Position Statement
regarding the
RIM Mobile E-Mail Patent Assertion

Free Protocols Foundation

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1 Introduction

The Free Protocols Foundation (FPF) is a non-profit organization and independent public forum dedicated to the support of patent-free protocols and software. The FPF views software and protocol patents as being detrimental to the industry and the consumer, and part of the FPF mandate is to oppose exceptionally harmful patents when they appear. For more information see the FPF website at `http://www.freeprotocols.org`.

In May 2001 Research in Motion (RIM) made a patent assertion which we regard as an egregious example of patent law abuse, and exceedingly harmful in its potential effects. The following is a statement of the FPF position regarding this patent, the actions we have undertaken to oppose it, and the remedial action we are now demanding of RIM.

2 Research in Motion (RIM) and BlackBerry

Research in Motion (RIM) is a Canadian wireless technology company based in Waterloo, Ontario, Canada.

Among other things RIM manufactures and licenses BlackBerry, a popular wireless handheld e-mail device. BlackBerry is a closed, single-vendor e-mail system, based on a set of proprietary protocols. For details see the BlackBerry website at `http://www.blackberry.net`.

3 RIM's Patent Assertion

In April 2001 RIM was granted U.S. Patent # 6,219,694, entitled *System and method for pushing information from a host system to a mobile data communication device having a shared electronic address*. The complete text of the patent is available in PDF format on the FPF website at:
`http://www.freeprotocols.org/usPatents/06219694.pdf`.

The patent describes a method of directing e-mail to wireless devices, while maintaining mailbox synchronization with a desktop e-mail system. The described method is a basic element of the functioning of various existing mobile e-mail systems, including the BlackBerry system.

RIM was quick to take advantage of this patent. Less than a month after the patent was granted, RIM announced a lawsuit against Glenayre Electronics, Inc. for infringement against the patent. To view an article describing this patent assertion, visit `http://www.totaltele.com/view.asp?ArticleID=40057&pub=tt&categoryid=625`. The same article is also available on the FPF website at `http://www.freeprotocols.org/rimBBPatentProblem/extNews2.html`.

In order to understand the eventual disposition of RIM's lawsuit, it is important to know that when it comes to patents Glenayre is no angel either; and in particular, had previously filed its own patent infringment suit against RIM. An article describing the Glenayre patent assertion is available at
`http://www.garywill.com/waterloo/ctt9908.htm`; the same article is also available on the FPF website at
`http://www.freeprotocols.org/rimBBPatentProblem/extNews1.html`.

Thus with the initation of RIM's lawsuit against Glenayre, both companies now had patent lawsuits pending against each other.

4 FPF Position on the RIM Patent Assertion

The Free Protocols Foundation views the RIM patent assertion as an extreme example of patent-law abuse. This is because:

- The patent is based on methods and processes which were previously known and implemented, and there is ample prior art to demonstrate this. RIM's claim that these processes are novel is false.
- The patent covers an aspect of mobile e-mail that is so fundamental that if it goes unchallenged, it will have the effect of hobbling the wireless and mobile e-mail industry.

The patent is particularly noxious because of the very large scope of its claims. Note that mobile e-mail is not merely another generic product or service – it is an extremely large-scale interconnected system, whose functioning is of profound importance to business and society. It is inappropriate and dangerous for any one company to have exclusive control over something of such enormous scope and significance.

Yet this patent purports to provide RIM with precisely this control. RIM's patent claim is so broad and general that if it remains unchallenged, it will restrict a major class of mobile e-mail services to a single closed system under the exclusive control of RIM, to the severe detriment of the mobile e-mail industry and society at large.

5 Recent History

This Position Statement was first published in July 2001, at which time RIM was actively prosecuting its lawsuit against Glenayre.

In addition to publishing this document, the FPF took various other actions to oppose the patent. Among other things we provided assistance to the law firm of Christensen, O'Connor, Johnson and Kindness, Glenayre's legal

representation in this matter. We provided our technical expertise to this firm in the preparation of their challenge to RIM's lawsuit, and in particular we identified and made the legal team aware of prior art which we believe demonstrates the invalidity of the patent. This prior art was subsequently presented to RIM during the discovery phase of the legal proceedings.

Our intention in providing this technical assistance to Glenayre was to see that the patent was conclusively defeated in the courts, permanently invalidating the patent.

However that is not how things turned out. Instead, RIM and Glenayre announced in January 2002 that they had reached a private settlement, in which each company agreed to dismiss its lawsuit against the other. An announcement of the settlement is available on Glenayre's website at `http://www.glenayre.com/NewsEvents/Glenayre_RIM_Final.htm`. The same announcement is also available on the FPF website at `http://www.freeprotocols.org/rimBBPatentProblem/Glenayre_RIM_Final.htm`.

The terms of their agreement included beneficial considerations to each party. One of these considerations was that Glenayre made an acknowledgement that it now considers the RIM patent to be valid.

6 A Continuing Threat

This sort of private accommodation, in which a pair of patent-holding companies grant each other reciprocal patent immunity, is all too common in the patent world.

Just as we oppose patents in general, we oppose such two-party patent trading. While these private agreements are advantageous to the companies involved, they leave the rest of the industry fully exposed to the detrimental effects of harmful patents.

We interpret RIM's declining to seek legal validation of the patent as indicative of their awareness that it cannot survive this process. We also believe that our efforts in identifying the prior art were a likely contributing factor in creating this awareness, and in bringing about the settlement between RIM and Glenayre. However the purpose of our collaboration with Glenayre was to defeat the patent conclusively in a court of law, not to achieve a private accommodation for Glenayre. While the settlement with RIM is advantageous for Glenayre, the threat to the rest of the industry remains unchanged.

We are disappointed that Glenayre chose to act with such narrow self-interest. Instead of making a private accommodation, we would have preferred that Glenayre take advantage of the opportunity to press its patent challenge to the legal limit, thereby conclusively invalidating the patent for the benefit of everyone. We find Glenayre's public statement of the patent's validity to be particularly disappointing.

But be that as it may, since the patent assertion was not subjected to legal adjudication, the patent has not yet been invalidated. RIM has in no way renounced the patent, or forsworn to assert the patent against other companies in the future. Indeed, Glenayre's acknowledgement of the patent's validity, made under the terms of their settlement, clearly signals that RIM continues to regard the patent as a strategic asset.

Thus the potential for patent abuse by RIM persists, and will persist until such time as the patent is legally invalidated, or until RIM undertakes to renounce future assertions of the patent.

7 A Simple Remedy: A Grant of Rights

RIM may take the position that it made its patent assertion in a defensive manner: it was under patent attack from Glenayre, and sought only to defend itself. RIM may further take the position that it has no intention of making abusive, offensive use of the patent – it was acquired defensively, and it will remain a purely defensive asset.

If so, there is a simple way that it can commit itself to this, while still maintaining defensive protection. This is by

means of a **Grant of Rights** declaration.

While patents can be harmful in any domain, the area of greatest concern to the FPF is that of Internet protocols. The Internet is of such large scope and importance that it is essential that its underlying protocols remain free from patent control.

An appropriately written Grant of Rights assures that no patent claims will be made against implementations of Internet protocols, either singly or in combination, while reserving defensive rights for the patent holder. There is ample precedent for this. Numerous companies have made such grant declarations and submitted them for publication on the IETF website; see `http://www.ietf.org/ipr.html` for a list. A good example is the Grant of Rights made by Hewlett-Packard, available at `http://www.ietf.org/ietf/IPR/hp-mib`.

We would like to see RIM clarify its intentions regarding U.S. Patent # 6,219,694. And if it is the case that RIM has no aggressive intentions towards any and all Internet protocols, we propose that it make an appropriate Grant of Rights declaration and present it for publication on both the FPF and IETF websites. Such a declaration can be e-mailed to the FPF at declarations@freeprotocols.org, and to the IETF at ietf-secretariat@ietf.org.

8 Actions and Remedies

In the meantime, the Free Protocols Foundation will continue to participate in fighting strenously against this patent. We will do so by means of the following activities:

- By continuing to assist in demonstrating the invalidity of the patent on the basis of prior art
- By supporting future legal challenges against the patent
- By endorsing and publicizing *Operation WhiteBerry*, a patent-free alternative to BlackBerry
- By pressuring RIM to renounce future assertion of the patent against free Internet protocols via a Grant of Rights
- Should these measures fail to discourage RIM from asserting the patent, by encouraging a consumer boycott of the BlackBerry system

8.1 Demonstrating Patent Invalidity

Those whose interests may be injured by the patent will certainly wish to challenge it. A key element of this challenge is to demonstrate that the patent is invalid on the basis of prior art. We believe that a substantial body of prior art exists which shows clearly that the patent is based on ideas which have been previously known, subjected to public discussion, and implemented.

As noted previously, we have already identified certain examples of prior art. However, any future challenges to the patent will be greatly strengthened by establishing additional examples. The basic requirement is to identify and make public the appropriate prior art. The Free Protocols Foundation is assisting in this effort by providing a public forum for discussion and commentary, and by acting as a central clearing house for information relating to the patent.

For this purpose the FPF has established and is hosting the public mailing list `RIM-6219694@lists.freeprotocols.org`. Any company, organization or individual may participate in this effort by submitting commentary or information to this mailing list. To join this mailing list, visit `http://www.freeprotocols.org/mailingLists`.

The following is a list of known development activities, each of which predates the RIM patent, and in which the same processes as represented in the patent claims were put into practical implementation. The documentation and discussion records relating to these activities are therefore extremely likely to yield appropriate examples of prior art:

- Various combinations and integrations of IMAP modes, including the concepts of disconnectedness and synchronization. While the claims represented in the RIM patent are not a formal part of the IMAP specification, many of the same methods and processes are clearly alluded to in the specification. Furthermore, many of those same methods and processes were discussed and implemented by the IMAP protocol designers during the protocol development process. Such discussions took place on a number of IETF and other mailing lists.
- Various combinations and integrations of FetchMail, ProcMail, dotForward, mail robots and mail header rewritings. These components have been linked together by many Unix users to produce practical implementations of the same claims as represented in the patent.
- The Limited Size Messaging (LSM) development work published and demonstrated at the CDPD Forum in 1995.
- The Lightweight & Efficient Application Protocols (LEAP) development work published as RFC 2188 in 1997, and RFC 2524 in 1999; also the relevant mailing lists.
- The development and commercial marketing of Mobile Messaging products such as the RadioMail wireless messaging service by RadioMail Corporation (initially led by Geoffrey Goodfellow), dating back to the early 1990s.
- Proprietary mail synchronization capabilities of commercial systems such as *Mail on the Run!* and numerous others.

The role of the Free Protocols Foundation consists primarily of the assistance and facilitation role described above. We invite and encourage other interested parties to identify specific examples of prior art by researching the archival records relating to the above activities. We especially request and encourage the original participants in those activities to step forward and assert their prior implementations of the RIM patent claims.

8.2 Support for Legal Challenges

In general, the Free Protocols Foundation supports legal challenges to software patents by providing its technical expertise regarding patent issues to companies who may be challenging patents in the courts.

Just as it provided support to Glenayre, the FPF stands ready to lend its support to any other company that mounts a legal challenge/defense against the RIM patent. Any company or organization wishing to avail itself of this assistance should contact the FPF directly at `info@freeprotocols.org`.

We are particularly interested in working with companies who, unlike Glenayre, are willing to pursue their patent challenge all the way to formal legal adjudication.

8.3 Operation WhiteBerry

The same mobile e-mail functionality as BlackBerry can be implemented in the form of a completely open system, based on existing technologies and protocols. This open equivalent to BlackBerry is called the **WhiteBerry** mobile messaging solution.

The WhiteBerry solution is based on a set of patent-free mobile messaging protocols called the **Lightweight & Efficient Application Protocols**, or **LEAP**. Under the WhiteBerry solution, mobile messaging functionality is provided by a multi-vendor series of products and services, and the necessary industry-wide interoperability is guaranteed by the openness and integrity of the underlying protocols. For more information on the LEAP protocols see the LEAP Forum website at `http://www.LeapForum.org`.

A complete description of the WhiteBerry solution is provided in a white paper entitled *Operation WhiteBerry*. *Operation WhiteBerry* was written prior to, and is independent of, the emergence of the RIM patent issue. It was first

published and remains available on the LEAP Forum website at
`http://www.LeapForum.org/operationWhiteberry/index.html`.

One of the general strategies by which the FPF opposes patented software is by supporting patent-free alternatives. Since *Operation WhiteBerry* describes an open, patent-free alternative to the patented BlackBerry system, it is directly aligned with this strategy. This paper is also fully consistent with FPF goals, and with the *FPF Policies & Procedures* described at `http://www.freeprotocols.org/freeProtocolProcess/main.html`.

We therefore endorse this paper fully, and are pleased to re-publish it on our own website at `http://www.freeprotocols.org/operationWhiteberry/index.html`. We encourage anyone who wishes to avoid the RIM patent issue to read this paper and participate in the WhiteBerry implementation.

The WhiteBerry solution is radically different from the BlackBerry system. WhiteBerry is not a single static messaging solution; rather, it is a highly mutable meta-solution. That is, any particular WhiteBerry implementation is created by integrating together an appropriate set of components, so as to achieve the particular functionality desired by the systems integrator or the end user.

The components that go into any given WhiteBerry implementation may be drawn from a large family of components which includes the EMSD protocol engines, FetchMail, ProcMail, mail forwarders, and various others. Each of these components is independent, freely available, useful in its own right, and entirely unrelated to the RIM patent.

Because of this inherently component-based nature, the WhiteBerry solution is exceedingly resistant to the RIM patent claim, and indeed to patent infringement claims in general. By making all the necessary components freely and publicly available, WhiteBerry provides systems integrators and end users with a variety of methods and strategies to circumvent or nullify invalid patent assertions.

8.4 Applying Pressure to RIM

Patent # 6,219,694 is a blatant attempt by RIM to lay exclusive claim to the entire mobile e-mail industry. The patent is fundamentally invalid, and cannot withstand technical scrutiny or legal challenge. The lawsuit against Glenayre has consumed the energies of both companies, with little tangible benefit except for their lawyers. The effort that the industry at large must exert to overturn the patent conclusively, and that RIM may exert in a futile attempt to defend it, are likewise a waste of energy. In the meantime the threat of patent assertion by RIM can only be detrimental to the mobile e-mail industry, by inhibiting free and fair competition, and by depriving the end-user of the benefits thereof.

We therefore urge RIM to do the right thing: make a Grant of Rights declaration to renounce future assertions of the patent. This is in the best interests of the industry and the consumer.

8.5 Boycotting RIM's BlackBerry System

If other measures fail to have the desired effect, and if RIM makes future assertions of the patent which begin to cause damage to the mobile e-mail industry, then the FPF intends to organize and encourage a consumer boycott of RIM's BlackBerry product.

9 Making Contributions to the Free Protocols Foundation

The Free Protocols Foundation is a U.S. tax-exempt non-profit organization, and any contributions made to the FPF are tax deductible in accordance with Internal Revenue Service regulations. Any organization or individual wishing to support the goals of the FPF is requested to make an appropriate donation. Monetary contributions may be mailed to the FPF at:

Free Protocols Foundation
17005 SE 31st Place
Bellevue, WA 98008

If you wish your contribution to be used solely for the purpose of opposing the RIM patent, please mark your contribution with the annotation **RIM-6219694**.