

- Patents Post Grant Blog - <http://www.patentspostgrant.com> -

CAFC Sends NTP Patent Reexaminations Back to USPTO

Posted By [Scott A. McKeown](#) On 1 August 2011 @ 14:05 In [Claim Interpretation](#), [Reexamination](#) | [No Comments](#)



[1]BPAI Definition of Email Found Unreasonable by CAFC

Last February NTP appealed the invalidity findings of the USPTO to the Court of Appeals for the Federal Circuit (CAFC). At that time [I predicted that the case would shift back to the USPTO on a disputed claim construction issue](#) [2]. Today, the CAFC, while affirming much of the USPTO's fact finding, did indeed remand the case for further consideration of a new definition of "electronic mail" or "electronic mail message."

The eight related appeals included thousands of claims of the NTP portfolio, of note, the [USPTO rejected all but one of the previously adjudicated \(RIM Litiigation\) NTP claims](#) [3] in patent reexamination. Specifically, all of the claims of NTP Inc's U.S. Patents 6,317,592, 5,819,172, and 6,067,451 were rejected and affirmed (BPAI). Rejections were affirmed-in-part in 5,436,960 and 5,625,670, (the surviving '670 claims were added in reexamination, claim 15 of the '960 appears to be the only surviving claim successfully asserted against RIM).

Today, the CAFC affirmed the rejection of all 764 claims of the '592 patent. (NTP I, [here](#) [4]).

A second decision (NTP II, [here](#) [5]), which pertains to the remaining patents noted above as well as a few others, Vacated-in-part, Reversed-in-part, and Remanded previous determinations of the BPAI.

What does all of this mean for NTP?

Certainly, the remand on claim construction is a positive development for NTP. If nothing else it gives NTP another opportunity to argue for claims that stood previously rejected by the USPTO. Yet, many of the claims subject to the reexamination proceedings were newly added and it seems unlikely that the reexamination proceedings will conclude in time for these claims to have any enforceable term.

As to the previously issued claims, while the CAFC did reverse some rejections, it is unclear whether or not the BPAI will enter new rejections based on obviousness, the new definition of "electronic mail," or newly formulated theories altogether.

Aside from the potentially positive developments noted above, the CAFC decisions were negative in many other respects. For example, the CAFC affirmed the BPAI's finding that the Telenor reference qualified as prior art, and also discounted the attempts of NTP to antedate certain art via 1.131 declaration evidence.

Uncharacteristically, the CAFC commented a few times that NTP's arguments have seemingly shifted over time, and noted on the record that NTP has conceded several points that should not be revisited by the USPTO.

At the end of the day, the fight returns back to the USPTO for further appeal briefing and argument, and perhaps an eventual return to the CAFC. As such, the only certainty created by

today's decisions are the likely years of USPTO and CAFC processing still to come.

Article printed from Patents Post Grant Blog: <http://www.patentspostgrant.com>

URL to article: <http://www.patentspostgrant.com/lang/en/2011/08/cafc-sends-ntp-patent-reexaminations-back-to-uspto>

URLs in this post:

[1] Image: <http://www.patentspostgrant.com/wp-content/uploads/2011/08/ntp-reexamination.bmp>

[2] I predicted that the case would shift back to the USPTO on a disputed claim construction issue: <http://www.patentspostgrant.com/lang/en/2011/02/ntp-patent-reexaminations-to-be-remanded-to-bpai>

[3] USPTO rejected all but one of the previously adjudicated (RIM Litiigation) NTP claims: <http://www.patentspostgrant.com/lang/en/2010/07/new-ntp-patent-suit-relies-on-non-existent-claims>

[4] here: <http://www.patentspostgrant.com/wp-content/uploads/2011/08/NTP1.pdf>

[5] here: <http://www.patentspostgrant.com/wp-content/uploads/2011/08/NTP-2.pdf>

Copyright © 2010 Patents Post Grant Blog. All rights reserved.