UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENFORA, INC., NOVATEL WIRELESS SOLUTIONS, INC., and NOVATEL WIRELESS, INC.
Petitioners

v.

M2M SOLUTIONS LLC
Patent Owner

Case IPR2015-01670 (Patent No. 8,648,717 B2)

Case IPR2015-01672 (Patent No. 8,648,717 B2)

RESPONSE TO THE BOARD'S DECEMBER 15, 2015 ORDER

I. INTRODUCTION

The Board's Question: In Paper No. 9, the Board requested the Parties' positions as to whether the challenged claims' "processing module" limitation "should be interpreted as a means-plus-function limitation" (herein "MPFL") and "if so, how the limitation should be interpreted." Paper No. 9 at 2.

Petitioners' Answer: Under the Broadest Reasonable Interpretation ("BRI") standard, the limitation need **not** be interpreted as a MPFL. Moreover, even if it were interpreted as a MPFL, the underlying structure can be considered to be a general purpose computer that can perform the claimed authentication, which has no practical effect on the invalidity analyses of the Petitions.

II. A DISTRICT COURT HAS FOUND THAT THE IDENTIFIED LIMITATION IS NOT SUBJECT TO SECTION 112(6), BOTH BEFORE AND AFTER *WILLIAMSON*

A. The *Williamson* Standard

When claims are asserted in district court, claim construction is governed by the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). Under the *Phillips* rubric, the Federal Circuit "has long recognized the importance of the presence or absence of the word 'means.'" *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015). Where the limitation does not include "means," there is a presumption that § 112, ¶ 6 does not apply, which can only be overcome "if the challenger demonstrates that the claim term fails to 'recite sufficiently definite structure' or else recites 'function without reciting sufficient

structure for performing that function.'" *Id*. (*quoting Watts v. XL Sys., Inc*., 232 F.3d 877, 880 (Fed. Cir. 2000)). The essential inquiry is "whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure." *Id*. (*citing Greenberg v. Ethicon Endo-Surgery, Inc*., 91 F.3d 1580, 1583 (Fed. Cir. 1996)).

B. The District of Delaware Has Found That The "Processing Module" Limitation is Not a MPFL

As discussed in Section II(B)(2) of the Petitions, M2M has brought actions based on two of the '717 Patent's ancestors, the '197 Patent (Ex. 1008)[1] and the '010 Patent (Ex. 1010). The "processing module" limitation is found (with some variation in language) in the asserted claims of each patent, and similar terms used within the same patent family should be similarly construed. *See In re Rambus Inc.*, 694 F.3d 42, 48 (Fed. Cir. 2012).

In these district court actions, Defendants proposed that the "processing module" limitations were MPFLs under the *Phillips* standard. Ex. 1022, p. 68.[2] The Court disagreed, construing those limitations as "components or units of a computer program" (Ex. 1023, p. 12) and citing a number of district court opinions finding "module" to be sufficient structure to avoid § 112, ¶ 6. *Id*. at 13.

[1] Cites to "Ex." are to Exhibits in both IPR proceedings unless otherwise indicated.

[2] The matters identified in Section II(B)(1) of the *Petitions* have been stayed.

Defendants sought reconsideration in view of *Williamson*, arguing that "module" was a well-known substitute for "means" and the limitation as a whole was consistent with traditional MFPLs.[3] The Court affirmed its construction.[4] Exs. 1038 (670) and 1037 (672) at pp. 2 and 5-9.

As part of the determination of whether the limitation has "sufficiently definite meaning as the name for structure" (*Williamson* 792 F.3d at 1348), the Court first cited the Federal Circuit's instruction that, in computer implemented inventions, "'[s]tructure may [] be provided by describing the claim limitation's operation .... [which] is more than just its function; it is how the function is achieved in the context of the invention." Exs. 1038 (670) and 1037 (672) at p. 6 (citing *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1299 (Fed. Cir. 2014)).

While the Court noted that the "processing module" limitation itself might not provide the requisite structure, the remaining claim limitations did describe a particular authentication algorithm with sufficient detail. Exs. 1038 (070) and 1037 (072) at p. 7. Specifically, the Court found that the "'processing module'

[3] In the 670 and 672 IPR proceedings, Defendants' Motion for Reconsideration is Exs. 1035 and 1034, respectively; M2M's Opposition is Exs. 1036 and 1035, respectively; and Defendants' Reply is Exs. 1037 and 1036, respectively.

[4] In the 670 and 672 IPR proceedings, the Court's Order is Exs. 1038 and 1037, respectively.

limitation expressly explains how this authenticating function is to be performed … [*i.e.*,] 'by determining if the at least one transmission contains the coded number.'" *Id*. at 8. The Court seemed particularly convinced in this regard by M2M's expert declaration that "the entire claim limitation recites sufficient structure for a person of skill in the art to be 'able to write a software program for implementing such an algorithm for use in a wireless data module ...'" and also noted that Defendants presented no contrary expert testimony. *Id*. at 7-8. No such expert testimony is in the record here, either.

Thus, the Court concluded that § 112 ¶6 does not apply. *Id*. at 9.

III. THE LIMITATION IS NOT A MPFL UNDER MPEP § 2181

In addition to the analysis under *Williamson* and *Phillips* set forth above, MPEP § 2181(I) specifies a particular MPFL analysis using the BRI standard. *First*, one looks at whether "means" or an equivalent "nonce term" is used. MPEP § 2181(I)(A). Here, "means" is not used, and "processing module" is not one of the "nonce terms" listed in MPEP § 2181(I)(A). *Second*, one looks to see if the limitation recites "the function it performs as opposed to the specific structure, material, or acts that perform the function." MPEP § 2181(I)(B). As discussed above, the Court found that "by determining if at least one transmission contains a coded number" provides sufficient computational structure. Exs. 1038 (670) and 1037 (672) at p. 8. *Third*, if the limitation is generic and functional, one confirms

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.