

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROCKWELL AUTOMATION, INC., ROCKWELL AUTOMATION
TECHNOLOGIES, INC.

Petitioners,

v.

AUTOMATION MIDDLEWARE SOLUTIONS, INC.

Patent Owner.

Case IPR2017-00048

Patent 6,516,236

PATENT OWNER AUTOMATION MIDDLEWARE SOLUTIONS, INC.'s

PRELIMINARY RESPONSE UNDER 37 CFR § 42.107

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Table of Exhibits

Ex #	Exhibit
2001	Affidavit in Support of Motion for Pro Hac Vice Admission of Christopher Limbacher
2002	<i>Inter Partes</i> Reexamination 95/000,396, Order Granting Request for Inter Partes Reexamination, Nov. 20, 2008
2003	<i>Inter Partes</i> Reexamination Filing Data – Sept. 30, 2016, https://www.uspto.gov/sites/default/files/documents/inter_parte_historical_stats_roll_up.pdf
2004	IPR2013-00062 Exhibit 1010 – Represented to be Cashin
2005	IPR2013-00062 Exhibit 1003 – Represented to be WOSA XFS
2006	IPR2013-00062 Exhibit 1011 – Represented to be Control Engineering August 1995
2007	IPR2013-00062 Exhibit 1002 – Represented to be Gertz Thesis
2008	PTAB Statistics – Oct. 31, 2016, https://www.uspto.gov/sites/default/files/documents/aia_statistics_october_2016.pdf
2009	Excerpts of the File History for U.S. Patent Application Serial No. 10/021,449, which issued as the '236 Patent, List of References Considered, Aug. 22, 2002
2010	U.S. Patent No. 6, 516, 236 C1 <i>Inter Partes</i> Reexamination Certificate, Issued Jun. 28, 2011
2011	Excerpts of the File History for <i>Inter Partes</i> Reexamination No. 95/000,396, Reexamination Right of Appeal Notice, Jan. 26, 2011
2012	Excerpts from Adrian King, Inside Windows 95
2013	Excerpts of the File History for <i>Inter Partes</i> Reexamination No. 95/000,396, Non-Final Action, Sept. 22, 2010
2014	IPR2013-00062 Petition
2015	IPR2013-00062 Decision on Institution of IPR, April 18, 2013
2016	Preliminary Claim Construction in <i>Automation Middleware Solutions, Inc. v. Invensys Systems, Inc., et al.</i> , No. 2-15-cv-00898-RWS (E.D. Tex. Dec. 6, 2016)
2017	U.S. Patent No 5,392,207 – GML
2018	Declaration of Douglas R. Wilson in Support of Patent Owner's Preliminary Response

I. Introduction

Patent Owner Automation Middleware Solutions, Inc. (hereafter “AMS”) respectfully submits this Preliminary Response to the Petition seeking *inter partes* review (“IPR”) in this matter. This filing is timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107, as it is being filed within three months of the November 1, 2016 mailing date of the Notice of Filing Date. *See* 37 C.F.R. § 42.107 (setting deadline for preliminary response at “three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date”).

A trial should not be instituted in this matter, because none of the references relied upon in the petition, whether considered alone or in combination, give rise to a reasonable likelihood of Petitioners prevailing with respect to any claim of U.S. Patent No. 6,516,236 (the “’236 Patent”) (Exhibit 1001).

A. Statement of Relief Requested

Pursuant to 35 U.S.C. § 314, Patent Owner respectfully requests that the Board refuse to institute *inter partes* review, because Petitioners have not shown a reasonable likelihood of prevailing with respect to either of the invalidity grounds presented on any of claims 1-3 of the ’236 Patent. Additionally, Patent Owner requests that the Board deny the Petition under 35 U.S.C. § 325(d) because the grounds asserted are substantially similar to those presented in previous United States Patent Office proceedings.

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