the Office has no response to the detailed rebuttal submitted in Patent Owner's previous responses.

As best Patent Owner can understand the PTO's position, the PTO is asserting that the Rule 1.131 affidavits are defective because not all of the inventors submitted them. Patent Owner believes this is a misreading of Rule 1.131 which states:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an

appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

The “or” language makes it clear that the three parties eligible to submit declarations are in the alternative. This language is disjunctive, not conjunctive. The PTO is apparently interpreting this rule as though the “or” were, instead, an “and.” Patent Owner believes this interpretation is incorrect.

Patent Owner has complied with this statute in multiple manners. First, the original Campana affidavit was from Mr. Campana in his capacity both as an inventor and as president of Patent Owner (i.e., “the owner of the patent under reexamination.”). Moreover, Patent Owner submitted an affidavit from its current president – also “the owner of the patent under reexamination.”

Patent Owner pressed for an explanation of this position and Patent Owner understood the PTO to state merely that it was comfortable with its present position as reflected in the Office Action (e.g., ‘960 Office Action, 2/27/2006 at p. 99). Patent Owner believes that the PTO’s current position is so vague as to raise Due Process concerns. Patent Owner believes that the PTO is obligated to provide rejections in sufficient detail both for Patent Owner to understand and for the Federal Circuit to meaningfully review. The Federal Circuit repeatedly has stated that the PTO is obligated to explain its reasoning both to provide the applicant with the opportunity to respond and for meaningful appellate review. *See, e.g., Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (the PTO is required to provide specific information “adequate to form a basis for [appellate] review.”); *In re Gartside*, 203 F.3d 1305 (Fed. Cir. 2000); *In re Sang-Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Since the PTO withdrew its substantive rejection and its procedural rejection is based upon a clear

misreading of the language of Rule 1.131, Patent Owner cannot understand what position the PTO is currently taking.

The PTO's present position also completely ignores that this very issue (invention priority against the Perkins reference) was exhaustively litigated in the NTP v. RIM litigation and trial. For example, in its Section 282 Notice, RIM specifically identified the Perkins reference as one of the "primary patent references on which RIM expects to rely in expert testimony and otherwise at trial." Campana gave extensive testimony establishing invention before Perkins priority date.

Finally, Patent Owner believes that the PTO's present unreasonable position is particularly egregious and wrong in light of the circumstances of the Campana affidavit. In February 2003, immediately after learning of Mr. Campana's serious illness, Patent Owner repeatedly contacted the PTO and requested that it expedite its consideration of Campana's affidavit in light of this illness. Patent Owner was repeatedly assured that Office Actions were expected imminently (e.g., March 2003). Had those assurances been accurate, Mr. Campana would have been able to submit a supplemental affidavit curing every single one of the present technical objections from the PTO. Instead, the PTO – without explanation – waited until after Mr. Campana's death to analyze his affidavit and adopt its present completely unreasonable interpretation. The PTO has yet to respond to this sequence of events as discussed in Patent Owner's responses filed in the '960 patent case.

## **2. Summary Of Discussion With PTO Regarding Telenor.**

Regarding the Telenor collection of asserted prior art documents ("Telenor"), Patent Owner focused the discussion on a small set of claims to demonstrate that, even under the PTO's

claim construction and interpretation of the references,<sup>1</sup> Telenor cannot be read to contain the claimed elements. The claims discussed were claims 1, 53, and 59 from the '472 patent and claims 1, 11, and 15 from the '960 patent. The discussions utilized a whiteboard drawing corresponding to the PTO's summary drawing of Telenor as shown on page 10 of the 2/24/2006 Office Action on the '960 patent.

a. '960 Patent.

Patent Owner presented an analysis of the treatment of claims 1, 11, and 15 of the '960 patent as reflected in the 2/27/2006 Office Action of that patent beginning on page 11. The Office Action contains at least 4 errors discussed in greater detail: (1) the Office Action interpreting all X.400-connected systems as one big "electronic mail system" is expressly contrary to the explicit language of the '960 specification, expressly contrary to the PTO's own evaluation of MHS in the '472 Office Action and unsupported by any citation to any reference for such an interpretation; (2) the Office Action reliance on an "auto forwarding" feature in the Telenor reference contradicts the explicit language of the claims; (3) the Office Action reliance upon an "MHS Equivalences" table from Volume 8, page 38 of the Telenor references is incorrect because that table only applies to alphabetical addresses – not the claimed numeric addresses; (4) the Office Action assertion that copying the same address from one location to another location meets the claim language contradicts both the plain and ordinary meaning of "add" as well as the explicit description in the specification regarding "adding."

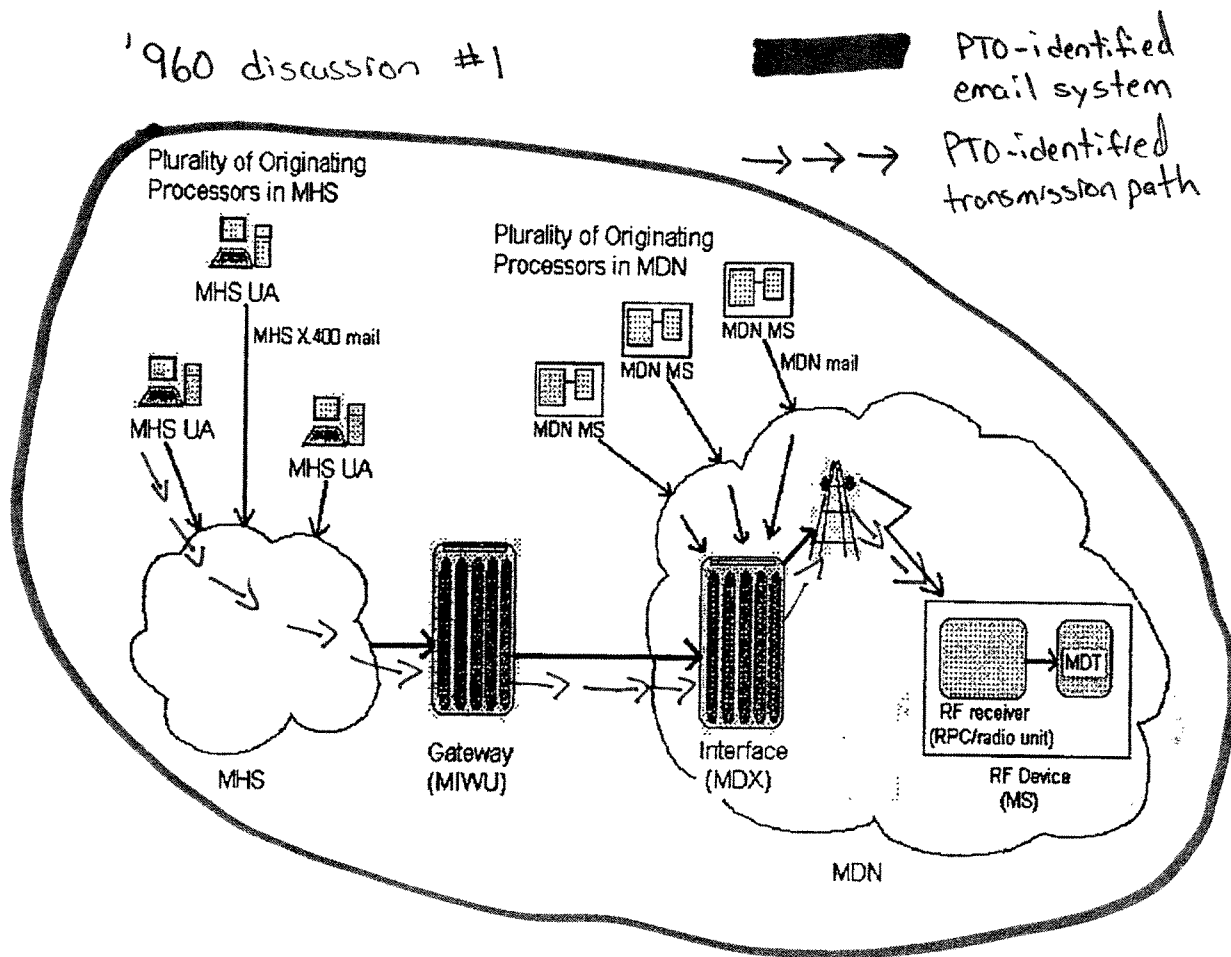
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<sup>1</sup> For the record, NTP does not concede that any of the PTO's analysis is correct. This includes, but is not limited to, the Office Action's discussion of claim construction and interpretation of the references. Additionally, NTP did not, and does not, concede that the PTO's identification or correlation of claimed elements to components in any of the Office Actions is correct. The purpose of this discussion was to demonstrate that certain claim rejections were improper even if the PTO's identification or correlation were accepted.

(i) **X.400-connected systems are not one giant electronic mail system.**

Construing all X.400-connected systems as one large email system contradicts both the express language of the specification and the PTO's own interpretation of the reference in the '472 Office Action.

Claims 1, 11 and 15 all recite the existence of a gateway which the Office Action asserts is the MIWU in the following drawing:



Furthermore, claims 1, 11 and 15 all require the email to be transmitted wirelessly after passing through the gateway. Thus, the only transmission path identified by the Office Action

that (1) goes through the MIWU/gateway and (2) is then transmitted wirelessly is shown in the dotted line starting in one of the MHS systems and ending in the MDN.

However, claims (1, 11, and 15) all require that the email originating processor and destination processor be in the same electronic mail system. The claim language is very explicit:

1. ... transmitting originated information from one of a plurality of originating processors in an electronic mail system to at least one of a plurality of destination processors in the electronic mail system ...

To meet this limitation, the '960 Office Action contradicts both the specification and the PTO's own interpretation of the Telenor references in the '472 Office Action (see below) to assert that all X.400 systems are one large email system. This is flatly wrong.

Specification: The '960 specification expressly states

However, a problem arises that users of one electronic mail system currently cannot send electronic mail to a subscriber of another electronic mail system (e.g., AT&T E-mail to Sprint Mail, etc.). Numerous attempts are currently underway in the industry to solve this problem. Current attempts are the **utilization of common protocols between electronic mail systems** (e.g. X.400).

'960 patent, column 3, lines 42-48. This passage clearly states that X.400 connects different email systems and forecloses the Office Action interpretation that all X.400-connected systems are one giant email system.

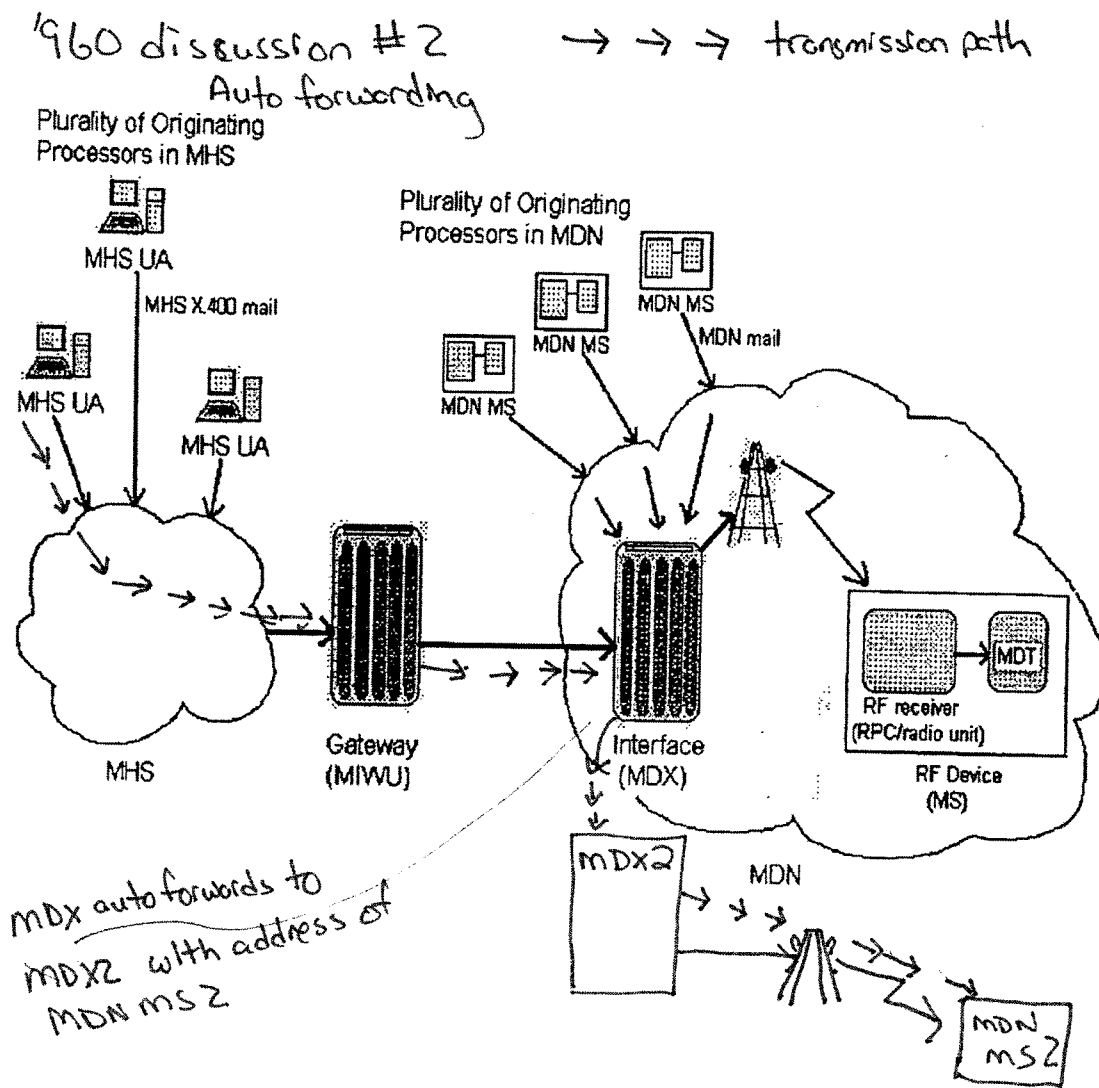
'472 Office Action. Additionally, the PTO took a diametrically opposed interpretation of the exact same reference in the '472 Office Action (see below). In that action, the PTO interpreted X.400 MHS systems as all being different email systems connected by X.400 – an interpretation more in accord with the specification description of X.400.

No Citation To Supporting Reference. The '960 Office Action cites to no supporting documentation or reference for the concept that disparate systems merely connected by a common protocol become the same electronic mail system.

Patent Owner respectfully submitted that it is not reasonable to utilize an interpretation that is contrary to the specification, contrary to the PTO's evaluation of the same reference in a companion case and is completely unsupported by any citation to any reference.

(ii) **The Autoforward citation in the '960 Office Action contradicts the claim language.**

On page 13 of the '960 Office Action, the Office relies upon citation to an auto forward feature allegedly in the Telenor reference. As was discussed, the Office usage of the auto forward feature requires the following path (in dotted line)



This is the only path that meets the claim requirements of (a) transiting through the asserted gateway (MIWU) and (b) wireless transmission after the gateway. According to the PTO, the MDX is the claimed “interface” and it adds the forwarding address of the mobile station (MS) (different from the initial destination processor address) that eventually receives the electronic mail.

However, this interpretation expressly violates the explicit limitation in claim 11 that the address sent from the interface be the same as the address added at the gateway. The following claim language demonstrates the flaw in the Office usage of the auto forward:

1. A system for transmitting...

the originated information is transmitted to the one interface switch by the one gateway switch in response to an address of the one interface switch added to the originated information at the one of the plurality of originating processors or by the electronic mail system and the originated information is **transmitted from the one interface switch** to the RF information transmission network with an address of the at least one of **the plurality of destination processors to receive the originated information** added at the originating processor, or by either the electronic mail system or the one interface switch;  
...

(CLAIM 11) the address of the at least one of the plurality of destination processors is an identification number of the at least one RF receiver receiving the originated information and transferring the originated information to the at least one of the plurality of destination processors and **is added to the originated information by the one gateway switch**.

Thus, for claim 11, the address of the ultimate recipient destination processor **must** be added at the gateway. In the PTO’s auto forward scenario, the address, at best, is added/changed by the interface – as per the explicit words of the Office Action on page 13 that state “the interface switch (MDX) adds the address of the destination processor...”.



**(iii) The Cited MHS Equivalence Table does not map numeric addresses as required by the claim language.**

Claim 11 (as cited above) requires that the address of the destination processor be a “number” and be added by the gateway switch. To meet this limitation, the ‘960 Office Action (at page 16) cites an MHS Equivalence Table located in volume 8 at page 24 of the Telenor references.

This is a fundamental misreading of the reference. The MHS Equivalence Table is only used to replace Norwegian alphabetical characters with English alphabetical characters. By definition, if the MHS Equivalence Table is used at all, the address cannot be a “number” as required by the claim because this Table is not, and cannot, be utilized for numeric addresses since there is no substitution of characters for numeric addresses.

**(iv) “Add” as per claims 11 and 15 does not correlate with merely copying the same data to multiple locations.**

Claims 11 and 15 require the gateway to “add” the address of the recipient destination processor. Patent Owner and the Examiner’s discussed whether such “adding” occurs if the MIWU copies the address it receives in an MHS packet into a separate MDN packet. Clearly, such copying of the same address does not constitute “adding” in the plain and ordinary meaning and the Office Action cites no reference that would so interpret the verb “add.”

More importantly, the specification expressly forecloses any such interpretation of “add” to mean simply “copy.” In column 28 starting at line 10 through line 62, the specification discusses the various addressing methodologies with reference to Figure 11. This passage never utilizes the verb “add” to mean copy – it always means the inclusion of other data.

Claim 15, in particular, forecloses such an interpretation of “add.” Claim 15 requires

the identification number is **added** to the originated information **by matching** an identification of the at least one of the plurality of destination processors with a stored identification of the at least one of the plurality of destination processors and **adding** an

**identification number** stored with the matched identification of the at least one of the plurality of destination processors to the originated information as the identification number.

With the simply “copying” of addresses at the MIWU, there is no “matching” that results in “adding.” In particular, there is no “identification number” that is “added” as a result of the “matching” in a copying situation.

b. ‘472 Patent.

Patent Owner presented an analysis of the treatment of claims 1, 53, and 59 of the ‘472 patent as reflected in the 11/30/2005 Office Action of that patent beginning on page 44. The language of claim 1 requires (in summarized form):

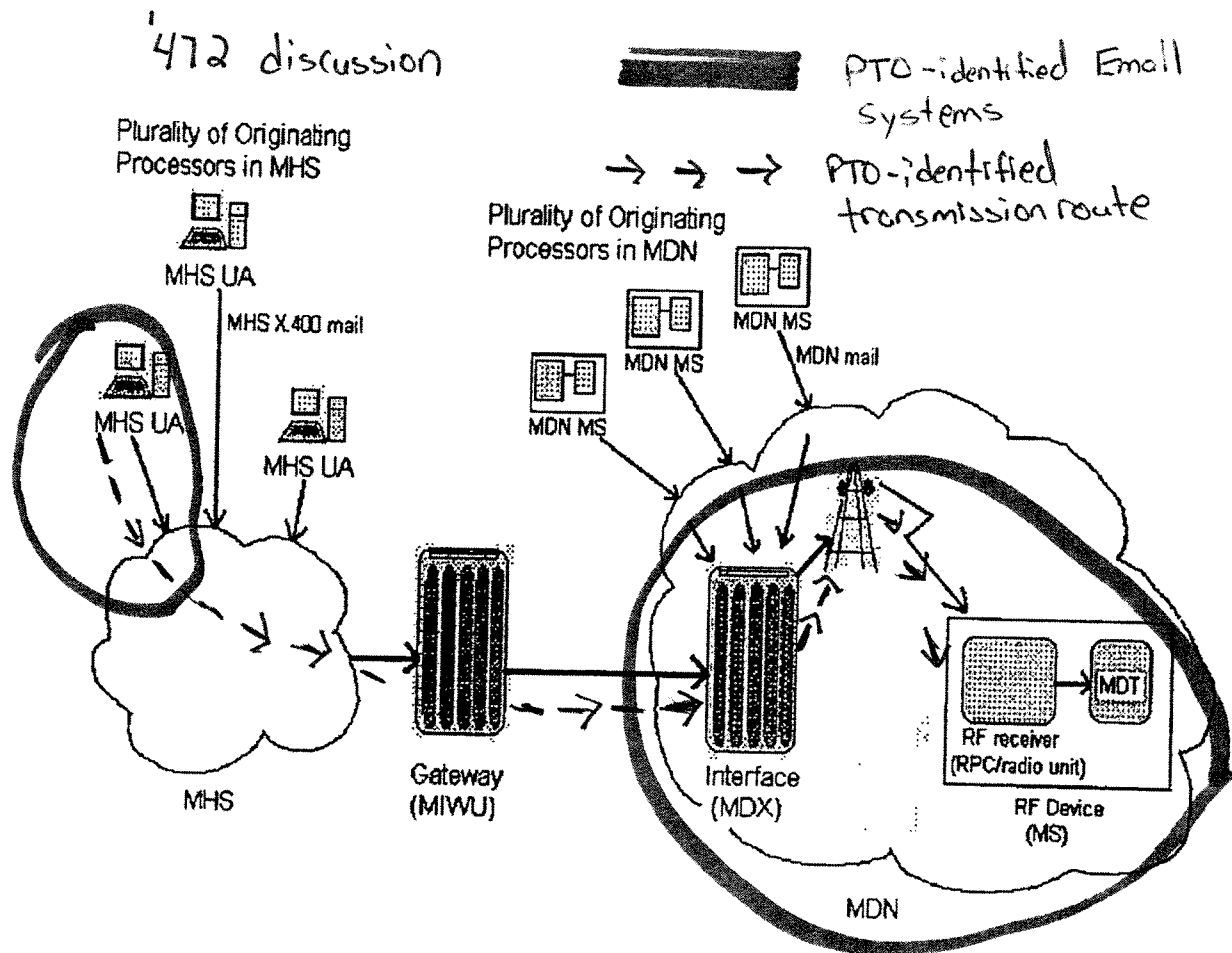
- a) “plurality of electronic mail systems”
- b) the originating processor is in “one of the electronic mail systems” (EMS “A”)
- c) destination processor is “in another [different] of the electronic mail systems” (e.g., EMS “B”)
- d) RF system must transfer the email to the destination processor in EMS “B.”

The 11/30/2005 Office Action identifies a number of different emails systems on page 44:

“The MHS includes plural email systems with interconnection via X.400” (Second paragraph).

“Each MDX is an email system” (Third paragraph).

These email systems were circled as follows (with the heavy lines)



Because of the requirement (d) above that the claimed destination processor receive information through the RF system, the claimed EMS “B” must be one of the MDX-related PTO-identified electronic mail systems (e.g., lower right of the drawing).

**Claim 53** depends upon claim 1 and requires “the one of the electronic mail systems comprises at least one gateway switch.”

The 11/30/05 Office Action identifies the MIWU as the claimed gateway. Because the MIWU is identified as the gateway and therefore must be in the transmission path of the email message, the transmitted email message must flow from one of the MHS-identified email systems through the MIWU to the MDX-identified email system. See the dotted transmission line.

Claim 53 requires the gateway to be in sender's email system with the language "the one of the electronic mail systems." Thus, under the PTO's interpretation, the MIWU would be required to be in the sender's email system in the MHS.

Patent Owner submits that under no reasonable construction can the MIWU be interpreted to be a gateway in any of the MHS-identified email systems. Simply put, no relationship whatsoever exists between the MIWU and the MHS-identified email systems.

**Claim 59** of the '472 patent is similar to claim 1, but states that "the another of the electronic mail systems comprises at least one gateway switch." The "another of the electronic mail systems" language requires that the gateway be in the recipient's email system.

The '472 Office Action, on page 49, states that the MIWU is the gateway and that because the "message goes through the MIWU" causes it to be part of the recipient's email system. This logic is incorrect.

A transmission node does not become "in an electronic mail system" merely because a message transits a node. Under the Office's interpretation, every MTA in an MHS system therefore is "in the electronic mail system" of every other possible mail system in the MHS. Such a construction is clearly contrary to MHS principles and to any reasonable interpretation of the art.

### **3. Summary of Discussion with PTO Regarding Verjinski**

Patent Owner respectfully submits that in contrast to the positions taken by the PTO in the numerous office actions presented in the above and other reexamination proceedings, Verjinski does not teach or suggest any feature or functionality where the *address* of the PHAC is added to electronic mail, originated information, or even otherwise referred to. In fact, Patent Owner respectfully submits that the only addressing functionality disclosed by Verjinski relates to the portable PC, not the PHAC.

As disclosed in Verjinski, the PHAC is used to enable a portable host to gain access to the Internet and to assign the portable host a temporary IP address. There is no disclosure in Verjinski of any addressing relating to the PHAC. For example, Figure 4 of Verjinski clearly illustrates that session functionality is limited to the addressing of portable PC's, not the PHAC. In step 1, the PC (portable host) connects to the PHAC, which proceeds to assign the PC a dynamically allocated IP address. At step 2, the PC periodically sends its name and temporary IP address to the Dynamic Domain Name Server. At step 3, a remote SMTP client queries the Dynamic Domain Name Server and receives the PC's temporary IP address. At step 4, the remote SMTP client communicates with the PC's SMTP server, the message is delivered, and the connection is closed. At step 5, the PC disconnects from the network causing Dynamic Domain Name Server to age its entry for the PC. At step 6, another remote SMTP client tries to query the DDNS for the PC's IP address without success. Patent Owner respectfully submits that -- as evidenced by the disclosure of Figure 4 -- Verjinski does not disclose any feature or functionality where addressing of the PHAC is involved.

### **C. New Arguments Traversing the Rejections**

#### **1. New Rejections in Final Office Action**

Claims 183-184 and 232 of the '960 patent now stand rejected as allegedly being unpatentable under over Verjinski in view of "The KA9Q Internet Software Package" Bdale Garbee, May 8, 1989 ("Garbee"). Patent Owner respectfully traverses this rejection and submits the Second Supplemental Declaration of Dr. V. Thomas Rhyne Under 37 C.F.R. § 1.132 ("Second Supplemental Rhyne Declaration") in support of this response. For purposes of 37 C.F.R. §1.116(e), Applicant respectfully submits the Second Supplemental Rhyne Declaration is necessary to fully rebut this rejection which was not previously made.

Patent Owner respectfully submits that the proposed combination of Verjinski in view of Garbee fails to render dependent claims 183-184 and 232 obvious for the following reasons:

a. Garbee is in a Different Field of Endeavor

Patent Owner submits that Garbee generally relates to communications involving file transfer protocol (FTP) – not electronic mail system components. Accordingly, it is not in the same field of endeavor as the Campana patents. *See* Second Supplemental Rhyne Declaration, ¶12.

b. Garbee and Verjinski are not properly combined

Patent Owner submits that one of ordinary skill in the art would not have been motivated to modify Verjinski with Garbee as apparently being alleged in the Office Action. There is no teaching or suggestion in either of Garbee or Verjinski that use of Garbee would cure any of the deficiencies of Verjinski. For example, Verjinski does not have an interface coupled to a gateway switch and an RF transmission network as recited in the claims. Adding the disclosure of Garbee would not cure the above noted deficiencies of Verjinski. *See* Second Supplemental Rhyne Declaration, ¶13.

Moreover, Garbee does not disclose an “interface switch” as that term has been defined. Since Garbee does not disclose the “interface switch” it follows that Garbee does not disclose any type of information that is received by the “interface switch,” and which is then transmitted through an RF information transmission network as recited in the claims. Thus, Garbee fails to cure these deficiencies of Verjinski. Any combination of Garbee with Verjinski would thus fail to provide an interface switch “connecting at least one of the at least one gateway switch to the RF information transmission network” as required by Claims 183, 184 and 232. *See* Second Supplemental Rhyne Declaration, ¶14.

- c. Garbee fails to disclose or suggest the limitation of Claim 183 and 184 requiring “a processor which is not included in said electronic mail system and which transmits further other information being information other than electronic mail including originated information,” and the limitation of Claim 232 requiring “another processor which is not included in said electronic mail system and which transmits information including originated information.”

Patent Owner respectfully submits that Garbee does not teach or suggest “a [another] processor” that, as required by Claim 183, 184 and 232 is not included in said electronic mail system and which transmits further other information being information other than electronic mail including originated information, wherein . . . said processor sends said further other information to the at least one of the plurality of destination processors using the RF information transmission network but not using the at least one gateway switch. *See* Second Supplemental Rhyne Declaration, ¶15.

In particular, there is no teaching or suggestion in Garbee of “further other information” being sent to the “at least one of the plurality of destination processors using the RF information transmission network but not using the at least one gateway switch” as recited in the claims. In fact, Garbee makes no mention of transmitting information to a plurality of destination processors using the RF information transmission network, as defined by Judge Spencer and the CAFC. *See* Second Supplemental Rhyne Declaration, ¶16.

Accordingly, Patent Owner submits that Garbee does not therefore teach or suggest “a (or another) processor which is not included in said electronic mail system and which transmits further other information being information other than electronic mail including originated information, wherein . . . said processor sends said further other information to the at least one of the plurality of destination processors using the RF information transmission network but not using the at least one gateway switch,” as expressly required by Claims 183, 184 and 232. *See* Second Supplemental Rhyne Declaration, ¶17.

Claims 203 and 227 have now been rejected under 35 U.S.C. §102(b) as being anticipated by Verjinski. Patent Owner respectfully traverses this rejection.

Claims 203 and 227 require that “the interface switch couples a plurality of said electronic mail systems to one another such that electronic mail transmitted from an originating processor in one electronic mail system can be received by a destination processor in another of said electronic mail systems.” The Office Action alleges that the PHAC couples Internet hosts to the portable PC host processors, which connect to the PHAC via dialup connection or through the Internet connection to the PHAC. The Office Action further alleges the Internet includes connection to many networks with many email services interconnected to the Internet. As such, the Office alleges that the PHAC couples a plurality of email services to each other by enabling a PHAC connected processor identified in one email service by unique domain name to receive email from a processor sending email using another email service and identified via different domain name. Patent Owner respectfully disagree with those statements; Verjinski does not teach or suggest *any* feature or functionality where a PHAC couples a plurality of said “electronic mail systems” to one another such that electronic mail transmitted from an “originating processor” in one electronic mail system can be received by a destination processor in another of said electronic mail systems, as those terms have been defined by Judge Spencer and the CAFC. *See* Second Supplemental Rhyne Declaration, ¶9.

Further, there is no disclosure in Verjinski that a PHAC connected processor identified in one email service by unique domain name is able to receive email from a processor sending email using another email service and identified via different domain name. *See* Second Supplemental Rhyne Declaration, ¶10.



Claims 203 and 227 have now been rejected under 35 U.S.C. §103(a) as being anticipated by Perkins in view of Hortensius (U.S. Patent No. 5,159,592). Patent Owner respectfully traverses this rejection.

Claims 203 and 227 require that “the interface switch couples a plurality of said electronic mail systems to one another such that electronic mail transmitted from an originating processor in one electronic mail system can be received by a destination processor in another of said electronic mail systems.” The Office Action alleges Perkins teaches an email system comprising LANs 2 and 3 which enable the transmitting of email between MU (processors) connected to HS and local gateways (interface). The Office Action also alleges that Perkins also provides connection or remote users in other subnetworks comprised of similar interconnected LANs, and thus other email systems. The Office Action alleges that email sent from such a remote subnetwork (remote user) in another email system is coupled to the LAN 2 via local gateway, such that email sent from a remote user (one email system) can be received by a destination processor in another email system. As such, the Office Action alleges, other email systems are coupled together via the local gateway. Patent Owner respectfully disagrees with those statements; Perkins does not teach or suggest *any* embodiment where a local gateway is shown coupling a plurality of “electronic mail systems,” as that term has been defined by Judge Spencer and the CAFC. *See* Second Supplemental Rhyne Declaration, ¶22.

Further, there is no disclosure in Perkins that a remote user in a subnetwork comprises an email system and that a remote user in another subnetwork comprises another email system. *See* Second Supplemental Rhyne Declaration, ¶23.

## **2. Authenticity of the Telenor Documents**

Patent Owner respectfully traverses the above rejections based on the Telenor documents on the grounds that the eight documents from the Norwegian Telecommunications

Administration (collectively, the “Telenor documents”) have been altered and manipulated since they were originally catalogued in the Norwegian library, and thus the Telenor documents, particularly their content, cannot be considered to have been “publicly accessible” in 1989 or at any time prior to the Campana invention. Patent Owner submits the Declaration of David Richard Browne under 37 CFR §1.132 (“Brown Declaration”) in support of this assertion. Patent Owner retained Mr. Browne, a forensics expert, to examine the documents and opine on their authenticity, particularly whether any of them had been altered or manipulated since their alleged original 1989 production in the Norwegian library.

For purposes of 37 CFR §1.116(e), Patent Owner respectfully submits that Mr. Browne’s declaration is necessary to further demonstrate that the Telenor documents are not prior art to the claims of the patent being reexamined. Moreover, Patent Owner has not previously submitted evidence challenging the authenticity of the Telenor documents because, as explained below, Patent Owner has only recently obtained the original Telenor documents from the Norwegian library, and thus had not been able to conduct a thorough and complete investigation. During the April 6<sup>th</sup>, 2006 Examiner interview, Patent Owner informed the Patent Office that it would present such evidence at a future date. Patent Owner also submits the following declarations to demonstrate chain of custody of the Telenor documents between the time when they were obtained from the Norwegian library and given to Mr. Browne for analysis:

- Declaration of David L. Gunn under 37 CFR §1.132 (“Gunn Declaration”)
- Declaration of Thomas Kaufman under 37 CFR §1.132 (“Kaufman Declaration”)
- Declaration of James Brown under 37 CFR §1.132 (“Brown Declaration”)
- Declaration of Peter Sadler under 37 CFR §1.132 (“Sadler Declaration”)

- Declaration of Kevin Anderson Relating To The Telenor Documents under 37 CFR §1.132 (“Anderson Telenor Declaration”).

The Telenor documents were first received by Patent Owner on June 30, 2005 from Research In Motion, Inc.’s counsel. On or about September 29, 2005, Patent Owner NTP, Inc. submitted via an Information Disclosure Statement (IDS) copies of the Telenor documents for consideration by the U.S. Patent and Trademark Office in the above-captioned reexamination proceeding.

However, the copies of the Telenor documents that were submitted were not obtained from the original by Patent Owner. Rather, Patent Owner provided copies of documents purported by Research in Motion to be copies of the original Telenor documents retrieved from the Norges teknisk-naturvitenskapelige universitet (NTNU) library in Trondheim, Norway. Because the originals from the NTNU library of the Telenor documents were unavailable since the time RIM first delivered these documents to Patent Owner, Patent Owner had been unable to verify the authenticity of these documents. Accordingly, Patent Owner reserved the right to challenge the authenticity of these copies at a later time if the originals are ever returned, and the right to challenge any position taken by the Patent Office that these documents qualify as printed publications based on its ongoing investigation into those issues.

Shortly after June 30, 2005, counsel for Patent Owner, Kevin Anderson, Esq., attempted to investigate the Telenor documents in his capacity as one of Patent Owner’s attorneys in the *NTP v. Research in Motion litigation*. See Anderson Telenor Declaration, ¶2.

As part of this investigation, Mr. Anderson inquired about the authenticity of the Telenor documents. The NTNU library indicated that the documents were checked out and that Mr. Anderson could put his name on the list but that he would not be at the top of the list requesting

these documents. Mr. Anderson was informed that Norwegian law forbids the disclosure of check-out information. *See* Anderson Telenor Declaration, ¶3.

On August 18, 2005, Mr. Anderson traveled to Trondheim and went to the NTNU library. Mr. Anderson was advised that the alleged documents were checked out and that there was a list of parties waiting to check the alleged documents out. Additionally, Mr. Anderson was advised that the library could attempt to “recall” the alleged documents but that there was no means of enforcing such a recall. Mr. Anderson was also informed that the typical check-out time was three months. *See* Anderson Telenor Declaration, ¶4.

During his visit to the NTNU library, Mr. Anderson was also advised that the library has no mechanism for verifying that a document, such as the alleged Telenor documents, was returned to the library with the same condition and contents as existed for the document when it was checked out. Mr. Anderson was also advised that the library cannot verify whether the documents have the same content as when originally deposited. *See* Anderson Telenor Declaration, ¶5.

On February 7, 2006, counsel for Patent Owner obtained the original Telenor documents from the NTNU library. *See* Gunn Declaration. Mr. Gunn gave the documents to counsel for Patent Owner, Thomas Kaufman, Esq., who in turn overnighted the original Telenor documents to James Brown, a solicitor in counsel for Patent Owner’s London office. Mr. Brown then instructed his paralegal, Peter Sadler, to hand-deliver the original Telenor documents to Mr. David Richard Brown, Patent Owner’s forensic expert, for analysis. *See* the Gunn, Kaufman, Brown and Sadler declarations. Patent Owner submits that throughout the chain of custody, the original Telenor documents were not altered or manipulated by either Mr. Gunn, Mr. Kaufman, Mr. Brown, or Mr. Sadler. *Id.*

On March 2, 2006, Mr. Browne, Patent Owner's forensics expert, took possession of the original Telenor documents, which comprise the following:

1. NTA report 30/86 dated April 86 stamped 23/5/86
2. Teledirektoratets Forskningsavdeling - TF-report 3/89 - Volume 1 - 22/2/89
3. Teledirektoratets Forskningsavdeling - TF-report 4/89 - Volume 2 - 22/2/89
4. Teledirektoratets Forskningsavdeling - TF-report 5/89 - Volume 3 - 24/4/89
5. Teledirektoratets Forskningsavdeling - TF-report 6/89 - Volume 4 - 22/2/89
6. Teledirektoratets Forskningsavdeling - TF-report 7/89 - Volume 6 - 22/2/89
7. Teledirektoratets Forskningsavdeling - TF-report 8/89 - Volume 8 - 24/4/89
8. Teledirektoratets Forskningsavdeling - TF-report 9/89 - Volume 7 - 24/4/89

*See Browne Declaration, ¶8.*

Mr. Browne's analysis led to the following statements, findings and conclusions, all of which are contained in Mr. Browne's report which is attached as Exhibit 2 to the Browne Declaration:

The above documents are all in booklet form. The first is stapled with three staples down the left margin and has a clear plastic front cover. Documents 2 to 8 are 'Perfect bound' booklets down the left edge between card covers and with a cloth strip around the edge. *See Browne Declaration, ¶9.*

Mr. Browne was instructed that all the documents allegedly describe a Mobile Data Network from the mid to late 1980s. Mr. Browne was also instructed that all of the documents were lodged in the library of the Trondheim University in Norway. The documents came to Mr. Browne, via Hunton & Williams, from that library. The dates at the end of each line in the above list are in European convention (i.e., day/month/year) and relate to the date on a rubber stamp on the front of each document. They purport to be the dates each document was lodged in the library. *See Browne Declaration, ¶10.*

Mr. Browne was asked to examine the documents to see if there is any evidence that the contents of the documents may have been manipulated in any way - particularly since their

original production. Given his educational training and professional experience, Mr. Browne was fully qualified to conduct an analysis and opine on this matter. *See Browne Declaration, ¶11.*

Mr. Browne examined the documents using various specialized lighting conditions. Ultra Violet light (UV) was used to detect any chemical changes to the paper. The background reaction by paper to UV varies from batch to batch and therefore UV can also be useful to identify different papers. This is particularly helpful if any chemical ink eradicators had been used on a document. Infrared light (IR) can be used to separate one ink from another. IR is absorbed at differing rates by different inks and these differences can be observed. High Intensity Blue Green light (BG) can be used to excite inks so that a luminescent reaction is caused in the infrared part of the spectrum. This luminescent reaction varies from ink to ink. *See Browne Declaration, ¶12.*

Document 1 has been bound into a blue card cover that covers the whole of the back but only the first inch, from the left edge, of the front - folded round from the back. A clear plastic sheet has been inserted at the front as a front cover and the whole booklet has been fastened together with three staples, approximately half an inch in from the left edge. *See Browne Declaration, ¶13.*

There are three pairs of holes slightly to the left of the staples in place. These are also visible at the back. These holes are commensurate with three staples having been present and having been removed. *See Browne Declaration, ¶14.*

In order to properly establish what has happened to the document, Mr. Browne removed the staples from the book to release the pages. Each staple has been preserved so it can be examined in the future. *See Browne Declaration, ¶15.*

Mr. Browne examined all the pages in the booklet. He noted that it has been produced in chapters. Behind a number of the chapters, there are illustrations and charts. Mr. Browne noted that the charts/illustration appear to have been printed on slightly different paper and using different printers from the rest of the Document. *See Browne Declaration, ¶16.*

Microscopic examination showed that, while it was possible to match the recently vacated staple holes, there was a slight disparity between the original holes in chapter 6 and those in chapter 7 and subsequent chapters. *See Browne Declaration, ¶17*

Mr. Browne noted there were slight abrasions on the paper within the pair of old staple holes at the top of page 7-1. Similar scratches can be seen within the pair of old staples holes at the bottom. *See Exhibit 3 to Browne Declaration.* These marks are clear signs that an implement was used to remove staples from the page/s. *See Browne Declaration, ¶18*

When staples are forced through a document or set of pages, the machine curls the tines (prongs) back towards the pages from the back. The ends of the tines often make marks in the back page and sometimes these marks can be seen several pages from the back. At the front of the stapled pages, the solid bar makes a marked dent in the paper between the holes. This dent can also be seen several pages down from the front. *See Browne Declaration, ¶19.*

There is no evidence of a dent in page 7-1. This indicates that it was not the top page of the stapled document, nor very close to the top. However, the scratch marks show that, at the time the staples were removed, page 7-1 was at the top. The most likely explanation for this is that pages were removed from the stapled booklet one at a time from the front. Only when 7-1 was reached was the decision made, that the staples should be removed properly. *See Browne Declaration, ¶20.*

The fact that Mr. Browne could not match exactly the old staples holes from chapter 6 and before with those in 7-1 indicates that they may not have been stapled together. *See Browne Declaration, ¶21.*

Mr. Browne considers these findings are strong evidence that the two sets of documents were once part of different booklets. It is possible that the back of one booklet (7-1 and after) was put behind the front of another booklet (chapters 1-6). The whole was then stapled together within the cover. *See Browne Declaration, ¶22.*

Mr. Browne noted from the tine-marks at the back that a different stapler was used the second time. The first stapler curled the tines back straight between the holes. The second stapler curled the tines to one side of the line of the staple. *See Browne Declaration, ¶23.*

Mr. Browne could find no evidence of the date of any part of the document, which would indicate when it may have been produced. It is not possible to state when the documents were dismantled and reassembled. *See Browne Declaration, ¶24.*

The other documents all purport to have been made in 1989. All have been produced in the form of bound books. They have all been 'Perfect' bound. This means that the pages have been bound together along one edge. The pages are bound by applying heated glue down one edge. This glued edge is normally protected by covering the spine with a layer of paper from one cover or a cloth strip. No stitching is used and no page surface is lost. In this case the pages are bound down the left edge. *See Browne Declaration, ¶25.*

The advantages of this system of binding are that it tends to be quick and cheap and can be performed by relatively inexperienced people. It is also relatively easy to melt the glue to change pages without any visible signs. The main disadvantage is that pages can fall out by



accident because the strength of the binding is limited by the amount of glue used. *See Browne Declaration, ¶26.*

Mr. Browne examined all the books under UV light. Mr. Browne noted that a number of the pages within each book were from different batches of paper. Mr. Browne could not find any reason for this - unlike in document 1 where different paper was used for the diagrams, which were also printed on different printers. *See Browne Declaration, ¶27.*

Mr. Browne noted that the following pages differed from the rest in 3/89, Volume 1. The TF front page, pages 3, 11, 19, 35 and 43. *See Browne Declaration, ¶28.*

All of the pages have been printed using dry-powder printing techniques, such as are used for laser printers or photocopiers. Modern dry-powder printers work by laser beams charging precise positions on a photoreceptive drum. Dry powder is attracted to only those places before being transferred to the paper where it is melted in position. Extraneous marks on the drum also attract powder and extra marks will be printed on the document. These marks are known as "Trash-marks". Printer drums differ in size from a small drum that rotates several times per printed page to the large drum that rotates only once per page. A trash-mark on the former will be repeated a number of times up the page while the latter will produce the mark once per page. *See Browne Declaration, ¶29.*

The need to place a document on a glass plate of a photocopier makes those machines prone to trash-marks. Any speck of dust, correcting fluid or ink on the glass will be copied as a black mark onto the document. This is the most common cause of trash-marks. The marks occur on every document copied and in the same relative position. *See Browne Declaration, ¶30.*

Mr. Browne considers that all of the pages have been photocopied. *See Browne Declaration, ¶31.*

Mr. Browne notes that the top line on each page of 3/89, Volume 1, i.e. the line starting “Volume 1:” and ending with the page number is poorly printed and formed. *See* Exhibit 4 of Browne Declaration. The disparity between this header on each page and the rest of the text indicates that the contents of the page have been copied onto paper on which a copy of the header already exists. This indicates that the original text on the page has been replaced in each case. *See* Browne Declaration, ¶32.

4/89, Volume 2, has also been photocopied. The header line throughout was produced at a different time from the rest each page, which has been copied onto it. Mr. Browne notes that the page numbering changed for the annex, i.e. after page 107. The numbers move from the outside of each page to the inside. Mr. Browne noted no different UV reaction with any of the pages in this book. However, the overall UV reaction is the same as the bulk of the pages in 3/89. *See* Browne Declaration, ¶33.

With 5/89, Volume 3, Mr. Browne notes that there is no difference between the content of each page and its header. The whole document has been photocopied. Mr. Browne notes the following pages have different UV reactions: 13, 21, 29, 37, 45, 53, 61, 69, 77, 85, 89, 97, 105, 113 and 129. Mr. Browne notes that there is a trash mark approximately 4” down from the top near the right margin. *See* Exhibit 5 of Browne Declaration. This mark can be seen on each page. This indicates that the whole document was copied while the photocopier was producing that mark. The bulk of the paper has the same UV reaction as the bulk of the paper used for documents 4 & 4/89. *See* Browne Declaration, ¶34.

According to the TF front sheet, it was purportedly produced on the same date - 6/2/89 - as the other two documents. They do not have the same trash mark. *See* Browne Declaration, ¶35.

Mr. Browne cannot explain how three documents, allegedly produced on the same date, using the same paper and all by photocopier, do not produce the same trash marks. *See Browne Declaration, ¶36.*

Document 6/89, Volume 4, has the same faults in the header as 3/89, Volume 1 & 4/89, Volume 2. I note that the following pages appear to have been made on different paper. Preface, 3, 11, 19, 27, 35, 43, 61 and 93. The bulk of the paper is the same as the previous 3 books. The trash marks seen in 5/89, Volume 3 are not in this document, even though it was purportedly produced on the same date 6/2/89. *See Browne Declaration, ¶37.*

Document 7/89, Volume 6, apparently has been purportedly produced at one time. This means that the header and the page contents are commensurate with each other. The following pages have been produced on different paper. Contents I, 3, 11, 19, 27, and 35. The bulk of the paper is the same as for the other books. It was purportedly produced on 6/2/89 but has none of the trash marks mentioned above. *See Browne Declaration, ¶38.*

Document 8/89, Volume 8, was also produced on 6/2/89. It does not have the trash marks seen in 5/89, Volume 3. It does have the same problems with the header throughout, in that the contents of each page were copied onto a page already bearing the header. Pages up to page 14 are loose, having become detached from the binding strip. Mr. Browne notes that the pages from page 83 to the end are produced on similar paper was used for the bulk of the previous books - 3/89, Volume 1 to 7/89, Volume 6. However the first pages, i.e. up to page 82 are significantly lighter under UV. *See Exhibit 6 of Browne Declaration - comparing pages 82 with 83.* The difference between the papers can also be seen in normal lighting. This book has clearly been produced on two separate papers and probably at different times. *See Browne Declaration, ¶39.*

Document 9/89, Volume 7, has the same header problems mentioned above. The whole document has been produced on the lighter paper used for the first half of 8/89, Volume 8. This document was purportedly produced on 15/2/89. Exhibit 7 shows the comparison of pages 14 of 9/89, Volume 7 with 3/89, Volume 1. *See Browne Declaration, ¶40.*

What is difficult to explain is why the first half of book 8/89, Volume 8, is on paper that is the same as that used for the next book in the series (produced some days later) while the second half uses the same paper as the previous 5 books. It should also be borne in mind that the TF sheet giving the date of production, is produced on paper that was purportedly used on 15/2/89 - even though the date shown is 6/2/89, the same as the previous books. *See Browne Declaration, ¶41.*

All of the books have been endorsed with a rubber library stamp showing the date the books were filed/lodged. Mr. Browne considers the same basic stamp was used for all the 89 books. A different stamp was used for the 1986 book. The stamps all have a moveable date band and it will be the work of a few seconds to wind dates backwards or forwards. *See Browne Declaration, ¶42.*

It should be noted that, without reference to the stamps used in the library, Mr. Browne has no way of judging the authenticity of the stamps, nor of their usage. Moreover, without sight of other books or papers in the library from the same period, Mr. Browne cannot assess when certain papers were in use and also which copiers may have been in use. *See Browne Declaration, ¶43.*

It should also be borne in mind that the stamps are only applied to the outside of the covers. The pages can be removed and replaced. It follows therefore that what is endorsed on the outside of the covers is no guarantee of the contents. *See Browne Declaration, ¶44.*

In Mr. Browne's opinion, there is evidence that all of the books have been put together as a collection of disparate parts. It is clear that much of the text has been added to existing pages. This is evidenced by the re-use of existing headers to introduce the current text. *See Browne Declaration, ¶45.*

Moreover, Mr. Browne considers that different papers have been sporadically used. *See Browne Declaration, ¶46.*

Although many of the books purport to have been produced at the same time, there is considerable evidence that this is not the case. *See Browne Declaration, ¶47.*

Documents 8/89, Volume 8, and 9/89, Volume 7 clearly show where part of the book 8/89, Volume 8 has been added after the event. *See Browne Declaration, ¶48.*

Without knowledge of other documents in the University library and or the Telecommunications Research Institute and the control procedures in use, or the copiers in use, it is not possible to give a definite opinion as to the dates of any alterations. *See Browne Declaration, ¶49.*

However, Mr. Browne's findings are significant and do cast doubt as to when these documents were created, when changes were made and what text was actually on the pages when they were first filed. *See Browne Declaration, ¶50.*

In view of the circumstances set forth above and in the Browne Declaration, Patent Owner respectfully submits that the Telenor documents are not "printed publications" under 35 U.S.C. § 102. In particular, Patent Owner respectfully submits that the presently known circumstances do not demonstrate that the Telenor documents were actually publicly available prior to the critical date of the patent being reexamined. Even if Patent Owner assumes, for the sake of argument, that some variation of the Telenor Documents were shelved as of the critical

date and were properly indexed and catalogued as of the critical date, there is no guarantee or certainty that such documents comprise the set that was disclosed to the Patent Office on September 29, 2005.

It should be noted here that Patent Owner has already shown in the previous response that the Telenor documents were not properly catalogued or indexed in such a way to make them available to persons interested and ordinarily skill in the relevant art to the Campana patents. Specifically, Patent Owner has shown that one skilled in the art of electronic mail communications systems would not have located the Telenor documents using reasonable diligence. *See* Rhyne Supplemental Declaration, ¶52.

Thus, Patent Owner has presented very compelling evidence that the Telenor documents have been altered and manipulated, and thus there can be no certainty that they were publicly available prior to the critical date of the patent under reexamination. Therefore, the Telenor documents are not “printed publications” and as such any rejections of the claims based on the Telenor documents should be reconsidered and withdrawn.

Patent Owner remains in possession of the original Telenor documents and would be willing to arrange a meeting so that they can be inspected by the Examiner and/or other interested Patent Office official(s).

Accordingly, in view of the above, Patent Owner respectfully requests that the pending rejection of claims based on the Telenor document be withdrawn.

**3. The PTO Engaged In Improper Communications with Third Parties That Are Not Reflected In The Record Of Decision for the Reexaminations.**

Patent Owner respectfully traverses the above rejections on the basis that the Patent Office during the course of the reexaminations has engaged in a substantial number of non-record communications with third parties, including the third-party requester, which the Patent

Owner contends have influenced the outcome of the reexaminations. For example, there has been apparent collusion between the PTO and third parties in off the record communications wherein the PTO was influenced to issue a response in the reexaminations in an expedited time period in order to assist RIM in its litigation efforts against the Patent Owner. The non-record communications demonstrate actual bias against Patent Owner by persons participating in the decision-making process. Further, the existence of a substantial number of these communications indicates the reexamination process was not fair and impartial, but rather that the outcome was pre-determined against Patent Owner.

The Patent Owner submits the declaration of Kevin P. Anderson under 37 C.F.R. § 1.132 (“Anderson Declaration”) in support of these assertions. There is good and sufficient reason under 37 C.F.R. §1.116(a) to admit Mr. Anderson’s Declaration because it is relevant and necessary to identify some of the non-record communications that should have been included in the record of decision in the reexaminations, and to demonstrate that a substantial number of additional non-record communications must exist.

The Anderson Declaration could not have been presented at an earlier time because it is based on documents produced under the Freedom of Information Act (“FOIA”) between January 31, 2006 and March 24, 2006. Most of the documents were produced on or after the date the PTO issued its final office action on February 24, 2006 on Patent No. 5,436,960. Patent Owner sought to raise objections to non-record communications between the PTO and third parties in a petition filed on January 23, 2006 in *inter partes* reexamination no. 00/000,000,020, but the PTO denied Patent Owner any relief in its Decision Denying Petition dated March 20, 2006 because Patent Owner did not produce specific examples and identify persons involved in improper non-record communications. See Decision Denying Petition, March 20, 2006 at 10-11. Patent

Owner could not provide that information when it filed its January 23, 2006 Petition because the PTO had not yet produced any of the documents sought by Patent Owner in its FOIA request.

While the PTO has not yet produced all responsive documents, the Anderson Declaration attaches all of the documents produced to date so that all the evidence of non-record communications in the FOIA documents are available and there can be no claim that Patent Owner has selectively edited out only a limited number of documents from the entirety of the production.

a. Communications with Third-Party Requesters  
Are Strictly Limited

In *ex parte* and Director ordered reexaminations, regulations limit communications between a third-party requester and the PTO to a single set of reply comments, which may be filed only if the patent owner files a statement under 37 C.F.R. § 1.530. *See* 37 C.F.R. § 1.535. The prohibition on further communications between the PTO and the third-party requester is set out, among other places, in 37 C.F.R. § 1.550(g), which states in pertinent part:

(g) The participation of the *ex parte* reexamination requester ends with the reply pursuant to §1.535, and no further submissions on behalf of the reexamination requester will be acknowledged or considered....

The PTO is required by regulation to return any authorized communication from a third party and note receipt of the material in the record of decision. *See* MPEP §§ 2266-2267. The PTO may not grant an oral interview with the third-party requester in an *ex parte* reexamination. *See* 37 C.F.R. § 1.560. In short, the PTO is prohibited to engage in oral or written communications with a third-party requester, and any communications from a third-party requester must be noted in the record of decision.

Communications between the PTO and a third party in an *inter partes* reexamination generally are limited to instances where the third-party requester is permitted to submit



comments on filings by the patent owner. *See* 37 C.F.R. § 1.947. Any unauthorized paper submitted by a third-party requester “will not be considered.” *See* 37 C.F.R. § 1.939. Further, PTO regulations explicitly require that “All communications between the Office and the parties to the inter partes reexamination which are directed to the merits of the proceeding must be in writing and filed with the Office for entry into the record of the proceeding.” *See* 37 C.F.R. § 1.937(c).

In addition, the regulations prohibit interviews in *inter partes* reexaminations. *See* 37 C.F.R. § 1.955. Accordingly, the MPEP § 2685 provides “where a party requests any information as to the merits of a reexamination proceeding, the examiner will not conduct a personal or telephone interview with that party to provide the information.” The phrase “merits of a reexamination” is strictly construed. All information that cannot be obtained by reading the PTO’s publicly available file is deemed to relate to the merits. MPEP §2685 provides: “Matters *not available from a reading of the file* are considered as relating to the merits of the proceeding, and *may not be discussed*.” (Emphasis in original).

Notwithstanding the near absolute bar on non-record communications with third-party requesters in reexaminations, FOIA documents demonstrate that officials at the highest levels of the Commerce Department and the PTO agreed to an off-the-record meeting with RIM’s President and Co-CEO during the reexaminations.

b. The PTO Had An Ex Parte Meeting With RIM To Discuss The Reexaminations

On Saturday, January 1, 2005, Theodore W. Kassinger, the Deputy Secretary of the Department of Commerce, sent an email to Mr. Dudas to arrange a meeting with RIM officials. The substance of Mr. Kassinger’s email to Mr. Dudas has been redacted *without the assertion of any claim of privilege or exemption under FOIA*. Redaction of the email without an assertion of

a privilege or exemption is improper. Further, to the extent that Mr. Kassinger's email reflects the substance of any discussion with RIM or its representatives, that information should have been noted in the record of decision.

Mr. Dudas responded on January 2 thanking Mr. Kassinger for arranging the meeting. He indicated he would be in his office on Tuesday, January 4, and that Jennifer Lo, the Under Secretary of Commerce for Intellectual Property, could work with Jane Dana, the Acting General Counsel of the Department of Commerce, to "set up a convenient time to meet with Mr. Cameron", a lawyer for RIM. A copy of this email is attached to the Anderson Declaration as Exhibit 5 p. 1.

Copied on Mr. Dudas' January 2 email, in addition to Ms. Lo, were Steve Pinkos, Deputy Under Secretary of Commerce and Deputy Director of the PTO, and Eleanor K. Meltzer, an attorney-advisor in the Office of Legislative and International Affairs of the PTO. Ms. Meltzer forwarded the emails between Mr. Kassinger and Mr. Dudas to James Toupin, General Counsel of the PTO, and John Whealan, Deputy General Counsel and Solicitor for the PTO. NTP infers from these facts and circumstances that Messrs. Toupin and Whealan joined Mr. Dudas and other Commerce Department and PTO officials to meet with Jim Balsillie, President and Co-CEO of RIM, and Don Cameron, RIM's Canadian counsel, on January 4, 2005. *See* Anderson Declaration Exhibit 5, p. 45.

To prepare for the meeting with Mr. Balsillie, Mr. Dudas requested that the PTO prepare briefing materials for him on, among other things, the status of the reexaminations of Patent Owner's patents and the Infringement Action. Ms. Meltzer sent a "High" Importance email at 9:36 A.M. on January 3 requiring, by 3:00 P.M. that day, the PTO to provide the following briefing materials for Mr. Dudas:

- Identification of the various outstanding patents (by number and owner), and whether they are *inter partes* re-exams (IPRs) or director-ordered re-exams (DORs);
- Current status of each;
- Procedural history of each IPR and DOR;
- Information-for each-on the volume of new materials being reviewed and the number of USPTO employees reviewing materials;
- Summary of the litigation history; and
- Outstanding issues before the USPTO.

A copy of this email is attached to the Anderson Declaration as Exhibit 2, p. 87.

Ms. Meltzer's email indicated the briefing materials were for a meeting on January 4, at 4:00 P.M., where "Mr. Dudas, other Commerce Department representatives, and possibly representatives from the Department of Justice will meet to discuss the 'RIM' case." Prior to the meeting with RIM, an internal PTO meeting was scheduled for 11:30 AM on January 4 with the subject "Briefing RE: RIM". The email indicates "Required Attendees" were Mr. Dudas, Mr. Pinkos, Nicholas Godici, Robert Bahr, Elizabeth Dougherty, Mr. Toupin, Mr. Whealan, Lois Boland, John Doll and Ms. Meltzer. A copy of this email is attached to the Anderson Declaration as Exhibit 3, p. 99.

It appears from the FOIA documents that the briefing materials Mr. Dudas requested for these meetings pertained directly to the reexaminations of Patent Owner's patents. NTP infers from these , the briefing materials contained non-public information related to the merits of the reexaminations, and the reexaminations where discussed in the meeting with RIM.

Further evidence that a meeting was scheduled between RIM and PTO officials involving the "RIM/NTP reexaminations" is contained in an email from Elizabeth Dougherty in the Office of Patent Legal Administration. On March 31, 2005, Ms. Dougherty wrote to newly appointed

PTO Commissioner John Doll to inquire about the propriety of “industry leaders” seeking an “audience with the Director.” Ms. Dougherty states that although she does not know whether the meeting actually occurred, “The present question reminds me somewhat of the situation in the RIM/NTP reexaminations where RIM wished to meet with officials at the Department of Commerce and Jim Toupin and John Whealan were to attend the meeting.” *See* Anderson Declaration Exhibit 4, p. 5.

Patent Owner believes there are numerous communications with the third-party requester related to the January 4, 2005 meeting that have not been produced in response to the FOIA request, and which have not been included in the record of decision as required by regulation. Additionally, Patent Owner believes there were communications between senior Commerce and PTO officials concerning communications with the third-party requester that have not been produced in response to the FOIA request. For example, there must have been a number of communications prior to Mr. Kassinger’s January 1, 2005 email wherein RIM representatives attempted to arrange the meeting with the PTO, including the agenda for the meeting. Additionally, Patent Owner believes there are internal communications wherein the PTO considered whether to accept a meeting with RIM and what the topics of the meeting would be. None of these communications have been produced or included in the record. Nor has the PTO produced an agenda for the meeting with RIM or provided minutes of the meeting. Nothing respecting the meeting between the PTO and RIM has been put in the record of decision as required by applicable regulations.

c. PTO Files Contain Communications With Third Parties

In addition to the January 4, 2005 meeting, PTO files include evidence of numerous other oral and written contacts between the PTO and third parties respecting the reexaminations. These include among others:

- An internal email between RIM lawyers and a RIM employee relating the retention of a former PTO Commissioner to represent RIM before the PTO. A copy of this email attached to the Anderson Declaration as Exhibit 4, p. 154.
- Email from a RIM lawyer to a PTO lawyer in the Office of Patent Legal Administration seeking access to a non-final Office Action or an “unofficial” statement as to how the 80 claims in *ex parte* reexamination 90/006,676 had been treated. A copy of this email is attached to the Anderson Declaration as Exhibit 4, p. 170.
- PTO email (described as a “mistake”) to RIM requesting information that reflects a “cc” copy to a RIM lawyer. A copy of this email is attached to the Anderson Declaration as Exhibit 5, p. 328.

Other FOIA documents produced by the PTO demonstrate there must have been oral or written communications between third parties and the PTO related to the reexaminations that have not been produced in response to the FOIA request and which have not been included in the record of decision. For example, as described below in detail, there is evidence that PTO officials communicated with third parties (likely RIM representatives) to prepare a status report in the reexaminations concerning the PTO’s projected timeline for rejecting Patent Owner’s patents. These communications have not been produced in response to the FOIA request and have not been included in the record of decision in the reexaminations.

Numerous PTO emails underline the extent to which the PTO has given RIM special treatment throughout the reexamination process. For example, when there was an inquiry about a delay in posting a decision favorable to RIM on the PTO’s public docket, PAIR, the PTO launched a full-scale investigation into the reasons for the delay. A copy of this email chain is attached to the Anderson Declaration as Exhibit 4, pp. 20-24.

On another occasion when a RIM lawyer inquired about when a decision favorable to RIM would be posted to PAIR, a PTO staffer, Krista Zele, personally hand-carried the decision

and all prior art referenced therein to the scanning service, “requested expedited scanning,” and emailed RIM’s lawyer to advise of her assistance. A copy of this email chain attached to the Anderson Declaration as Exhibit 4, p. 170. By contrast, Patent Owner pleadings, such as its January 23, 2006 motion for reconsideration of the PTO’s refusal to dismiss the ‘020 *inter partes* reexamination, languished for almost 6 weeks without being posted on PAIR.

The special treatment accorded by the PTO throughout the reexaminations is even reflected on the “subject” lines of numerous PTO emails. The reexaminations ordered by then Director Rogan were of *NTP’s patents*, not *RIM patents*. Yet the “subject” lines of PTO emails produced in response to Patent Owner’s FOIA request frequently refer to the reexaminations as the “RIM reexams” or “Blackberry reexams”, or sometimes simply “RIM”. Titling emails in this manner suggests the PTO was conducting the reexaminations for the benefit of RIM. *See, e.g.*, Anderson Declaration Exhibit 4, pp. 13-138, 177.

NTP infers from these facts and circumstances that the PTO has sought to conceal the extent of its bias against Patent Owner by selectively redacting portions of the FOIA documents that are embarrassing to the agency. For example, an email dated February 21, 2003 between PTO officials, including Mr. Schor, the author of the ‘020 *inter partes* decision, has the subject line partially redacted. The first two words of the subject line are “blackberry reexamination”, but approximately 24 additional characters and/or spaces are redacted, allegedly under Exemption 5 of FOIA. The body of the email has as its only text the letters “FYI.” It forwards a publicly available news service article entitled “Congress Enters Struggle Over Blackberry Patent.” A copy of this email is attached to the Anderson Declaration as Exhibit 4, p. 177.

Patent Owner disputes that the redacted 24 characters of the subject line are privileged under FOIA Exemption 5, which the Supreme Court has recognized exempts only (i) deliberative

process communications, (ii) attorney-client communications, (iii) attorney work product, and (iv) confidential commercial information. Plainly, an email that does nothing more than forward a news article verbatim does not qualify for any of the recognized exemptions. Patent Owner infers from these facts and circumstances that the PTO has redacted this document not because it qualifies for a legitimate privilege under FOIA, but because the remainder of the subject line reflects agency bias.

Patent Owner infers from these facts and circumstances that numerous other FOIA documents have been redacted by the PTO not because they are legitimately privileged under Exemption 5, but because the redacted text, if disclosed, would reveal agency bias. *See, e.g.*, Anderson Declaration, Exhibit 3, p. 1 (subject line improperly deleted).

d. Political Pressure Resulted in Actual Bias Against Patent Owner

FOIA documents reflect Congressional pressure on the PTO to move quickly on the reexaminations. An internal PTO document titled “Congressional Inquiry re Reexam Cases” shows, for example, that Senator Sununu contacted the PTO about the NTP reexaminations and demanded to know “(1) why further action has not occurred in these cases, and (2) how much longer it is anticipated to be before action will be taken.” Internal PTO email between officials participating in the reexaminations makes clear there was pressure to respond “ASAP”. One PTO email asks in response to the Sununu inquiry: “Can we possibly provide an answer to these questions today?” *See* Anderson Declaration Exhibit 4, p. 2. As described below, the PTO yielded to political pressure to “provide an answer today” in ways that demonstrate its bias against Patent Owner.

FOIA documents reveal that the Canadian government repeatedly lobbied the Commerce Department with respect to the reexamination proceedings. Articles in the Canadian press note that lobbying by the Canadian government was unprecedented in previous Canadian experience.

Patent Owner infers from these facts and circumstances that lobbying by the Canadian government and others influenced the PTO to issue a ruling in the reexaminations on an extremely expedited basis that was specifically intended by the PTO to assist RIM in the patent infringement litigation pending before the Hon. James R. Spencer in the United States District Court for the Eastern District of Virginia styled *NTP, Inc. v. Research in Motion Ltd.* (the “Infringement Action”).

After the Federal Circuit affirmed on appeal most of the District Court’s ruling sustaining the validity of Patent Owner’s patents, the Infringement Action was remanded to District Court for, among other things, consideration of damages and possible imposition of an injunction. Judge Spencer ordered that the parties should appear on November 9, 2005 at 9:30 AM to schedule a hearing on Patent Owner’s motion for an injunction.

It was vitally important to RIM to avoid an injunction that could shut down its Blackberry devices, effectively putting the company out of business in the United States. One of RIM’s strategies to avoid an injunction was to argue that the District Court should stay consideration of an injunction pending the outcome of the reexaminations.

Patent Owner infers from the documents obtained that the Canadian government lobbied the Commerce Department to direct the PTO to provide a timeline for when the reexaminations of Patent Owner’s patents would be concluded. Such a timeline could be used by RIM to argue that Judge Spencer should stay consideration of an injunction pending the outcome of the reexaminations.

On November 7, 2005, the Canadian Minister of Industry faxed the U.S. Secretary of Commerce a letter requesting that the “USPTO should be encouraged to issue a public time



frame regarding when the re-examination process will be completed.” A copy of this letter is attached to the Anderson Declaration as Exhibit 2, pp. 3-4.

On November 8, at approximately 11:42 AM, RIM faxed a pleading to the PTO entitled: “Third Party Requester’s Status Inquiry Regarding U.S. Patent Number 6,317,592, Merged Reexamination Control Numbers 95/000,020 and 90/006,495.” A copy of RIM’s request is attached to the Anderson Declaration as Exhibit 6.

RIM requested the PTO to provide “a timeline from the present to the expected issuance of a final office action, an Action Closing Prosecution in the instant *inter partes* reexamination through this written status inquiry pursuant to MPEP Section 2671 *et seq.*....” In fact, MPEP § 2671 does not authorize a third-party requester to request a status report. Nor does the MPEP establish a procedure for the PTO to issue “status reports” to third-party requesters such as RIM. On the contrary, MPEP § 2685 specifically provides that “a question relating to when the next Office action will be rendered is improper as it relates to the merits of the proceeding....”

Nevertheless, *the PTO acted within approximately 3 hours of receiving RIM’s request* to provide a response detailing the anticipated time table for concluding the reexamination. This response came complete with a flow chart detailing the expected process. Further, the PTO transmitted the response to RIM’s lawyers (but not Patent Owner’s lawyers) on an expedited basis. RIM received the PTO’s response on November 8, the same day it filed its request, allowing RIM to file the response with the District Court in Richmond, Virginia prior to the hearing the next morning at 9:30 AM. As the PTO expected and intended, Patent Owner was blind- sided at the hearing in Richmond when it learned for the first time of the PTO’s actions. A copy of the PTO’s response is attached to the Anderson Declaration as Exhibit 7.

Patent Owner infers from the documents obtained that the timing of the Canadian Minister's letter to the Commerce Department requesting its assistance to induce the PTO to provide public status information on future office actions, RIM's request for a status report, and the PTO's expedited, 3 hour response to allow RIM to include the paper in its court filing, were neither coincidental nor uncoordinated events. Rather, Patent Owner infers from these facts and circumstances that this action resulted from (i) inappropriate oral communications between agency personnel and third parties that are not reflected in the record of decision, and (ii) actual bias by PTO decision-makers charged with the responsibility for conducting the reexaminations of Patent Owner's patents.

FOIA documents reveal that the Director of the Central Reexam Unit, Lissi Marquis, was "directed" by more senior PTO officials to prepare a timeline. Further, that directive was issued *before* RIM filed its request for a status report on November 8, 2005.

Ms. Marquis sent an email on November 7 to William LaMarca and Thomas Stoll, Associate Solicitors in Mr. Whealan's office, and Robert Clarke, the subject line of which is "meeting regarding drafting a letter for a timeline in the NTP case." The reference to the "NTP case" demonstrates the PTO knew the timeline it was preparing in the reexaminations would be submitted in the patent infringement lawsuit pending between Patent Owner and RIM. The email states: "We have been *directed* to provide a timeline so we need to come up with a draft that works for all parties involved." (Emphasis added). A copy of this email is attached to the Anderson Declaration as Exhibit 5, p. 336.

A meeting was arranged for the morning of November 8 between 9 and 10 AM to work on the timeline. *Id.* RIM's "request" for the timeline was not faxed to the PTO for filing until approximately 11:44 AM, 2 hours and 44 minutes later. *See* Anderson Declaration, Exhibit 6,

p.1. Patent Owner infers from these facts and circumstances that senior PTO officials, either directly or through Commerce Department officials, had communications with a third party about the timing of future actions in the reexaminations and agreed to coordinate the production of a status report setting forth a timeline for completion of future office actions in the reexaminations. Patent Owner infers from these facts and circumstances that these communications included discussion of the timetable on which the status report had to be prepared in order for it to be presented to the District Court in Richmond, Virginia. Patent Owner infers from the documents obtained that senior PTO officials had communications with a third party in which these officials agreed to assist RIM by preparing the status report on an expedited basis. Further, senior PTO officials made this commitment to assist RIM prior to the time that RIM filed its motion requesting the status report, as demonstrated by the fact that work began on the timeline a day prior to RIM's formal written request for the timeline, which was filed in the record of decision.

Patent Owner infers from the documents obtained that the "direction" to the Director of the Central Reexam Unit to prepare the timeline--even though it was not authorized by the MPEP--came from senior PTO officials who had engaged in communications with third parties about how provision of such a timeline would benefit RIM's litigation efforts in the District Court. The PTO has not produced these communications in response to the FOIA request and has not included a written notice of the communications in the record of decision as required by law.

The result is that unauthorized, non-record communications between PTO decision-makers and one or more third parties produced an advance agreement to prepare a response to a motion that had not yet been filed in the reexaminations, which motion by prior secret agreement

with the agency, would be granted. Patent Owner received a copy of the motion RIM filed on the record in the reexamination proceedings, but it had no knowledge of or opportunity to respond to the non-record communications that pre-determined the issue of whether to grant the motion. Indeed, based on the prior secret agreement, the PTO granted RIM's motion so quickly that Patent Owner never even had an opportunity to oppose the motion before the requested relief was granted.

Patent Owner infers from these facts and circumstances that the goal of these PTO officials was to assist RIM at the November 9 hearing before Judge Spencer. Although RIM's request for the status report was not filed until 11:42 AM, the PTO was able to provide a response within 3 hours because the PTO knew from its unauthorized communications with third parties that such a request would be filed and had agreed to provide the timeline even before the motion requesting it was filed. Based on non-record communications, senior PTO officials directed Ms. Marquis, the Director of the Central Reexam Unit, to prepare the timeline. This direction was issued, and work on the timeline was begun, before RIM's request for the timeline was filed because senior PTO officials had decided based on non-record and improper communications to assist RIM on an expedited basis.

The PTO's actual bias also appears on the face of its November 8 response to RIM's status request. In setting out the timeline for issuing future decisions and concluding the reexaminations, *the PTO assumed Patent Owner's patents would be rejected*. The time table provided by the PTO states: "The second Office action issued under *inter partes* reexamination procedure, *in which claims are rejected*, will ordinarily be an action closing prosecution." See Anderson Declaration, Exhibit 7, p. 2. (Emphasis added).

The PTO's assumption in its response to RIM's motion that the patent claims would be rejected is consistent with information that the PTO had previously provided assurances to RIM that Patent Owner's claims would be rejected as a result of the reexamination process. PTO assurances to RIM long prior to the conclusion of the reexaminations that Patent Owner's patents would be rejected are not only improper, such assurances demonstrate the outcome of the reexaminations was pre-determined.

FOIA documents reveal further evidence that there was active coordination between the PTO and RIM's counsel regarding RIM's efforts to avoid entry of an injunction. RIM's counsel sent the government a rough draft of its brief opposing entry of a permanent injunction for review and comment before the brief was filed. RIM was again arguing that the District Court should stay consideration of an injunction while the PTO was completing the reexaminations of Patent Owner's patents, so the timing of the final office actions by the PTO was critical. On January 9, 2006, John Fargo in the Department of Justice sent Mr. Toupin, Mr. Whealan and Mr. Stoll an excerpt of Rim's brief with the following email:

Counsel for RIM has provided me with a rough draft of their expected opposition to NTP's motion for imposition of a permanent injunction, [additional text redacted by PTO]. I have attached an excerpt from it that addresses the pending PTO reexam as a reason for denial of an injunction. [Additional text redacted by PTO.] Let me know if you believe that we should address any of RIM's comments in this excerpt, and of course, provide your views as to what we should say in response.

A copy of this email is attached to the Anderson Declaration as Exhibit 5, p. 312.

Pressure exerted from Congress and the most senior levels of the PTO to complete the reexaminations/rejections of Patent Owner's patents before the District Court enjoined RIM caused the PTO to ignore its own rules and procedures set out in the MPEP. The MPEP establishes time periods in reexamination proceedings for filing responses to PTO Office actions.

For example, MPEP § 2263 provides that “A shortened statutory period of 2 months will be set for response to Office actions in reexaminations. . . .” This time period was utilized by the PTO in its November 8 status report, where it indicated Patent Owner would have two months to respond to an action closing prosecution. *See* Anderson Declaration Exhibit 7, p. 2.

On November 9, Judge Spencer set January 24, 2006 as the date for a hearing on Patent Owner’s request for a permanent injunction. This was a more expedited hearing date than expected. If Patent Owner was allowed the full two months mandated by the MPEP to respond to an Office action, Patent Owner’s responses to some of the Office actions would not be due until *after* the hearing set by Judge Spencer. Patent Owner infers from these facts and circumstances that this was inconsistent with the PTO’s goal of assisting RIM by issuing, prior to the injunction hearing, Office actions rejecting each of Patent Owner’s patents.

Accordingly, after the November 9 hearing, the PTO *sua sponte* shortened the deadlines for Patent Owner’s responses to every Office action (seven in total) to one month instead of two months. The PTO made every response due *prior* to the date of the permanent injunction hearing.

Because the reduced time period materially prejudiced Patent Owner’s ability to respond fully to each of the Office actions, it had to file motions for extensions of time requesting that it be granted two months to respond, as specified in the MPEP. Contrary to the speed with which the PTO responded to motions filed by RIM, the PTO delayed responding to Patent Owner’s motions. Sometimes, the PTO made Patent Owner wait until the day that the papers were due before granting an “extension” of time that in fact simply allotted Patent Owner *the time normally permitted* by the MPEP to respond to the Office actions.

The November 8 status report indicated that the PTO's "goal" was to issue a final action six weeks after Patent Owner filed its response. *See* Anderson Declaration, Exhibit 7, p. 2.

Granting the full two months to respond to the Office actions meant that, on one of the primary patents contested in the Infringement Action, Patent Owner's papers would be filed with the PTO on February 15, 2006. If the PTO took six weeks to issue its final action, its decision would not be published for more than a month after the February 24 preliminary injunction hearing, and perhaps not until after Judge Spencer had already issued an injunction.

Patent Owner infers from these facts and circumstances that in order to achieve its goal of rejecting Patent Owner's main patent prior to the injunction hearing, the PTO accelerated its internal time-table for issuing its final decision. Although there were only 5 business days (and a total of 9 calendar days) between the day when Patent Owner submitted its response and the date of the hearing, the PTO rushed its decision so that it could be released on the morning of the injunction hearing.

The PTO could not have reviewed and properly considered Patent Owner's February 15 filing, which was hundreds of pages long including numerous claims and several amended and new claims, and prepared its own 121 page decision, in 5 business days. Patent Owner infers from these facts and circumstances that the PTO's decision had been pre-determined long before, and even its opinion had been substantially written prior to receipt of Patent Owner's papers on February 15.

The rushed release of the PTO's decision on the morning of the preliminary injunction hearing is reflective of the palpable predisposition of the PTO throughout the reexamination proceedings. The PTO made good on its earlier assurances to RIM that it would reject Patent Owner's patents.

The full scope of the PTO's bias is not reflected in the current record of the reexaminations because that record has been compiled selectively. Patent Owner infers from these facts and circumstances that the record omits large numbers of communications between the PTO and third parties, including officers and representatives of RIM. Any opportunity for a full and fair review of the PTO's actions will be prejudiced unless the non-record communications involving PTO officials are produced and the record of decision is supplemented to reflect these communications. Accordingly, Patent Owner hereby requests that the non-record communications involving PTO officials be produced and that the record of decision be supplemented to reflect these communications.

Patent Owner cannot at present identify all of the non-record communications. The PTO is in exclusive possession and control of the non-record communications with third parties. To date, the PTO has produced what Patent Owner believes is only a small fraction of the documents responsive to its FOIA request. The PTO has a statutory and regulatory responsibility not to engage in unauthorized communications with third parties, and to enter in the record of decision in the reexaminations all third party communications respecting the merits of the reexaminations. Similarly, the PTO has a legal duty to provide a fair, impartial and unbiased reexamination of Patent Owner's patents, which reexamination must be on the record and not based in whole or in part on non-record communications. The PTO has breached these legal duties and, in the process, so tainted the reexaminations that they should be vacated by the Director in their entirety, with prejudice.

In view of the above, Patent Owner respectfully requests that the pending rejections be withdrawn.




### **III. CONCLUSION**

In view of the foregoing, it is respectfully submitted that the present reexamination proceeding is in condition for a Notice of Intent to Issue a Reexamination Certificate, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Dated: April 24, 2006  
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By:

  
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CERTIFICATE OF SERVICE

I hereby certify that on the 24<sup>th</sup> of April, 2006, I caused a copy of the foregoing  
RESPONSE TO FINAL OFFICE ACTION OF FEBRUARY 24, 2006 to be served as follows:

***By First Class Mail:***

Customer Number 28,694

Novak Druce DeLuca & Quigg

1300 Eye Street, N.W.

Suite 400 East Tower

Washington DC US 20005



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Brian M. Buroker