UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIERRA WIRELESS AMERICA, INC.; SIERRA WIRELESS, INC.;
and RPX CORP.,
Petitioners,

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2015-01823
Patent 8,648,717

PATENT OWNER'S SUPPLEMENTAL BRIEF

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Cases

Patent Owner, M2M Solutions Inc. ("M2M") respectfully submits this supplemental brief pursuant to the Board's Order, Conduct of the Proceedings, 37 C.F.R. §§ 42.5, 42.20. Paper 12. Consistent with the District Court's decision in a related proceeding (Ex. 2002),[1] the processing module limitation should not be interpreted as a means-plus-function limitation.

I. LEGAL STANDARD

When a claim term lacks the word "means" it is presumed that § 112(6) does not apply. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (en banc). However, "the presumption can be overcome and § 112, para. 6 will apply 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.*

For software-implemented claim terms, the relevant supporting structure is an algorithm. *Apple, Inc. v. Motorola, Inc.*, 757 F.3d 1286, 1298-99 (Fed. Cir. 2014). An algorithm provides at least "some explanation of how . . . [the claim term] performs the claimed function," and offers a description of a "means for achieving that end." *Blackboard, Inc. v. Desire2Learn, Inc.*, 574 F.3d 1371,

[1] For completeness, M2M submits pertinent portions of the brief and declarations before the District Court as Exs. 2003-2005.

1384-85 (Fed. Cir. 2009). The Federal Circuit's liberal standard "permits a patentee to express . . . [an] algorithm in *any understandable terms* including as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure." *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008) (emphasis added) (citation omitted). Ex. 2002 at 6.

In determining whether a claim term recites sufficient structure to avoid the application of Section 112(6), initial focus is placed on the claim term itself. *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1359-60 (Fed. Cir. 2004). Next, the analysis turns to the surrounding claim language of the "entire claim limitation" in which the claim term appears to ascertain whether it "connotes 'sufficiently definite structure' to a person of ordinary skill in the art." *Apple*, 757 F.3d at 1296. If the surrounding language of the full claim limitation provides a "structural definition" for the disputed claim term, or a "sufficient description of its operation," then statutorily adequate structure for that claim term has been disclosed. *Id*. at 1299-1300. This analytical approach applies with full force "[e]ven if a patentee elects to use a 'generic' claim term, such as a 'nonce word or a verbal construct.'" *Id.* at 1299.

II. THE CLAIM LANGUAGE ITSELF DISCLOSES STRUCTURE

The recited function for the "processing module" of independent Claims 1, 24 and 29 is authenticating a received incoming transmission. Ex. 1001 at 12:39-

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