

# Inequitable Conduct: Unwinding the Tangled Web of Deceit

Stephen S. Korniczky  
Chair, IP Practice Group  
skorniczky@sheppardmullin.com  
&  
Martin R. Bader, Partner  
mbader@sheppardmullin.com



Oh! what a tangled web we weave  
When first we practice to deceive!

-Sir Walter Scott

# Who is Daniel Henderson?



US007310416B1

## (12) United States Patent Henderson

(10) Patent No.: US 7,310,416 B1  
(45) Date of Patent: \*Dec. 18, 2007

- (54) METHOD AND APPARATUS FOR IMPROVED PERSONAL COMMUNICATION DEVICES AND SYSTEMS 3,787,626 A 1/1974 Subieta ..... 179:5.5  
3,812,296 A 5/1974 Paraskevakos ..... 179:18  
3,984,625 A 10/1976 Camras .....  
4,065,642 A 12/1977 McClure ..... 179:18

(75) Inventor: Daniel A. Henderson, Los Altos, CA (US)

(73) Assignee: Intellect Wireless Inc., Fort Worth, TX (US)

(\*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 161 days.

This patent is subject to a terminal disclaimer.

(Continued)

### FOREIGN PATENT DOCUMENTS

DE 3315625 10/1984 ..... 379:58

(Continued)

### OTHER PUBLICATIONS

Communication Base-Set With LCD Screen by Jonathan Carr et al. Jun. 1993.\*

(Continued)

Primary Examiner—Fan Tsang

Assistant Examiner—Olisa Anwah

(74) Attorney, Agent, or Firm—Robert K. Tendler

(21) Appl. No.: 11/045,677

(22) Filed: Jan. 28, 2005

### Related U.S. Application Data

(60) Division of application No. 10/033,824, filed on Dec. 19, 2001, which is a continuation of application No. 08/726,024, filed on Oct. 4, 1996, and a continuation-in-part of application No. 08/177,851, filed on Jan. 5, 1994, now Pat. No. 6,278,862.

(60) Provisional application No. 60/005,029, filed on Oct. 6, 1995.

(51) Int. Cl. H04M 1/56 (2006.01)

(52) U.S. CL. 379/142.04; 340/7.56; 455/415; 379/142.17

(58) Field of Classification Search 455/418, 455/419, 41.2, 414.1, 575, 90, 344, 351, 455/556

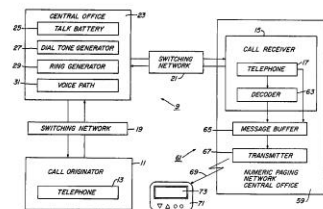
See application file for complete search history.

(56) References Cited

### U.S. PATENT DOCUMENTS

3,727,003 A 4/1973 Paraskevakos ..... 178:28

44 Claims, 45 Drawing Sheets



US007266186B1

## (12) United States Patent Henderson

(10) Patent No.: US 7,266,186 B1  
(45) Date of Patent: \*Sep. 4, 2007

- (54) METHOD AND APPARATUS FOR IMPROVED PAGING RECEIVER AND SYSTEM 3,787,626 A 1/1974 Subieta ..... 179:5.5  
3,812,296 A 5/1974 Paraskevakos ..... 179:18

(Continued)

### FOREIGN PATENT DOCUMENTS

DE 3315625 10/1984 ..... 379:58

(Continued)

### OTHER PUBLICATIONS

Messaging: A New Direction—Awash in E-Mail Troubles? A Rife of new Products is Coming to the Rescue, Network Computing, Oct. 1, 1996, pp. 58.

(Continued)

Primary Examiner—Fan Tsang

Assistant Examiner—Olisa Anwah

(74) Attorney, Agent, or Firm—Robert K. Tendler

(21) Appl. No.: 10/033,824

(22) Filed: Dec. 19, 2001

### Related U.S. Application Data

(63) Continuation-in-part of application No. 08/726,024, filed on Oct. 4, 1996, which is a continuation-in-part of application No. 08/177,851, filed on Jan. 5, 1994, now Pat. No. 6,278,862.

(60) Provisional application No. 60/005,029, filed on Oct. 6, 1995.

(51) Int. Cl. H04M 1/56 (2006.01)

(52) U.S. CL. 379/142.04; 340/7.56; 455/415; 379/142.17

(58) Field of Classification Search 379/142.17, 379/142.04, 142.15, 88.11, 88.15, 88.21, 379/88.2; 455/415; 340/7.56

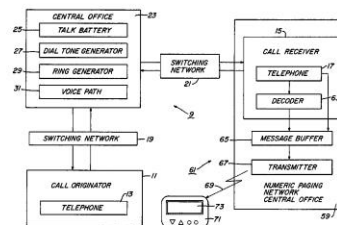
See application file for complete search history.

(56) References Cited

### U.S. PATENT DOCUMENTS

3,727,003 A 4/1973 Paraskevakos ..... 178:28

37 Claims, 45 Drawing Sheets



# Henderson's Patents

Case 1:09-cv-02945 Document 23 Filed 08/06/2009 Page 1 of 9

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS

INTELLECT WIRELESS, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 09 C 2945
	)	
HTC CORPORATION,	)	Honorable William T. Harte
HTC AMERICA, INC.,	)	Honorable Geraldine Soat Brown
RESEARCH IN MOTION LIMITED,	)	
AND AT&T MOBILITY LLC,	)	
	)	<b>JURY TRIAL DEMANDED</b>
Defendants.	)	

## AMENDED COMPLAINT

Plaintiff, Intellect Wireless, Inc. ("Intellect Wireless") complains of  
defendants HTC Corporation ("HTC Corporation"), HTC America, Inc. ("HTC

Mr. Henderson has been awarded 25 United States patents with several more pending that relate to picture / video messaging in wireless devices such as PDA's, portable computers and cellular phones.

3. Daniel Henderson is the founder of Intellect Wireless, and the sole inventor of the patents-in-suit. Mr. Henderson has been awarded 25 United States patents with several more pending that relate to picture / video messaging in wireless devices such as PDA's, portable computers and cellular phones. Mr. Henderson's prototype for a wireless picture phone device was received as part

# Henderson's Prototype in the Smithsonian

Case 1:09-cv-02945 Document 23 Filed 08/06/2009 Page 1 of 9



Henderson's prototype for a wireless picture phone device was received as part of the permanent collection of the Smithsonian Institution in the National Museum of American History.

inventor of the patents-in-suit. Mr. Henderson has been awarded 25 United States patents with several more pending that relate to picture / video messaging in wireless devices such as PDA's, portable computers and cellular phones. Mr. Henderson's prototype for a wireless picture phone device was received as part

Case 1:09-cv-02945 Document 23 Filed 08/06/2009 Page 2 of 9

of the permanent collection of the Smithsonian Institution in the National Museum of American History. The Honorable Senator Gordon H. Smith, (OR), declared that Mr. Henderson has "truly blazed new trails in the fields of wireless technology and digital convergence" and called him a "true visionary."

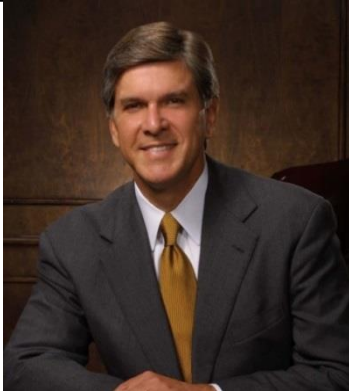
4. Intellect Wireless owns all right, title, interest in and has standing to sue for the infringement of United States Patent No. 7,266,186 entitled "Method and Apparatus for Improved Paging Receiver and System" which issued on September 4, 2007 ("the '186 Patent").

5. Intellect Wireless owns all right, title, interest in and has standing to sue for the infringement of United States Patent No. 7,310,416 entitled "Method

Mr.

corporate headquarters at 23 Xinghua Road, Taoyuan 330, Taiwan. HTC Corporation does substantial business in this judicial district including the

# Henderson Recognized by Senator



23 Filed 08/06/2009 Page 1 of 9

UNITED STATES DISTRICT COURT  
DISTRICT OF ILLINOIS

Civil Action No. 09 C 2945

Honorable William T. Harte  
Honorable Geraldine Soat Brown

**JURY TRIAL DEMANDED**

## AMENDED COMPLAINT

Plaintiff, Intellect Wireless, Inc. ("Intellect Wireless") complains of  
defendants HTC Corporation ("HTC Corporation"), HTC America, Inc. ("HTC  
America"), and AT&T Intellectual Property ("AT&T")

Case 1:09-cv-02945 Document 23 Filed 08/06/2009 Page 2 of 9

of the permanent collection of the Smithsonian Institution in the National Museum  
of American History. The Honorable Senator Gordon H. Smith, (OR), declared  
that Mr. Henderson has "truly blazed new trails in the fields of wireless  
technology and digital convergence" and called him a "true visionary."

4. Intellect Wireless owns all right, title, interest in and has standing to  
sue for the infringement of United States Patent No. 7,266,186 entitled "Method  
and Apparatus for Improved Paging Receiver and System" which issued on  
September 4, 2007 ("the '186 Patent").

5. Intellect Wireless owns all right, title, interest in and has standing to  
sue for the infringement of United States Patent No. 7,310,416 entitled "Method  
and Apparatus for Improved Personal Communication Devices and Systems"  
which issued on December 18, 2007 ("the '416 Patent").

The Honorable Senator Gordon H. Smith, (OR), declared  
that Mr. Henderson has "truly blazed new trails in the fields of wireless  
technology and digital convergence" and called him a "true visionary."

States patents with several more pending that relate to picture / video messaging  
in wireless devices such as PDA's, portable computers and cellular phones. Mr.  
Henderson's prototype for a wireless picture phone device was received as part

corporate headquarters at 25 Xinghua Road, Taoyuan 300, Taiwan. HTC  
Corporation does substantial business in this judicial district including the

# Work with Nobel Prize Winning Engineer

## Services

## History

of Dr. Hashimoto  
of Mr. Henderson  
of Philanthropy

## Patents

## News

## Contact Us



Daniel Henderson holding the first patent model of the telephone coil submitted to the USPTO by Alexander Graham Bell in March, 1876.



## On the shoulders of giants.

In 1993, inventor Daniel Henderson became an apprentice of Dr. Kazuo Hashimoto and worked with him on licensing, management issues and infringement analysis. Unfortunately, their collaborative efforts were cut short in 1995 with Dr. Hashimoto's

Henderson worked with Jack Kilby, who received the Nobel Prize for Physics in 2000 for the invention of the world's first integrated circuit (IC) chip, to study infringement of some of Hashimoto's patents.

Henderson worked with Jack Kilby, who received the Nobel Prize for Physics in 2000 for the invention of the world's first integrated circuit (IC) chip,

machine.

many artifacts and early prototypes donated by PhoneTel.

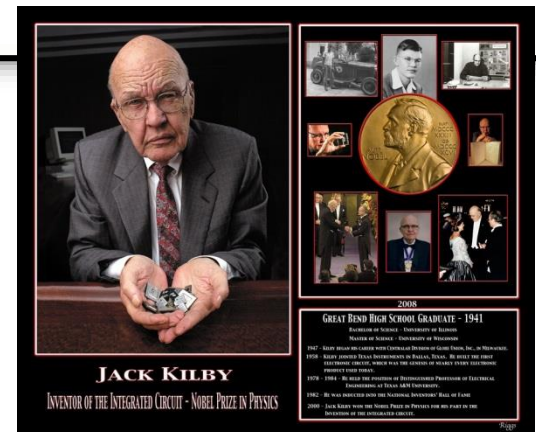
## A promise kept.

By successfully licensing nearly every telecommunications and computer company Daniel Henderson made sure Hashimoto's work was respected and rewarded.

He has broad experience in the creation, management, and licensing of intellectual property. He holds numerous patents in telephony and communications. Henderson was formerly with IBM Corporation and



Daniel Henderson with his mentor, Dr. Kazuo Hashimoto



# Apprentice to Dr. Hashimoto, Inventor of the Answering Machine

On the shoulders of giants.

## Services

## History

of Dr. Hashimoto  
of Mr. Henderson

In 1993, inventor Daniel Henderson became an apprentice of Dr. Kazuo Hashimoto and worked with him on licensing, management issues and infringement analysis. Unfortunately, their collaborative efforts were

Henderson worked with Jack Kilby, who received the Nobel Prize for Physics in 2000 for the invention of the world's first integrated circuit (IC) chip, to study infringement of some of Hashimoto's patents.

In 1993, inventor Daniel Henderson became an apprentice of Dr. Kazuo Hashimoto



Daniel Henderson holding the first patent model of the telephone coil submitted to the USPTO by Alexander Graham Bell in March, 1876.



Smithsonian Institution

telecommunications and computer industries.

In 1996, Henderson and Hashimoto's widow cofounded PhoneTel Communications, a company dedicated to protecting the patent portfolios of inventors including Dr. Kazuo Hashimoto, one of history's most prolific inventors and the father of the answering machine.

### A promise kept.

By successfully licensing nearly every telecommunications and computer company Daniel Henderson made sure Hashimoto's work was respected and rewarded.

He has broad experience in the creation, management, and licensing of intellectual property. He holds numerous patents in telephony and communications. Henderson was formerly with IBM Corporation and

the PhoneTel Endowed Graduate Fellowship Fund and involvement in creating a new course entitled "Inventions and Patents." He was the commencement speaker when NJIT first presented the Hashimoto prize in 1998.

Henderson was invited to the Smithsonian Institution to accept a deed of gift for the many artifacts and early prototypes donated by PhoneTel.



Daniel Henderson with his mentor, Dr. Kazuo Hashimoto



Daniel Henderson with his mentor, Dr. Kazuo Hashimoto

# Work for IBM and Distinguished Alumnus Award



## History

Services

History

of Dr. Hashimoto  
of Mr. Henderson  
of Philanthropy

Patents

News

Contact Us



Daniel Henderson holding the first patent model of the telephone call submitted to the USPTO by Alexander Graham Bell in March, 1876.



Smithsonian Institution

Hashimoto, one of history's most prolific inventors and the father of the answering machine.

A promise kept.

By successfully licensing nearly every telecommunications and computer company Daniel Henderson made sure Hashimoto's work was respected and rewarded.

He has broad experience in the creation, management, and licensing of intellectual property. He holds numerous patents in telephony and communications. Henderson was formerly with IBM Corporation and received the "Distinguished Alumnus Award" from Southern Oregon University.

Henderson was invited to the Smithsonian Institution to accept a deed of gift for the many artifacts and early prototypes donated by PhoneTel.



Daniel Henderson with his mentor, Dr. Kazuo Hashimoto

## Henderson

was formerly with IBM Corporation and received the "Distinguished Alumnus Award" from Southern Oregon University.

Copyright © 2002 PhoneTel Patent Services Incorporated. [All rights reserved.](#)

# Ties to New Jersey Institute of Technology

Henderson's many ties to the New Jersey Institute of Technology include establishing the PhoneTel IE Inventions and Patents Fund, the PhoneTel Endowed Graduate Fellowship Fund and involvement in creating a new course entitled "Inventions and Patents." He was the commencement speaker when NJIT first presented the Hashimoto prize in 1998.



## History

giants.

Henderson became Hashimoto and management ysis. tive efforts were Hashimoto's

Henderson worked with Jack Kilby, who received the Nobel Prize for Physics in 2000 for the invention of the world's first integrated circuit (IC) chip, to study infringement of some of Hashimoto's patents.

He currently presides over several companies including PhoneTel Patent Services, PhoneTel Communications and Pinpoint Incorporated. He has lectured on "The Power of the Patent."

on to keeping a mentor. He'd do sure Dr. respected in the puter industries.

Hashimoto's widow nications, a ting the patent ng Dr. Kazuo most prolific ve answering

ly every puter company Hashimoto's rded.

he creation, management, and licensing of intellectual property. He holds numerous patents in telephony and communications. Henderson was formerly with IBM Corporation and received the "Distinguished Alumnus Award" from Southern Oregon University.

Henderson's many ties to the New Jersey Institute of Technology include establishing the PhoneTel IE Inventions and Patents Fund, the PhoneTel Endowed Graduate Fellowship Fund and involvement in creating a new course entitled "Inventions and Patents." He was the commencement speaker when NJIT first presented the Hashimoto prize in 1998.

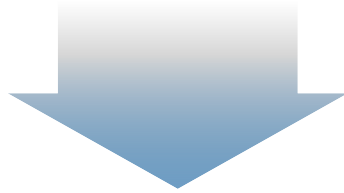
Henderson was invited to the Smithsonian Institution to accept a deed of gift for the many artifacts and early prototypes donated by PhoneTel.



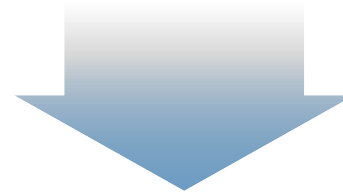
Daniel Henderson with his mentor, Dr. Kazuo Hashimoto

# Case Study: *Intellect Wireless, Inc. v. HTC Corp.*

- Intellect Wireless accused HTC of infringing 2 patents.



- Both patents list Daniel Henderson – the CEO of Intellect – as the sole inventor.



- Intellect claimed its patents covered all MMS (multimedia messaging service) technology, and that Henderson was the first to invent a wireless picture phone.

# Many Sophisticated Companies Paid Millions of Dollars to License Henderson's Patents

Presented below are the logos of the companies that have been sued under the Henderson patents; all of which were successfully resolved and dismissed, including the claim against Motorola which owns the Breeden reference. The total dollar volume of license payment under these Henderson patents is \$19,000,000.00.



T-Mobile



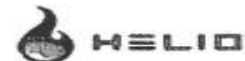
U.S. Cellular



KYOCERA



SANYO



PANTECH

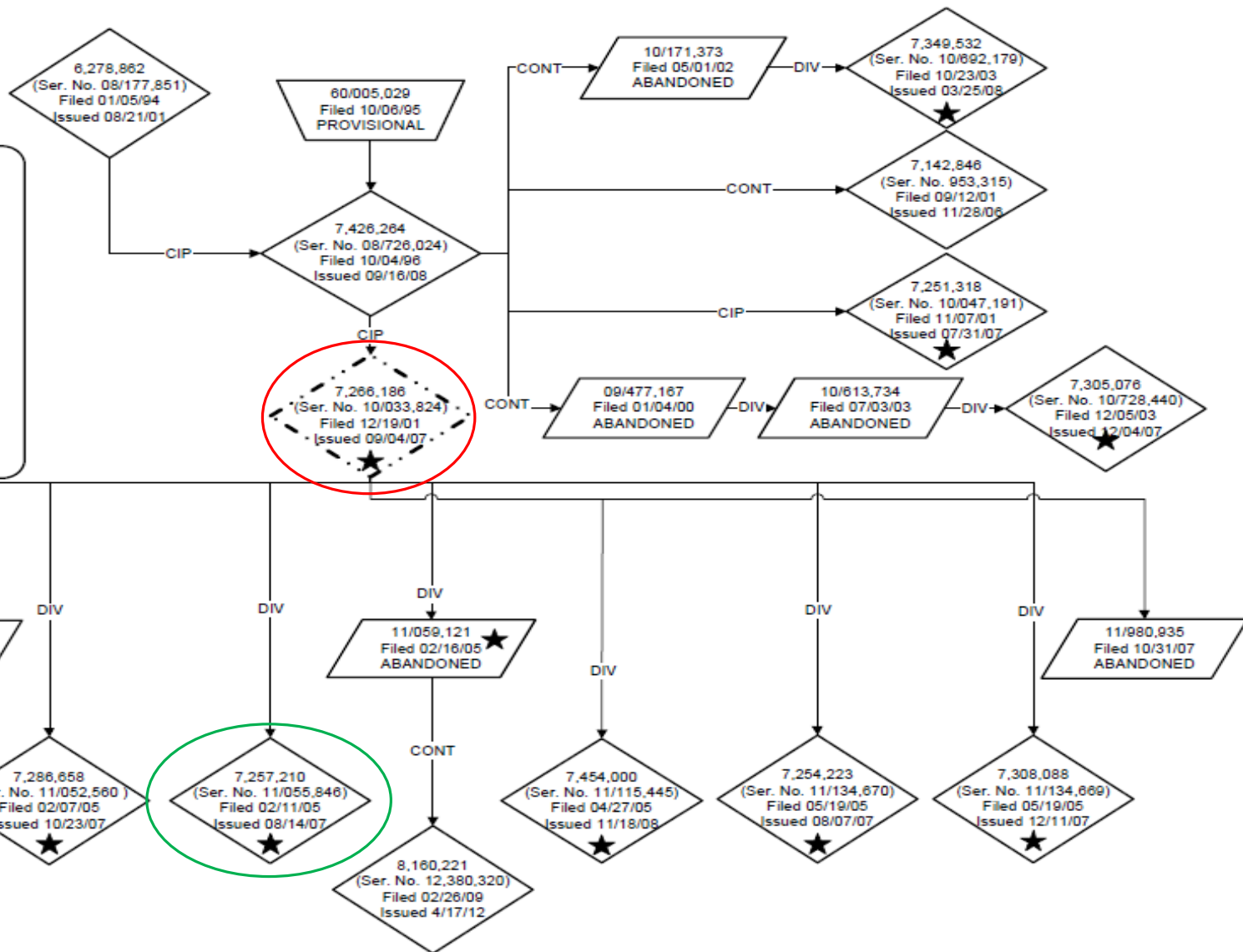
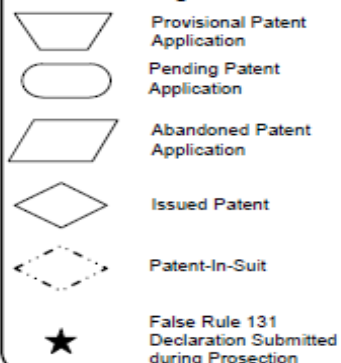
GARMIN

These companies constitute more than 90% of the camera phone market and as such point to the unobviousness of the claimed invention.


# Henderson's Patent Family

## Intellect Wireless '416 and '186 Patent Family Tree

### Legend



# There's Something Fishy In Henderson's File Wrappers!



US007266186B1

(12) **United States Patent**  
**Henderson**

(54) **METHOD AND APPARATUS FOR IMPROVED PAGING RECEIVER AND SYSTEM**

(75) Inventor: **Daniel A. Henderson**, Fort Worth, TX (US)

(73) Assignee: **Intellect Wireless Inc.**, Fort Worth, TX (US)

(\* ) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(h) by 1064 days.

This patent is subject to a terminal disclaimer.

(21) Appl. No.: **10/033,024**

(22) Filed: **Dec. 19, 2001**

**Related U.S. Application Data**

(53) Continuation-in-part of application No. 09/726,024, filed on Oct. 4, 1996, which is a continuation-in-part of application No. 06/177,821, filed on Jan. 5, 1994, now Pat. No. 6,278,862.

(60) Provisional application No. 60/177,821, filed on Jan. 5, 1995.

(51) Int. Cl. **H04B 1/56** (2006.01)

(52) U.S. Cl. **379/142.04, 340/455.415, 379/382.2**

(58) **Field of Classification Search**  
379/142.04, 142.15, 88.11, 142.12, 379/382.2, 455/415, 455/7.56  
See application file for complete search history.

(56) **References Cited**  
**U.S. PATENT DOCUMENTS**  
3,727,003 A 4/1973 Parakevian 179:28

(10) Patent No.: **US 7,266,186 B1**

(45) Date of Patent: **\*Sep. 4, 2007**

3,727,026 A 1/1974 Subita 179:5.1  
3,812,296 A 5/1974 Parakevian 179:18  
(Continued)

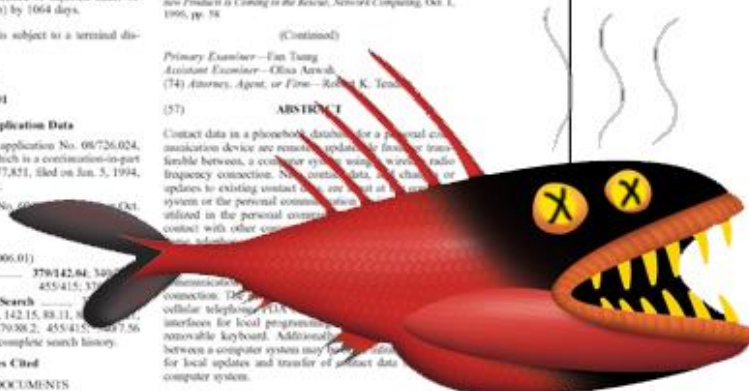
**FOREIGN PATENT DOCUMENTS**  
DE 3315625 10/1994 379:58  
(Continued)

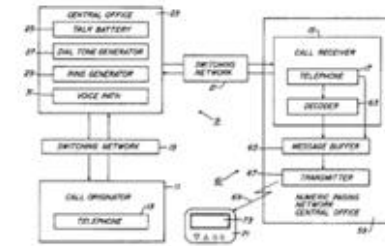
**OTHER PUBLICATIONS**  
*Messaging: A New Dimension—A Look at E-Mail Boudles? A Look at New Products is Coming to the Rescue, Network Computing, Oct. 1, 1996, pp. 58*  
(Continued)

Primary Examiner—Fan Tung  
Assistant Examiner—Olga Arwold  
(74) Attorney, Agent, or Firm—Robert K. Tene

**ABSTRACT**  
Contact data in a phonebook, database, for a personal communication device are received, updateable, including transferable between, a computer system, wireless, radio frequency connection. New contact data and changes or updates to existing contact data are input at a personal system or the personal communication device and are utilized in the personal communication device to establish contact with other communication devices, including a personal communication device, via a radio frequency connection. The personal communication device is a cellular telephone, PDA, or a personal communication device with a removable keyboard. Additionally, a connection between a computer system may be established for local updates and transfer of contact data to a computer system.

**37 Claims, 45 Drawing Sheets**





# Henderson Files His 1st Rule 131 Declaration

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Daniel A. Henderson  
Application No: 11/055,846  
Filing Date: 02/11/2005  
Title: Method and Apparatus for Improved Personal Communication Devices and Systems, U.S. Patent Application No. 11/055,846, having a priority date of January 5, 1994.  
Atty. Docket: H-123 (HEND)

**FEB - 9 - 07 8:18PM**

**RULE 131 DECLARATION**

Commissioner of Patents & Trademarks  
U.S. Patent and Trademark Office  
P. O. Box 1450  
Alexandria, VA 22313-1450

Now comes Daniel A. Henderson and deposes and says:

1. That I am the inventor of the invention described in the patent application entitled "Method and Apparatus for Improved Personal Communication Devices and Systems, U.S. Patent Application No. 11/055,846, having a priority date of January 5, 1994.

2. That this priority date is based on U.S. Patent Application Serial No. 08/177,851, filed January 5, 1994, the subject application having claimed benefit thereof under 35 USC 119, as can be seen in Appendix A.

3. That in the prosecution of the above-captioned case a reference to David E. Albert, U.S. Patent No. 5,452,356, which issued September 19, 1995 and has a filing date of February 16, 1993, was cited against the claims of this case.

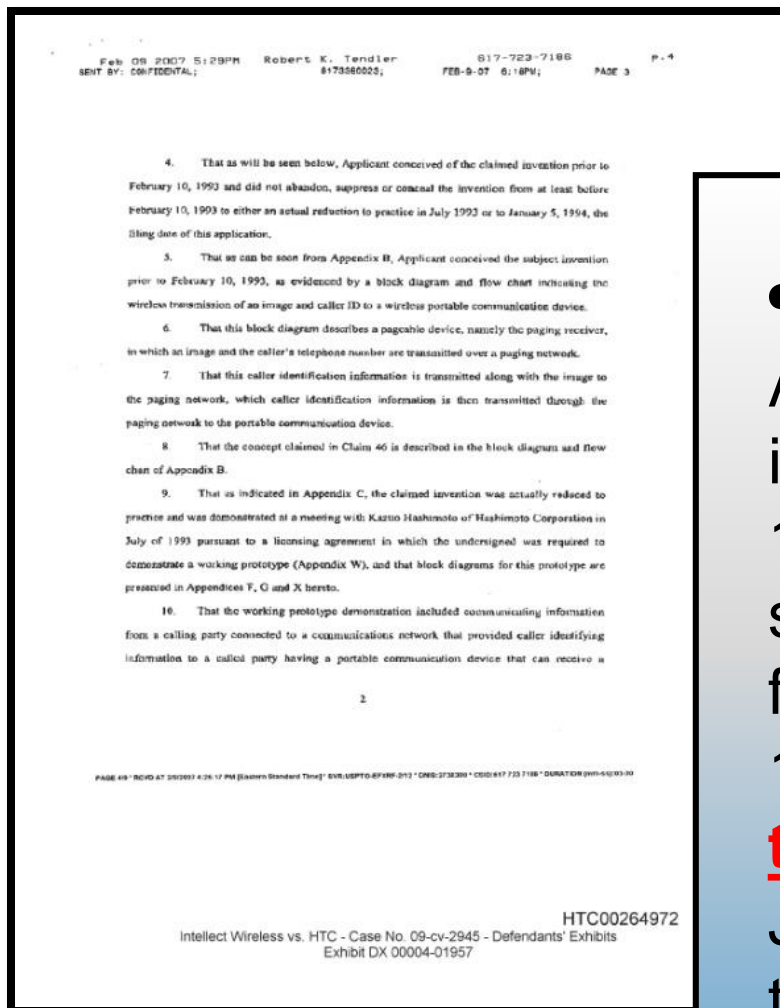
**RULE 131 DECLARATION**

HTC00264971

Intellect Wireless vs. HTC - Case No. 09-cv-2945 - Defendants' Exhibits  
Exhibit DX 00004-01956

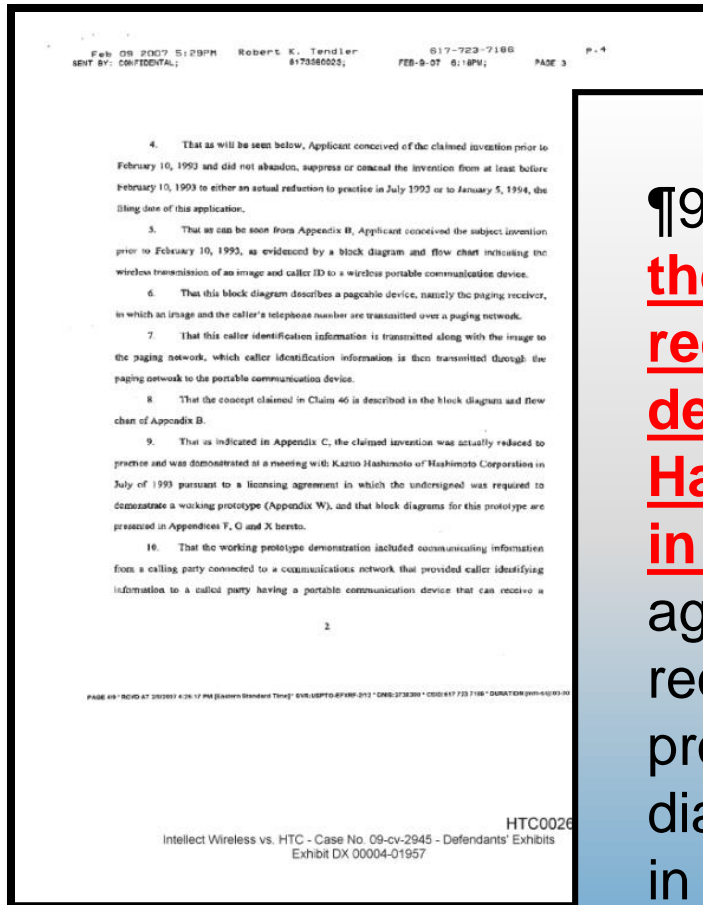
- PTO Examiner cites the Albert Patent as potentially anticipating prior art.
- Albert Patent filed nearly one year before Henderson's January 4, 1994 filing (priority) date.
- Henderson files Rule 131 Declaration to swear behind Albert.

# Henderson's 1st Rule 131 Declaration



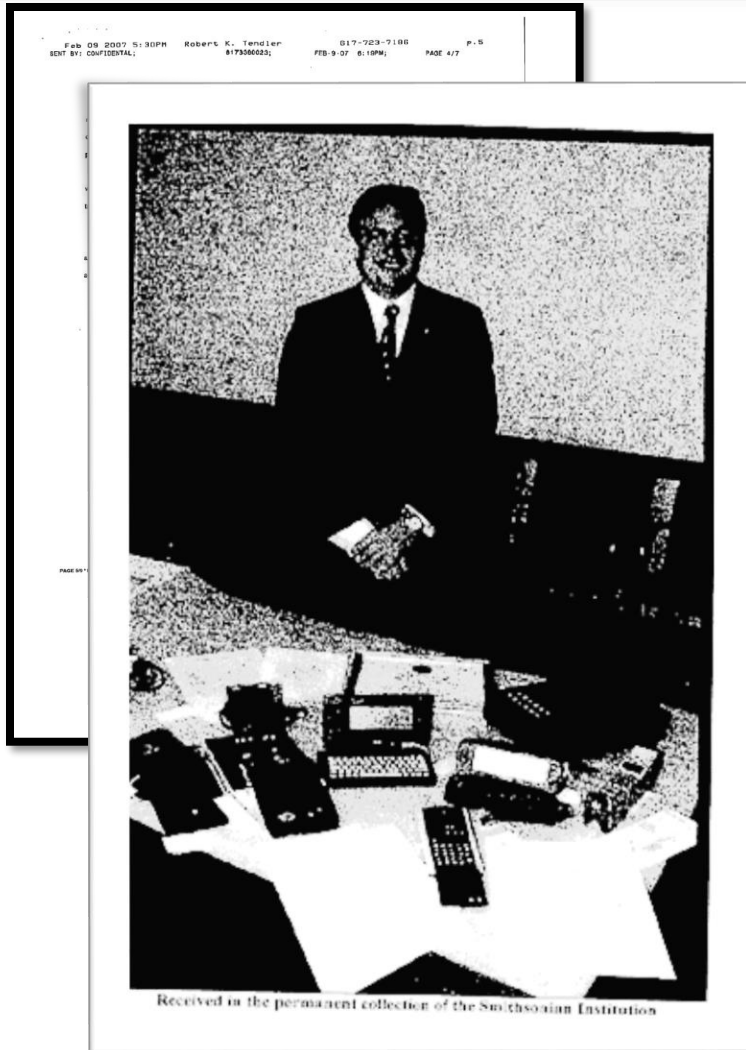
¶4: That as will be seen below, Applicant conceived of the claimed invention prior to February 10, 1993 and did not abandon, suppress or conceal the invention from at least before February 10, 1993 to either an **actual reduction to practice** in July 1993 or to January 5, 1994, the filing date of this application.

# Henderson's 1st Rule 131 Declaration



¶9. That as indicated in Appendix C, the claimed invention was actually reduced to practice and was demonstrated at a meeting with Kazuo Hashimoto of Hashimoto Corporation in July of 1993 pursuant to a licensing agreement in which the undersigned was required to demonstrate a working prototype (Appendix W), and that block diagrams for this prototype are presented in Appendices F, G and X hereto.

# Henderson's 1st Rule 131 Declaration



¶11. That the picture depicted in Appendix C is a picture of a handheld device along with a display that displayed the caller identification and associated image information transmitted via the wireless network.

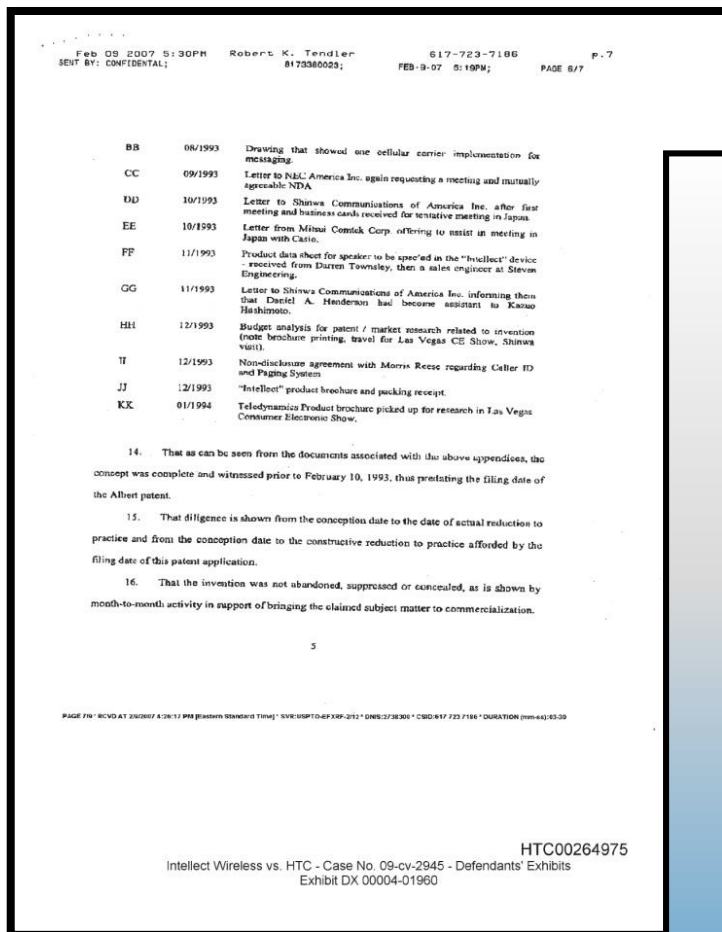
¶12. That this device later became known as the Intellect product.

# Henderson's 1st Rule 131 Declaration

Feb 09 2007 5:30PM Robert K. Tendler 617-723-7186 P. 6	
SENT BY: CONFIDENTIAL; 8173380023; FEB-9-07 8:16PM; PAGE 5/7	
K	04/1993 Non-disclosure agreement between Doctor Design, Inc. and Innovad regarding Daniel A. Henderson's RFP for design assistance of an auto-dialing paging receiver.
L	04/1993 Letter from NEC America Inc. indicating that they will not meet with Daniel A. Henderson without signing their NDA in which Daniel A. Henderson would have given up all his rights.
M	04/1993 Letter to Doctor Design Inc. thanking them for Daniel A. Henderson's visit to their facilities to pursue production design assistance.
N	04/1993 Non-disclosure Agreement with Robert Hotta, design engineer referred from Doctor Design.
O	05/1993 Approx. date is early May 1993, which shows Daniel A. Henderson's notations for the phone number in Japan for Kazuo Hashimoto seeking a license under his patents.
P	05/1993 Facsimile received from AT&T customer information center regarding research about Caller ID technical reference materials.
Q	05/1993 Engineering Services Quotation received from Doctor Design Inc.
R	05/1993 Non-disclosure agreement with Innovad and Hashimoto Corporation regarding the Radio Frequency Auto Dialer.
S	05/1993 Short thank-you note to Kazuo Hashimoto after initial meeting.
T	06/1993 Letter to Kazuo Hashimoto with draft letter of understanding for license under his US Patents 4,821,308; 4,882,744; and 4,065,642.
U	06/1993 Letter to Kazuo Hashimoto regarding GlobalLink company and the draft license agreement.
V	06/1993 Non-disclosure agreement between GlobalLink Communications Inc. and Innovad - Dan Henderson.
W	06/1993 Letter of understanding - signed License Agreement between Hashimoto Corporation and Daniel Henderson/Innovad Company.
X	07/1993 Product view and feature chart shows the "intellect" prototype new in the Smithsonian that was in development for Hashimoto demonstration.
Y	08/1993 Letter to Hewlett Packard requesting license or joint venture for serial infrared Link and PCMCIA technology.
Z	08/1993 Fax received from inquiry related to AlphaAge product.
AA	08/1993 Article covering the Patent Information Clearing House that resulted in an interview of Daniel A. Henderson. Henderson often conducted his own prior art searches in 1992-1995.
4	
PAGE 05* RCVD AT 29/287 4:26:17 PM [Eastern Standard Time] *SVRUSPTO-EPX0P-212 *DWS/273836 *CSO/817 723 7186 *DURATION (mm-ss) 03:30	
HTC00264974	
Intellect Wireless vs. HTC - Case No. 09-cv-2945 - Defendants' Exhibits	
Exhibit DX 00004-01959	

Appendix X 07/1993  
Product view and feature chart shows the "intellect" prototype now in the Smithsonian that was in development for Hashimoto demonstration

# Henderson's 1st Rule 131 Declaration



¶15. That diligence is shown from the conception date to the date of actual reduction to practice and from the conception date to the constructive reduction to practice afforded by the filing date of this patent application.

# The Examiner Relies on Henderson's 1st Rule Declaration

Notice of Allowability	
Application No.	Applicant(s)
11/055,648	HENDERSON, DANIEL A.
Examiner	Art Unit
Olisa Anwah	2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

All claims being allowable, PROSECUTION ON THE MERITS (or previously mailed), a Notice of Allowance (PTO-152) or a Notice of Abandonment (PTO-152) of the Office or upon petition by the applicant. See 37 CFR 1.312.

1. ☒ This communication is responsive to the amendment(s) of the application.

2. ☒ The allowed claim(s) is/are 46-61 and 63-75.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. 119(a) or (b) of the following:

a) ☐ All b) ☐ Some c) ☐ None of the:

1. ☐ Certified copies of the priority document

2. ☐ Certified copies of the priority document

3. ☐ Copies of the certified copies of the priority document

\* Certified copies not received: \_\_\_\_\_

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) ☐ Including changes required by the Notice of Draftperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_

(b) ☐ Including changes required by the attached Examiner's Amendment / Comment or Information Statement

Paper No./Mail Date \_\_\_\_\_

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the top of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.84(c).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL. See attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)

2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)

3. ☒ Information Disclosure Statements (PTO/SB008), Paper No./Mail Date 12/26/2006

4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)

6. ☐ Interview Summary (PTO-949), Paper No./Mail Date \_\_\_\_\_

7. ☒ Examiner's Amendment (PTO-152)

8. ☐ Examiner's Statement of Reasons for Allowance (PTO-949)

9. ☐ Other \_\_\_\_\_

U.S. Patent and Trademark Office  
PTO-37 (Rev. 08-06)

Notice of Allowability

Part of Paper No./Mail Date 20061227

HTC00265121

Intellect Wireless vs. HTC - Case No. 09-cv-2945 - Defendants' Exhibits  
Exhibit DX 00004-02106

The Examiner also submits that the claims are allowable over Albert, U.S. Patent No. 5,452,356 in light of Appendix B of the submitted Affidavit.

OA

Olisa Anwah  
Patent Examiner  
February 12, 2007

# Henderson's 2nd Rule 131 Declaration

- Three days after his first declaration, Henderson files a second Rule 131 declaration.
- Second declaration framed as an “additional” declaration.
- Submitted “because it is unclear whether the fax submission was received and because Applicant wishes to submit a revision thereto.”
- Continued to represent an actual reduction to practice.

# Henderson's 2nd Rule 131 Declaration

SENT BY: CONFIDENTIAL; 8173380023; FEB-12-07 3:20PM; PAGE 5/6

W	08/1993	Fax received from inquiry related to AlphaPage product
X	08/1993	Article covering the Patent Information Clearing House that resulted in an interview of Daniel A. Henderson. Henderson often conducted his own prior art searches in 1992-1995.
Y	08/1993	Drawing that showed one cellular carrier implementation for messaging.
Z	09/1993	Letter to NEC America Inc. again requesting a meeting and mutually agreeable NDA
AA	10/1993	Letter to Shinwa Communications of America Inc. after first meeting and business cards received for tentative meeting in Japan.
BB	10/1993	Letter from Mitsui Comtek Corp. offering to assist in meeting in Japan with Casio.
CC	11/1993	Product data sheet for speaker to be specc'd in the "Intellect" device - received from Darren Townsley, then a sales engineer at Steven Engineering.
DD	11/1993	Letter to Shinwa Communications of America Inc. informing them that Daniel A. Henderson had become assistant to Kazuo Hashimoto
EE	12/1993	Budget analysis for patent / market research related to invention (note brochure printing, travel for Las Vegas CE Show, Shinwa visit).
FF	12/1993	Non-disclosure agreement with Morris Reese regarding Caller ID and Paging System
GG	12/1993	"Intellect" product brochure and packing receipt.
HH	01/1994	Teledynamics Product brochure picked up for research in Las Vegas Consumer Electronic Show.

10. That as can be seen from the documents associated with the above appendices, the concept was complete and witnessed prior to February 10, 1993, thus predating the filing date of the Althert patent.

11. That diligence is shown from the conception date to the date of actual reduction to practice and from the conception date to the constructive reduction to practice afforded by the filing date of this patent application.

4

HTC00264  
Intellect Wireless vs. HTC - Case No. 09-cv-2945 - Defendants' Exhibits  
Exhibit DX 00004-01973

¶11. That diligence is shown from the conception date to the date of actual reduction to practice and from the conception date to the constructive reduction to practice afforded by the filing date of this patent application.

# Henderson's 2nd Rule 131 Declaration

SENT BY: CONFIDENTIAL; 8173380023; FEB-12-07 3:20PM; PAGE 4/6

G	04/1993	Notes regarding Daniel A. Henderson's discussions with NEC - North America Pager engineering Department and their legal department as well as Motorola at their Boynton Beach, Florida facility.
H	04/1993	Non-disclosure agreement between Doctor Design, Inc. and Innovad regarding Daniel A. Henderson's RFP for design assistance of an auto-dialing paging receiver.
I	04/1993	Letter from NEC America Inc. indicating that they will not meet with Daniel A. Henderson without signing their NDA in which Daniel A. Henderson would have given up all his rights.
J	04/1993	Letter to Doctor Design Inc. thanking them for Daniel A. Henderson's visit to their facilities to pursue production design assistance.
K	04/1993	Non disclosure Agreement with Robert Hotto, design engineer referred from Doctor Design.
L	05/1993	Approx. date is early May 1993, which shows Daniel A. Henderson's notations for the phone number in Japan for Kazuo Hashimoto seeking a license under his patents.
M	05/1993	Facsimile received from AT&T customer information center regarding research about Caller ID technical reference materials.
N	05/1993	Engineering Services Quotation received from Doctor Design Inc.
O	05/1993	Non-disclosure agreement with Innovad and Hashimoto Corporation regarding the Radio Frequency Auto Dialer.
P	05/1993	Short thank-you note to Kazuo Hashimoto after initial meeting.
Q	06/1993	Letter to Kazuo Hashimoto citing draft letter of understanding for license under his US Patents 4,821,308; 4,882,744; and 4,065,042.
R	06/1993	Letter to Kazuo Hashimoto regarding GlobalLink company and the draft license agreement.
S	06/1993	Non-disclosure agreement between GlobalLink Communications Inc. and Innovad - Dan Henderson.
T	06/1993	Letter of understanding - signed License Agreement between Hashimoto Corporation and Daniel Henderson/Innovad Company.
U	07/1993	Product view and feature chart shows the "intellect" prototype now in the Smithsonian that was in development for Hashimoto demonstration.
V	08/1993	Letter to Hewlett Packard requesting license or joint venture for serial infrared Link and PCMCIA technology.

3

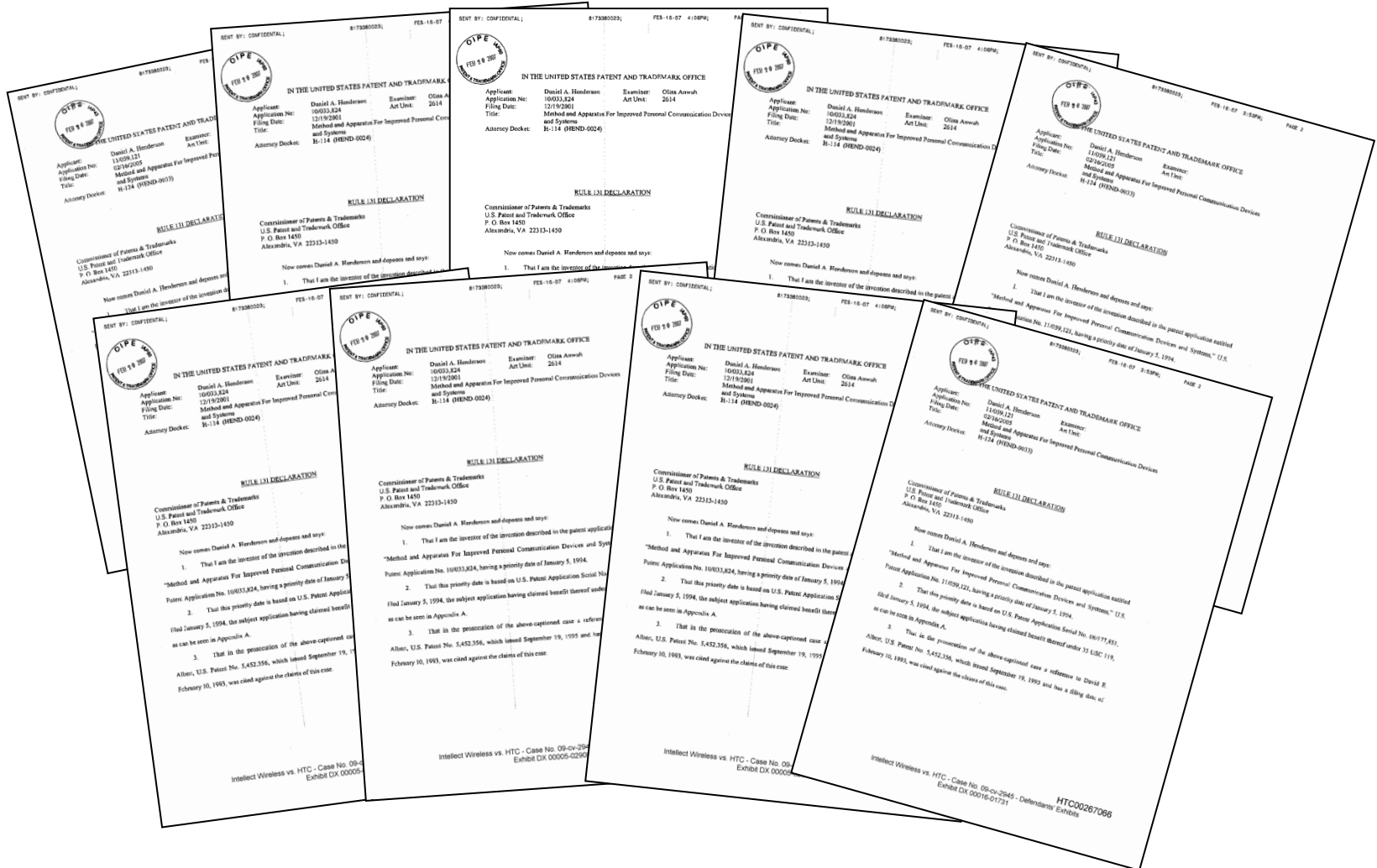
## Appendix U 07/1993

Product view and feature chart shows the "intellect" prototype now in the Smithsonian that was in development for Hashimoto demonstration

HTC00264987

Intellect Wireless vs. HTC - Case No. 09-cv-2945 - Defendants' Exhibits  
Exhibit DX 00004-01972

# Henderson Files 9 More Rule 131 Declarations



# Focused Litigation Strategy – Served A Single Interrogatory

## INTERROGATORY NO. 1:

Separately, for EACH claim of the PATENTS-IN-SUIT, IDENTIFY AND describe ALL facts, circumstances, legal bases AND support thereof relating to when the claimed subject matter was first conceived, first reduced to practice (both actually AND/OR constructively), AND ANY diligence (OR lack thereof) between conception AND reduction to practice, including, but not limited to, IDENTIFYING: (a) the dates of conception; (b) the dates of reduction to practice (actual AND constructive, even if the actual reduction to practice occurred before OR after the constructive reduction to practice); (c) the locations of conception AND

# Intellect Admits No Actual Reduction to Practice

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION

INTELLECT W

## **INTELLECT WIRELESS, INC.'S FIRST SUPPLEMENTAL RESPONSE TO HTC CORPORATION'S FIRST SET OF INTERROGATORIES**

HTC CORPOR  
HTC AMERIC

RESEARCH IN MOTION LIMITED,  
AND AT&T MOBILITY LLC,  
Defendants.

### **INTELLECT WIRELESS, INC.'S FIRST SUPPLEMENTAL RESPONSE TO HTC CORPORATION'S FIRST SET OF INTERROGATORIES**

Plaintiff Intellect Wireless, Inc. ("Intellect Wireless") for its first

supplemental

Corporation ("

1. In  
interrogatories

privilege and

information w

withheld docu

exchange thei

2. In

the extent th

calculated to

As its supplemental response to subpart (f) of Interrogatory No. 1, Intellect Wireless states neither Daniel Henderson nor Intellect Wireless actually reduced to practice the inventions of the '186 patent or the '416 patent, accordingly Intellect Wireless does not have any products that are an actual reduction to practice of the '186 patent or the '416 patent.

Intellect Wireless vs. HTC - Case No. 09-cv-2945 - Defendants' Exhibits  
Exhibit DX 00081-00001

DX4-1973

# Takes 9 Months For Henderson to Verify the Interrogatory

April 2, 2010

75103.00004

VIA E-MAIL (MAHALEK@NSHN.COM)

David J. Mahalek, Esq.  
Niro, Scavone, Haller & Niro, Ltd.  
181 West Madison Street, Suite 4600  
Chicago, IL 60602

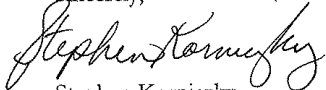
Re: *Intellect Wireless v. HTC Corporation, et al.* (Case No. 1:09cv02945)

Dear David:

We are in receipt of Intellect Wireless, Inc.'s First Supplemental Responses to HTC Corporation's First Set of Interrogatories. We request that Intellect kindly provide a certification of its responses per Federal Rule of Civil Procedure 26.

Thank you.

Sincerely,



Stephen Korniczky  
for PAUL, HASTINGS, JANOFKY & WALKER LLP

- We did not allege inequitable conduct until after receiving the verification.


## VERIFICATION

I, Daniel Henderson declare:

I am the Chief Executive Officer of Intellect Wireless, Inc. I am authorized to make this verification for and on behalf of Intellect Wireless, Inc. I have read Intellect Wireless, Inc.'s Second Supplemental Responses to HTC Corporation's First Set of Interrogatories and know its contents. The factual matters stated in response to interrogatories no. 1 are (a) true and correct based on my own personal knowledge, or (b) true and correct to the best of my knowledge and belief, because it has been made available to me by agents of Intellect Wireless, Inc. who are reliable and whom I know to have personal knowledge of the facts stated therein. I declare the foregoing in the foregoing response, subject to inadvertent or undiscovered errors and omissions, and is therefore necessarily limited by the records and information in existence, past or present, thus far discovered in the course of the preparation of this response. Consequently, Intellect Wireless reserves the right to make any changes in the response if it appears at any time that omissions have been made therein or that more accurate information is available. On this basis, I am authorized to make this verification for and on behalf of Intellect Wireless, Inc. in this lawsuit.

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

Executed on the 28 day of Feb., 2011.

 (Signature)

Daniel A. Henderson (printed name)

**SIGN  
HERE**

# Proving Inequitable Conduct

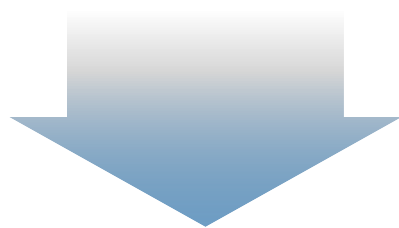
1. Intentionally made a false statement of material fact, or
2. Intentionally withheld material information

Intent and materiality must each be proven separately, by clear and convincing evidence



# Therasense: Materiality

- “But for” test: Information material if PTO “would not have allowed a claim to issue had it been aware of the undisclosed [information].” *Therasense, Inc. v. Becton Dickinson & Co.*, 649 F.3d 1276, 1291 (Fed. Cir. 2011).

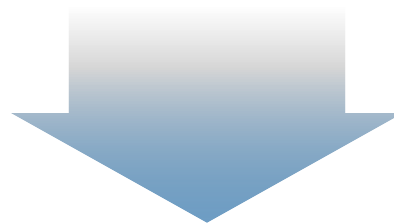


- Exception: “When the patentee has engaged in affirmative acts of egregious misconduct, such as the filing of an unmistakably false affidavit” *Id.* at 1292.



# *Therasense*: Proving Intent

- The patentee knew of the information, knew it was material, and made a deliberate decision to withhold.  
*Therasense*, 649 F.3d at 1292.
- “The specific intent to deceive must be the single most reasonable inference able to be drawn from the evidence.”  
*Id.*



No sliding scale



# Rohm & Haas: Requirements to Cure a False Statement

1. Applicant must "expressly advise the PTO" of the misrepresentation and state "specifically wherein it resides;"
2. Advise the PTO "what the actual facts are... making it clear that further examination in light thereof may be required if any PTO action has been based on the misrepresentation;" and
3. Based on "the new and factually accurate record, the applicant must establish patentability of the claimed subject matter."

– *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 1572-73 (Fed. Cir. 1983).

# Proving Intent to Deceive

More falsehoods were uncovered through our interrogatories and by deposing Henderson:



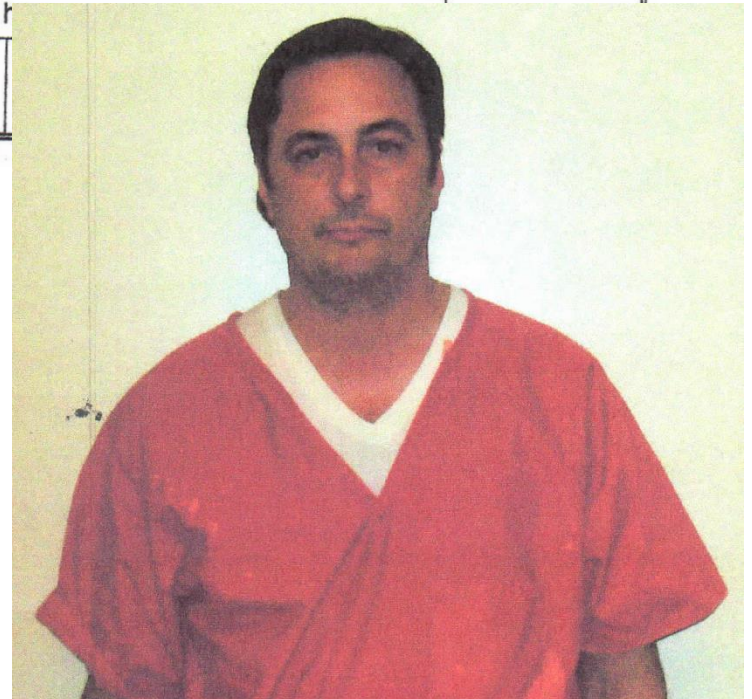
- Was Hashimoto's apprentice.
- Worked with Jack Kilby.
- Was diligent in building a working model.
- Motorola had paid millions to license the patents.
- Deposition Testimony Re: Arrests

# Henderson Lost Credibility At Deposition



# Henderson Was Arrested For Assaulting His Girlfriend

WESTOVER HILLS POLICE DEPARTMENT							CASE NO. 0907-0048		
OFFENSE / INCIDENT REPORT							DATE OF REPORT 7/11/2009		
RELATED REPORTS	ARREST NMBS	EVIDENCE	<input checked="" type="checkbox"/>	SUSPECT	<input checked="" type="checkbox"/>	PROPERTY	<input type="checkbox"/>	UCR CODE	CASE STATUS
		CSSU	<input type="checkbox"/>	WITNESS	<input type="checkbox"/>	FAM. VIOL	<input type="checkbox"/>		
OFFENSE / INCIDENT TITLE							PENAL CODE	OFFENSE GRADE	
Assault							22.01	MA	
DATE / TIME SECURE				DATE/TIME DISCOVERED				SHIFT	
				07-11-2009 2358					
LOCATION					DISTRICT				
6109 Westover Drive					2				



# The Motorola Agreement

## LICENSE AND SETTLEMENT AGREEMENT

This License and Settlement Agreement ("License Agreement") is made as of September 5, 2008 ("Effective Date") between Intellect Wireless, Inc.

## LICENSE AND SETTLEMENT AGREEMENT

This License and Settlement Agreement ("License Agreement") is made as of **September 5, 2008** ("Effective Date") between Intellect Wireless, Inc., ("Intellect"), a Texas corporation with offices in Fort Worth, Texas and Reston, Virginia, on the one hand, and Motorola, Inc. ("Motorola"), a Delaware corporation with corporate headquarters at 1303 East Algonquin Road, Schaumburg, Illinois 60196, on the other. As used herein, "Party" refers to Intellect or Motorola, and "Parties" refers to Intellect and Motorola collectively.

WHEREAS, Intellect owns the Intellect Patents, including the exclusive right to license the Intellect Patents to third parties such as Motorola;

### 3.0 CONSIDERATION

3.1 The total payment due Intellect shall be Five Million Dollars (**\$5,000,000 US**), which shall be payable in two installments as follows:

# The Refund Agreement That Was Withheld During Discovery

## ROYALTY ADJUSTMENT AGREEMENT

THIS ROYALTY ADJUSTMENT AGREEMENT entered into this 5th day of September 2008 (the "Effective Date"), by and between Intellect Wireless, Inc. ("Intellect"), a Texas corporation with offices in Reston, Virginia, on the one hand, and Motorola, Inc. ("Motorola"), a Delaware corporation with offices at 1303 East Algonquin Road, Schaumburg, Illinois 60196, on the other. As used herein, "Party" refers to Intellect or Motorola, and "Parties" refers to Intellect and Motorola collectively.

Intellect Patents, and

## IV. ADJUSTED ROYALTY PAYMENTS

A. Intellect shall adjust the royalty amount paid by Motorola by paying Motorola the Designated Percentage of all licensing fees, royalties, settlement amounts, payments, fees, judgments, recoveries, or other compensation or payments (collectively "Intellect Licensing Revenue") paid to Intellect or any other related recipient of consideration after the Effective Date of this Royalty Adjustment Agreement for the licensing, release, enforcement, or transfer of rights under any of the Intellect Patents (whether alone or in combination with the provision of other rights). The "Designated Percentage" shall be fifty percent (50%) from the first Ten Million Dollars (\$10,000,000 U.S.) paid to Intellect ("the Target Amount"), up to a cumulative total of Five Million Dollars (\$5,000,000 U.S.) paid to Motorola.

# Intellect Changed Its Story Several Times

- Henderson's declaration did not refer to an actual reduction to practice.
- There "may" be an actual reduction to practice.
- Henderson actually reduced a different patent invention to practice.
- The declaration stated that the invention "was constructively reduced to practice **or** actually reduced to practice." But the declarations used the word "and."
- Henderson admitted at deposition that he never built a picture phone.



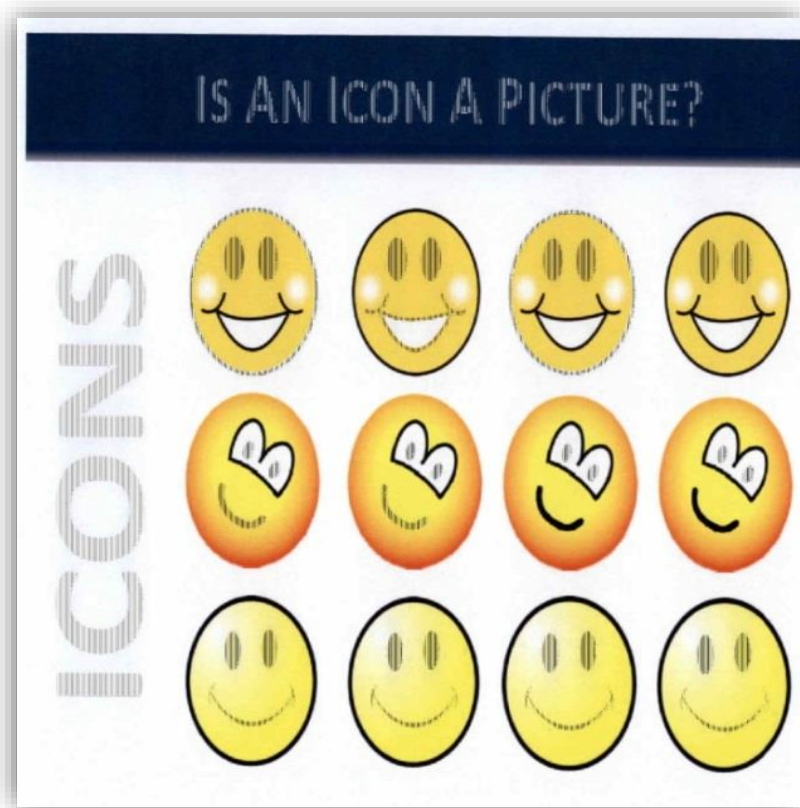
# Focused Litigation Strategy

- Moved for summary judgment.
- When denied, asked Court to bifurcate.
- Expedited bench trial on inequitable conduct.

# Henderson's Prototype and Mock-up in the Smithsonian

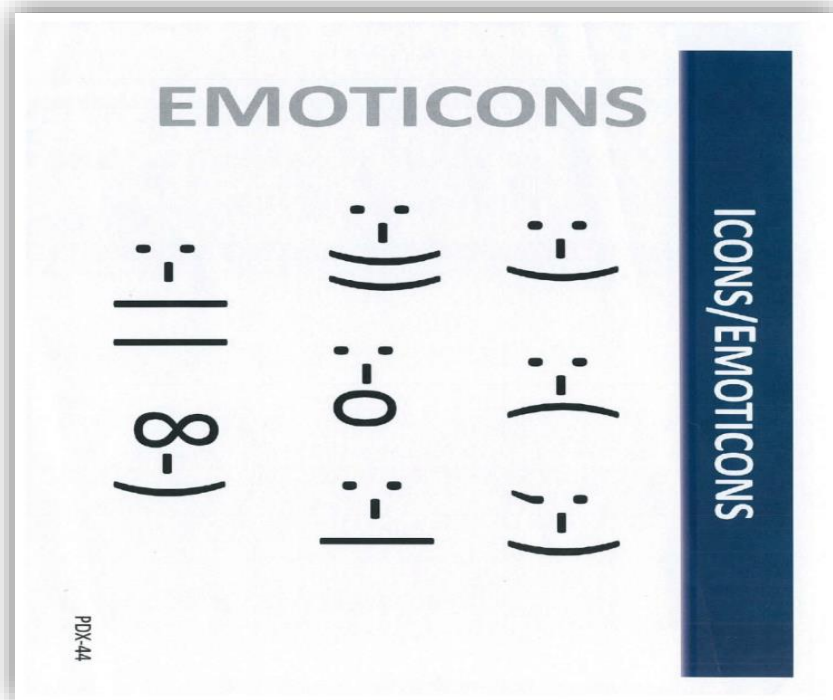


# Intellect's Trial Strategy: An Icon Could Be a "Picture"



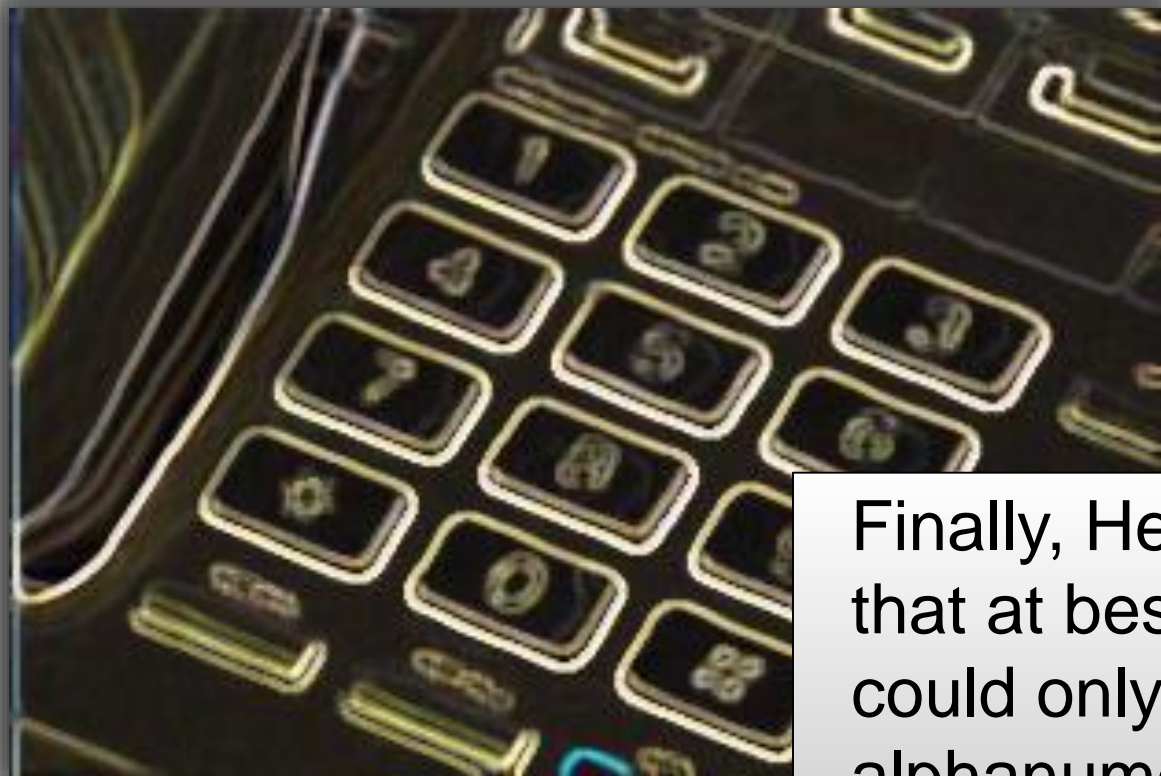
Henderson testified that his prototype could “simulate” the icons shown. No icon was wirelessly transmitted.

# Intellect's Trial Strategy: An Icon Could Be a "Picture"



Then, Henderson testified it could only “simulate” icons composed of ASCII characters. No ASCII characters were wirelessly transmitted.

# Intellect's Trial Strategy: An Icon Could Be a "Picture"



Finally, Henderson admits that at best his prototype could only display standard alphanumeric characters. Alphanumeric characters were not wirelessly transmitted either.



# Federal Circuit: Henderson Committed Inequitable Conduct, Patents Unenforceable

INTELLECT WIRELESS, INC., Plaintiff-Appellant, v. HTC CORPORATION  
AND HTC AMERICA, INC., Defendants-Appellees.

2012-1658

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

732 F.3d 1339; 2013 U.S. App. LEXIS 20529; 103 U.S.P.Q.2D (BNA) 1563

October 9, 2013, Decided

**PRIOR HISTORY:** [\*\*1]

Appeal from the United States District Court for the Northern District of Illinois in No. 09-CV-2945, Senior Judge William T. Hart.

*Intellect Wireless, Inc. v. HTC Corp.*, 910 F. Supp. 2d

(‘186 patent) and 7,310,416 (‘416 patent) are unenforceable due to inequitable conduct. *We affirm.*

**BACKGROUND**

The technology at issue in this case involves wire-

Intellect Wireless, Inc. (Intellect) appeals from the district court's judgment that U.S. Patent Nos. 7,266,186

(‘186 patent) and 7,310,416 (‘416 patent) are unenforceable due to inequitable conduct. *We affirm.*

THOMAS R. BADER and MATTHEW M. MUELLER, of counsel on the brief were NAGENDRA SETTY and GEORGE KANABE, of San Francisco, California. Of counsel was GRAHAM MARC BUCCIGROSS, of San Diego, California.

**JUDGES:** Before PROST, MOORE, and O'MALLEY, Circuit Judges.

**OPINION BY:** MOORE

**OPINION**

[\*1341] [\*\*\*1564] MOORE, Circuit Judge.

Intellect Wireless, Inc. (Intellect) appeals from the district court's judgment that U.S. Patent Nos. 7,266,186

a receiver operably coupled to receive a message from a message center over a wireless connection, the message including a non-facsimile picture supplied by the message originator and a caller ID automatically provided by a communications network that identifies the telephone number of the message originator, the message [\*\*\*1565] originator sending the caller ID with the picture to the message center;

a display, and

## Federal Circuit Held that:

- The declarations were false and, thus, material
- Submission of false affidavit raises strong inference of intent.
- Henderson engaged in a “pattern of deceit.”
- Replacement declaration “dances around the truth.”
- The second declaration did not cure the first declaration

Two golden-brown, triangular fortune cookies are positioned on a white surface. A semi-transparent white rectangular box is placed between them, containing the text 'Attorneys' Fees?'.

# Attorneys' Fees?

# Post-Appeal/Attorney Fee Motion Discovery: Henderson Knew the Declaration Was False

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

**Subject:** RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege  
**From:** "Daniel Henderson" <dhenderson@phonetel.com>  
**Date:** Sat, 10 Feb 2007 20:22:24 -0600  
**To:** <rtendler@fonefinder.com>

Fair enough. Looks like a real mess on my hands here post Katherine and Linda but the CPAs have a handle on it now. Talk to you on Monday.

**From:** rtendler [mailto:rtendler@fonefinder.com]  
**Sent:** Saturday, February 10, 2007 5:01 PM  
**To:** Daniel Henderson  
**Subject:** Re: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

my recent inaccurate declaration. This of course will cause problems in the file wrapper with two contradictory statements by me and will subject me to intense questioning during deposition and impact my credibility as a witness.

The questions will go like this:

"Do you know of your duty of candor and good faith with the PTO?"

"Do you read documents before you sign them?"

"Are you a careless person when it comes to stating important facts?"

"How do we know that you have not been careless with other factual statements made to the PTO during prosecution?"

"What did you really invent that you showed to Hashimoto?"

"The intellect device shown to Hashimoto and now in the Smithsonian wasn't capable of showing a picture, was it, despite what you swore under penalty of perjury in your 131 affidavit. ..."

etc. etc. etc.

I have lived through many of these depositions, and my concerns are tempered by the experience of such hostile scrutiny. These are not imaginary issues. The improper declaration and allegations of fraud on the patent office will now be the easiest way to invalidate the entire patent portfolio and impeach my credibility as a witness. I fully expect that it will also introduce serious concerns for my litigation counsel given the potential

I want to address what I perceive is a potentially lethal blow to the integrity and validity of my patent portfolio from the incorrect declaration faxed to the PTO on Friday.

I think this is fixable with complete candor with the USPTO. We will have to delineate what the prior 131s covered and what we were claiming, and how the new 131 covers what we are claiming now. Anwar will be OK with this.

As to the billing, it stands. I put my bloody soul into this as well as getting us to this point and eliminating reference to pagers and other extraneous claim language. I can't control Fan. The best I can do is try to satisfy him. He is the gatekeeper. We will get this done.

Bob

Daniel Henderson wrote:

Bob,  
I want to address what I perceive is a potentially lethal blow to the integrity and validity of my patent portfolio from the incorrect declaration faxed to the PTO on Friday. I was asked to read a patent that before Friday I had never seen, and give a thumbnail analysis about it within an hour, which I did. I also found support for a prior invention date by me, which I also did. I followed your instruction and signed the declaration prepared by you in haste without reviewing it, as you felt speed was of the essence. And now it seems that we may be confronted with a very difficult situation as a result.  
I am quite upset about the money and time that I have spent to arrive at this point without any clear indication that there will EVER be any other patents allowed. The damage generated by the factually inaccurate declaration I signed is potentially devastating in the event that any patents do issue. I am quite certain that I will be deposited ad infinitum about the declaration during litigation and I do not see any way around this. My concern is that the incorrect declaration will create a weak flank for attack by even marginally-competent litigation counsel on the other side. Since the PTO has already received the incorrect declaration signed by me, we cannot uncrack the egg.  
To suggest to the PTO that they disregard a fax received would be worse than the fact that they received it at all. However, we cannot let this go unaddressed. It will come out in litigation that the intellect device shown to Hashimoto in July 1993 HAD NO WAY of displaying a picture on a two line alphanumeric display, contrary to

1 of 3

1/ RKT 49

1

**From:** Robert Tendler [mailto:rtendler@fonefinder.com]  
**Sent:** Friday, February 09, 2007 4:13 PM  
**To:** Daniel Henderson  
**Subject:** Anwah's comment RE: H-123 Rule 131 Declaration]

----- Original Message -----  
**Subject:** RE: H-123 Rule 131 Declaration  
**Date:** Fri, 9 Feb 2007 16:21:33 -0500  
**From:** Anwah, Olisa <Olisa.Anwah@USPTO.GOV>  
**To:** Robert Tendler <rtendler@fonefinder.com>

looks good.

-----Original Message-----  
**From:** Robert Tendler [mailto:rtendler@fonefinder.com]  
**Sent:** Friday, February 09, 2007 4:20 PM  
**To:** Anwah, Olisa  
**Subject:** H-123 Rule 131 Declaration

We are faxing this to the USPTO.

2 of 3

1/ RKT 49 2

# Post-Appeal/Attorney Fee Motion Discovery: Henderson Knew the Declaration Was False

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

**Subject:** RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege  
**From:** "Daniel Henderson" <dhenderson@phonetel.com>  
**Date:** Sat, 10 Feb 2007 20:22:24 -0600  
**To:** <rtendler@fonefinder.com>

Fair enough. Looks like a real mess on my hands here post Katherine and Linda but the CPAs have a handle on it now. Talk to you on Monday.

**From:** rtendler [mailto:rtendler@fonefinder.com]  
**Sent:** Saturday, February 10, 2007 5:01 PM  
**To:** Daniel Henderson  
**Subject:** Re: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

my recent inaccurate declaration. This of course will cause problems in the file wrapper with two contradictory statements by me and will subject me to intense questioning during deposition and impact my credibility as a witness.

The questions will go like this:

"Do you know of your duty of candor and good faith with the PTO?"

"Do you read documents before you sign them?"

"Are you a careless person when it comes to stating important facts?"

"How do we know that you have not been careless with other factual statements made to the PTO during prosecution?"

"What did you really invent that you showed to Hashimoto?"

"The intellect device shown to Hashimoto and now in the Smithsonian wasn't capable of showing a picture, was it, despite what you swore under penalty of perjury in your 131 affidavit. ..."

etc. etc. etc.

I have lived through many of these depositions, and my concerns are tempered by the experience of such hostile scrutiny. These are not imaginary issues. The improper declaration and allegations of fraud on the

My concern is that the incorrect declaration will create a weak flank for attack by even marginally-competent litigation counsel on the other side.

I think this is fixable with complete candor with the USPTO. We will have to delineate what the prior 131s covered and what we were claiming, and how the new 131 covers what we are claiming now. Anwar will be OK with this.

As to the billing, it stands. I put my bloody soul into this as well as getting us to this point and eliminating reference to paggers and other extraneous claim language. I can't control Fan. The best I can do is try to satisfy him. He is the gatekeeper. We will get this done.

Bob

Daniel Henderson wrote:

Bob,

I want to address what I perceive is a potentially lethal blow to the integrity and validity of my patent portfolio from the incorrect declaration faxed to the PTO on Friday. I was asked to read a patent that before Friday I had never seen, and give a thumbnail analysis about it within an hour, which I did. I also found support for a prior invention date by me, which I also did. I followed your instruction and signed the declaration prepared by you in haste without reviewing it, as you felt speed was of the essence. And now it seems that we may be confronted with a very difficult situation as a result.

I am quite upset about the money and time that I have spent to arrive at this point without any clear indication that there will EVER be any other patents allowed. The damage generated by the factually inaccurate declaration I signed is potentially devastating in the event that any patents do issue. I am quite certain that I will be deposited ad infinitum about the declaration during litigation and I do not see any way around this.

My concern is that the incorrect declaration will create a weak flank for attack by even marginally-competent litigation counsel on the other side. Since the PTO has already received the incorrect declaration signed by me, we cannot uncrack the egg.

To suggest to the PTO that they disregard a fax received would be worse than the fact that they received it at all. However, we cannot let this go unaddressed. It will come out in litigation that the intellect device shown to Hashimoto in July 1993 HAD NO WAY of displaying a picture on a two line alphanumeric display, contrary to

1 of 3

1/RKT 49 1

**From:** Robert Tendler [mailto:rtendler@fonefinder.com]  
**Sent:** Friday, February 09, 2007 4:13 PM  
**To:** Daniel Henderson  
**Subject:** Anwah's comment RE: H-123 Rule 131 Declaration]

----- Original Message -----

**Subject:** RE: H-123 Rule 131 Declaration

**Date:** Fri, 9 Feb 2007 16:21:33 -0500

**From:** Anwah, Olisa <Olisa.Anwah@USPTO.GOV>

**To:** Robert Tendler <rtendler@fonefinder.com>

looks good.

-----Original Message-----

**From:** Robert Tendler [mailto:rtendler@fonefinder.com]

**Sent:** Friday, February 09, 2007 4:20 PM

**To:** Anwah, Olisa

**Subject:** H-123 Rule 131 Declaration

We are faxing this to the USPTO.

2 of 3

1/RKT 49 2

# Post-Appeal/Attorney Fee Motion Discovery: Henderson Knew the Declaration Was False

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

**Subject:** RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege  
**From:** "Daniel Henderson" <dhenderson@phonetel.com>  
**Date:** Sat, 10 Feb 2007 20:22:24 -0600  
**To:** <rtendler@fonefinder.com>

Fair enough. Looks like a real mess on my hands here post Katherine and Linda but the CPAs have a handle on it now. Talk to you on Monday.

**From:** rtendler [mailto:rtendler@fonefinder.com]  
**Sent:** Saturday, February 10, 2007 5:01 PM  
**To:** Daniel Henderson  
**Subject:** Re: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege

ATTORNEY CLIENT PRIVILEGE

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

The questions will go like this:

"Do you know of your duty of candor and good faith with the PTO?"  
"Do you read documents before you sign them?"  
"Are you a careless person when it comes to stating important facts?"  
"How do we know that you have not been careless with other factual statements made to the PTO during prosecution?"  
"What did you really invent that you showed to Hashimoto?"  
"The intellect device shown to Hashimoto and now in the Smithsonian wasn't capable of showing a picture, was it, despite what you swore under penalty of perjury in your 131 affidavit. ..."  
etc. etc. etc.  
I have lived through many of these depositions, and my concerns are tempered by the experience of such hostile scrutiny. These are not imaginary issues. The improper declaration and allegations of fraud on the patent office will now be the easiest way to invalidate the entire patent portfolio and impeach my credibility as a witness. I fully expect that it will also introduce serious concerns for my litigation counsel, given the potential invalidity arguments that will be posed by the other side. This additional risk would have otherwise not existed if

The damage generated by the factually inaccurate declaration I signed is potentially devastating in the event that any patents do issue. I am quite certain that I will be deposed ad infinitum about the declaration during litigation and I do not see any way around this.

Anwah will be OK with this:

As to the billing, it stands. I put my bloody soul into this as well as getting us to this point and eliminating reference to pagers and other extraneous claim language. I can't control Fan. The best I can do is try to satisfy him. He is the gatekeeper. We will get this done.

Bob

Daniel Henderson wrote:

Bob,  
I want to address what I perceive is a potentially lethal blow to the integrity and validity of my patent portfolio from the incorrect declaration faxed to the PTO on Friday. I was asked to read a patent that before Friday I had never seen, and give a thumbnail analysis about it within an hour, which I did. I also found support for a prior invention date by me, which I also did. I followed your instruction and signed the declaration prepared by you in haste without reviewing it, as you felt speed was of the essence. And now it seems that we may be confronted with a very difficult situation as a result.  
I am quite upset about the money and time that I have spent to arrive at this point without any clear indication that there will EVER be any other patents allowed. The damage generated by the factually inaccurate declaration I signed is potentially devastating in the event that any patents do issue. I am quite certain that I will be deposed ad infinitum about the declaration during litigation and I do not see any way around this. My concern is that the incorrect declaration will create a weak flank for attack by even marginally-competent litigation counsel on the other side. Since the PTO has already received the incorrect declaration signed by me, we cannot uncrack the egg.  
To suggest to the PTO that they disregard a fax received would be worse than the fact that they received it at all. However, we cannot let this go unaddressed. It will come out in litigation that the intellect device shown to Hashimoto in July 1993 HAD NO WAY of displaying a picture on a two line alphanumeric display, contrary to

1 of 3

1/ RKT 49 1

Sent: Friday, February 09, 2007 4:13 PM  
**To:** Daniel Henderson  
**Subject:** Anwah's comment RE: H-123 Rule 131 Declaration]

----- Original Message -----

**Subject:** RE: H-123 Rule 131 Declaration  
**Date:** Fri, 9 Feb 2007 16:21:33 -0500  
**From:** Anwah, Olisa <Olisa.Anwah@USPTO.GOV>  
**To:** Robert Tendler <rtendler@fonefinder.com>

looks good.

-----Original Message-----  
**From:** Robert Tendler [mailto:rtendler@fonefinder.com]  
**Sent:** Friday, February 09, 2007 4:20 PM  
**To:** Anwah, Olisa  
**Subject:** H-123 Rule 131 Declaration

We are faxing this to the USPTO.

2 of 3

1/ RKT 49 2

# Post-Appeal/Attorney Fee Motion Discovery: Henderson Knew the Declaration Was False

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

**Subject:** RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege  
**From:** "Daniel Henderson" <dhenderson@phonetel.com>  
**Date:** Sat, 10 Feb 2007 20:22:24 -0600  
**To:** <rtendler@fonefinder.com>

Fair enough. Looks like a real mess on my hands here post Katherine and Linda but the CPAs have a handle on it now. Talk to you on Monday.

**From:** rtendler [mailto:rtendler@fonefinder.com]  
**Sent:** Saturday, February 10, 2007 5:01 PM  
**To:** Daniel Henderson  
**Subject:** Re: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

my recent inaccurate declaration. This of course will cause problems in the file wrapper with two contradictory statements by me and will subject me to intense questioning during deposition and impact my credibility as a witness.

The questions will go like this:

"Do you know of your duty of candor and good faith with the PTO?"  
"Do you read documents before you sign them?"  
"Are you a careless person when it comes to stating important facts?"  
"How do we know that you have not been careless with other factual statements made to the PTO during prosecution?"  
"What did you really invent that you showed to Hashimoto?"  
"The intellect device shown to Hashimoto and now in the Smithsonian wasn't capable of showing a picture, was it, despite what you swore under penalty of perjury in your 131 affidavit. ...?"  
etc. etc. etc.  
I have lived through many of these depositions, and my concerns are tempered by the experience of such hostile scrutiny. These are not imaginary issues. The improper declaration and allegations of fraud on the patent office will now be the easiest way to invalidate the entire patent portfolio and impeach my credibility as a

It will come out in litigation that the intellect device shown to Hashimoto in July 1993 HAD NO WAY of displaying a picture on a two line alphanumeric display, contrary to my recent inaccurate declaration. This of course will cause problems in the file wrapper with two contradictory statements by me and will subject me to intense questioning during deposition and impact my credibility as a witness.

As to the billing, it stands. I put my bloody soul into this as well as getting us to this point and eliminating reference to pagers and other extraneous claim language. I can't control Fan. The best I can do is try to satisfy him. He is the gatekeeper. We will get this done.

Bob

Daniel Henderson wrote:

Bob,  
I want to address what I perceive is a potentially lethal blow to the integrity and validity of my patent portfolio from the incorrect declaration faxed to the PTO on Friday. I was asked to read a patent that before Friday I had never seen, and give a thumbnail analysis about it within an hour, which I did. I also found support for a prior invention date by me, which I also did. I followed your instruction and signed the declaration prepared by you in haste without reviewing it, as you felt speed was of the essence. And now it seems that we may be confronted with a very difficult situation as a result.  
I am quite upset about the money and time that I have spent to arrive at this point without any clear indication that there will EVER be any other patents allowed. The damage generated by the factually inaccurate declaration I signed is potentially devastating in the event that any patents do issue. I am quite certain that I will be deposited ad infinitum about the declaration during litigation and I do not see any way around this. My concern is that the incorrect declaration will create a weak flank for attack by even marginally-competent litigation counsel on the other side. Since the PTO has already received the incorrect declaration signed by me, we cannot uncrack the egg.  
To suggest to the PTO that they disregard a fax received would be worse than the fact that they received it at all. However, we cannot let this go unaddressed. It will come out in litigation that the intellect device shown to Hashimoto in July 1993 HAD NO WAY of displaying a picture on a two line alphanumeric display, contrary to

1 of 3

1/RKT 49 1

**To:** Daniel Henderson  
**Subject:** Anwah's comment RE: H-123 Rule 131 Declaration]

----- Original Message -----

**Subject:** RE: H-123 Rule 131 Declaration  
**Date:** Fri, 9 Feb 2007 16:21:33 -0500  
**From:** Anwah, Olisa <Olisa.Anwah@USPTO.GOV>  
**To:** Robert Tendler <rtendler@fonefinder.com>

looks good.

-----Original Message-----

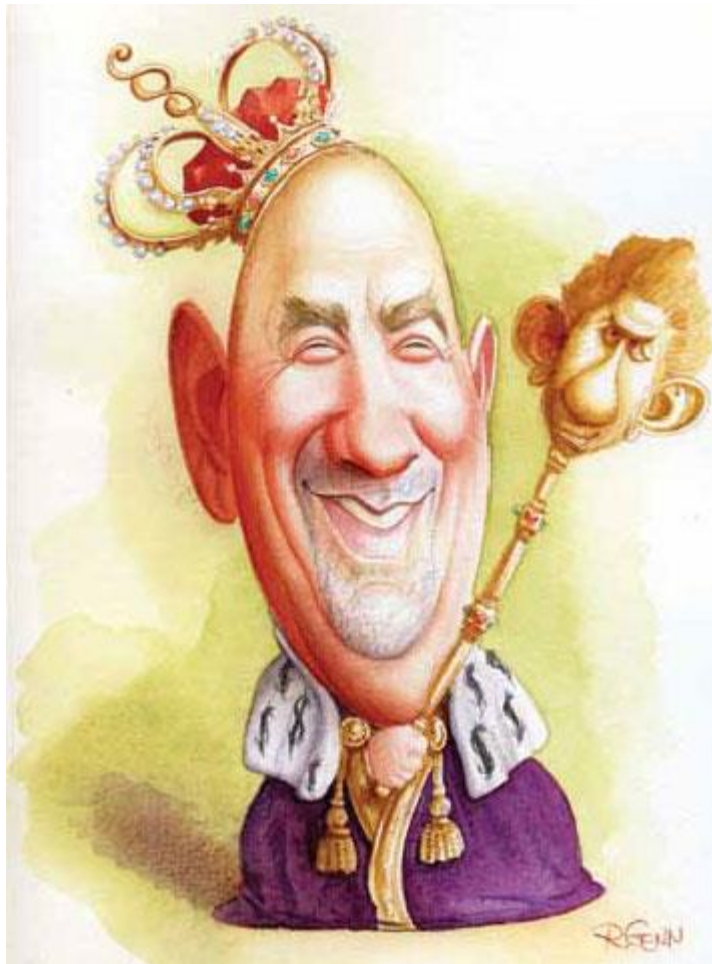
**From:** Robert Tendler [mailto:rtendler@fonefinder.com]  
**Sent:** Friday, February 09, 2007 4:20 PM  
**To:** Anwah, Olisa  
**Subject:** H-123 Rule 131 Declaration

We are faxing this to the USPTO.

2 of 3

1/RKT 49 2

# “The Original King Of The Patent Trolls”



## Exclusive with Ray Niro: The Man They Call the Patent Troll



By Gene Quinn on July 23, 2013



Ray Niro

On July 1, 2013, I spoke on the record with Ray Niro, who is one of the most well known patent litigators in the United States. Throughout his career he has been a champion for the inventor who was facing long odds due to widespread patent infringement. So loathed was Niro, he was the one who was originally referred to as the “patent troll” by the media due to his representing innovators against giant technology companies. Of course, if you are going to call Ray Niro a patent troll you might want to also point out that he is extraordinarily successful, which means he has been very good at proving that large corporations have infringed valid patents, sometimes on fundamentally important innovations.

What follows is the final segment of my interview with the man they call the patent troll, Ray Niro. To read part 1 see [\*In Defense of Innovators: An Exclusive Interview with Ray Niro.\*](#)

# Niro Knew The Declarations Were False

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

Subject: RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege

Please contact Examiner Anwah Monday and report to me where we are in this matter. Also contact Cliff Kraft at Niro's office to see what their take is on this development. As you suggested, it makes sense to discuss with them what they may recommend in terms of the road blocks by Fan Tsang that continue to thwart my efforts in securing allowance of the patents. My sense is that he is not finished with these applications yet.

To: Daniel Henderson  
Subject: Re: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Client Privilege

ATTORNEY CLIENT PRIVILEGE

dAN:

I suggest we address this on the phone. There is no guarantee that this will not be discoverable.

BTW, I had no idea that what you did for Hashimoto didn't support the reduction to practice. After all it was in the block diagram. Don't blame me.

I think this is fixable with complete candor with the USPTO. We will have to delineate what the prior 131s covered and what we were claiming, and how the new 131 covers what we are claiming now. Anwar will be OK with this.

As to the billing, it stands. I put my bloody soul into this as well as getting us to this point and eliminating reference to pagers and other extraneous claim language. I can't control Fan. The best I can do is try to satisfy him. He is the gatekeeper. We will get this done.

Bob

Daniel Henderson wrote:

Bob,  
I want to address what I perceive is a potentially lethal blow to the integrity and validity of my patent portfolio from the incorrect declaration faxed to the PTO on Friday. I was asked to read a patent that before Friday I had never seen, and give a thumbnail analysis about it within an hour, which I did. I also found support for a prior invention date by me, which I also did. I followed your instruction and signed the declaration prepared by you in haste without reviewing it, as you felt speed was of the essence. And now it seems that we may be confronted with a very difficult situation as a result.  
I am quite upset about the money and time that I have spent to arrive at this point without any clear indication that there will EVER be any other patents allowed. The damage generated by the factually inaccurate declaration I signed is potentially devastating in the event that any patents do issue. I am quite certain that I will be deposited ad infinitum about the declaration during litigation and I do not see any way around this. My concern is that the incorrect declaration will create a weak flank for attack by even marginally-competent litigation counsel on the other side. Since the PTO has already received the incorrect declaration signed by me, we cannot uncrack the egg.  
To suggest to the PTO that they disregard a fax received would be worse than the fact that they received it at all. However, we cannot let this go unaddressed. It will come out in litigation that the intellect device shown to Hashimoto in July 1993 HAD NO WAY of displaying a picture on a two line alphanumeric display, contrary to

1 of 3

1/1 RKT 49

1

RE: Anwah's comment RE: H-123 Rule 131 Declaration /Attorney Cli...

my recent inaccurate declaration. This of course will cause problems in the file wrapper with two contradictory statements by me and will subject me to intense questioning during deposition and impact my credibility as a

hostile scrutiny. These are not imaginary issues. The improper declaration and allegations of fraud on the patent office will now be the easiest way to invalidate the entire patent portfolio and impeach my credibility as a witness. I fully expect that it will also introduce serious concerns for my litigation counsel, given the potential invalidity arguments that will be posed by the other side. This additional risk would have otherwise not existed if we had taken the time to check the declaration prior to sending it to the PTO. This is truly insufferable and most discouraging.

Please contact Examiner Anwah Monday and report to me where we are in this matter. Also contact Cliff Kraft at Niro's office to see what their take is on this development. As you suggested, it makes sense to discuss with them what they may recommend in terms of the road blocks by Fan Tsang that continue to thwart my efforts in securing allowance of the patents. My sense is that he is not finished with these applications yet.

Finally, I would like your thoughts on how the billing should be handled to address this matter.  
Dan

From: Robert Tendler [mailto:rtendler@fonefinder.com]  
Sent: Friday, February 09, 2007 4:13 PM  
To: Daniel Henderson  
Subject: Anwah's comment RE: H-123 Rule 131 Declaration]

----- Original Message -----

Subject: RE: H-123 Rule 131 Declaration  
Date: Fri, 9 Feb 2007 16:21:33 -0500  
From: Anwah, Olisa <Olisa.Anwah@USPTO.GOV>  
To: Robert Tendler <rtendler@fonefinder.com>

looks good.

-----Original Message-----

From: Robert Tendler [mailto:rtendler@fonefinder.com]  
Sent: Friday, February 09, 2007 4:20 PM  
To: Anwah, Olisa  
Subject: H-123 Rule 131 Declaration

We are faxing this to the USPTO.

2 of 3

1/1 RKT 49 2

# Motion to Compel Based on Crime-Fraud Exception

Case: 1:09-cv-02945 Document #: 276 Filed: 03/27/14 Page 1 of 12 PageID #:7850

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION

INTELLECT WIRELESS, INC.,

Plaintiff,

v.

HTC CORPORATION, HTC AMERICA, INC.,  
and AT&T MOBILITY LLC,

Defendants.

Case No. 1:09-cv-02945

Honorable Judge William T. Hart

Magistrate Judge Geraldine Scott Brown

Case: 1:09-cv-02945 Document #: 291 Filed: 05/06/14 Page 5 of 5 PageID #:8104

IT IS THEREFORE ORDERED that defendants' motion to compel [276]

is granted. Within seven days, Intellect Wireless and the Niro law firm shall  
produce the requested documents. A hearing on status will be held on May 29,  
2014 at 2:00 p.m.

ENTER:

**MOTION TO COMPEL PRODUCTION OF ALLEGEDLY PRIVILEGED  
DOCUMENTS FROM INTELLECT WIRELESS, INC. AND THE NIRO FIRM**

JUDGE

production of documents withheld under the guise of privilege. Specifically, HTC requests  
that the Court order Intellect Wireless, Inc., ("IW") and its attorneys, Raymond P. Niro, Paul  
K. Vickrey, Paul C. Gibbons, David J. Mahalek, and Niro, Haller & Niro Ltd. (collectively,  
"Niro") to produce, pursuant to the crime-fraud exception, documents responsive to the  
Court's January 30, 2014 Order that have been improperly withheld as privileged and/or work  
product.

**I. INTRODUCTION**

For years and at trial, Dan  
Henderson believed his original P  
However, as the Court will recall  
produced a February 10, 2007 em

from the outset that the declaration was "incorrect," "factually inaccurate" and "improper."

IT IS THEREFORE ORDERED that defendants' motion to compel [276]

is granted. Within seven days, Intellect Wireless and the Niro law firm shall

SMRH-4186804123

-1-

- 5 -

# Niro Only Produced A Few Limited Documents

Mahalek, David J

From: Daniel Henderson [dhenderson@phonetel.com]  
Sent: Friday, November 06, 2009 12:32 PM  
To: Gibbons, Paul C  
Cc: Vickrey, Paul K; Mahalek, David J  
Subject: RE: Intellect discovery responses

Interrogatory information:

NEC and enclosing it in a prototype case along with a Sharp pocket autodialer. This device did not actually receive caller id automatically from the telephone network as there was no provision for it by the pager company I used at the time, but the basic idea for caller id with a name to a wireless device was demonstratable where upon receipt of a page within the device, a screen pop would show both the telephone number and the name of the person calling that was associated with the number that had called. During the demonstration I also showed them a mock-up of the intellect device that included a picture of someone sending a message, which was a picture of myself. It did not operate but was used in conjunction to demonstrate what the invention could include. During the demonstration I explained that

knowledge at that time, and not until sometime in 1993 or 1994 that caller id was first placed into trial for cellular service on some limited basis.

In 1992 I began researching this in depth by frequent patent and periodical literature searches, reviewing electronic stores and products for sale at the time, and in discussions with people that could assist me in constructing a product, including Doctor Design, out of Texas, a friend, Gary Jenson, who lived in the same apartment complex, Bob Hotto, a fellow inventor. I also spoke with a company, Positive communications, who sold pagers at that time, and I recall contacting PageNet and possibly others in 1993. I believe I executed an NDA with Bob Hotto and possibly discussed the autodialer aspect of the product idea with Linda Thomas, who was also in the dialer business at the time. I had my wife at that time, Sue Billing Henderson, witness and sign some conception drawings in January and February of 1993 that were referenced in my Rule 131 Declaration submitted to the patent office, which established my date of conception.

The first demonstration of the intelligpager was to Gary Jenson, a friend and also to Kazuo Hashimoto in June of 1993. It was also shown to Shinwa Communications in Oklahoma, to members of their company and some others from Mitsui Comtek sometime later in 1993. Then later on, I had travelled to Las Vegas to the Consumer Electronics show, where I walked the various trade show booths looking at other wireless products and also where I demonstrated my intelligpager and intellect products. There was in fact one company in Canada I recall that was impressed enough to ask for pricing and delivery information, which should be referenced in my 131 declaration.

The product names intelligpager and intellect was intended to connote that there was more information sent to a user then just numeric paging data, and more efficiently sent in an automatic fashion. After researching the costs to build products, and due to limited finances, I decided to construct a prototype myself using a numeric pager manufactured by NEC and enclosing it in a prototype case along with a Sharp pocket autodialer. This device did not actually receive caller id automatically from the telephone network as there was no provision for it by the pager company I used at the time, but the basic idea for caller id with a name to a wireless device was demonstratable where upon receipt of a page within the device, a screen pop would show both the telephone number and the name of the person calling that was associated with the number that had called. During the demonstration I also showed them a mock-up of the intellect device that included a picture of someone sending a message, which was a picture of myself. It did not operate but was used in conjunction to demonstrate what the invention could include. During the demonstration I explained that



# Niro Only Produced A Few Limited Documents

Mahalek, David J

From: Mahalek, David J  
Sent: Friday, February 25, 2011 7:10 AM  
To: 'Daniel Henderson'  
Cc: Gibbons, Paul C  
Subject: RE: Intellect Wireless

Dan

We're not taking the position that it wasn't an actual reduction to practice. We're trying to be more circumspect than that and convey an impression that we're unsure. If you think that doesn't come across in the answers let me know. Thanks

Sent from my GoogleTalk-synchronized handheld (see read.com)

We're not taking the position that it wasn't an actual reduction to practice. We're trying to be more circumspect than that and convey an impression that we're unsure. If you think that doesn't come across in the answers let me know. Thanks

the document, but other than that no comments. I guess we are then taking the position that there was no actual reduction to practice? I am still not clear on whether or not what I built constitutes actual reduction or not in terms of the legal definition.

Dan

On Thu, Feb 24, 2011 at 4:38 PM, Mahalek, David J <mahalek@nshn.com> wrote:  
> Here is a draft second supplemental response to HTC's interrogatory no. 1.  
> The new material begins on page 15.

>  
>  
>  
> This is due tomorrow. Any and all thoughts and comments are appreciated.  
> Thanks.

>  
>  
>

> Dave

>  
>  
>  
>  
>  
>  
> David J. Mahalek  
>  
> Niro, Haller & Niro  
>

1

# Motion for Adverse Inference Is Granted

Case: 1:09-cv-02945 Document #: 312 Filed: 06/27/14 Page 1 of 16 PageID #:8881

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF ILLINOIS  
EASTERN DIVISION

INTELLECT WIRELESS, INC.,

Plaintiff,

v.

HTC CORPORATION, HTC AMERICA, INC.,  
and AT&T MOBILITY LLC,

Defendants.

Case No. 1:09-cv-02945

Honorable Judge William T. Hart

Magistrate Judge Geraldine Soat Brown

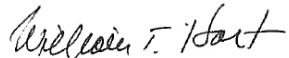
Case: 1:09-cv-02945 Document #: 343 Filed: 01/08/15 Page 29 of 29 PageID #:11183

Alternatively, if the parties can reach a settlement finally resolving the amounts due, there will be no need to enter a further judgment.

IT IS THEREFORE ORDERED that defendants HTC Corporation's and HTC America's motions for an adverse inference [307, 312] are granted. Defendants' motion to hold plaintiff Intellect Wireless, Inc. and Attorneys Raymond Niro, Paul Vickrey, Paul Gibbons and David Mahalek jointly and severally liable for attorney fees and costs [300] is granted. Defendants' motions

**MOTION FOR ADVERSE INFERENCE, OR IN THE ALTERNATIVE TO ENFORCE COMPLIANCE WITH THE COURT'S JUNE 2, 2014 ORDER, AND FOR SANCTIONS**

ENTER:

  
United States District Judge

DATED: JANUARY 8, 2015

IT IS THEREFORE ORDERED that defendants HTC Corporation's and HTC America's motions for an adverse inference [307, 312] are granted.

# Judgment Against Intellect Wireless & Niro

## THE RECORDER

Click to Print or Select 'Print' in your browser menu to print this document.

Page printed from: [The Recorder](#)

Case: 1:09-cv-02945 Document #: 343 Filed: 01/08/15 Page 29 of 29 PageID #:11183

Alternatively, if the parties can reach a settlement finally resolving the amounts

due, there will be no need to enter a further judgment.

## Judge to Make Niro Firm Pay Millions in Sanctions Over False Declarations

U.S. District Judge William Hart on Friday held Niro, Haller & Niro jointly and severally liable for what's likely to be several million dollars in attorney fees assessed against Intellect Wireless and inventor Daniel Henderson. The ruling ends a year of hotly contested wrangling over what Niro did and didn't know, delivering a black eye to one of the country's most prominent patent lawyers.

hotly contested wrangling over what Niro did and didn't know, delivering a black eye to one of the country's most prominent patent lawyers.

"The false presentation of Henderson's activity and knowledge justifies making Niro jointly and severally liable with IW for attorney fees and costs," Hart wrote in his order.

Niro did not immediately respond to an email seeking comment Friday evening. Niro, partners Paul Vickrey and David Mahalek and former partner Paul Gibbons have filed declarations saying they knew nothing about an email Henderson sent to his patent prosecutor in 2007 raising loud alarms about false declarations filed with the PTO. Henderson had warned that false declarations filed on his behalf presented a "potentially lethal blow" to his patent portfolio, and asked that his litigation counsel at the Niro firm be consulted about it.

HTC Corp. and its attorneys at Sheppard, Mullin, Richter & Hampton say it was "inconceivable" that Niro and his colleagues didn't hear about Henderson's concerns long before suing HTC in 2009.

Hart sided with HTC on Friday, concluding from the evidence that the lawyers knew Henderson had lied about his involvement.

"Therefore, Niro is liable for all reasonable attorney fees and costs."

HTC has asked for \$4.7 million, plus additional fees and costs of more than \$2.3 million. Hart did not determine a final amount, but he rejected some of Niro's objections while denying others.

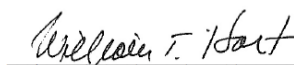
"We are very pleased with Judge Hart's decision," Sheppard Mullin Richter & Hampton said in a statement. "Settlement of this lawsuit is a lawsuit that never should have been filed."

Contact the reporter at [sgraham@alm.com](mailto:sgraham@alm.com).

Copyright 2015. ALM Media Properties, LLC. All rights reserved.

Defendants' bill of costs [222] is granted in part and denied in part. A status hearing is set for January 22, 2015 at 2:00 p.m.

ENTER:

  
United States District Judge

DATED: JANUARY 8, 2015

Defendants' motion to hold plaintiff Intellect Wireless, Inc. and Attorneys

Raymond Niro, Paul Vickrey, Paul Gibbons and David Mahalek jointly and

severally liable for attorney fees and costs [300] is granted. Defendants' motions

# Questions?? Comments??

## Inequitable Conduct: Unwinding the Tangled Web of Deceit

Stephen S. Korniczky  
Chair, IP Practice Group  
skorniczky@sheppardmullin.com  
&  
Martin R. Bader, Partner  
mbader@sheppardmullin.com