

Patent Owner's Response  
*Inter Partes* Review of U.S. Patent No. 8,648,717

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**

*Mail Stop "PATENT BOARD"*  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

I.	PROCEDURAL BACKGROUND .....	1
II.	RELIEF REQUESTED .....	2
III.	STATEMENT OF MATERIAL FACTS .....	2
IV.	THE CLAIMS ON WHICH THE IPR WAS INSTITUTED ARE NOT OBVIOUS .....	3
A.	Claims 1, 3, 5, 6, 10-13, 15, 18, 22-24, And 29 Are Not Obvious Based On The Combination Of Whitley And The SIM Specification As Alleged In Ground 1 .....	3
1.	Petitioners' Obviousness Analysis Is Inadequate .....	3
a)	Petitioners failed to articulate the differences between the claimed invention and the prior art .....	3
b)	Petitioners did not provided an adequate rationale to combine the references .....	4
2.	Whitley In View Of The SIM Spec Fails To Disclose All Elements In Independent Claim 1 And Fails To Render That Claim Obvious As Alleged In Ground 1 .....	5
3.	Whitley In View Of The SIM Specification Fails To Disclose Element 1(b) In Independent Claim 1 And Fails To Render That Claim Obvious As Alleged In Ground 1 .....	7
4.	Whitley In View Of The SIM Specification Fails To Disclose Element 1(d) In Independent Claim 1 And Fails To Render That Claim Obvious As Alleged In Ground 1 .....	13
a)	Overview Of The SIM Specification And The Related SAT Specification Prior Art References .....	18
(i)	The SIM Specification .....	18
(ii)	The SAT Specification .....	21

b)	Overview Of Petitioners’ Detailed Analysis For How The SIM Specification Purportedly Satisfies The Requirements Of Claim Element 1(d).....	23
c)	Petitioners’ Detailed Analysis Of Claim Element 1(d) Must Fail For Being Premised Upon Mischaracterizations Of The Disclosures and Teachings Of The SIM Specification .....	26
(i)	The SIM Specification Fails To Teach That the FDN Phonebook Is An Outbound Restrictive Calling List.....	26
(ii)	The SIM Specification Fails To Teach That Wireless “SMS-PP data download” Messages Are Sent Over A GPRS Network, And In Any Event It Is Unproven That SMS Messages Sent Over GPRS Would Be Packet Switched Data Messages .....	29
(iii)	The SIM Specification Fails To Teach That Any Type Of APDU Command Would Ever Be Transmitted In A Wireless “SMS-PP Data Download” Message .....	34
(iv)	The SIM Specification Fails To Teach That The SIM OS Identified By Petitioners As The “Processing Module” Would Ever Even Receive Wireless “SMS-PP Data Download” Message Transmissions .....	37
(v)	The SIM Specification Fails To Teach That The SIM OS Identified By Petitioners As The “Processing Module” Is Capable Of Authenticating Or Otherwise Processing The Content Of The Data Payload Originating In An “SMS-PP Data Download” Message Transmission .....	39

(vi)	Petitioners Have Not Provided An Adequate Rationale To Combine Whitley With The SIM Specification.....	42
5.	Whitley In View Of The SIM Specification Fails To Disclose Element 1(g) In Independent Claim 1 And Fails To Render That Claim Obvious As Alleged In Ground 1 .....	45
6.	Whitley In View Of The SIM Specification Fails To Disclose All Elements Of Independent Claims 24 And 29 And Fails To Render Those Claims Obvious As Alleged In Ground 1 For Substantially The Same Reasons Discussed Above In Relation To Claim Elements 1(b), 1(d) And 1(g) .....	49
7.	Whitley In View Of The SIM Specification Fails To Disclose All Elements Of Dependent Claim 6 And To Render That Claim Obvious As Alleged In Ground 1 .....	50
8.	Whitley In View Of The SIM Specification Fails To Disclose All Elements Of Dependent Claim 10 And To Render That Claim Obvious As Alleged In Ground 1 .....	50
9.	Whitley In View Of The SIM Specification Fails To Disclose All Elements Of Dependent Claim 23 And To Render That Claim Obvious As Alleged In Ground 1 .....	52
B.	Claims 16, 17, 19 And 20 Are Not Obvious Based On The Combination Of Whitley, The SIM Specification, And Kail As Alleged In Ground 3.....	53
1.	Claims 16 And 17 .....	53
2.	Claims 19 And 20 .....	56
C.	Claim 21 Is Not Obvious Based On The Combination Of Whitley, The SIM Specification, And Eldredge As Alleged In Ground 4.....	59
V.	CONCLUSION.....	61

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Cases</b>	
<i>Advanced Display Sys., Inc. v. Kent State Univer.</i> , 212 F.3d 1272 (Fed. Cir. 2000) .....	28, 32
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	3
<i>Heart Failure Technologies, LLC v. CardioKinetix, Inc.</i> , IPR2013-00183 (PTAB July 31, 2013) (Paper 12) .....	4
<i>Kinetic Technologies, Inc. v. Skyworks Soalutions, Inc.</i> IPR2014-00529 (Paper 8, p. 15) .....	44, 45
<i>KSR Int’l Co. v. Teleflex</i> , 127 S. Ct. 1727 (2007).....	4
<i>KSR Int’l Co. v Teleflex Inc.</i> , 550 U.S. 398 (2007).....	3
<i>Luminara Worldwide, LLC v. Liown Electronics Co. Ltd.</i> , IPR2015-01183 (Paper 8, p. 17) .....	44
<i>Plantronics Inc. v. Aliph Inc.</i> , 724 F.3d 1343 (Fed. Cir. 2013) .....	4
<i>Trintec Indus. v. Top-U.S.A. Corp.</i> , 295 F.3d 1292 (Fed. Cir. 2002) . . . . .	29, 36
<b>Statutes</b>	
35 U.S.C. § 103 .....	3
<b>Other Authorities</b>	
37 C.F.R. § 42.100 .....	63

# 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.