

## ALERT

## Federal Circuit Patent Bulletin: *Mformation Techs., Inc. v. Research in Motion Ltd.*

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August 22, 2014

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On August 22, 2014, in *Mformation Techs., Inc. v. Research in Motion Ltd.*, the U.S. Court of Appeals for the Federal Circuit (Prost,\* Schall, Hughes) affirmed the district court's judgment as a matter of law that BlackBerry did not infringe U.S. Patent No. 6,970,917, which related to the wireless activation and management of an electronic device without the need to have physical access to the device. The Federal Circuit stated:

Mformation argues that the district court impermissibly added an order-of-steps claim requirement post-verdict in its JMOL opinion—*i.e.*, a requirement that a connection must be completely established before the transmitting step begins. However, according to Mformation, with respect to the "wherein the connection is established . . ." limitation, the district court only informed the jury that this limitation requires that the connection be initiated before transmitting. Thus, Mformation argues that the jury was told that transmitting could begin before the connection is fully established, as long as the connection is later completed. The record indicates that such a sequence is not only possible but also what indeed occurs with BES [(Blackberry Enterprise Server)] software. . . . We agree with BlackBerry and, therefore, conclude that the district court did not change its claim construction post-verdict. Rather, the district court at most clarified its previous construction that was already present in the jury instructions. . . .

We now turn to the issue of whether claim 1 of the '917 patent requires that a connection be completely established before transmission. As a general rule, "[u]nless the steps of a method [claim] actually recite an order, the steps are not ordinarily construed to require one." However, a claim "requires an ordering of steps when the claim language, as a matter of logic or grammar, requires that the steps be performed in the order written, or the specification directly or implicitly requires" an order of steps. Below, the district court read an order-of-steps requirement into the claim, concluding that "before the server can 'transmit' the command, it

must first ‘establish a connection’ that is used for transmitting. The district court explained that, “[i]n the context of a network communication, the ordinary meaning of the phrase ‘a connection’ is ‘a means of communication or transport.’”

On appeal, Mformation challenges the district court’s construction. It argues that the patentee’s use of “ing” in “establishing a connection between the wireless device and the server” conveys that formation of the connection is in progress, rather than completed. And Mformation adds that the wherein clause does not specifically dictate when the connection must be established; it only requires that a connection eventually be established. Further, the word “established” is distant from the “establishing a connection” sub-step. According to Mformation, this serves as evidence that completely establishing a connection is not required before transmission. Thus, Mformation claims that the point of the “wherein” limitation was to define the subset of factors that could trigger the establishment of the connection—not to create rigid step-ordering requirements. . . .

We agree with the district court and BlackBerry that claim 1 requires that a connection be established before transmission. We are persuaded by BlackBerry’s argument that the separate sub-step for establishing a connection would become “superfluous” if we concluded that a connection did not have to be established (completed) before transmission. That is because, under such construction of the claim, establishing a connection is necessarily encompassed in transmitting a command. Further, we note that other sub-steps in claim 1 inherently require an order-of-steps. As a matter of logic, a mailbox must be established before the contents of said mailbox can be transmitted. And while it is true that “we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment,” we do note that our conclusion is consistent with the sole embodiment in the specification.

Finally, Mformation argues that BlackBerry is not entitled to JMOL even if an order-of-steps requirement is read into the claims. Mformation argues that there is still substantial evidence of infringement because BlackBerry’s BES software need not create the communication channel itself but, rather, could use an existing wireless communication channel. And Mformation claims to have presented ample evidence at trial that, before the start of the “transmitting” sub-step, the BES software selects an existing wireless communication channel that allows a server to communicate with a remote device. Consequently, Mformation claims that a reasonable juror could find that the accused products establish a connection between the BES software and the wireless device before commencement of the “transmitting” sub-step.

We disagree. As the district court noted, Mformation’s expert based his infringement opinion on his understanding that the claims do not require a connection to be established between the server and the wireless device before transmission. . . . [S]electing a path for a wireless connection is not the equivalent of establishing a wireless connection. We therefore conclude that substantial evidence does not support a jury verdict of infringement under the proper claim construction of the “establishing” sub-step. Because we affirm the district court’s grant of JMOL of no infringement, we need not address its conditional grant of a new trial.