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

IPR2015-01823 (Patent No. 8,648,717 B2)

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and
DANIEL J. GALLIGAN, *Administrative Patent Judges.*

I. Introduction

On December 15, 2015, the Patent Trial and Appeal Board issued an Order requesting the parties submit additional briefing on the issue of whether "a processing module for authenticating one or more wireless transmissions sent from a programming transmitter and received by the programmable communicator device by determining if at least one transmission contains a code number" should be interpreted as a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6 and *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015), and if so, how the limitation should be interpreted. Given a prior District Court ruling discussed below on a related patent where defendants, including petitioner, lost an argument that a similarly worded processing module claim limitation is a means plus function limitation, petitioner submits that the Board should act consistently with the district court and interpret this claim limitation as a means-plus-function limitation under 35 U.S.C. § 112, ¶ 6 and *Williamson v. Citrix Online, LLC*. Petitioner believes that under the broadest reasonable construction standard, a plain and ordinary meaning should apply to this claim limitation.

II. Claim Construction

In *In re Cuozzo Speed Tech, LLC*, No. 2014-1301, slip op. (Fed. Cir. July 8, 2015), the Federal Circuit confirmed the Patent Trial and Appeal Board's practice

of applying the broadest reasonable interpretation standard in *inter partes* review proceedings is proper as set forth in 37 C.F.R. § 42.100(b). Under the broadest reasonable interpretation standard, claim terms are given their broadest reasonable interpretation in view of the specification to one having ordinary skill in the art at the time of the invention and without importing limitations into the claims from the specification. *See* Manual of Patent Examining Procedure ("MPEP") § 2111.

In the petition, petitioners proposed that the plain and ordinary meaning be applied to any claim limitations not specifically discussed in the petition. *See* Petition, p. 13 (Section IV.E.). In light of the District Court's decision, but without conceding the correctness of that decision, Petitioners respectfully submit that the plain and ordinary meaning is the proper claim construction for the "processing module" claim limitation under the broadest reasonable claim construction standard.

The Federal Circuit's decision in *Williamson v. Citrix* held that the rebuttable presumption against applying 35 U.S.C. 112, ¶6 to non-means claim terms should be reduced from a "heightened" to an ordinary presumption, and that the word "module" standing alone may *sometimes* serve as a "nonce word." *M2M Solutions LLC v. Sierra Wireless America, Inc.*, 2015 WL5826816 *3 (D. Del. 2015) (citing *Apple Inc. v. Motorola, Inc.*, 757 F.2d 1286, 1299-1300 (Fed. Cir.

2014). However, where scrutiny of the entire claim limitation reveals surrounding claim language that provides a generic term with a sufficient description of its operation, the presumption against means-plus-function claiming remains intact. *Apple Inc. v. Motorola, Inc.*, 757 F.2d at 1300.

In a related district court case, M2M, the patent owner, contended (and the district court agreed) that a similarly worded "processing module" claim limitation was not governed by 35 U.S.C. 112, ¶6 under *Williamson v. Citrix* because its surrounding claim language connoted sufficiently definite structure. *M2M Solutions LLC v. Sierra Wireless America, Inc.*, 2015 WL5826816 *3. The district court, applying the narrower *Phillips* standard of claim construction to that claim limitation, ultimately construed "processing module" as "components or units of a computer program."[1]

The similarly worded "processing module" claim limitations are presented below:

Processing module limitation in the '010 patent at issue in the district court case	Processing module limitation in the '717 patent at issue here
a processing module for authenticating an at least one transmission sent from a programming transmitter and received	a processing module for authenticating one or more wireless transmissions sent from a programming transmitter and

[1] Petitioner's note that there is no explicit written description support in the patent application for the court's construction of "processing module" in the related district court case or for the construction proposed by Plaintiff for the processing module that it is "components or units of a computer program." Accordingly, the court's construction that the processing module is components or units of a computer program should be rejected.

by the programmable communicator device, the at least one transmission including a coded number and at least one telephone number or Internet Protocol (IP) address corresponding to an at least one monitoring device, wherein the processing module authenticates the at least one transmission by determining if the at least one transmission contains the coded number, the processing module authenticating the at least one transmission if the transmission includes the coded number	received by the programmable communicator device by determining if at least one transmission contains a coded number

M2M contended that the language surrounding the "processing module" limitation expressly explains how the "processing module" is able to perform the recited function of authenticating a received incoming transmission – i.e., "by determining if the at least one transmission contains the coded number." *Id.* The patent owner argued that the disclosures in prose of a particular manner for how the "processing module" performs its authenticating function constitute algorithmic structure, which prevents the invocation of 35 U.S.C. 112, ¶6. *Id.* Similarly, in the district court case for the patent-at-issue, Plaintiff rejected Defendant's proposal that the "processing module" is subject to 35 U.S.C. 112, ¶6. See Joint Claim Construction Statement, Case No. 1:14-cv-01102-RGA, Dkt. No. 34 (D. Del. 2015), p. 10. Here, the "processing module" claim limitation includes the same language regarding the specific process for performing the authentication function ("by

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