Patent No. 8,648,717

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIERRA WIRELESS AMERICA, INC., SIERRA WIRELESS, INC. AND RPX CORP.

Petitioner

v.

M2M SOLUTIONS LLC
Patent Owner

Patent No. 8,648,717
Issue Date: February 11, 2015
Title: PROGRAMMABLE COMMUNICATOR

Inter Partes Review No. <u>2015-01823</u>

REPLY IN SUPPORT OF PETITION FOR INTER PARTES REVIEW

Page

Contents

EXHIBITS

1001   U.S. Patent No. 8,648,717 ("the '717 patent")

1002   Prosecution History for U.S. Patent No. 8,648,717 ("the '717 prosecution history").

1003   Int'l Patent Pub. No. WO99/49680 ("Whitley")

1004   Digital cellular telecommunications system, Phase 2+; Specification of the Subscriber Identity Module - Mobile Equipment, SIM - ME interface, GSM 11.11 version 7.4.0 Release 1999 ("SIM+ME Spec")

1005   U.S. Patent No. 5,959,529 ("Kail")

1006   Int'l Patent Pub. No. WO 95/05609 ("Eldredge")

1007   Digital cellular telecommunications system (Phase 2+); AT command set for GSM Mobile Equipment (ME) (GSM 07.07 version 5.8.1 Release 1996) ("AT Command Set")

1008   Excerpts from Expert Report of Dr. Nettleton

1009   Digital cellular telecommunications system, Phase 2+; General Packet Radio Service (GPRS); Service description; Stage 2 (GSM 03.60 version 6.3.2 Release 1997) ("GPRS Service Description")

1010   U.S. Patent No. 5,772,586

1011   U.S. Patent No. 6,225,901

1012   U.S. Patent No. 6,804,558

1013   Declaration of Kevin Negus

1014   Digital cellular telecommunications system, Phase 2+; Specification of the SIM Application Tookit for the Subscriber Identity Module – Mobile Equipment (SIM-ME) interface (GSM 11.14 version 7.3.0 Release 1998)

1015   The Subscriber Identity Module, European Telecommunications

	Standardization and the Information Society, The State of the Art 1995
1016	Claim Construction Order in C.A. Nos. 12-030-RGA, 12-031-RGA, 12-032-RGA, 12-033-RGA, and 12-034-RGA
1017	Digital cellular telecommuncations system (Phase 2+) (GSM); Universal Mobile Telecommunications System (UMTS); General Packet Radio Service (GPRS); Service description; Stage 2 (3G TS 23.060 version 3.3.0 Release 1999)
1018	Mobile Handset Design, Sajal Kumas Das, John Wiley & Sons, ISBN 978-0-470-82467
1019	Opening Brief in Support of Defendants Sierra Wireless America Inc.'s and Sierra Wireless Inc.'s Motion for Summary Judgment of Non-Infringement
1020	Opening Brief in Support of Defendants Sierra Wireless America Inc.'s and Sierra Wireless Inc.'s Motion for Summary Judgment of Invalidity
1021	Excerpts of Plaintiff M2M Solutions LLC's Preliminary Infringement Contentions
1022	Transcript of Deposition of Joel R. Williams
1023	August 15, 2016 Declaration of Kevin Negus
1024	Declaration of Jennifer Hayes, August 15, 2016

I.   Preliminary Statement

Sierra Wireless America Inc., Sierra Wireless Inc. and RPX Corp.

(Petitioners) submit this Reply in response to Patent Owner's Response.

Patent Owner attempts to salvage the validity of the instituted claims despite

the fact that the claims were well-known in the prior art. Patent Owner

mischaracterizes Petitioners' identification of the claimed limitations in the prior

art, mischaracterizes the disclosures of the prior art, and mischaracterizes the

record. Primarily, Patent Owner bases its arguments in support of validity on

narrow claim construction positions that are inconsistent with the "broadest

reasonable claim construction." Furthermore, Petitioners do not rely on inherency

to support its Petition; accordingly, all of Patent Owner's arguments regarding

inherency are irrelevant and should be disregarded.

Because the claims are rendered obvious over Whitley in view of the GSM

Standards documents (and in view of Kail and/or Eldridge), and Patent Owner's

arguments rely on overly narrow claim constructions and disregard the prior art

and the record, Petitioners respectfully request the Board to a final decision

cancelling claims 1, 3, 5-6, 10-13, 15-24 and 29 of the '717 patent.

II.   Claim Construction

In *inter partes* review, claim terms should be given their "broadest

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.