UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORPORATION
Petitioner

v.

MOBILEMEDIA IDEAS LLC
Patent Owner

Case IPR2013-00016 (JYC)
Patent U.S. 6,441,828

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO AMEND

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I. MMI's MOTION IS NON-COMPLIANT

MobileMedia Ideas LLC's ("MMI") Motion to Amend ("Motion") fails to comply with the Board's Order of May 16, 2013, which states, "MobileMedia must explain how the proposed substitute claims obviate the grounds of unpatentability authorized in this trial, and why they are patentable over the prior art of record." (Paper 20, 3.) MMI's Motion acknowledges that requirement but merely points to the Madisetti Declaration for providing the requisite explanation. (Mot. 14.) Because the Motion lacks the required explanation, it should be denied.

Independently, the Board should deny the Motion because it fails to provide a claim construction. The Order of May 16, 2013 states that MMI "should include a claim construction of the proposed substitute claims." (Paper 20, 3.) MMI's repetitive statements that the new claim language "should be construed according to its plain, ordinary meaning" (Mot. 9–13) is insufficient because it prejudices RIM's ability to explain how the claims are unpatentable within the 15-page limit of this Opposition.

Additionally, the Motion should be denied with respect to claims 20–23 because it fails to comply with 37 C.F.R. § 42.121(a)(2). Those claims "do[] not either include or narrow each feature of the challenged claim[s] being replaced." *Idle Free Sys. v. Bergstrom.*, IPR2012-0027, Paper 26, June 11, 2013, 5. Substitute claims 20–23 improperly delete many of the original claim features. (*See* Mot. 5-

7.) This is improper because "a substitute claim may not enlarge the scope of the challenged claim it replaces by eliminating any feature." *Idle Free Sys.*, 5.

II. THE SUBSTITUTE CLAIMS ARE UNPATENTABLE

A. Claim 19 Is Indefinite under 35 U.S.C. § 112 ¶ 2

1. The term "means for determining …" still invokes § 112 ¶ 6

MMI's argument that "means for determining …" in claim 19 is not a means-plus-function limitation is incorrect. (*See* Mot. 9.) A claim limitation is presumed to invoke § 112 ¶ 6 when it explicitly uses the phrase "means for" and includes functional language. The presumption applies here because claim 19 uses the term "means for" and recites the function "determining a direction in which an image of the image signal is to be displayed on the image displaying means according to [1] a posture in which the apparatus is placed and [2] information on a direction in which an image of the image signal is to be displayed read from the recording medium." (Bracketed annotations added.)

The structural limitations that MMI adds to claim 19 are insufficient to overcome the presumption that § 112 ¶ 6 applies. "This presumption can be rebutted where the claim, in addition to the functional language, recites structure sufficient to perform the claimed function *in its entirety*." *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375–76 (Fed. Cir. 2003) (emphasis added). As shown below, MMI clearly has not overcome this presumption.

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