

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORP and RESEARCH IN MOTION LIMITED

Petitioner,

v.

MOBILEMEDIA IDEAS LLC

Patent Owner

Case IPR2013-00016 (JYC)

Patent U.S. 6,441,828

**PATENT OWNER'S REPLY TO OPPOSITION TO MOTION TO
AMEND**

Under 37 C.F.R. § 42.23, Patent Owner MobileMedia Ideas LLC (“MobileMedia”) respectfully submits this Reply and the Second Declaration of Dr. Vijay K. Madiseti, dated August 19, 2013 (Ex. 2011). Any fees due may be charged to Attorney Deposit Account 50-3081.

I. INTRODUCTION

Petitioner devotes most of its Opposition to arguing that MobileMedia’s proposed substitute claims 19-23 are either not compliant, not supported, or indefinite, and devotes fewer than three pages to arguing that proposed claims 19-23 are obvious based on the combinations of multiple prior art references it has needed to string together to attempt to show that all of the claimed elements were known, let alone obvious in combination, to a person of ordinary skill at the time of the invention. Petitioner improperly relies on hindsight bias (*see, e.g., KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 421 (2007)), and uses claims 19-23 as a roadmap, but has still been unable to show that all claimed features of all claims were known, even when combining references.

Claims 19-23 are one-for-one substitutes for each canceled claim. MobileMedia conferred with the Board prior to filing the Motion. Petitioner’s argument that those claims, which amended the original claims

to add structure that narrowed the claims to distinguish the proposed claims from prior art, are somehow purportedly broader than the original claims defies basic logic and has no merit. As shown below and in the Second Madisetti Declaration, proposed claims 19-23 are narrower, supported and definite. Petitioner's arguments are simply a distraction and have no merit.

II. MOBILE MEDIA'S MOTION IS COMPLIANT.

The Motion and Madisetti Declaration (Ex. 2001) explained how the proposed substitute claims are patentable (pages 3, 14) and provided significant discussion of the plain meaning claim interpretation (pages 7-13), which is proper. Proposed claim 19 amended original claim 6 to recite specific and sufficient structure for the "means for determining" consistent with the Board's own construction in the Initial Decision (Paper No. 16), resulting in that limitation no longer invoking 35 U.S.C. § 112, paragraph 6. The specification makes clear that the position sensor "may be either a type of which a moving element is moved in two directions *or* a type of which a pendulum type element is moved in *all directions*." (See, e.g., Ex. 2001 ¶ 57 (citing Ex. 1001, 6:26-36 (emphasis added).))

Proposed claim 19 narrowed the structure to require a sensor with a moving element moved in all directions as opposed to one that could be

moved either in two directions or all directions (*see, e.g.*, Ex. 2001 ¶ 57 (citing Ex. 1001, 6:26-36)) and added a recognition sensor that further narrowed the claim from original claim 6. (Ex. 2011 ¶¶ 46-52, 66-67.)

Petitioner’s argument that substitute claims 20-23 improperly delete “many” unidentified original claim features and do “not include or narrow each feature of the challenged claim[s] being replaced” should be rejected. (Opposition at 1 (citing *Idle Free Sys. v. Bergstrom*, IPR 2012-0027, Paper 26, June 11, 2013, at 5).)

Neither 35 U.S.C. § 316(d)(1)(B) nor USPTO rules give notice of, let alone require, that a substitute claim cannot “eliminate any feature” in order to be responsive to “an alleged ground of unpatentability. Unlike in *Idle Free Systems*, MobileMedia has not proposed a “complete remodeling of its claim structure according to a different strategy,” with multiple alternative claims for each claim. (*Id.* at 5). MobileMedia’s Motion presents one-for-one replacement claims that narrowed the independent claim and substituted the dependent elements with different features that result in a narrower claim. The Trial Practice Guide expressly contemplates new dependent claims with previously unclaimed features. (*See* Patent Office Trial Practice Guide at 48766-67 (*e.g.*, claim 7).) Petitioner has failed to show how an apparatus that infringes proposed claims 19-23 would not also have

infringed the original claims. *Cf. Hickerson-Halberstadt v. Converse, Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999).

III. PROPOSED NEW CLAIMS 19-23 ARE SUPPORTED AND NOT INDEFINITE.

As explained in the Second Madisetti Declaration, Proposed claim 19 is supported and not indefinite. (Ex. 2011 at ¶¶ 35-45, 53-59.) Petitioner resorts to misdirection and obfuscation. Dr. Madisetti did not “improperly splice[] together the two independent embodiments described in the ‘828 patent,” the first described in relation to Figures 1-12, and the second described in relation to Figures 13-17, starting at column 7, line 57.

This manufactured distinction is plainly incorrect. (Ex. 2011 ¶¶ 53-59.)

Proposed claims 20-23 are also supported and not indefinite. (Ex. 2011 ¶¶ 60-65.)

IV. THE PROPOSED NEW CLAIMS 19-23 ARE PATENTABLY DISTINCT FROM AND NOT OBVIOUS BASED ON THE PRIOR ART RELIED UPON BY PETITIONER.

As explained in greater detail in the Second Madisetti Declaration, claims 19-23 are patentably distinct from the prior art on which the Petitioner has relied. (Ex. 2011 at ¶¶ 68-227.) Claim 19 recites an apparatus that determines a direction in which an image of the image signal is to be displayed according to a posture in which the apparatus is placed based on the recited structure, which includes the position sensor. Claim 19

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