Paper No. _____

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 RESPONSE PURSUANT TO 37 C.F.R. § 42.120

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TABLE OF AUTHORITIES

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Cases

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