

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Microsoft Corporation,
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC
Patent Owner

Case IPR2016-01581
Patent 5,754,946

**PATENT OWNER MOBILE TELECOMMUNICATIONS
TECHNOLOGIES, LLC'S PRELIMINARY RESPONSE**

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OTHER AUTHORITIES

35 United States Code § 102.....	1, 3, 22, 35
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I. BACKGROUND

On August 11, 2016, the Petitioner Microsoft Corporation (“Microsoft” or “Petitioner”) filed a Petition for *Inter Partes* Review under 37 C.F.R. § 42.100, requesting *inter partes* review of claims 1-2, 4, and 7-9 of U.S. Patent No. 5,754,946 (“the ’946 Patent”) on two grounds. The Petitioner asserts that claims 1-2, 4, and 7-9 of the ’946 Patent are unpatentable over the following references under 35 U.S.C. §§ 102, 103:¹

Ground 3 - Claims 1, 4, and 7-8 as anticipated and obvious over U.S. Patent No. 5,448,759 (“*Krebs*”); and

Ground 4 – Claims 1-2, 4, and 7-9 as obvious over *Krebs* in view of U.S. Patent No. 5,396,537 (“*Schwendeman*”) in view of U.S. Patent No. 5,031,179 (“*Yoshida*”).

The ’946 Patent, entitled “Nationwide Communication System,” was filed on September 21, 1993 and issued on May 19, 1998. The ’946 Patent expired on May 19, 2015.

The ’946 Patent describes and claims methods and systems for communication between a system network and a mobile unit. The system network

¹ Grounds 1 and 2 involving four other references: Japanese Unexamined Patent Application H2-213237 (“*Akiyama*”), U.S. Patent No. 4,940,963 (“*Gutman*”), U.S. Patent No. 4,644,351 (“*Zabarsky*”), and U.S. Patent No. 5,311,516 (“*Kuznicki*”), are described in another petition, IPR2016-01576.

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