

**UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION**

MOBILE TELECOMMUNICATIONS,
TECHNOLOGIES, LLC,

Plaintiff,

v.

BLACKBERRY CORPORATION,

Defendant.

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Civil Action No. 3:12-CV-1652-M

FINAL CLAIM CONSTRUCTION ORDER

Plaintiff Mobile Telecommunications Technologies, LLC (“MTel”) brings this suit against BlackBerry Corporation (“BlackBerry”) for infringement of U.S. Patent Nos. 5,809,428 (the “428 Patent”), 5,754,946 (the “946 Patent”), 5,559,862 (the “862 Patent), 5,894,506 (the “506 Patent”) and 5,581,804 (the “804 Patent”) (collectively, the “Patents”).

The parties seek construction of disputed terms used in the asserted claims of the Patents. For many of these claim terms, BlackBerry proffers no construction and, instead, argues that the recited claims are invalid for indefiniteness. Having reviewed the evidence, and having considered the parties’ arguments and the applicable law, the Court now construes the disputed terms as stated on Exhibit A.

I. LEGAL STANDARD

A. General Principles of Claim Construction

Claim construction is a question of law exclusively for the court. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 971–72 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

“Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the

claim.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). Accordingly, the correct construction will be the one that “stays true to the claim language and most naturally aligns with the patent’s description of the invention.” *Id.*

In construing disputed terms, a court looks first to the claim language, for “[i]t is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Id.* at 1312 (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). Generally, the words of a claim should be given their “ordinary and customary meaning,” which is “the meaning that the term[s] would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1312–13.

In many cases, the meaning of a term to a person skilled in the art will not be immediately apparent, and a court must turn to other sources to determine the term’s meaning. *See id.* at 1314. “Those sources include the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Id.*

Courts should also consider the context in which the term is used in an asserted claim or in related claims in the patent, bearing in mind that “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.* at 1313. Indeed, the specification “‘is always highly relevant to the claim construction analysis’” and “[u]sually . . . dispositive; it is the single best guide to the meaning of a disputed term.” *Id.* at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). Where the specification reveals that the patentee has given a special definition to a claim term

that differs from the meaning it would ordinarily possess, the inventor's lexicography governs. *Id.* at 1316. Likewise, where the specification reveals an intentional disclaimer or disavowal of claim scope by the inventor, the inventor's intention, as revealed through the specification, is dispositive. *Id.* Nevertheless, claims are not necessarily limited to the disclosed embodiments. *Id.* at 1323. The patent's prosecution history is also relevant to the extent it "demonstrat[es] how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution." *Id.* at 1317.

Finally, courts may consider extrinsic evidence such as "expert and inventor testimony, dictionaries, and learned treatises." *Id.* (citing *Markman*, 52 F.3d at 980). Such evidence, however, is "less reliable than the patent and its prosecution history in determining how to read claim terms," and thus is considered "less significant than the intrinsic record." *Id.* at 1317–18.

B. Means-Plus-Function Claims

A patentee may claim an element of the invention in terms of the element's function, without reciting corresponding structure in the claim itself. 35 U.S.C. § 112, ¶ 6. However, a claimed function is valid only if the specifications "set forth . . . adequate disclosure showing what is meant by the language." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1367 (Fed. Cir. 2008) (quotation omitted).

Construction of a means-plus-function limitation requires the court to (a) determine the claimed function and (b) "identify the corresponding structure in the written description of the patent that performs the function." *Noah Sys., Inc. v. Intuit Inc.*, 675 F.3d 1302, 1311 (Fed. Cir. 2012). "A structure disclosed in the specification qualifies as a 'corresponding structure' if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim." *Id.* (citation omitted).

Where the claim involves a computer-implemented means-plus-function limitation, the specification must disclose more than a general purpose computer; rather, it must disclose an algorithm for performing the claimed function, unless the claimed function can be “achieved by any general purpose computer without special programming.” *See id.* at 1312 (citations omitted); *see In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1303, 1316 (Fed. Cir. 2011). That algorithm can be expressed “as a mathematical formula, in prose, as a flow chart,” or in any other manner that makes the corresponding structure clear to a person of ordinary skill. *Noah Sys., Inc.*, 675 F.3d at 1312–13.

II. OVERVIEW OF THE TECHNOLOGY IN THE PATENT-IN-SUIT

The '946 patent, titled “Nationwide Communication System,” and filed September 21, 1993, is a continuation-in-part of U.S. Patent No. 5,590,403 (the “'403 Patent”), which is not asserted in this case. The '946 patent is directed toward avoiding retransmission of unnecessary information from a system network to a mobile unit. *See* '946, 4:6–5:45. The '428 patent, titled “Method and Device for Processing Undelivered Data Messages in a Two-Way Wireless Communications System,” and filed July 25, 1996, incorporates by reference the '946 patent. The '428 patent generally relates to acknowledging receipt of data and probe messages by a mobile unit, and the storing of undelivered data messages for future delivery to the mobile unit. *See* '428, 1:34–55; 1:62–2:59. The '804 patent, titled “Nationwide Communication System,” and filed February 13, 1995, is a divisional of the '403 patent. Like the '428 patent, the '804 patent discloses improvements to a two-way communication system between a network and mobile unit, and generally relates to freeing up bandwidth usage by reducing registration traffic. *See* '804, 30:5–25. The '862 patent, titled “Mobile Paging Telephone Call Back System and Method,” and filed on September 2, 1994, incorporates by reference Reissue Patent No. 33,417

(the “’417 Patent”), which is not asserted in this case. The ’862 patent is directed to solving the problem existing in the prior art of mobile paging telephone devices being unable to complete a call using a received call back number, by determining the appropriate prefix necessary to complete a call back to the sender of a page message. *See* ’862, 2:11–49. The ’506 patent, titled “Method and Apparatus for Generating and Communicating Messages Between Subscribers to an Electronic Messaging Network,” was filed September 5, 1996. In general, the ’506 patent relates to sending “canned” messages by using associated message codes. *See* ’506, 1:38–2:45.

The Court interprets the disputed terms as stated on Exhibit A.

SO ORDERED.

May 8, 2015.

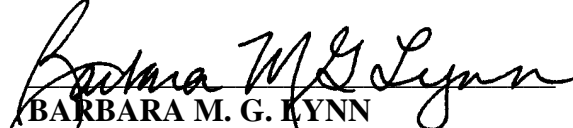

BARBARA M. G. LYNN
UNITED STATES DISTRICT JUDGE
NORTHERN DISTRICT OF TEXAS

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CLAIM CONSTRUCTIONS

Claim Term	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<i>data message</i> (’428 Patent: Claims 1, 4, and 8)	“a message containing end-user information, which is not a registration message, a probe message, a data acknowledgment message, or a probe acknowledgment message”	No construction necessary; plain and ordinary meaning.	“a message which is not a registration message, a probe message, a data acknowledgment message, or a probe acknowledgment message”	With respect to these terms, the parties dispute whether: (1) a “data message,” “message,” and “message signal” are distinct from the other messages and signals recited in the claims; and (2) these terms must be construed to include the limitation that they contain “end-user information.”
<i>message</i> (’804 Patent: Claims 1 and 5)	“a message containing end-user information, which is not a registration signal, a probe signal, or an acknowledgment signal”	No construction necessary; plain and ordinary meaning.	“a message which is not a registration signal, a probe signal, or an acknowledgment signal”	Although the Court concludes that the patents teach these messages and signals as distinct from other recited messages and signals, a point not disputed by MTel, ¹ it also finds that the patents do not support narrowing these terms to require inclusion of an “end-user information” limitation.
<i>message signal</i> (’804 Patent: Claim 10)	“a signal containing end-user information, which is not a probe signal or an acknowledgment signal”	No construction necessary; plain and ordinary meaning.	“a signal which is not a probe signal or an acknowledgment signal”	At the outset, the Court notes that the claims do not recite an end-user. BlackBerry’s reliance on two phrases from the specification of the ’428 patent to argue that such embodiments must be read into the claims is unpersuasive, and the Court will not construe these terms to include such a limitation.

¹ See March 27, 2014 *Markman* Hr’g Tr. at 33–34 (“Court: [C]an you tell me that a data message could be a probe message or registration message or an acknowledgment message at the same time that it’s a data message? Mr. Scardino: I don’t think that they can be. And, in fact, I think the patent says they have distinct characteristics.”); *id.* at 31–32 (“Mr. Scardino: In the context of the invention that’s described in the patent, [a data message, probe message, registration message, and acknowledgment message], they’re different things. No question.”).

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				<p>The claims do, however, separately identify these message and signal terms as different from other recited message and signal terms. <i>See, e.g.</i>, ’428, 9:16–32 (separately reciting “data message,” “probe message,” and “acknowledgment message”); ’428, 9:44–10:11 (separately reciting “data message,” “probe message,” “registration message,” “data acknowledgment message,” and “probe acknowledgment message”); ’804, 33:1–40 (separately reciting “message,” “registration signal,” “probe signal,” and “probe acknowledgment signal”); ’804, 35:13–36:25 (separately reciting “message signal,” “probe signal,” and “acknowledgment signal”).</p> <p>The Court’s construction, thus, acknowledges that these recited message and signal terms are distinct from the other messages and signals recited. <i>See Becton, Dickinson and Co. v. Tyco Healthcare Grp., LP</i>, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (“Where a claim lists elements separately, the clear implication of the claim language is that those elements are distinct component[s] of the patented invention.”) (internal citation and quotation marks omitted).</p>
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Claim Term	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<i>probe message</i> (’428 Patent: Claims 1, 4, and 8)	“a message for transmission by more than one base transmitter to locate a mobile unit”	No construction necessary; plain and ordinary meaning. In the alternative: “a message that is generated to determine the location or status of a mobile unit for the purpose of determining whether the mobile unit can be reached”	“a message that is generated to locate a mobile unit”	With respect to these terms, the parties dispute whether: (1) the “probe” is used solely to locate a mobile unit; and (2) the “probe” must be transmitted by more than one base transmitter. The Court concludes that one skilled in the art would understand the “probe message” and “probe signal,” as recited in the patents, to be used to locate a mobile unit. In so finding, the Court notes that at the July 17, 2014 <i>Markman</i> hearing in this case, MTel proffered its revised construction and cited to an extrinsic technical dictionary to support its revised, broader construction. <i>See Newton’s Telecom Dictionary</i> 929 (10th ed. 1996) (defining “probe” as “[a]n empty message that is sent to reach a particular address to determine if an address can be reached.”). Notwithstanding that technical dictionaries may be of assistance to the Court in ascertaining the meaning ascribed to a term by persons skilled in the art, <i>see Phillips v. AWH Corp.</i> , 415 F.3d 1303, 1318 (Fed. Cir. 2005), the Court must be cautious not to rely on the dictionary definition to the exclusion of the meaning given to the term within the particular context of the patent, <i>id.</i> at 1321, and the Court finds that the intrinsic evidence fully supports the Court’s construction.
<i>probe signal</i> (’804 Patent: Claims 1 and 10)	“a signal for transmission by more than one base transmitter to locate a mobile unit”	No construction necessary; plain and ordinary meaning. In the alternative: “a signal that is generated to determine the location or status of a mobile unit for the purpose of determining whether the mobile unit can be reached”	“a signal that is generated to locate a mobile unit”	This is so because the specifications of both patents consistently demonstrate that the “probe”

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			<p>is used to locate a mobile receiver. <i>See, e.g.</i>, ’428, 4:37–40 (a “probe message . . . is generally a message generated by a network operations center to locate a mobile unit.”);² ’428, 1:44–45 (explaining that a “probe message” is a “message sent by the network operations center to locate a mobile unit”); ’804, 11:49–54 (teaching that a probe signal may be used to “request[] a particular mobile unit to broadcast an acknowledgment signal to allow the system to determine its approximate location”); ’804, 11:54–56 (“Probe signals, thereby, may be used to track the locations of mobile units, or to uncover the location of ‘lost’ mobile units.”). Thus, the intrinsic evidence of both patents reveals that a “probe” is generated for locating a mobile unit.³</p> <p>The Court will not construe these terms, however, to include the limitation that a “probe” be transmitted by more than one base transmitter. The relevant claims of the ’428 patent do not recite the use of base transmitters, and the patent teaches that it is the network operations center that transmits the probe messages. <i>See, e.g.</i>, ’428, 4:37–40; ’428, 61–5:1; ’428, 1:15–31.</p>
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² Preceding this language, the patent states that the term “probe message” is “defined below.” ’428, 4:29–31. Therefore, Blackberry argues that the patentee has served as his own lexicographer to define “probe message” as stated above. The Court disagrees, finding that this language, specifically the use of *generally*, is not precise enough to serve as a lexicography. *See Mobile Telecommunications Technologies, LLC v. Sprint Nextel Corp., et al.*, Nos. 2:12-CV-832, 2:13-CV-258, 2:13-CV-259, at *43–48 (E.D. Tex. May 2, 2014). Nevertheless, as noted above, it is useful in determining the context in which “probe message” is used in the patent. *See id.*

³ The Court additionally notes that a person having ordinary skill in the art would not have understood “locate” to require a particular geographic location, such as latitude and longitude, and will not accept any arguments to the contrary. *See MTel, LLC v. Sprint Nextel Corp.*, No. 2:12-CV-832-JRG-RSP, Dkt. Nos. 162 at 47, 246 at 3–4 (E. D. Tex. 2014)

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				Additionally, the relevant claims of the '804 patent already state the use of a “plurality of base transmitters” to send a probe signal. For instance, claim 10 of the '804 patent recites the transmission of a probe signal by a “plurality of base transmitters.” Finally, the preamble of claim 1 recites that the “plurality of base transmitters” are capable of sending a probe signal, <i>see</i> '804, 33:14–22, which further supports the Court’s construction.
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>registration message</i> (’428 Patent: Claim 4)	“a message generated by a mobile unit to update its location to the network operations center”	No construction necessary; plain and ordinary meaning. In the alternative: “a message used for registration of a mobile unit”	“a message that is generated to update the location of a mobile unit”	With respect to these terms, the parties dispute whether: (1) the “registration” is used solely to update the mobile unit’s location; and (2) the construction of these terms should include the limitation that the location update is sent to the network operations center. The Court concludes that one skilled in the art would understand the “registration message” and “registration signal,” as recited in the patents, to be used to update the location of a mobile unit. <i>See</i> '428, 4:32–34 (“A registration message is generally a message generated by a mobile unit to update its location to the network operations center”); '428, 5:54–57 (“As RMP module 306 receives a registration message from MTD module 302, it updates in memory storage unit 110 the location of mobile unit 200 and forwards to message transmitting unit 108 any undelivered
<i>registration signal</i> (’804 Patent: Claims 1 and 5)	“a signal generated by a mobile unit to update its location to the network operations center”	No construction necessary; plain and ordinary meaning. In the alternative: “a signal used for registration of a mobile unit”	“a signal that is generated to update the location of a mobile unit”	

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			<p>data messages stored in memory storage unit 110.”); ’428, Fig. 8 (diagram depicting a method of transmitting undelivered data messages upon mobile unit registration, and identifying steps as: (1) “receive registration message from mobile unit”; (2) update mobile unit location; and (3) transmit to mobile unit any undelivered data messages stored in memory”); ’804, 29:31–37 (“[I]t is preferred that each mobile transceiver unit have the capability to ‘register’ with the network operations center 600 by sending a registration signal to a base receiver into the network to update the location data”); ’804, 29:52–57 (“The mobile transceiver unit may also transmit a registration signal in other desirable instances. For example, if the mobile transceiver unit has moved away from the transmitter coverage areas of the network for a period of time, the mobile transceiver unit may preferably transmit a registration signal upon returning to a coverage area.”).</p> <p>The Court is mindful that in construing claim terms, it must “capture the scope of the actual invention” rather than “allow the claim language to become divorced from what the specification conveys is the invention.” <i>Retractable Techs., Inc. v. Becton</i>, 653 F.3d 1296, 1305 (Fed. Cir. 2011). As shown above, the intrinsic evidence consistently demonstrates that a registration message and signal are used to update the location of the mobile unit, and the Court’s construction thus captures the scope of the actual invention. In so construing these terms, the Court does not agree</p>
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				<p>with MTel that the '428 patent specification supports registration for purposes other than to update the location of the mobile unit, <i>see</i> '428, 2:52–55, and instead finds this language fully consistent with the fact that “registration” is used to update the location of a mobile unit. Although the intrinsic evidence teaches <i>when</i> a registration message is sent, or how to gather statistical data <i>about</i> registration messages, it also consistently and exclusively teaches that the <i>purpose</i> of a registration message/signal is to update the location of a mobile unit. <i>Compare</i> '946, 28:32–35 <i>with id.</i> at 21:20–22, 28:16–18, 51–55, 64–67.</p> <p>The Court does not construe these terms to include the limitation that the mobile unit’s location be updated to the network operations center, because, as MTel argues, the preambles and claims identify the destination of registration messages and signals. <i>See</i> '428, 9:44–10:11; '804, 33:1–22; '804, 33:51–34:23.</p>
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<p><i>mobile unit</i> (’946 Patent: Claims 1, 7, and 8)</p>	<p>“a mobile unit that does not automatically request retransmission of a received message when it contains an error”</p>	<p>No construction necessary; plain and ordinary meaning.</p>	<p>“a mobile unit that relies on the user to request retransmission of a message that contains an error”</p>	<p>The parties’ dispute turns on whether the Court should limit “mobile unit” to a mobile unit that does not automatically request retransmission of a received message when it contains an error.</p> <p>While MTel is correct that “[i]mporting negative limitations in a claim . . . is generally disfavored,” <i>WesternGeco LLC v. Ion Geophysical Corp.</i>, 735</p>

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				<p>F. Supp. 2d 623, 637 (S.D. Tex. 2010), the Court concludes that the specification and prosecution history demonstrate the patentee’s disclaimer of claim scope, such that the mobile unit does not automatically request retransmission of a received message that contains an error. <i>See Nystrom v. TREX Co.</i>, 424 F.3d 1136, 1144–45 (Fed. Cir. 2005) (holding that the patentee “is not entitled to a claim construction divorced from the context of the written description and prosecution history.”).</p> <p>During the patent’s prosecution history, the patentee explicitly represented to the PTO that the mobile unit does not automatically request retransmission of a message that contains an error. <i>See, e.g.</i>, BlackBerry Resp. Br., Ex. C. (1/12/96 Resp. to PTO) (“[T]he mobile unit does not automatically request retransmission of a received message simply because it contains an error. Rather, the switch must be actuated before any request for retransmission will be transmitted. . . . [N]o teaching can be found in any of the cited references of an element corresponding to the switch.”); BlackBerry Resp. Br., Ex. D. (1/11/96 Proposed Amendment Under 37 C.F.R. § 1.116) (“[T]he mobile unit does not automatically request retransmission of a received message when it contains an error. Rather, the user must actuate the switch means to cause the mobile unit of claim 1 to request retransmission.”).</p> <p>These statements are fully consistent with the language of the disputed claims. <i>See</i> ’946, 32:2–4</p>
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			<p>(“a switch actuatable to specify a portion of the displayed message for which a user desires retransmission from the communications network”); ’946, 32:35–44 (“mobile unit having . . . a switch actuatable to specify a portion of the displayed message for which a user desires retransmission”); ’946, 32:54–56 (“transmitting, only upon receipt of the indication, a signal requesting retransmission of said indicated portion of said message”). For these same reasons, the Court does not find that its constructions render redundant the above-cited claim language but, instead, finds them fully harmonious with these recitations—<i>i.e.</i>, there is no automatic request for retransmission by the mobile unit because the mobile unit allows for user selection. The constructions are also fully consistent with the specification. <i>See, e.g.</i>, ’946. 17:14–21 (“The user reads the message and determines whether the displayed message is acceptable. If not, the user can cause the system to retransmit the message, or the erroneous portions, by pressing request retransmission button 1622. By pressing button 1622, the user causes the transmit logic 1518 to transmit a signal to the base receivers indicating that the user wishes the message or a partial message to be retransmitted.”).</p> <p>The adoption of this construction does not in the Court’s view present the implications MTel suggests. <i>See</i> March 27, 2014 <i>Markman</i> Hr’g Tr. at 66 (“If the mobile unit can send automatic</p>
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				<p>messages, that's not important to infringement of the claim. What the mobile unit has to do, whether or not it can send automatic responses or request automatic retransmission, that's irrelevant to the claim. It's got to be able to allow user selection. That's the point."). The Court's construction is fully consistent with the point made by MTel's counsel—<i>i.e.</i>, the mobile unit <i>does not</i> automatically request retransmission of a received message when it contains an error <i>because</i> the device affords user selection. In so reasoning, the Court rejects BlackBerry's argument that the patentee disclaimed from claim scope mobile units that are capable of requesting retransmission of erroneous messages when the user selects that, and because it is inconsistent with its construction of these terms, the Court will not permit Blackberry to argue it in future proceedings.</p>
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Claim Term	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<i>a portion of the displayed message</i> ('946 Patent: Claims 1 and 8)	"a portion of the previously received and displayed message, rather than the entire displayed message"	"less than the entire message that is partially displayed"	"less than the entire displayed message"	At the July 17, 2014 <i>Markman</i> hearing, MTel revised its proposed construction for these terms indicated herein. Notably, MTel has abandoned its position that these terms must be construed to reflect that the retransmission could be of the entire message. <i>See</i> July 17, 2014 <i>Markman</i> Hrg. Tr. at 7–8 (counsel for MTel stating that the revised construction "does give up the ground that we were arguing for in this case in the briefing, that a portion could be some or all . . . we don't think it's worth fighting for."). MTel did not provide adequate support or explanation at the hearing for why these terms should be construed to be "less than the entire message <i>that is partially displayed</i> ," and the Court concludes that its construction accurately reflects the scope of these claim terms. <i>See Sprint Nextel Corp., et al.</i> , Nos. 2:12-CV-832, 2:13-CV-258, 2:13-CV-259, at *23–24 (E.D. Tex. May 2, 2014) (construing the term "a portion of the displayed message" to be "less than the entire displayed message," upon concluding that the specification and prosecution history both supported the finding that a "portion" is less than the entire message); <i>see also, e.g.</i> , '946, 17:8–17; BlackBerry Resp. Br., Ex. D. (1/11/96 Proposed Amendment Under 37 C.F.R. § 1.116) (patentee stating that "if the user is unable to understand the message, the user may elect to request retransmission of the portion
<i>a portion of a displayed message</i> ('946 Patent: Claim 7)	"a portion of a previously received and displayed message, rather than the entire displayed message"	"less than the entire message that is partially displayed"	"less than the entire displayed message"	
<i>a portion of the message</i> ('946 Patent: Claim 7)	"a portion of the previously received and displayed message, rather than the entire displayed message"	"less than the entire message that is partially displayed"	"less than the entire displayed message"	

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				containing the error” and that “the user can elect retransmission of only a portion of a message rather than the entire message.” ⁴
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>switch actuatable</i> (’946 Patent: Claim 1)	[AGREED]	[AGREED]	“a switch that requires user activation”	The Court adopts the parties’ agreed-upon construction.
<i>switch actuatable</i> (’946 Patent: Claim 7)	[AGREED]	[AGREED]	“a switch that requires user activation”	The Court adopts the parties’ agreed-upon construction.
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>mobile telephone paging call back device</i>	“A device with a two-way mobile telephone radio and a one-way pager radio”	No construction necessary.	“A device with a mobile telephone radio and pager radio”	Whether or not the Court concludes that the preamble of claim 8 is limiting, the Court must still construe the term, as it is recited in the body of claim 19.

⁴ The parties did not dispute the meaning of “retransmission”; however, the Court is mindful that its construction of “portion” will bear on the meaning of “retransmission” at summary judgment. Thus, the Court will proceed with the understanding that “retransmission” has its plain and ordinary meaning—to request a second transmission of all or part of what was originally transmitted, or *sent*. See ’946, 17:8–27.

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('862 Patent: Claim 8)				Preliminarily, the Court concludes that this term requires construction, because it is not a term having a readily apparent meaning in the art and there is a legitimate dispute as to its meaning.
<p><i>mobile paging telephone call back device</i></p> <p>('862 Patent: Claim 19)</p>	“A device with a two-way mobile telephone radio and a one-way pager radio”	<p>No construction necessary.</p> <p>In the alternative: “a call back device”</p>	“A device with a mobile telephone radio and pager radio”	<p>The crux of the parties’ dispute with respect to these terms is whether “paging” simply means data communication, as MTel argues, or whether it refers solely to a paging device, as BlackBerry argues. Apart from citing to excerpted testimony of BlackBerry’s expert, Dr. Wicker, without any meaningful explanation as to the relevancy of his testimony to the patent at hand, <i>see</i> MTel Resp. Br. at 2 n. 2, 4, MTel presented the Court with no actual evidence to support the proposition that “paging” is merely data communication.</p> <p>The Court concludes that, in the context of this patent, one of skill in the art would understand the “mobile paging telephone call back device” and “mobile telephone paging call back device”⁵ to refer to both a telephone and paging device. MTel’s alternative proposed construction will not be adopted because it reads the term “paging” entirely out of the claim language, and renders the terms “mobile,” “telephone,” and “paging” entirely superfluous.</p> <p>The ’862 patent consistently demonstrates that the mobile telephone paging call back device is not</p>

⁵ The parties agree that “mobile telephone paging call back device” and “mobile paging telephone call back device” have the same meaning. *See* BlackBerry Opening Br. at 5 n.2.

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				<p>simply a “call back device,” but a device that includes both a pager and a cellular telephone. The patent expressly distinguishes between the cellular telephone and paging receiver, going so far as to teach that they can be independently turned on and off. <i>See, e.g.</i>, Abstract; ’862, 1:16–22 (“Because cellular telephones often exhibit poor reception qualities and consume power quickly, however, cellular companies have begun to incorporate paging receivers into cellular telephones. With the paging receiver, the cellular telephone can be turned off, conserving battery life, while the paging receiver remains on monitoring for calls.”); ’862, 1:24–29 (“An example of a mobile paging telephone call back device is disclosed in commonly assigned U.S. Pat. No. Re. 33,417 (‘the ‘417 patent’) . . . the contents of which are hereby incorporated by reference.”); ’862, 1:30–37 (FIG. 1 is a block diagram of a mobile paging telephone call back device 10, as described in the ‘417 patent. The mobile paging telephone call back device 10 includes a control unit 12 connected to a radio pager 14, a memory 16, a radio telephone interface 18, control switches 20, and an indicator 22. The radio telephone interface 18 is also connected to an intelligent automatic dialer 24, which is in turn connected to a mobile radio telephone 26.”). ’862, 1:50–53 (“Mobile paging telephone devices, like call back device 10, greatly conserve the battery life of the cellular telephone, which, as described, can be turned-off, then turned-on when a page comes in.”).</p>
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				<p>The '417 patent, titled “Mobile paging call back system and related method,” and incorporated by reference into the '862 patent, similarly describes the device as containing both a pager receiver and cellular telephone. <i>See, e.g.</i>, '417, 1:12–15 (“The present invention relates to a paging call back system which permits telephone numbers received with a radio paging unit to be responded to using a mobile radio telephone.”); '417, 2:15–32 (“[A]n object of the present invention is to provide a single system which overcomes the disadvantages of not being able to respond to a page initiated through a radio paging system while the user is mobile, and not being able to use a mobile radio telephone system to collect and respond to incoming calls when the user of that system is not present upon receipt of such calls. An additional object of the present invention is to provide a system which permits a convenient and effective call back to a paging party through utilization of a mobile radio telephone system.”); '417, 3:41–47.</p> <p>The Court’s construction is also supported by Dr. Wicker’s testimony. <i>See</i> BlackBerry Opening Br., Ex. A (Dr. Wicker Decl.) at ¶¶ 47–49 (declaring that one of skill in the art would understand the '862 patent to refer to a “combination of a telephone and a pager receiver” and that, at the time of the invention, “paging and radio telephone technologies were not only distinct, but they were also practically orthogonal.”).</p>
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				<p>To the extent that MTel argues that the Court’s construction limits the invention to the disclosed prior art, the Court disagrees. The purpose of the ’862 patent was to improve on the prior art mobile telephone paging call back device of the ’417 patent, by “adding appropriate prefixes to received telephone numbers to permit automatic dialing of the telephone numbers by a mobile telephone device.” ’862, 1:10–13. As the patent makes clear, the device, a fundamental aspect of the invention, served as the baseline prior art on which this improvement was rendered. ’862, 2:10–48. Moreover, although MTel does not explain the import of Dr. Wicker’s testimony that “‘paging’ is the term for setting up phone calls,” <i>see</i> MTel’s Resp. Br. at 2 n.4, this testimony related to paging channels in the cellular context, which causes the phone to ring as part of call set up. <i>See id.</i> MTel provides absolutely no argument or evidence that either the ’862 patent, or the ’417 patent it incorporates by reference, would be understood to refer to “paging” in this sense.⁶ Indeed, the claim language itself would appear to reject such an argument. <i>See</i> ’862, 7:19–26 (“means for receiving a page message including a call back number; controlling means for determining an appropriate prefix to be added to</p>
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⁶ The same is true with respect to Dr. Wicker’s testimony relating to the “irregular use” of paging channels for the delivery of “some data messages.” *See* MTel Resp. Br., Ex. B (Wicker Dep. Tr.) at 129:17–24. While MTel did not cite this aspect of Wicker’s testimony in support of its claim construction arguments in its briefing, it did include it in its bound presentation to the Court at the March 27, 2014 *Markman* hearing, but again, did not explain or even reference this testimony when making its claim construction arguments.

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			<p>the call back number in accordance with the system identification number (SID); and means for displaying the call back number with the appropriate prefix”); ’862, 8:30–36 (“receiving an incoming message at the mobile paging telephone call back device; extracting a call back number from the received message; receiving a system identification number (SID) at the mobile paging telephone call back device; and determining an appropriate prefix for the call back number based on the SID”).</p> <p>In construing these terms, the Court will not limit the “paging radio” to being a one-way paging radio. While parts of the specification of the ’417 patent could support such a finding, <i>see</i> 1:22–23, the ’862 claim language does not recite that the paging aspect of the device is a one-way radio, and even Dr. Wicker testified that “[i]t’s certainly the case that by 1994 there were pagers that were capable of transmission.” MTel’s Resp. Br., Ex. B (Wicker Dep. Tr.) at 17.</p> <p>Finally, because the phrase “mobile telephone paging call back device” appears only in the preamble of claim 8, and the parties contest whether the preamble is limiting, the Court must determine whether the preamble imports a limitation to the claim. “A preamble is generally limiting if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.” <i>Proveris Scientific Corp. v. Innovasystems, Inc.</i>, 739 F.3d 1367, 1372 (Fed.</p>
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				<p>Cir. 2014) (internal citations and quotation marks omitted). The preamble may also limit the body of the claim where limitations in the body rely upon and derive antecedent basis from the preamble. <i>Id.</i></p> <p>Although the novel concept of the '862 patent may relate to the addition of appropriate prefixes to received telephone numbers to permit automatic dialing by the mobile telephone device, 1:8–13, the patent teaches that the mobile paging telephone call back device is a basic characteristic of the claimed invention. <i>See Poly-Am, LP v. GSE Lining Tech., Inc.</i>, 383 F.3d 1303, 1310 (Fed. Cir. 2004) (finding preamble limiting where it disclosed a “fundamental characteristic of the claimed invention”). For instance, the Background of the Invention and the Summary of the Invention state that “the present invention” is related and directed to mobile paging telephone call back systems and methods. '862, 1:8–9; 2:11–12. The specification also explains that “the present invention provides a mobile paging telephone call back device,” '862, 2:43–44, and discusses the transmission of pages to the “call back device of the present invention,” '862, 4:20–21. The patent is even titled, “Mobile Paging Telephone Call Back System and Method.” The Court, thus, finds that the preamble of claim 8 is limiting.</p>
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Claim Term	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>page message</i></p> <p>('862 Patent: Claims 8 and 19)</p>	<p>"a message sent in response to a sender dialing into the paging system central controller"</p>	<p>Claim 8: No construction necessary; plain and ordinary meaning.</p> <p>Claim 19: The term appears only in the preamble and is not a limitation / no construction necessary; plain and ordinary meaning.</p>	<p>No construction is necessary.</p>	<p>Whether or not the Court concludes that the preamble of claim 19 is limiting, the Court must still resolve the parties' dispute as to the meaning of this term, as it is recited in the body of claim 8.</p> <p>In light of the Court's construction of "mobile telephone paging call back device" and "mobile paging telephone call back device," the Court concludes that "page message," when read in the context of the claims, will be readily understood by a jury. Thus, no construction is necessary.</p> <p>Notwithstanding that the Court determines no construction of this term is necessary, the Court must still determine whether the preamble of claim 19 limits the claim scope, as "page message" appears only in the preamble of the claim. The Court concludes that it does. As noted above, a preamble imports a limitation into a claim when it is necessary to give meaning to the claim. <i>See Proveris</i>, 739 F.3d at 1372. Here, the claim is directed to "[a] method of receiving a page message containing a call back number on a mobile paging telephone call back device" '862, 8:27–29. The "incoming message" is the only message recited in the body of claim 19 that is received at the mobile paging telephone device. '862, 8:30–32. Thus, "page message," as recited in the preamble, is necessary to give meaning to "incoming message," in that it necessarily</p>

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				demonstrates that the “incoming message” is the “page message.”
<i>incoming message</i> (’862 Patent: Claim 19)	“page message”	No construction necessary; plain and ordinary meaning.	“page message”	The Court construes “incoming message” as “page message” for the same reasons given by the Court in finding the preamble of claim 19 limiting with respect to the term “page message.”
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>appropriate prefix</i> (’862 Patent: Claims 8 and 19)	[AGREED]	[AGREED]	“a prefix necessary to complete a call”	The Court adopts the parties’ agreed-upon construction.

Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>caller</i> (’862 Patent: Claim 1)	“a person who made a telephone call”	No construction necessary; plain and ordinary meaning. In the alternative: “the originator of a message”	“a person who places a telephone call, by whatever means”	MTel argues that the term “caller” requires no construction. Ordinarily, the Court would agree, except here MTel posits that a “caller” is merely an originator of any message—meaning that a message from a “caller,” as recited in claim 1, could include, for instance, an email or a text message. This is consistent with MTel’s alternative proposed construction that a caller is simply “the originator of a message.” MTel’s understanding is wholly divorced from the claim

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				<p>language and the specification, and to embrace it would read the term “caller” entirely out of the claim.</p> <p>The claim language, itself, teaches that a “caller” is an individual who places a call, because it expressly recites terms associated with the making of calls, such as area code and call back number. <i>See</i> ’862, 6:38–52. The fact that the body of claim 1 recites “receiving a message from a caller,” ’862, 6:38, does not mean that “caller” is necessarily modified as a result, and the patent does not support such a reading of the claim. The specification confirms the fact that a “caller” makes a telephone call. <i>See, e.g.,</i> ’862, 1:39–43 (“a caller wishing to reach a subscriber . . . calls a paging station . . . leaves a call back telephone number, and, typically, hangs up.”); ’862, 2:17–29 (“[T]he present invention provides . . . a method of transmitting a page message containing a call back number, comprising the steps of receiving a message from a caller”); ’862, 2:30–42 (“[T]he present invention provides a method of receiving a page message containing a call back number on a mobile paging device); ’862, 4:59–5:2 (“[A] caller (or paging party) wishing to page a subscriber dials into paging system central control . . . the telephone carrier handling the call automatically supplies to the paging system central controller 70 the ANI, preferably identifying at least the area code from which the caller is calling”).</p>
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				<p>The Court does not find, however, the patent to require that the “telephone call” be made by use of a telephone, such that “caller” would exclude one who otherwise places a call using a computer, the internet, or some other means; nor is this point disputed by BlackBerry.⁷ <i>See</i> July 17, 2014 <i>Markman</i> Hr’g Tr. at 7–8.</p> <p>Because the Court concludes that the intrinsic evidence fully and clearly demonstrates that a “caller” is an originator of a telephone call, the Court does not afford weight to MTel’s less significant, less reliable extrinsic evidence in determining the legally operative meaning of this term. <i>See Phillips</i>, 415 F.3d at 1317–18.</p> <p>The Court, thus, construes the term as indicated above.</p>
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>area code</i> (’862 Patent: Claim 1)	“a three-digit prefix of a telephone number that identifies a particular geographic region within a country or group of countries”	No construction necessary; plain and ordinary meaning. In the alternative: “prefix used to	“a prefix of a telephone number that identifies a particular geographic region within a country or group of countries”	MTel clarified at the July 17 <i>Markman</i> hearing that it was not arguing “area code” to be coextensive with a prefix. <i>See</i> July 17, 2014 <i>Markman</i> Hr’g Tr. at 20. Rather, it argued that, should construction be necessary, the “area code” “should relate to some area,” although not necessarily to the “universe of known or disclosed

⁷ *See* July 17, 2014 *Markman* Hr’g Tr. at 45–46 (“Mr. Pankratz: [N]othing in the patent tells us that they’re using this term ‘caller’ to be anything other than what you and I or anyone would understand it to be, which is a person who placed a call. The Court: Okay. But not necessarily with a telephone? Mr. Pankratz: Are you referring to a computer? The Court: Yes. Mr. Pankratz: [W]e’re not trying to exclude that. That is encompassed within the definition that we proposed. That’s a call. . . . I consider Skype . . . a call.”).

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		<p>return a message to the caller”</p>	<p>ways that area codes were organized at the time of the patent.” <i>Id.</i> at 31.</p> <p>The Court finds construction of this term necessary, because there is a legitimate dispute as to its meaning, and so construes the term as indicated above.</p> <p>Other than demonstrating that an “area code” is a type of prefix that may be required to complete return telephone calls, the patent is otherwise largely unhelpful in revealing the meaning a person of ordinary skill in the art would ascribe to the term. The patent states that an “area code” may be necessary to complete a return call “where dialing plans require a prefix, such as an area code, to complete even local calls.” ’862, 1:65–67. The problem with prior art mobile paging telephone devices was that they often could not “complete the call back because the call back telephone number lack[ed] the appropriate prefix, such as an area code or a “1,” necessary to complete the return call.” ’862, 1:55–57. This is consistent with the patent’s prosecution history. <i>See</i> BlackBerry Op. Br., Ex. O (’862 Patent 8/8/1996 PTO Interview Summary) (“The examiner was associating an area code with the claim language ‘appropriate prefix’, which as pointed out by [applicant’s attorney], is not exactly correct. For example, in the Southern Maryland, Washington D.C., Northern Virginia area, you do not have to dial a one [<i>sic</i>] “1”, just the area code to be reached.”). Although BlackBerry argues that the “1” represents the United States country code, the</p>
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				<p>evidence it submits on claim construction demonstrates that the “1” can also be the prefix required to dial a toll call. <i>See</i> BlackBerry Op. Br., Ex. M (Numbering and Dialing Plan Within the United States December 2008, Alliance for Telecommunications Industry Solutions) at 71, 76.</p> <p>As noted above, technical dictionaries may be of assistance to the Court on claim construction where the intrinsic evidence does not conclusively establish a term’s meaning. <i>See Phillips</i>, 415 F.3d at 1318. Technical dictionaries confirm that one of ordinary skill in the art would understand an “area code” to refer to a prefix of a telephone number identifying a particular geographic region within a country or group of countries. <i>See</i> BlackBerry Op. Br., Ex. D, <i>Dictionary of Telecommunications</i> 8 (Revised ed. 1991) (defining “area code” as “a three-digit number identifying geographical areas of the United States and its territories and Canada, the area code is part of the 10-digit numbering plan for placing telephone calls”); BlackBerry Op. Br., Ex. E, <i>IBM Dictionary of Computing</i> (10th ed. 1994) (defining “area code” as “[a] three-digit number that identifies a geographic area of the USA or Canada to permit direct distance dialing on the telephone system.”). Even the declaration of MTel’s expert, Dr. Nettleton, confirms the Court’s understanding. <i>See</i> MTel Op. Br., Ex. 3 (Nettleton Decl.) at 10–11 (“To call my friends in the United Kingdom . . . I must dial 01144 or +44 <i>followed by</i> the three-digit UK <i>area code</i> before dialing my friends’ number.</p>
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				<p>The UK certainly qualifies as a ‘geographic region within a . . . group of countries.’).</p> <p>In construing the term “area code” to identify a particular geographic region within a country or group of countries, the Court rejects the limitation that the prefix must be three-digits. This is so, because the patent contemplates that non-North American Numbering Plan (which utilizes a three-digit area code) call back numbers can be used, and because dependent claims recite the use of the World Numbering Plan⁸ in connection with the dialable telephone number. <i>See</i> ’862, 3:46–49 (“DTNE application 34 recognizes dialable telephone numbers according to acceptable telephone number formats, such as the North American Numbering Plan and the World Numbering Plan.”); ’862, 6:59–61 (“A method according to claim 1, wherein a dialable telephone number is determined according to the World Numbering Plan.”).</p>
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>canned message</i>	“a predefined, commonly-used phrase”	“a predefined message”	“a predefined phrase” ⁹	The parties agree that a canned message is “predefined.” The crux of the parties’ dispute is whether the “canned message” must be a

⁸ Although the patent does not define “World Numbering Plan,” and neither party presented evidence as to what the World Numbering Plan may or may not be, the patent makes clear that it is an alternative to the North American Numbering Plan.

⁹ The Court is aware that Judge Payne construed this term to be “predefined sequence of characters.” *See Sprint Nextel Corp., et al.*, Nos. 2:12-CV-832, 2:13-CV-258, 2:13-CV-259, at *65–71 (E.D. Tex. May 2, 2014). However, the Court finds that construing this

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<p>(’506 Patent: Claims 8 and 21)</p>				<p>commonly used phrase. The Court concludes that it does not.</p> <p>Although the specification may state that “commonly used phrases can be treated as ‘canned’ messages,” ’506, 1:46–49, nothing in the patent supports the view that canned messages must be commonly used phrases, and such a construction would provide no standard against which “commonly used” could, or should, be measured. Adopting such a construction, as MTel correctly argues, would necessarily imply that canned messages are static and cannot change. The patent, however, refutes any such suggestion, teaching that canned messages may be “updated” and “customized” to the needs of particular subscribers. <i>See</i> ’506, 2:1–6; <i>see also</i> ’506, Fig. 6.</p> <p>The Court, therefore, construes “canned message” as indicated above, and rejects inclusion of the narrowing limitation that canned messages must be “commonly-used” phrases. To the extent that BlackBerry is concerned that MTel may argue this construction also covers message codes, the Court notes that the claim language itself—as well as the specification—distinguishes between “canned messages” and “message codes,” and the Court, therefore, will not permit MTel to argue that they are one and the same.</p>
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term as a “phrase,” rather than a “sequence of characters,” is consistent with the specification, which describes canned messages as statements and questions. *See* ’506, 1:45–46; 4:16; 5:4–5.

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				Finally, the Court notes that its construction of “message” as a “phrase” is consistent with the specification, which teaches that a “message” is a “phrase,” and not a single character. <i>See</i> ’506, 1:44–49; 4:5; 4:56–57, 5:24–25.
Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>selecting an appropriate canned message</i> (’506 Patent: Claim 8)	[AGREED]	[AGREED]	“selecting one of the canned messages based on user preference”	The Court adopts the parties’ agreed-upon construction.

Claim Term	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>multiple response options</i> (’506 Patent: Claim 21)	“predefined responses to a canned message”	“responses to a canned message”	“predefined responses to a canned message”	<p>While the specification may teach that “multiple response options” may or may not be predefined, <i>see e.g.</i>, ’506, 2:20–27, the body of claim 21 demonstrates that one of ordinary skill in the art would understand this term, as used therein, to refer to responses that are predefined.</p> <p>The claim recites a message terminal comprising “a memory storing . . . a file of canned multiple response options and response codes respectively assigned thereto,” a “means . . . for selecting multiple response options” and the use of a</p>

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				<p>“message compiler for compiling . . . the response codes assigned to the selected multiple response options.” ’506, 12:34–56. Thus, in order for the “message compiler” to compile the response codes, the “multiple response options” must be the “canned multiple response options” recited in the first element of the claim body that are assigned response codes. This is confirmed by the specification, which teaches that “multiple response options” that are also “canned responses” have assigned to them “response codes” that are treated similarly to message codes. ’506, 2:23–27.</p> <p>The Court, thus, construes the term as indicated above.</p>
<p><i>canned multiple response options</i></p> <p>(’506 Patent: Claim 21)</p>	[AGREED]	[AGREED]	<p>“predefined responses to a canned message”</p>	<p>The Court adopts the parties’ agreed-upon construction.</p>

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Claim Term	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>determining whether failure of the mobile transceiver to receive the message transmitted in step (a) is likely caused by the mobile unit being located in a weak signal area within a zone</i></p> <p>('804 Patent: Claim 10)</p>	Indefinite.	<p>No construction necessary; plain and ordinary meaning.</p> <p>In the alternative: determine whether failure of the mobile transceiver to receive the transmitted message is likely caused by a weak signal provided to the mobile unit</p>	No construction necessary.	<p>BlackBerry moves the Court to invalidate claim 10 for indefiniteness, arguing that the intrinsic evidence fails to inform a person of ordinary skill in the art of the scope of the invention claimed with reasonable certainty. Specifically, BlackBerry claims that neither the patent, nor the prosecution history, adequately explains the scope of the terms “likely” and “weak.”</p> <p>As the Court previously stated at the <i>Markman</i> hearings, if the Court determines that no construction of a term is necessary, or finds that it is able to construe a disputed term, it will resolve questions of indefiniteness on a motion to find the claim term indefinite.</p> <p>The Court will apply the plain and ordinary meaning of this claim language on the assumption it would be readily apparent to one of ordinary skill in the art. BlackBerry may move for summary judgment or a dismissal for indefiniteness.</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for transmitting messages to the mobile unit</i></p> <p>('428 Patent: Claim 1)</p>	<p>“transmitting messages to the mobile unit”</p>	<p>Indefinite (The patent does not disclose sufficient corresponding structure)</p>	<p>message transmitting unit 108, and equivalents (pursuant to 35 U.S.C. § 112)</p>	<p>message transmitting unit 108, and equivalents</p>	<p>BlackBerry proposes no competing construction of this term, and does not dispute that the specification links message transmitting unit 108 to the recited function. Rather, BlackBerry argues that such disclosure is insufficient and the claim is indefinite, because message transmitting unit 108 is merely a “black box” that does nothing more than restate the function of transmitting.</p> <p>As the Court previously stated at the <i>Markman</i> hearings, if the Court finds that it is able to determine that the patent discloses corresponding structure, it will resolve questions of indefiniteness on a motion to find the claim term indefinite.</p> <p>The Court finds that the specification discloses message transmitting unit 108 as corresponding structure. <i>See</i> '428, 7:15–29 (describing that the network operations center “transmits a current data message through message transmitting unit 108 to the last known location of a corresponding mobile unit . . .”). The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p>

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					<p>The Court will apply the plain and ordinary meaning of this claim language on the assumption it would be readily apparent to one of ordinary skill in the art. BlackBerry may move for summary judgment or a dismissal for indefiniteness.</p>
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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for receiving acknowledgment messages from the mobile unit</i></p> <p>('428 Patent: Claim 1)</p>	<p>“receiving acknowledgment messages from the mobile unit”</p>	<p>Indefinite (The patent does not disclose sufficient corresponding structure)</p>	<p>message receiving unit 104, and equivalents (pursuant to 35 U.S.C. § 112)</p>	<p>message receiving unit 104, and equivalents</p>	<p>BlackBerry proposes no competing construction of this term, and does not dispute that the specification links message receiving unit 104 to the recited function. Rather, BlackBerry argues that such disclosure is insufficient and the claim is indefinite, because message receiving unit 104 is merely a “black box” that does nothing more than restate the function of receiving. The parties agree on the recited function.</p> <p>As the Court previously stated at the <i>Markman</i> hearings, if the Court finds that it is able to determine that the patent discloses corresponding structure, it will resolve questions of indefiniteness on a motion to find the claim term indefinite.</p> <p>The Court finds that the specification does link message receiving unit 104 to the recited function. <i>See, e.g.,</i> '428, 3:57–61 (teaching that</p>

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					<p>“[m]essage receiving unit 104 receives messages,” including data messages, acknowledgment messages, and registration messages). The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p> <p>The Court will apply the plain and ordinary meaning of this claim language on the assumption it would be readily apparent to one of ordinary skill in the art. BlackBerry may move for summary judgment or a dismissal for indefiniteness.</p>
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Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>means for determining whether an acknowledgment message is an acknowledgment to a data message or an acknowledgment to a probe message</i>	“determining whether an acknowledgment message is an acknowledgment to a data message or an acknowledgment to a probe message”	Indefinite (The patent does not disclose sufficient corresponding structure)	acknowledgment message processing (AMP) module 310, and equivalents (pursuant to 35 U.S.C. § 112)	acknowledgment message processing (AMP) module 310, and equivalents, and the algorithm recited at ’428, 5:24–34.	BlackBerry proposes no competing construction of this term, and does not dispute that the specification links AMP 310 to the recited function. Rather, BlackBerry claims that the specification fails to disclose an algorithm for performing the recited function, thus rendering claim 1 invalid. Therefore, BlackBerry argues that the AMP module is nothing more than a “black box” that reiterates the function recited in the claim. The parties agree on the recited function.

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<p>(’428 Patent: Claim 1)</p>				<p>The Court concludes that AMP 310 is corresponding structure. <i>See</i> ’428, 5:24–27 (“[a]s AMP module 310 receives an acknowledgment message from MTD module 302, it first determines whether the message is a data acknowledgment message or a probe acknowledgment message.”). Notwithstanding that MTel argued in its briefing that the corresponding structure for this claim element included a processor, <i>see</i> MTel Op. Br. at 30–31, MTel argued otherwise at the March 27, 2014 <i>Markman</i> hearing. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p> <p>The Court concludes that, as MTel originally conceded, that the AMP module 310 is computer implemented, <i>see, e.g.</i>, ’428, 4:61–5:3; 5:59–67, and, as discussed below, that the <i>Katz</i> exception does not apply.</p> <p>“In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” <i>WMS Gaming, Inc. v. Int’l Game Tech.</i>, 184 F.3d 1339, 1349 (Fed. Cir. 1999). In <i>In re Katz Interactive Call Processing Patent Litigation</i>, the Federal Circuit identified a narrow exception to this</p>
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				<p>requirement for those situations where the function “can be achieved by any general purpose computer without special programming.” 639 F.3d 1303, 1316 (Fed. Cir. 2011); <i>see id.</i> at 1316 n.11 (holding that “[a]bsent a possible narrower construction” of the terms ‘processing,’ ‘receiving,’ and ‘storing,’” the disclosure of a general-purpose computer was sufficient). By contrast, where the function requires “more than merely plugging in a general-purpose computer,” special programming is required. <i>Ergo Licensing, LLC v. CareFusion 303, Inc.</i>, 673 F.3d 1361, 1366 (Fed. Cir. 2012). Thus, if special programming is required for the general purpose computer to perform the recited function, then disclosure of an algorithm is required.</p> <p>Although MTel argues that any general purpose computer could accomplish the “determining means” function, it acknowledges that a novel aspect of the invention claimed by the ’428 patent was the fact that it could distinguish, unlike the prior art, between a data acknowledgment message and a probe acknowledgment message. The Court does not find that the “determining” function, as recited herein, is simply akin to “processing” and “storing.” Thus, an algorithm must be disclosed as corresponding structure. “The specification can express the algorithm in any understandable terms including as a</p>
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					<p>mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.” <i>Function Media, LLC v. Google, Inc.</i>, 708 F.3d 1310, 1318 (Fed. Cir. 2013) (internal citation and quotation marks omitted). MTel argues that the ’428 patent provides an “if-then-else” algorithm, <i>see</i> ’428, 5:24–34, which BlackBerry disputes as sufficient, claiming that it does not explain how the “determining” function is performed.</p> <p>For the reasons already given, the Court believes that any indefiniteness challenge should be resolved on a future motion and, thus, assumes for purposes of construing this means-plus-function element that the language argued by MTel as constituting a sufficiently detailed algorithm provides the necessary structure for the recited function, subject to future indefiniteness challenge.</p>
Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>means for transmitting a probe message to the mobile unit if, after transmitting a data message to the mobile unit, no data</i>	“transmitting a probe message to the mobile unit if, after transmitting a data message to the mobile unit, no data	Indefinite (The patent does not disclose sufficient corresponding structure)	message transmitting unit 108, and equivalents (pursuant to 35 U.S.C. § 112)	message transmitting unit 108, and equivalents	BlackBerry proposes no competing construction of this term, and does not dispute that the specification links message transmitting unit 108 to the recited function. Rather, BlackBerry argues that such disclosure is insufficient and the claim is indefinite, because message transmitting unit 108 is merely a “black box” that does nothing more than restate

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<p><i>acknowledgment is received</i></p> <p>(’428 Patent: Claim 1)</p>	<p>acknowledgment is received”</p>				<p>the function of transmitting. The parties agree on the recited function.</p> <p>As the Court previously stated at the <i>Markman</i> hearings, if the Court finds that it is able to determine that the patent discloses corresponding structure, it will resolve questions of indefiniteness on a motion to find the claim term indefinite.</p> <p>The Court finds that the specification does link message transmitting unit 108 to the recited function. <i>See</i> ’428, 7:30–48 (teaching that “[i]f no data acknowledgment message is received . . . [probe message generation] module 312 transmits a probe message through message transmitting unit 108 to the corresponding mobile unit . . .”). The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p> <p>For the reasons already given, the Court believes that any indefiniteness challenge should be resolved on a future motion and, thus, assumes for purposes of construing this means-plus-function element that the language argued by MTel as constituting a sufficiently detailed algorithm provides the necessary structure for the recited function, subject to future indefiniteness challenge.</p>
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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for marking a data message as undelivered and storing the undelivered data message if, after transmitting a probe message to the mobile unit, no probe acknowledgment message is received</i></p> <p>('428 Patent: Claim 1)</p>	<p>“marking a data message as undelivered and storing the undelivered data message if, after transmitting a probe message to the mobile unit, no probe acknowledgment message is received”</p>	<p>Indefinite (The patent does not disclose sufficient corresponding structure)</p>	<p>undelivered data message processing module 314, and equivalents (pursuant to 35 U.S.C. § 112)</p>	<p>undelivered data message processing module 314, and equivalents, and algorithms shown in schematic form in '428, Fig. 6 and '946, Fig. 21.</p>	<p>BlackBerry proposes no competing construction of this term, and does not dispute that the specification links UDMP module 314 to the recited function. Rather, BlackBerry claims that the specification fails to disclose an algorithm for performing the recited function, thus rendering claim 1 invalid. Thus, BlackBerry argues that the specification discloses the UDMP module as nothing more than a “black box” that reiterates the function recited in the claim. The parties agree on the recited function.</p> <p>The Court concludes that UDMP 314 is disclosed by the specification as performing the recited function. <i>See</i> '428, 4:61–5:3; 5:50–53; 7:49–57. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p> <p>The Court further concludes that the “means for marking” limitation is computer implemented, <i>see</i> '428, 4:61–5:3; 5:59–65, and that it does not implicate the <i>Katz</i> exception—<i>i.e.</i>, it cannot be accomplished by merely “plugging in” a computer. Thus, the question to be resolved by the Court is whether the specification discloses an algorithm for performing the function.</p>

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				<p>The Court notes that MTel argues that disclosures in the '946 patent (incorporated by reference into the '428 patent), which do not appear in the '428 patent, can provide structure for this means-plus-function element. The Court disagrees because “material incorporated by reference cannot provide the corresponding structure necessary to satisfy the definiteness requirement for a means-plus-function clause.” <i>See Default Proof Credit Card Systems, Incorporated v. Home Depot U.S.A., Incorporated</i>, 412 F.3d 1291 (Fed. Cir. 2005); <i>see also</i>. <i>Mobile Telecommunications Technologies, LLC v. Amazon.com, Inc.</i>, No. 2:13-CV-883-JRG-RSP, 2014 WL 5766050, at *28 (E.D. Tex. Nov. 5, 2014) (Payne, J.) (citing <i>Default Proof</i>, 412 F.3d at 1301).</p> <p>To the extent MTel relies on <i>Otto Bock HealthCare LP v. Ossur HF</i> to distinguish <i>Default Proof</i>, the Court finds <i>Otto Bock</i> distinguishable because the parties in that case did not dispute whether the specification of the patent-in-suit disclosed a corresponding structure for the claimed function. <i>See Otto Bock HealthCare LP</i>, 557 Fed. App'x 950, 955–56 (Fed. Cir. Feb. 18, 2014) (unpublished). Rather, the parties disputed the scope of the corresponding structure. <i>Id.</i></p> <p>MTel also argues that Fig. 6, described in the '428 patent, and Fig. 21 of the '946 patent,</p>
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					<p>illustrate algorithms as corresponding structure for the “means for marking” limitation. BlackBerry argues that Fig. 6 of the ’428 patent is insufficient corresponding structure, because it fails to describe how the recited function is performed, and that MTel cannot rely on the ’946 patent to identify an algorithm. For the reasons already stated, the Court agrees in part with BlackBerry and finds that Fig. 21 of the ’946 Patent cannot provide corresponding structure. <i>See Default Proof</i>, 412 F.3d at 1301. Thus, the Court will limit its indefiniteness inquiry to Fig. 6 of the ’428 Patent.</p> <p>For the reasons already given, the Court believes that any indefiniteness challenge should be resolved on a future motion and, thus, assumes for purposes of construing this means-plus-function element that the language argued by MTel as constituting a sufficiently detailed algorithm provides the necessary structure for the recited function, subject to future indefiniteness challenge.</p>
Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>means for receiving data and probe messages from the network</i>	“receiving data and probe messages from the network	[AGREED subject to inclusion of “equivalents” in identification	[AGREED subject to inclusion of “equivalents” in identification of	receiver 204, and equivalents	The parties agree on the recited function and corresponding structure. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.

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<i>operations center</i> (’428 Patent: Claim 4)	operations center”	of corresponding structure].	corresponding structure].		
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Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>means for generating, upon receiving a data message, a data acknowledgment message, said data acknowledgment message being transmitted by said transmitter</i> (’428 Patent: Claim 4)	“generating, upon receiving a data message, a data acknowledgment message, said data acknowledgment message being transmitted by said transmitter”	Indefinite (The patent does not disclose sufficient corresponding structure)	acknowledgment message generating module 402, and equivalents (pursuant to 35 U.S.C. § 112)	acknowledgment message generating module 402, and equivalents, and the algorithm recited at 428, 6:13-21 and 6:36-40	<p>BlackBerry proposes no competing construction of this term, and does not dispute that the specification links AMG module 402 to the recited function. Rather, BlackBerry claims that the specification fails to disclose an algorithm for performing the recited function, thus rendering claim 4 invalid. Thus, BlackBerry argues that the specification discloses the AMG module as nothing more than a “black box” that reiterates the function recited in the claim. The parties agree on the recited function.</p> <p>The Court concludes that AMG module 402 is disclosed by the specification as performing the recited function. <i>See</i> ’428, 6:4–7; 6:15–19; 6:37-41. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p> <p>The Court further concludes that this means limitation is computer implemented, <i>see</i> ’428,</p>

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				<p>6:4–11; 6:49–57, and that it does not fall under the <i>Katz</i> exception—<i>i.e.</i>, it cannot be accomplished by merely “plugging in” a computer. Thus, the question to be resolved by the Court is whether the specification discloses an algorithm for performing the function.</p> <p>Although BlackBerry cites to a statement from MTel’s expert, Dr. Nettleton, to argue that the patent does not disclose any “discernible algorithm for the function of ‘generate a message,’” <i>see</i> Am. Nettleton Rep. at 42, BlackBerry neglects to acknowledge that Dr. Nettleton further stated “the multiple flowcharts and extended discussions in the ‘428 Patent . . . are more than enough to inform a person having ordinary skill in the art how to perform each function” to the extent an algorithm would be required, <i>see id.</i></p> <p>MTel argues that the specification identifies the algorithm for this means-plus-function element at 6:43–21 and 6:36–40. Again, BlackBerry argues that, because the specification does not explain how the generating function is performed, no algorithm is disclosed.</p> <p>For the reasons already given, the Court believes that any indefiniteness challenge should be resolved on a future motion and, thus, assumes for purposes of construing this means-plus-function element that the language argued by MTel as constituting a sufficiently</p>
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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for generating, upon receiving a probe message, a probe acknowledgment message, said probe acknowledgment message being transmitted by said transmitter</i></p> <p>('428 Patent: Claim 4)</p>	<p>“generating, upon receiving a probe message, a probe acknowledgment message, said probe acknowledgment message being transmitted by said transmitter”</p>	<p>Indefinite (The patent does not disclose sufficient corresponding structure)</p>	<p>acknowledgment message generating module 402, and equivalents (pursuant to 35 U.S.C. § 112)</p>	<p>acknowledgment message generating module 402, and equivalents, and the algorithm recited at '428, 6:13–21 and 6:27–35</p>	<p>detailed algorithm provides the necessary structure for the recited function, subject to future indefiniteness challenge.</p> <p>BlackBerry proposes no competing construction of this term, and does not dispute that the specification links AMG module 402 to the recited function. Rather, BlackBerry claims that the specification fails to disclose an algorithm for performing the recited function, thus rendering claim 4 invalid. Thus, BlackBerry argues that the specification discloses the AMG module as nothing more than a “black box” that reiterates the function recited in the claim. The parties agree on the recited function.</p> <p>The Court concludes that AMG module 402 is disclosed by the specification as performing the recited function. <i>See</i> '428, 6:4–7; 6:37–41. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p> <p>The Court further concludes that this means limitation is computer implemented, <i>see</i> '428, 6:4–11; 6:49–57, and that it does not fall under the <i>Katz</i> exception—<i>i.e.</i>, it cannot be accomplished by merely “plugging in” a</p>

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					<p>computer. Thus, the question to be resolved by the Court is whether the specification discloses an algorithm for performing the function.</p> <p>MTel argues that the specification identifies the algorithm for this means-plus-function element at 6:14–21 and 6:27–35. As with the prior “means for generating” element, BlackBerry argues that, because the specification does not explain how the generating function is performed, no algorithm is disclosed.</p> <p>For the reasons already given, the Court believes that any indefiniteness challenge should be resolved on a future motion and, thus, assumes for purposes of construing this means-plus-function element that the language argued by MTel as constituting a sufficiently detailed algorithm provides the necessary structure for the recited function, subject to future indefiniteness challenge.</p>
Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<p><i>means for powering the transmitter on and off</i> (’428 Patent: Claim 4)</p>	<p>“powering the transmitter on and off”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>transmitter power switch 504, and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for determining whether a probe message has been received while said transmitter was powered off</i></p> <p>('428 Patent: Claim 4)</p>	<p>“determining whether a probe message has been received while said transmitter was powered off”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure, and algorithm as corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure, and algorithm as corresponding structure].</p>	<p>registration message generation module 404 or probe message processing module 410, and equivalents, and the algorithm: “check memory for control information indicating that the mobile unit has received a probe message when the transmitter is powered off.”</p>	<p>The parties agree on the recited function and the corresponding structure. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p> <p>The parties’ disagreement centers on whether: (1) an algorithm is required; and (2) “and equivalents” should be included in the Court’s construction. If the Court determines that an algorithm is corresponding structure, the parties agree that the algorithm is: “registration message generation module 404 or probe message processing module 410, and the algorithm: check memory for control information indicating that the mobile unit has received a probe message when the transmitter is powered off.” Left to be resolved, then, is whether the algorithm must be disclosed as corresponding structure.</p> <p>MTel argues that an algorithm is not required as corresponding structure, because the RMG Module 404 functions as a general purpose computer—<i>i.e.</i>, MTel argues that the <i>Katz</i> exception is applicable. <i>See also</i> MTel Op. Br. at 30 (“Thus, the ‘means for determining’ of</p>

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					<p>Claims 1 and 4 are definite structure: a processor.”).</p> <p>The Court concludes that the ’428 patent requires a special purpose computer specifically programmed to perform the recited function. The specification discloses that RMG module 404 comprises software and microcode, and any hardware necessary to effect the execution of that software and microcode, and may alternatively be implemented in electronic logic circuitry. ’428, 6:49–57. The specification teaches that when transmitter 202 is turned on, RMG module 404 checks memory 212 for an indication that a probe message has been received when transmitter 202 is off. 428, 6:42-46; 9:1-3. The recited function, thus, requires more than simply plugging in a general purpose computer, and so the Court concludes that disclosure of the agreed upon algorithm is required as part of corresponding structure.</p>
Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>means for generating, upon power restoration to the transmitter, a registration message if a probe message has been</i>	“generating, upon power restoration to the transmitter, a registration message if a probe message has been received while	Indefinite (The patent does not disclose sufficient corresponding structure)	registration message generation module 404, and equivalents (pursuant to 35 U.S.C. § 112)	registration message generation module 404, and equivalents, and the algorithm recited at ’428, 6:42–48	BlackBerry proposes no competing construction of this term, and does not dispute that the specification links RMG module 404 to the recited function. Rather, BlackBerry claims that the specification fails to disclose an algorithm for performing the recited function, thus rendering claim 4 invalid. Thus, BlackBerry argues that the specification discloses the RMG module as nothing more

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<p><i>received while the transmitter was powered off, said registration message being transmitted by said transmitter</i></p> <p>(’428 Patent: Claim 4)</p>	<p>the transmitter was powered off, said registration message being transmitted by said transmitter”</p>				<p>than a “black box” that reiterates the function recited in the claim. The parties agree on the recited function.</p> <p>The Court concludes that RMG module 404 is disclosed by the specification as performing the recited function. <i>See</i> ’428, 6:4–8; 6:42–48. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p> <p>The Court further concludes that this means limitation is computer implemented, <i>see</i> ’428, 6:4–11; 6:49–57, and that it does not fall under the <i>Katz</i> exception—<i>i.e.</i>, it cannot be accomplished by merely “plugging in” a computer. Thus, the question to be resolved by the Court is whether the specification discloses an algorithm for performing the function.</p> <p>MTel argues that the specification identifies the algorithm for this means-plus-function element at 6:42–48.¹⁰ As with the other “means for generating” elements, BlackBerry argues that, because the specification merely restates the claimed function, no algorithm is disclosed.</p> <p>For the reasons already given, the Court believes that any indefiniteness challenge</p>
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¹⁰ MTel mistakenly cites this portion of the specification in its opening brief as 6:42–58. It confirms in its Response that the correct citation is ’428, 6:42–48.

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					should be resolved on a future motion and, thus, assumes for purposes of construing this means-plus-function element that the language argued by MTel as constituting a sufficiently detailed algorithm provides the necessary structure for the recited function, subject to future indefiniteness challenge.
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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<i>means for receiving a radio frequency message from the network</i> (’946 Patent: Claim 1)	“receiving a radio frequency message from the network”	[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].	[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].	receiver 1506 or receiver 1706, and equivalents	The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.
Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<i>means for transmitting, only upon actuation of the switch, a signal to the communications</i>	“transmitting, only upon actuation of the switch, a signal to the communications network	Indefinite (The patent does not disclose sufficient	transmitter 1520, and equivalents (pursuant to 35 U.S.C. § 112)	transmitter 1520, and equivalents	BlackBerry argues that this claim term is indefinite. BlackBerry’s indefiniteness argument turns on its contention that the corresponding structure clearly linked to the

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<p><i>network requesting retransmission of said specified portion of said message</i></p> <p>(’946 Patent: Claim 1)</p>	<p>requesting retransmission of said specified portion of said message”</p>	<p>corresponding structure)</p>			<p>recited function is transmit logic 1518,¹¹ not transmitter 1520, and the patent fails to describe any corresponding algorithm by which transmit logic 1518 performs the recited function. The parties agree on the recited function.</p> <p>The Court finds that the corresponding structure is transmitter 1520, and that one of ordinary skill in the art would find that the specification clearly links transmitter 1520 to the recited “means for transmitting” function.</p> <p>BlackBerry argues that transmit logic 1518 is corresponding structure because the specification states that, upon receipt of an erroneous message, a user may actuate request retransmission button 1622. By doing so, “the user causes transmit logic 1518 to transmit a signal to the base receivers indicating that the user wishes the message or partial message to be retransmitted.” ’946, 17:8–21. The mobile unit then receives the retransmitted message upon transmission by the base transmitters. ’946, 17:21–23.</p> <p>A complete reading of the specification, however, demonstrates that transmit logic 1518</p>
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¹¹ BlackBerry mistakenly refers to “transmit logic 1518” as “transmit logic 1520” in its responsive *Markman* brief. Because BlackBerry referred to “transmit logic 18” in its opening brief when arguing that this claim element was indefinite, and because the patent recites a transmitter 1520 and transmit logic 1518, the Court understands BlackBerry to be arguing that “transmit logic 1518” is the corresponding structure disclosed in the specification.

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				<p>actually “generate[s] an output signal to the transmitter 1520,” and that transmitter 1520 then “generates an appropriately modulated RF signal to be broadcast by antenna 1502.” ’946, 15:35–45. The patent further teaches that “it is desirable for the mobile transceiver . . . to transmit a negative acknowledge signal if the message was only partially received,” and that the “negative acknowledge signal indicates that the network operations center should rebroadcast the message to the mobile unit.” ’946, 15:15–22.</p> <p>Thus, the specification states as follows: “A set of input switches 1516 is provided to allow the user to . . . generate a message to be transmitted by the mobile transceiver. The input switches 1516 also include a switch that allows the user to request retransmission of a message corrupted by errors. The input switches are connected to transmit logic 1518 which decodes the signal from the input switches 1516 to generate an output signal to the transmitter 1520. The transmitter 1520 generates an appropriately modulated RF signal to be broadcast by antenna 1502.” ’946, 15:35–44.</p> <p>That transmitter 1520 is corresponding structure is fully consistent with the language of this claim element, notwithstanding BlackBerry’s argument to the contrary. That is, transmitter 1520 transmits a signal to the</p>
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					communications network requesting retransmission of the specified portion of the message <i>only upon</i> actuation of request retransmission button 1622—an input switch of input switches 1516—which allows transmit logic to decode the signal from the input switches and generate an output signal to the transmitter 1520. <i>See also</i> '946, Fig. 15. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.
Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<i>means for receiving said specified portion retransmitted from the communications network and for displaying the received specified portion on the display</i> (’946 Patent: Claim 1)	“receiving said specified portion retransmitted from the communications network and for displaying the received specified portion on the display”	Indefinite (The patent does not disclose sufficient corresponding structure)	receiver 1506, display 1514, and equivalents (pursuant to 35 U.S.C. § 112)	receiver 1506 and display 1514, and equivalents	BlackBerry argues that MTel’s proposed structure must be rejected, because it recites two structures for performing the recited function. BlackBerry argues that the ’946 patent discloses the “display and storage logic 1508” as performing both the receiving and displaying functions, and that because the patent does not disclose an algorithm by which the display and storage logic performs the recited function, the claim fails for indefiniteness. The parties agree on the recited function, which should more accurately be characterized as: (1) receiving said specified portion retransmitted from the communications network; and (2) displaying the received specified portion on the display.

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				<p>In making its argument, BlackBerry relies on <i>Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.</i>, wherein the Federal Circuit held that to adequately disclose structure corresponding to the “means” limitation, the specification was required to disclose structure that performed both functions recited in the claim element—<i>i.e.</i>, the single structure performed dual functions. 296 F.3d 1106, 1114–15 (Fed. Cir. 2002). Contrary to BlackBerry’s reading of the decision, however, the Federal Circuit did not announce a <i>per se</i> rule that a means-plus-function element reciting two functions must <i>always</i> be performed by a single structure. <i>See, e.g., U.S. Ethernet Innovations, LLC v. Richoh Am. Corp.</i>, Nos. 6:12-CV-235, 6:11-CV-491, 2013 WL 5883772, at *4–5 (E.D. Tex. Oct. 31, 2013). Instead, the <i>Cardiac</i> court found, on the facts before it, that the prosecution history and the language of the claim, itself, compelled the result that the same means perform both functions recited. <i>See Cardiac</i>, 296 F.3d at 1114–15.</p> <p>Here, the intrinsic evidence supports a finding that the recited dual function <i>can</i> be performed by two separate structures.</p> <p>While MTel argued in its <i>Markman</i> presentation materials that the prosecution history of the ’946 patent shows that the patentee intended for two structures to perform the recited function, the materials it cites in its</p>
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				<p>briefing for this point were not actually submitted to the Court, at least not where cited to. <i>See</i> MTel March 27, 2014 <i>Markman</i> presentation at 157–58 (citing to MTel Op. Br. Ex. 11 at 32); MTel Op. Br., Ex. 11 (containing only application pages 73–74). Nevertheless, the Court still concludes that the language of the claim demonstrates that a single structure need not perform both the “receiving” and “displaying” function. Unlike that in <i>Cardiac</i>, the means clause here is not drafted to require that the “means for receiving” must also perform the display function. <i>See</i> 296 F.3d at 1115 (“The limitation at issue claims a “third <i>monitoring</i> means for monitoring . . . [and] for activating . . . Consequently, the claim at issue requires a monitoring means that activates. An alternative construction would render the first “monitoring” term meaningless.”). Here, by contrast, the claim element is simply drafted as “a means for doing x and y,” <i>id.</i> at 1114, which can, and the Court finds does, lead to the conclusion that separate structure could perform “x” and another “y,” <i>id.</i></p> <p>The Court’s conclusion is supported by the specification, which demonstrates that receiver 1506 is the corresponding structure for the “receiving”, and display 1514 the corresponding structure for “displaying.” <i>See, e.g.,</i> ’946, 14:55–57 (“A receiver 1506 is provided to receive the messages from the base transmitter.”); 14:66–67 (“The receiver 1506 is connected to a display and storage logic section</p>
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					<p>1508 to process the received signal.”); 15:7–10 (“A display 1514 . . . is also connected to the display and storage logic 1508 to display messages and various other information to the user.”).</p> <p>The Court thus finds that the corresponding structures are receiver 1506 and display 1514. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>
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Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<p><i>means for transmitting radio frequency signals containing a message to the mobile unit</i></p> <p>(’946 Patent: Claim 7)</p>	<p>“transmitting radio frequency signals containing a message to the mobile unit”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>base transmitter 612; base transmitter 614; base transmitter 1300; or base transmitter 1400, and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for retransmitting radio frequency signals containing the portion of the message to the mobile unit</i></p> <p>('946 Patent: Claim 7)</p>	<p>“retransmitting radio frequency signals containing the portion of the message to the mobile unit”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>base transmitter 612; base transmitter 1300; or base transmitter 1400, and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>
Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for receiving, from the mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission</i></p> <p>'946 Patent: Claim 7</p>	<p>“receiving, from the mobile unit, radio frequency signals representing a portion of the message that the user desires retransmission”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>base receiver 628; base receiver 630; base receiver 632; base receiver 634; analog base receiver (FIG. 18(A)); digital base receiver (FIG. 18(B)); or base receiver (FIG. 19), and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for receiving a page message including a call back number</i></p> <p>'862 Patent: Claim 8</p>	<p>“receiving a page message including a call back number”</p>	<p>radio pager 14</p>	<p>radio pager 14, or mobile radio telephone 26, and equivalents (pursuant to 35 U.S.C. § 112)</p>	<p>radio pager 14, and equivalents</p>	<p>The parties agree on the recited function, but disagree as to corresponding structure.</p> <p>The Court concludes that the corresponding structure is radio pager 14. MTel provides no meaningful support for the proposition that the specification links “mobile telephone 26” to the function recited in the claim. Rather, the specification demonstrates that only radio pager 14 is corresponding structure. <i>See</i> '862, 1:43–44 (“The radio pager 14 receives the call back number and passes it to control unit 12.”); 3:29–32 (“Upon receiving a page message, <i>pager 14</i> activates telephone 26”) (emphasis added); 5:44–46 (“Initially, pager 14 receives a message transmitted from the paging system central controller 70 (step 202) and determines whether cellular phone 26 is turned on (step 204).”).</p> <p>The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>controlling means for determining an appropriate prefix to be added to the call back number in accordance with a system identification number (SID)</i></p> <p>'862 Patent: Claim 8</p>	<p>“determining an appropriate prefix to be added to the call back number in accordance with a system identification number (SID)”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure, and algorithm as corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure, and algorithm as corresponding structure].</p>	<p>radio pager interface control unit 12, dialing plan determination application 36, and Figure 5 steps 208, 210, and 212, and equivalents</p>	<p>The parties agree on the recited function, but disagree as to corresponding structure. The parties' disagreement centers on whether: (1) an algorithm is required; and (2) “and equivalents” should be included in the Court's construction. If the Court determines that an algorithm is corresponding structure, the parties agree that the algorithm is comprised of steps 208, 2010, and 212 recited in Fig. 5. <i>See</i> '862, 3:32–35; 3:65–66; 4:5–10; 5:42–59.</p> <p>The Court also concludes that radio pager interface control unit 12 and dialing plan determination application 36 are clearly linked to the recited function. '862, 1:39–49; 5:49–59. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p> <p>Left to be resolved, then, is whether the algorithm must be disclosed as corresponding structure. Because the control unit's processor performs the recited function, <i>see</i> '862, 3:16–28, an algorithm must be disclosed as corresponding structure unless the narrow <i>Katz</i> exception applies. The Court concludes that the controlling means limitation requires more than simply plugging in a general purpose computer. '862, 1:54–57; 2:2–17. Because the</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for displaying the call back number with the appropriate prefix</i></p> <p>'862 Patent: Claim 8</p>	<p>“displaying the call back number with the appropriate prefix”</p>	<p>Indefinite (The patent does not disclose sufficient corresponding structure)</p>	<p>indicator 22, and equivalents (pursuant to 35 U.S.C. § 112)</p>	<p>indicator 22, and equivalents</p>	<p>Court concludes that a special purpose computer is necessary to accomplish the recited function, it finds that disclosure of the agreed upon algorithm is required as part of corresponding structure.</p> <p>The parties agree on the recited function. BlackBerry does not appear to dispute that the specification discloses that indicator 22 performs this function. Instead, BlackBerry argues that an indicator, as understood by one skilled in the art, is incapable of performing the function of displaying a call back number with an appropriate prefix. Thus, BlackBerry argues that the claim is indefinite, for failing to disclose <i>sufficient</i> structure.</p> <p>As the Court previously stated at the <i>Markman</i> hearings, if the Court finds that it is able to determine that the patent discloses corresponding structure, it will resolve questions of indefiniteness on a motion to find the claim term indefinite.</p> <p>The Court finds that the specification does link indicator 22 to the recited function. The patent teaches that indicator 22 is part of the mobile paging telephone call back device, <i>see</i> '862, 1:31–35, and that the call back number received by the radio pager is ultimately displayed on</p>

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					indicator 22 along with the appropriate prefix, <i>id.</i> at 1:39–47; 5:43–60. The Court includes “and equivalents” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.
Claim Term	Recited Function	BlackBerry’s Proposed Construction	MTel’s Proposed Construction	Court’s Construction	Explanation
<p><i>means for retrieving the file of canned messages and the file of canned multiple response options from the memory</i></p> <p>’506 Patent: Claim 19</p>	<p>“retrieving the file of canned messages and the file of canned multiple response options from the memory”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>CPU 110, ROM 112 (including stored application program for controlling terminal operation), and system bus 130 (which interconnects system components such as CPU 110, ROM 112, and RAM 114), and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>

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Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for selecting one of the canned messages and at least one of the multiple response options appropriate for the selected canned message for communication to a designated other message terminal</i></p> <p>'506 Patent: Claim 19</p>	<p>“selecting one of the canned messages and at least one of the multiple response options appropriate for the selected canned message for communication to a designated other message terminal”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>terminal keypad 126; or a mouse; or a cursor, and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr’ g Tr. at 164:15-17.</p>
Claim Term	Recited Function	BlackBerry's Proposed Construction	MTel's Proposed Construction	Court's Construction	Explanation
<p><i>means for retrieving the file of canned messages and message codes from the memory</i></p>	<p>“retrieving the file of canned messages and message codes from the memory”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>CPU 110, ROM 112 (including stored application program for controlling terminal</p>	<p>The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily</p>

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<p>'506 Patent: Claim 21</p>		<p>corresponding structure].</p>		<p>operation), and system bus 130 (which interconnects system components such as CPU 110, ROM 112, and RAM 114), and equivalents</p>	<p>provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p>
<p>Claim Term</p>	<p>Recited Function</p>	<p>BlackBerry's Proposed Construction</p>	<p>MTel's Proposed Construction</p>	<p>Court's Construction</p>	<p>Explanation</p>
<p><i>means for selecting one of the canned messages for communication to a designated other message terminal and for selecting multiple response options appropriate for the selected canned message</i></p> <p>'506 Patent: Claim 21</p>	<p>“selecting one of the canned messages for communication to a designated other message terminal and selecting multiple response options appropriate for the selected canned message”</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>[AGREED subject to inclusion of “equivalents” in identification of corresponding structure].</p>	<p>terminal keypad 126; or a mouse; or a cursor, and equivalents</p>	<p>The parties agree on the recited function and corresponding structure. The only dispute the parties have with respect to construction of this means-plus-function term is whether “and equivalents” should be included in the Court’s construction. The Court includes “and equivalents,” as equivalents are statutorily provided for by 35 U.S.C. 112, ¶ 6; Mar. 27, 2014 Hr' g Tr. at 164:15-17.</p>