

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, DC

In the Matter of)
)

CERTAIN AUTHENTICATION SYSTEMS,)
INCLUDING SOFTWARE AND HANDHELD)
ELECTRONIC DEVICES)
)

Investigation No.
337-TA-_____

VERIFIED COMPLAINT UNDER SECTION 337
OF THE TARIFF ACT OF 1930, AS AMENDED

Complainant:

Prism Technologies LLC
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402.934.2020

Proposed Respondents:

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EXHIBIT LIST

- 1 U.S. Patent No. 7,290,288
- 2 U.S. Patent No. 7,290,288 Assignment Record
3. Claim Chart for RIM BlackBerry Desktop Enterprise Activation System.
4. Claim Chart for RIM BlackBerry Administrator Activation System.
5. April 24, 2008 download of BlackBerry Enterprise Server Software.
6. Photocopy of packaging for the RIM BlackBerry Curve 8330 smartphone; photocopy of associated disk; photocopies of the invoice and sale receipt for purchase of same.
7. Documentation Relating to August 27, 2009 Download of RIM BES Software.
8. Photocopy of the replacement packaging for the RIM BlackBerry Curve 8330 smartphone; photocopy of the associated disk.
9. RIM 2009 Annual Report.
10. *What Is the Wireless Enterprise Activation Process* – KB13850, Last Modified Feb. 24, 2009, Research In Motion Limited.
11. *BlackBerry Enterprise Solution, Security Technical Overview*, Research In Motion Limited, 2008.
12. *BlackBerry Enterprise Server for Microsoft Exchange Version 4.1.4 Feature and Technical Overview*, Research In Motion Limited, last modified May 10, 2007.
13. *BlackBerry Wireless Enterprise Activation, Release 4.0, Technical Overview*, Research In Motion Limited, 2004.
14. Complaint for *Prism Tech., LLC v. Research in Motion, Ltd., et al.*, Case No. 08-cv-00537-LES-TDT (D. Neb.).
15. **(Confidential)** Copy of the Settlement and License Agreement executed by Prism Technologies in favor of Microsoft Corporation.
16. Complaint for *Prism Techs., LLC v. VeriSign, Inc. et al.* Case No. 05-214-JJF (D. Del.).
17. First Amended Complaint for *Prism Techs., LLC v. VeriSign, Inc. et al.* Case No. 05-214-JJF (D. Del.).
18. Second Amended Complaint for *Prism Techs., LLC v. VeriSign, Inc. et al.* Case No. 05-214-JJF (D. Del.).
19. **(Confidential)** Prism Resource's Financial Information Relating To The Domestic Industry Requirement.
20. **(Confidential)** Prism Technologies, LLC's Financial Information Relating To The Domestic Industry Requirement.
21. **(Confidential)** Internet Subscription Access (ISA) Design Specifications, dated January 7, 1997.
22. **(Confidential)** Income Tax Returns of Prism Resources for the year ended December 31, 1996.
23. **(Confidential)** Income Tax Returns of Prism Resources for the year ended December 31, 1997.
24. **(Confidential)** Income Tax Returns of Prism Resources for the year ended December 31, 1998.
25. **(Confidential)** Contribution Agreement as between Prism Resources, Prism Technologies and others.

26. Letters sent to RSA Security Inc. and Nintendo of America regarding purchasing patent and application.
27. **(Confidential)** Copy of the Patent Purchase Agreement executed by Prism Technologies in favor of third party.
28. **(Confidential)** Confidential Summary of Demonstrations of ISA Product.
29. *Placing the BlackBerry Router in the DMZ*, Research In Motion Ltd., 2005.
30. BlackBerry Server Configuration Panel Screen Shot, July 8, 2008.
31. Registry Editor Screen Shot, July 8, 2008.
32. Examination of BESMgmt. Database using the MSDE Query Tool, <http://www.msde.biz>, July 8, 2008.
33. TCP/IP Illustrated, Vol. 1, W. Richard Stevens, Addison-Wesley, 1994.
34. *Placing the BlackBerry Enterprise Solution in a Segmented Network*, Research In Motion, Ltd., last modified Aug. 1, 2006.
35. *What Is a Service Book* – KB03151, Research In Motion Ltd., May 10, 2007.
36. RIM *BlackBerry Server Capacity Calculator*, BlackBerry Enterprise Server 4.1, Research In Motion, Ltd.
37. *Administration Guide – BlackBerry Enterprise Server for Microsoft Exchange Version 4.1 Service Pack 5*, Research In Motion, Ltd., 2008.

APPENDICES

- A. Certified Copy of U.S. Patent No. 7,290,288
- B. One certified and three additional copies of the U.S. Patent and Trademark Office prosecution history for U.S. Patent No. 7,290,288.
- C. Copies of each patent and applicable pages of each technical reference mentioned in the prosecution history for U.S. Patent No. 7,290,288.
- D. Certified Copy of Assignment Record for U.S. Patent No. 7,290,288.

I. INTRODUCTION

1. Complainant Prism Technologies LLC (“Prism”) files this complaint pursuant to Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 (“Section 337”). Prism respectfully requests that the U.S. International Trade Commission (“Commission”) institute an investigation relating to the unlawful importation into the United States, the sale for importation into the United States, and/or the sale within the United States after importation of certain authentication systems, including software and handheld electronic devices.

2. The proposed respondents are Research In Motion, Ltd. and Research In Motion Corp. (collectively “RIM” or “Respondents”).

3. Respondents have violated and continue to violate Section 337 through the importation, sale for importation, and/or the sale within the United States after importation of certain authentication systems, including software and handheld electronic devices, that infringe Prism’s United States Patent No. 7,290,288 (“the ‘288 Patent” or “Asserted Patent”) to the detriment of Prism’s industry in the United States relating to the Asserted Patent.

4. To remedy Respondents’ continuing and unlawful violation of Section 337, Prism seeks as permanent relief a limited exclusion order barring from entry into the United States all Respondents’ authentication systems, including software and handheld electronic devices, that, when used together, infringe one or more of the asserted claims of the ‘288 Patent. Prism also seeks cease and desist orders pursuant to 19 U.S.C. § 1337(f) prohibiting domestic Respondent Research In Motion Corp. from engaging in the importation into the United States and/or the sale within the United States after importation of articles that infringe one or more claims of the ‘288 Patent. Further, Prism requests that the Commission impose a bond upon Respondents’ importation of infringing authentication systems, including software and handheld electronic

devices during the 60-day Presidential review period pursuant to 19 U.S.C. § 1337(j) to prevent further injury to Prism's domestic industry relating to the '288 Patent.

II. THE PARTIES

A. Complainant

5. Complainant Prism is a limited liability company organized under the laws of the State of Nebraska with its principal place of business in Omaha. Prism now focuses its business on managing, licensing and enforcing patented technology that it developed and/or acquired relating to technology fundamental to Internet security and e-commerce, including the '288 Patent. Its predecessor, Prism Resources, developed and sold products embodying the invention claimed in the '288 Patent and parent patent to the '288 Patent.

B. Proposed Respondents

6. With regard to the proposed Respondents, Prism alleges the following upon information and belief:

Research In Motion, Ltd.

7. Respondent Research In Motion, Ltd. ("RIM, Ltd.") is a foreign company with its principal place of business at 295 Phillip Street, Waterloo, Ontario, Canada N2L 3W8. RIM, Ltd. is in the business of developing, manufacturing, and selling telecommunication devices and computer systems including, but not limited to, the BlackBerry Enterprise Solution (consisting of BlackBerry devices, BlackBerry Device Software, BlackBerry Desktop Software, and BlackBerry Enterprise Server).

Research In Motion Corp.

8. Respondent Research In Motion Corp. ("RIM Corp.") is a wholly-owned subsidiary of Respondent RIM, Ltd. RIM Corp. is located at 122 W. John Carpenter Parkway, Suite 430, Irving, Texas 75039. On information and belief, Respondent RIM Corp. markets,

distributes and uses telecommunication devices and computer systems including, but not limited to, the BlackBerry Enterprise Solution (consisting of BlackBerry devices, BlackBerry Device Software, BlackBerry Desktop Software, and BlackBerry Enterprise Server), in the United States, which are manufactured outside in the United States. RIM Ltd. and RIM Corp. are collectively referred to as “RIM” or “Respondents.”

III. THE ASSERTED ‘288 PATENT

9. By way of assignment, Prism holds all rights, title, and interest to the ‘288 Patent, “Method and System for Controlling Access, by an Authentication Server, to Protected Computer Resources Provided Via an Internet Protocol Network.” Pursuant to Commission rules 210.12(a)(9)(i)-(ii), a certified copy of the ‘288 Patent, and a certified copy of the assignment record for the ‘288 Patent are attached hereto as Appendices A and D, respectively. Appendix B, pursuant to Commission rule 210.12(c)(2), contains one certified copy (on CD) and three additional copies (the three additional copies are also submitted on CD and, in addition, one unbound copy of the prosecution history is submitted herewith) of the U.S. Patent and Trademark Office prosecution history for the ‘288 Patent. Appendix C, pursuant to Commission rule 210.12(c)(3), contains four copies of each patent and the applicable pages of each technical reference mentioned in the prosecution history of the ‘288 Patent.¹

10. The application that resulted in the ‘288 Patent was filed on August 29, 2002 and issued on October 30, 2007. The application that resulted in the ‘288 Patent is a continuation-in-

¹ The examination of the ‘288 patent resulted in the submission of approximately 1,000 references to the PTO. The physical size of this documentation is quite extensive. After several discussions with staff attorneys at OUII and ITC docket services, it was decided that only copies of the six patent references cited by the PTO Examiner during prosecution will be submitted along with this Complaint and included in Appendix C. Upon request, Prism can commence the time and cost intensive process of compiling all 1,000 references.

part of U.S. Application No. 08/872,710, filed on June 11, 1997, now U.S. Patent 6,516,416 (“the ‘416 Patent”).

11. The ‘288 Patent has one hundred and eighty seven (187) claims, twenty-nine of which depend from independent claim 1, thirty of which depend from independent claim 31, twenty four of which depend from independent claim 62, twenty-eight of which depend from independent claim 87, thirty-two of which depend from independent claim 117, and thirty-four of which depend from independent claim 150. The ‘288 Patent also includes independent claim 116, independent claim 185, independent claim 186, and independent claim 187, from which no other claims depend.

12. There are no foreign patents or patent applications having a disclosure corresponding to the ‘288 Patent pending, filed, abandoned or rejected.

IV. NON-TECHNICAL DESCRIPTION OF THE PATENTED TECHNOLOGY

13. Prism’s ‘288 Patent covers an innovative way of controlling access to protected electronically stored data and information requested by a device using an Internet Protocol network.

14. More specifically, the method and system disclosed by the ‘288 Patent controls access to protected electronically stored data and information using an authentication server. The authentication server has an associated database that stores authentication data associated with a user device and authorization data associated with the protected electronically stored data and information. The user device requests access to the protected electronically stored data and information by sending its’ authentication data to an access server which, in-turn, forwards the data to the authentication server in order to authenticate the user device. If the user device is authenticated, the authorization server then authorizes the user device to receive access to the

protected electronically stored data and information. Upon successful authentication and authorization of the user device by the authentication server, the authentication server permits the device to access the protected electronically stored data and information.

V. UNFAIR ACTS OF PROPOSED RESPONDENTS

15. Upon information and belief, Respondents have been and continue to be engaged in the importation, the sale for importation, and/or the sale within the United States after importation of certain authentication systems, including software and handheld electronic devices that infringe, directly, indirectly, contributorily and/or through inducement, at least one claim of the '288 Patent. Specifically, the BlackBerry Desktop Enterprise Activation configuration of the BlackBerry Enterprise Solution infringes claims 31-35, 38, 41, 51, 54, 56, 58, 59, 61, 87-92, 95, 98, 109-113, 115, 117, 119-26, 129-32, 143-45, 149-50, 152-59, 164-67, 178-80, and 184-87 of the '288 Patent. (See Exhibit 3 for claim chart of asserted independent claims). The BlackBerry Administrator Enterprise Activation configuration of the BlackBerry Enterprise Solution infringes claims 31-35, 38, 41, 51, 54, 56, 58, 59, 61, 87-92, 95, 98, 109-113, 115, 117, 119-26, 129-32, 143-45, 149-50, 152-59, 164-66, 178-80, and 184-87 of the '288 Patent. (See Exhibit 4 for claim chart of asserted independent claims). Each element of the asserted claims is found either literally or under the doctrine of equivalents in the accused systems.

16. The BlackBerry Enterprise Solution (consisting of a BlackBerry device, BlackBerry Device Software, BlackBerry Desktop Software, and the BlackBerry Enterprise Server) is designed to protect a company's important confidential data and information. Unlike BlackBerry devices sold to consumers, those sold to Enterprise customers (which upon information and belief constitutes approximately 68 percent of BlackBerry's sales of BlackBerry devices) require Enterprise Activation. Enterprise Activation must occur before a Blackberry

device can be used to access an Enterprise user's Calendar entries, Address Book entries, Tasks, Memos and Email messages. Enterprise Activation occurs when the BlackBerry device is connected to a personal computer running the BlackBerry Desktop Manager software. When connected, the BlackBerry Desktop Manager software communicates with the BlackBerry Enterprise Server (BES) to perform the activation.

17. On April 24, 2008, Prism, at its facility in Omaha, Nebraska, downloaded Blackberry Enterprise Server software ("BES"). Exhibit 5 is a copy of the confirmation of the download of the BES software on April 24, 2008. The BES software was later installed on or about June 2008. On information and belief, the BES software ordered and received by Prism in Omaha, Nebraska originated at RIM's facility in Canada and was imported, sold for importation, and/or sold within the United States after importation.

18. On June 13, 2008, Prism, at its facility in Omaha, Nebraska, purchased a BlackBerry Curve 8330 smartphone that, on information and belief, Respondents imported, sold for importation, and/or sold within the United States after importation. Exhibit 6 includes a photocopy of the box in which the RIM BlackBerry Curve 8330 smartphone was packaged, a photocopy of the disk on which computer software was provided, a photocopy of the invoice for such purchase and a photocopy of the sales receipt. As shown in the photocopies contained in Exhibit 5, the box reads "Handheld Made in CANADA" and the disk reads "software developed in US and Canada."

19. On August 27, 2009, Prism, at its facility in Omaha, Nebraska, downloaded BES software that, on information and belief, Respondents imported, sold for importation, and/or sold within the United States after importation. Exhibit 7 includes a series of screenshots summarizing the ordering and downloading process. On information and belief, the BlackBerry

Enterprise Server software, or BES, ordered and received by Prism in Omaha, Nebraska originated at RIM's facility in Canada and was imported, sold for importation, and/or sold within the United States after importation. Exhibit 6 also includes documents showing the origin of the software.

20. On October 8, 2009, Prism, at its facility in Omaha, Nebraska, received a replacement BlackBerry Curve 8330 smartphone device that, on information and belief, Respondents imported, sold for importation, and/or sold within the United States after importation. Exhibit 8 includes a photocopy of the box in which the replacement RIM BlackBerry Curve 8330 smartphone was packaged and a photocopy of the disk on which replacement computer software was provided. As shown in the photocopies contained in Exhibit 8, the box reads "Handheld Made in MEXICO" and the disk reads "software developed in US and Canada."

21. On information and belief, RIM continues to manufacture, sell, offer for sale, use and/or import into the United States products that operate in the same infringing manner as those products described above in paragraphs 17-20.

22. On information and belief, Respondent RIM Corp. has used and continues to use handheld electronic devices in conjunction with BES software for purposes of authentication inside the United States after importation.

23. On information and belief, the BlackBerry smartphone devices, including the BlackBerry Curve 8330 smartphone device, have been and continue to be used in conjunction with BES software in a manner that infringes claims of the '288 Patent. Specifically, the BlackBerry Desktop Enterprise Activation configuration infringes claims 31-35, 38, 41, 51, 54, 56, 58, 59, 61, 87-92, 95, 98, 109-113, 115, 117, 119-26, 129-32, 143-45, 149-50, 152-59, 164-

67, 178-80, and 184-87 of the '288 Patent. (See Exhibit 3 for claim chart of asserted independent claims). The BlackBerry Administrator Enterprise Activation configuration infringes claims 31-35, 38, 41, 51, 54, 56, 58, 59, 61, 87-92, 95, 98, 109-113, 115, 117, 119-26, 129-32, 143-45, 149-50, 152-59, 164-66, 178-80, and 184-87 of the '288 Patent. (See Exhibit 4 for claim chart of asserted independent claims).

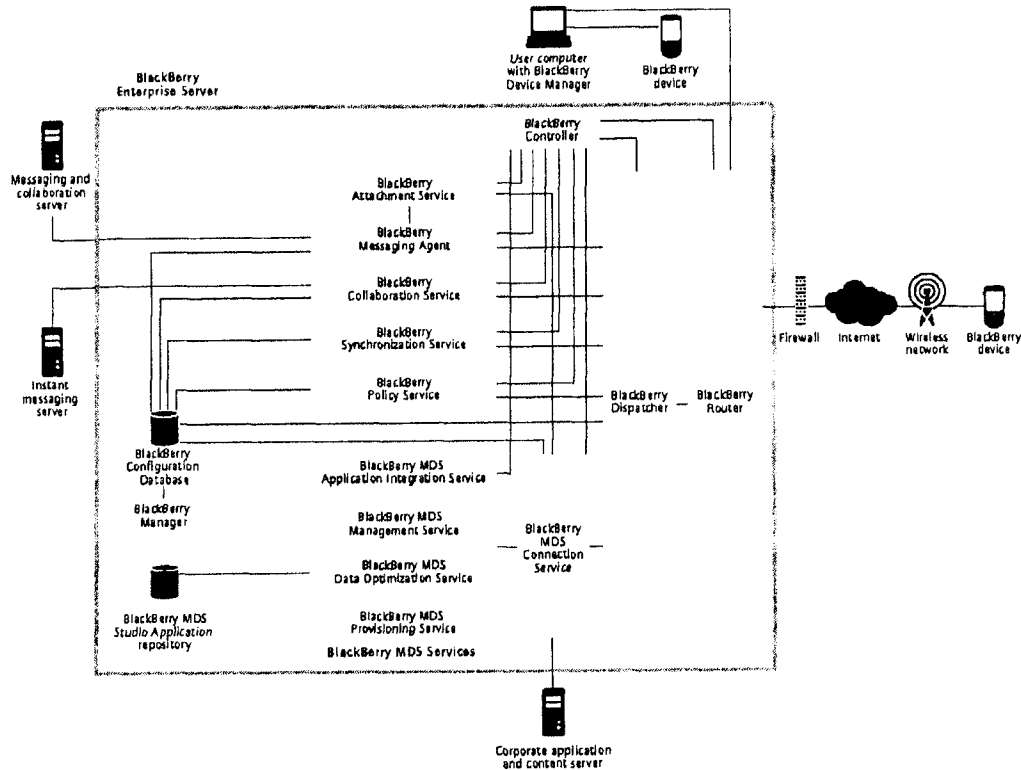
24. On information and belief, Respondents continue to import, sell for importation, and/or sell within the United States after importation handheld electronic devices, including BlackBerry smartphone devices used in conjunction with BES software. Exhibit 9 is a document entitled "2009 Annual Report" downloaded from RIM's website which shows that RIM has significant sales of wireless devices, services and software within the United States (approximately \$6,967,598,000 for FY2009).

25. Upon information and belief, BlackBerry Enterprise Activation enables a BlackBerry device to be activated on the BlackBerry Enterprise Server (BES). Enterprise Activation must occur before a Blackberry device can be used to access *protected resources*.² The *protected resources* accessed during activation include Calendar entries, Address Book entries, Tasks, Memos and Email messages. Exhibit 10, *What is the Wireless Enterprise Activation Process – KBI3850*, Last Modified February 24, 2009, Research In Motion Limited; Exhibit 11, *BlackBerry Enterprise Solution, Security Technical Overview*, p. 29. In addition, "[t]o send and receive messages, the master encryption key stored on the BlackBerry Enterprise Server and on the BlackBerry device must match." See Exhibit 11, *BlackBerry Enterprise Solution, Security Technical Overview*, at p. 9.

² Italicized terms are to the '288 Patent claim terms that correspond to the referenced BlackBerry Enterprise Activation system component.

26. According to RIM’s literature, “[t]he BlackBerry Enterprise Server consists of services and components. The BlackBerry services are designed to provide productivity tools – such as e-mail, instant messaging and organizer functionality – and data from enterprise applications to mobile users. The BlackBerry components are designed to monitor BlackBerry services, process, route, compress, and encrypt data; and communications with the wireless network.” Exhibit 12 includes *BlackBerry Enterprise Server for Microsoft Exchange Version 4.1.4 Feature and Technical Overview*, Research In Motion Ltd., May 10, 2007, pg. 7. Exhibit 11, *BlackBerry Enterprise Solution, Security Technical Overview*, includes a diagram at page 33 that illustrates the BlackBerry Enterprise Server Architecture.

27. The following illustration, entitled “BlackBerry Enterprise Server architecture,” is excerpted from Exhibit 12, which includes *BlackBerry Enterprise Server for Microsoft Exchange Version 4.1.4 Feature and Technical Overview*, Research In Motion Ltd., May 10, 2007, pg. 7:



28. Upon information and belief, “[w]hen a BlackBerry device user connects the BlackBerry device to the computer for the first time, the BlackBerry Desktop Software [*client computer device*] creates the master encryption key [*identity data (client), digital identification*] and sends it to the BlackBerry device and the messaging server.” Exhibit 11 at p. 11. Upon information and belief, the BlackBerry device (*hardware key, access key*) stores a master encryption key in flash memory. Exhibit 11 at p. 9-11. Upon information and belief, the BlackBerry device sends and receives data to and from the BlackBerry Router. Exhibit 11 at pp. 7-8. Upon information and belief, the BlackBerry Router (*server computer, access server*) receives data from the BlackBerry device and forwards that data to the BlackBerry Dispatcher for authentication, authorization and further processing and sends data from the BlackBerry Dispatcher (*clearinghouse, authentication server*) to the BlackBerry device. *Id.* at p. 22. Upon information and belief, the BlackBerry Dispatcher sends and receives data to and from the BlackBerry Configuration Database. Exhibit 12 at pp. 7-8.

29. Upon information and belief, the BlackBerry Configuration Database (*associated database*) is a relational database that contains configuration information that is used by the BlackBerry components. Exh. 12 at p. 8. The BlackBerry Configuration Database contains a master encryption key, *i.e., identity data and digital identification*. Exh. 12 at p. 8; Exh. 11 at pp. 9-11 and 34. The master encryption key uniquely identifies the BlackBerry device to the BlackBerry Enterprise Server. Exh. 11 at p. 9; Exh. 13, *BlackBerry Wireless Enterprise Activation*, Research In Motion Limited, 2004, pgs. 4, 12. The master encryption key is authenticated by the BlackBerry Dispatcher before Enterprise Activation can continue. *Id.*

30. Upon information and belief, once the BlackBerry Dispatcher has authenticated the BlackBerry device master encryption key, the BlackBerry Dispatcher authorizes the

BlackBerry device by giving the BlackBerry device access to Calendar entries, Address Book entries, Tasks, Memos and Email messages (*protected resources*). Exh. 10, *What is the Enterprise Activation Process*, – KB13850, Last Modified February 24, 2009, Research In Motion Limited; *see also* Exh. 11 at pp. 29-30.

31. Pursuant to Commission rule 210.12(a)(9)(viii), Exhibit 3 to the complaint includes a chart comparing independent claims 31, 87, 117, 150, and 185-187 of the ‘288 Patent to the RIM BlackBerry Desktop Enterprise Activation system. In addition, Exhibit 4 to the complaint includes a chart comparing independent claims 31, 87, 117, 150, and 185-187 of the ‘288 Patent to the RIM BlackBerry Administrator Activation system. Exhibits 3 and 4 show that the Respondents’ handheld electronic devices and associated BES software are covered by at least independent claims 31, 87, 117, 150, and 185-187 of the ‘288 Patent. Thus, Respondents are violating Section 337 of the Tariff Act of 1930 by importing, selling for importation, and/or selling within the United States after importation certain authentication systems, including software and handheld electronic devices.

VI. HARMONIZED TARIFF SCHEDULE INFORMATION

32. The articles subject to this complaint are classifiable under at least the following headings and subheadings of the Harmonized Tariff Schedule (“HTS”) of the United States: 8517.18.50 (Other apparatus for transmission or reception of voice, images or other data, including apparatus for communication in a wired or wireless network (such as a local or wide area network)); 8517.62.50 (Machines for the reception, conversion and transmission or regeneration of voice, images or other data, including switching and routing apparatus). These HTS numbers are illustrative only and are not intended to restrict the scope of this investigation.

VII. RELATED LITIGATION

33. On December 29, 2008, Prism filed a complaint for infringement of the '288 Patent against Research In Motion, Ltd. and Microsoft Corporation in the United States District Court for the District of Nebraska ("the Nebraska district court action"). *Prism Techs., LLC v. Research In Motion, Ltd., et al.*, Case No. 8:08-cv-00537-LES-TDT (D. Neb.). A copy of the Complaint in this case is included in Exhibit 14.

34. On September 25, 2009, Prism and Microsoft Corp. filed a joint motion to dismiss Microsoft Corp. from the case in view of the parties' agreement to a compromise and settlement. Confidential Exhibit 15 includes a copy of the Settlement and License Agreement between Microsoft and Prism. Microsoft was dismissed from the case on September 28, 2009. The Nebraska district court action is currently pending as against RIM.

35. Prior to the Nebraska litigation, Prism also sued third party companies for infringement of a patent related to the '288 Patent – U.S. Patent No. 6,516,416 ("the '416 Patent"). The '288 Patent is a continuation in part of an application that led to the '416 Patent. Prism filed a complaint for infringement of the '416 Patent on April 11, 2005 against Verisign Inc., RSA Security Inc., Netegrity, Inc., Computer Associates International Inc., and Johnson & Johnson in the United States District Court for the District of Delaware. *Prism Techs., LLC v. VeriSign, Inc. et al.*, Case No. 05-214-JJF (D. Del.) ("Delaware district court action"). A copy of the Complaint in this case is included in Exhibit 16.

36. On July 22, 2005, Prism filed an amended complaint and on August 29, 2006 a second amended complaint. Prism asserted in the Delaware district court action that the defendants infringed at least claims 1 and 24 of the '416 Patent. A copy of the first and second amended Complaints in this case are included in Exhibits 17 and 18, respectively.

37. On April 2, 2007, the Delaware district court entered an Order on claim construction of 21 claim terms of the '416 Patent. On April 18, 2007, the parties entered a stipulation that, pursuant to the Delaware district court's construction of two of the 21 claim terms, the defendants did not infringe the asserted claims of the '416 Patent. Prism preserved its right to appeal the Delaware district court's ruling on claim construction. On April 23, 2007, the Delaware district court entered final judgment of non-infringement.

38. On April 27, 2007 Prism filed a Notice of Appeal to the United States Court of Appeals for the Federal Circuit. On February 6, 2008, the Federal Circuit affirmed the lower court's decision without a written opinion.

39. The allegations contained herein are fully consistent with the ruling on claim construction by the Delaware district court and the Federal Circuit.

40. Subsequently on December 19, 2008 Prism entered into an agreement regarding the licensing of the '288 Patent, the '416 Patent, and U.S. Patent Nos. 5,745,574, 5,850,442, and 5,943,423.

VIII. DOMESTIC INDUSTRY RELATING TO THE ASSERTED PATENT

A. Prism Maintains A Domestic Industry Under 19 U.S.C. 1337(a)(3)

41. A domestic industry exists through substantial investment in the '288 Patent through licensing by Prism Technologies, and substantial research and development by Prism Technologies' predecessor, Prism Resources. *See* Confidential Exhibits 19 and 20.

42. As background, Prism Resources was founded by Mr. Richard L. Gregg in 1989. Mr. Gregg is currently the Founder, Vice-President and Chief Technology Officer of Prism Technologies. Prism Technologies LLC was formed in 2003 as a limited liability company dedicated to the management, acquisition and licensing of technology fundamental to Internet

security and e-commerce. Shortly after its formation in August 2003, Prism Technologies LLC purchased the equipment, software, and intellectual property of Prism Resources.

43. Individuals employed by Prism Resources, in particular Mr. Gregg, Timothy Goeke and Sandeep Giri, conceived of, developed and commercially sold products embodying the inventions claimed in the '288 Patent (and its parent, the '416 Patent), and, thus, Prism Resources is the direct predecessor-in-interest to Prism Technologies with respect to ownership of the '416 and '288 Patents as well as business interests. Mr. Gregg maintains his leadership position at Prism Technologies and Messrs. Goeke and Giri are contracted with Prism Technologies under a consulting agreement for purposes of licensing efforts and litigation consulting.

44. Thus, with respect to the '288 Patent, a domestic industry in the United States exists as defined under Section 337(a)(3) through licensing by Prism Technologies, and substantial research and development by Prism Technologies' predecessor. Specifically, Prism has, in the past as Prism Resources, made substantial investments in the research and development of the technology claimed in the '288 Patent. In addition, Prism Technologies has also made and is currently making substantial investments in the exploitation of the '288 Patent through licensing the technology claimed in the patent. Those efforts are outlined in more detail below.

1. Prism Resources Made Substantial Investments in the Research and Development of the Technology Claimed In the '288 Patent Pursuant to Section 337 (a)(3)(C)

45. In 1989, Mr. Gregg began performing consulting resources under the entity name Prism Resources. From the inception of Prism Resources until 1997, Mr. Gregg acted as the President and Sole Director of Prism Resources. From 1998 to 2003, Prism Resources expanded to include several officers, directors and employees. At the height of Prism Resources there

were approximately 15 full time employees. Prism Resources maintained 2,500 square feet of office space at 2328 Bob Boozer Drive, Omaha, Nebraska. Prism Resources quickly gained a reputation for providing superior project management and implementing reliable software and systems in a timely and efficient manner.

46. In early 1996, with the Internet still in its infancy, business models encouraged open access to computer resources available on the Internet, but costly private networks were preferred where access control was desired because the open Internet posed problematic security issues. This was largely a result of the fact that Internet technology was not created with security in mind. An early customer of Prism Resources perceived the cost savings potential in employing the low-cost Internet to replace higher-cost private networks if the Internet's security problems could be solved. Prism Resources set out to solve this problem by developing a revolutionary solution for controlling access to computer resources over an open network like the Internet. Prism Resources' novel system enabled access to resources using a hardware key that contained digital credentials necessary for authentication. The invention turned the insecure public Internet connection between two parties into the equivalent of a secure, low-cost private network. After developing the system Prism Resources proceeded to patent the invention and produce a product called Internet Subscription Access (or "ISA"), embodying the invention, that was successfully sold in the marketplace.

47. In or around March, 1996, Mr. Gregg began the process that led to the conception of ISA, the subject matter claimed in the '416 and '288 Patents. At that time, Mr. Gregg was asked by Data Transmission network Corp. ("DTN") to develop a system using the Internet that would replace DTN's existing satellite-based transmission network. In responding to this request Mr. Gregg conceived of the subject matter of the '416 and '288 Patents. He directed the

development of the ISA system and approved the software design and system architecture as well as managed the design project team and performed system tests. The subject matter of the '288 Patent was described in a Functional Specification on or around May, 1996, a document authored and edited by four individuals, including Mr. Gregg. Mr. Timothy Goeke and Sandeep Giri, the other two inventors named on the '416 and '288 Patents, also assisted in developing the ISA system and drafting the Functional Specification. Prism Resources spent an extensive amount of time and resources drafting design specifications for the ISA product. Confidential Exhibit 21 includes design specifications for the ISA product.

48. In or around July 1996, Prism Resources performed the first confidential demonstration of a prototype of the ISA system to DTN, but never sold the ISA product to that company. Later, Prism Resources developed and sold commercial embodiments of the ISA product (i.e., the subject matter claimed in the '288 Patent) for American Business Information, Inc. ("ABI"), Securities America, Inc. ("SAI") and Construction Network Services, Inc. ("CNS"). The revenues received by Prism Resources for the direct sales of those ISA systems and for services rendered on those systems are summarized in Confidential Exhibit 19. Confidential Exhibits 22-24 include Prism Resource tax returns from the years 1996-1998, respectively.

49. Prism Resources made substantial investments in the research and development of the technology underlying the ISA system and contained in the '416 and '288 patents. At its height, Prism Resources employed 15 full time employees, providing those employees with salaries and benefits. In addition, Prism Resources incurred other overhead expenses such as rent and utilities. A summary of Prism Resources' revenues and expenses relating to the ISA

product is provided in Confidential Exhibit 19. Confidential Exhibits 22-24 include Prism Resource tax returns from the years 1996-1998, respectively.

50. As discussed below, Prism Resources sold its assets to Prism Technologies LLC in 2003 to further utilize those assets in the management of technology for Internet security. Mr. Gregg is the Founder, Vice-President and Chief Technology Officer of Prism Technologies and Messrs. Goeke and Giri are engaged by Prism Technologies under a consulting agreement.

2. Prism Has Made, and Is Making, Substantial Investments In the Exploitation of the Technology Claimed In the '288 Patent Pursuant to Section 337 (a)(3)(C)

51. Prism Technologies LLC was formed in August 2003. Prism currently generates revenue from the management, acquisition and licensing of technology fundamental to Internet security and e-commerce. At the present time, four individuals are employed by Prism, all of whom are officers of the company and all of whom are engaged full time in the activities of managing, acquiring, licensing and enforcing the technology claimed in the '288 Patent, and other patents owned by Prism.

52. In September 2003, Prism Technologies LLC purchased Prism Resources' equipment, the ISA product software, the '416 patent and the related continuation-in-part (now the '288 Patent). Confidential Exhibit 25 includes a copy of the September 15, 2003 Contribution Agreement memorializing the purchase of Prism Resources by Prism Technologies, LLC. The financial details of Prism's acquisition of the '416 Patent and related '288 Patent application are summarized in Confidential Exhibit 20. Subsequent to the purchase, Prism Resources retained a majority ownership interest in Prism Technologies in the form of shares of the company.

53. After Prism Technologies was formed and acquired the right, title and interest to the '416 Patent and the relating continuation-in-part application, Prism sent letters to five

companies in an effort to license the '416 Patent. Details regarding these efforts are outlined in more detail in Confidential Exhibit 20. These efforts related to claims 22 and 23 of the '416 Patent. None of the companies expressed an interest in licensing the '416 Patent. Subsequently, after the Prism initiated the Delaware district court action it sent out letters rescinding any offers previously extended to these companies.

54. Prism has also approached other companies to provide information regarding the asserted subject matter of the '416 Patent and the related '288 Patent application. The details of these efforts are outlined in Confidential Exhibit 20.

55. After the '288 Patent issued, Prism approached several companies regarding the licensing of that patent. The details of these efforts are outlined in Confidential Exhibit 20.

56. Prism also sought to license the '288 Patent to Microsoft Corporation. On September 10, 2009, Prism and Microsoft entered into a Settlement and License Agreement relating to the '288 Patent. Confidential Exhibits 15 and 20 provide more detail.

57. In addition to these licensing efforts, Prism had discussions regarding the licensing of the '288 and '416 Patents with other companies. The details of those discussions are outlined in Confidential Exhibit 20.

58. Prism has entered into another licensing agreement relating to the '288 Patent with another company. Confidential Exhibit 20 includes a summary of the licensing and associated revenues from licensing of the '288 Patent and other related patents.

59. Additionally, Prism has licensed other patents in its portfolio. Confidential Exhibit 20 explains this activity in more detail and Confidential Exhibit 27 contains a copy of a Settlement and License Agreement Prism executed in favor of another company.

60. Prism has made, and continues to make, a significant investment in the exploitation of the '288 Patent. Currently, Prism has four full-time employees fully dedicated to the efforts of licensing and enforcing its patent technology, including technology relating to the '288 Patent. Included within these employees is a full-time in-house counsel, responsible for legal aspects of Prism's intellectual property litigation. Prism maintains an office in Omaha, Nebraska. In sustaining the day-to-day business operations, Prism incurs significant expenses, including salaries, employee benefits, rent, utilities and other overhead costs. Prism's efforts to license the technology patented in the '416 and '288 Patents, including patent related market research, patent licensing, patent prosecution and associated business administration, have culminated in almost seven years of significant expenditures to exploit its rightfully owned technology. A summary of the expenses incurred by Prism relating to the technology claimed in the '288 Patent is provided in Confidential Exhibit 20.

IX. RELIEF

WHEREFORE, by reason of the foregoing, Prism requests that the Commission:

- a. Institute an investigation pursuant to Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, with respect to Respondents' violations of Section 337 based on the importation into the United States, the sale for importation into the United States, and/or the sale within the United States after importation of certain authentication systems, including software and handheld electronic devices that infringe the '288 Patent;
- b. Schedule and conduct a hearing on permanent relief pursuant to 19 U.S.C. § 1337(d) and (f) of the Tariff Act of 1930, as amended;
- c. Issue a Limited Exclusion Order specifically directed to each named Respondent, pursuant to 19 U.S.C. § 1337(d), excluding from entry into the United States

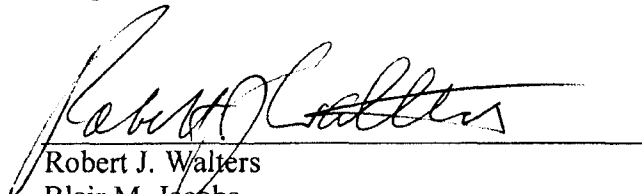
articles that infringe the '288 Patent, including but not limited to the BlackBerry Enterprise Solution (consisting of BlackBerry devices, BlackBerry Device Software, BlackBerry Desktop Software, and BlackBerry Enterprise Server);

d. Issue a cease and desist order pursuant to 19 U.S.C. § 1337(f) prohibiting domestic Respondent Research In Motion Corp. from engaging in the unlawful importation and/or sale within the United States after importation of the BlackBerry Enterprise Solution (consisting of BlackBerry devices, BlackBerry Device Software, BlackBerry Desktop Software, and BlackBerry Enterprise Server) that infringes the '288 Patent;

e. Impose a bond upon Respondents who continue to import infringing articles during the 60-day-Presidential review period per 19 U.S.C. § 1337(j); and

f. Issue such other and further relief as the Commission deems just and proper under the law, based upon the facts determined by the investigation and the authority of the Commission.

Respectfully submitted,



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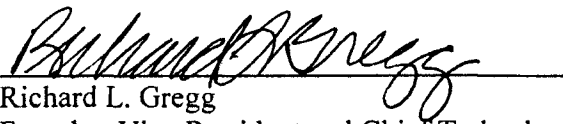
André J. Bahou, Esq.
V.P. and Chief Intellectual Property Officer
Prism Technologies LLC
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Washington DC 20004

VERIFICATION OF COMPLAINT

I, Richard L. Gregg, declare, in accordance with 19 C.F.R. § 210.4 and § 210.12(a), as follows:

1. I am Founder, Vice-President and Chief Technology Officer for Prism Technologies LLC, and I am duly authorized to sign this Complaint;
2. I have read the Complaint and I am aware of its contents;
3. The Complaint is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;
4. To the best of my knowledge, information and belief founded upon reasonable inquiry, the claims and legal contentions of the Complaint are warranted by existing law or a nonfrivolous argument for the extension, modification or reversal of existing law or the establishment of new law; and
5. The allegations and other factual contentions made in the Complaint have evidentiary support or are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

I declare under the penalty of perjury under the laws of the United States of America that the foregoing is true and correct.


Richard L. Gregg
Founder, Vice-President and Chief Technology
Officer
Prism Technologies LLC