

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

Case IPR2019-00820
Patent 7,937,581

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

	Page
I. INTRODUCTION.....	1
II. INSTITUTION SHOULD BE DENIED UNDER 35 U.S.C. § 325(d).....	3
A. The Examiner Conducted A Thorough Examination	10
B. Petitioner’s Primary Reference, Ishiyama, Was Fully Discussed, And Was The Basis Of A Rejection That Was Traversed And Overcome, During Prosecution Of The Parent Application In Connection With Substantially The Same Arguments Raised Here	11
C. Ahonen Was Fully and Repeatedly Discussed, And Formed The Basis Of Three Rejections During Prosecution Of The Parent <i>And</i> Continuation Applications In Relation To The Same Argument Raised In The Petition	15
D. Petitioner Fails To Show That Its Reliance On Murakawa Is Not Substantially The Same As The Examiner’s Reliance On Ahonen	22
E. Petitioner Fails To Show That Its Reliance On Forslöw Is Not Substantially The Same As The Examiner’s Reliance On Ahonen	24
F. The Applicant Admitted Prior Art (AAPA) Mentioned In The Petition Was Already Presented To The Examiner	26
G. The Section 325(d) Factors Favor Denying The Petition	29
1. The Similarities And Material Differences Between The Asserted Art And The Prior Art Involved During Examination	30
2. The Cumulative Nature Of The Asserted Art And The Prior Art Involved During Examination.....	30
3. The Extent To Which The Asserted Art Was Evaluated During Examination, Including Whether The Prior Art Was The Basis For Rejection.....	31

4.	The Extent Of The Overlap Between The Arguments Made During Examination And The Manner In Which Petitioner Relies On The Prior Art Or Patent Owner Distinguishes The Prior Art	33
5.	Whether Petitioner Has Pointed Out Sufficiently How The Examiner Erred In Its Evaluation Of The Asserted Prior Art ..	38
6.	The Extent To Which Additional Evidence And Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments	42
H.	Conclusion Regarding § 325(d) Factors	46

III. INSTITUTION SHOULD BE DENIED BECAUSE THE PETITION FAILS TO SHOW THAT THE ISHIYAMA-MURAKAWA COMBINATION RENDERS THE CLAIMS OBVIOUS (ALL CLAIMS, ALL GROUNDS).....46

A.	Ishiyama Does Not Disclose A “Security Gateway”	47
1.	Ishiyama Is Directed To A Specific Improvement To Mobile IP.....	48
2.	Mobile IP Does Not Use A Security Gateway	51
3.	Ishiyama’s Figure 4 And Accompanying Disclosure Confirm That The Correspondent Host Is An End Point And Not A “Security Gateway”	52
4.	During Prosecution of the Parent Application, The Applicant Traversed A Rejection Based On Ishiyama On The Basis That Ishiyama Does Not Disclose A “Security Gateway”	54
5.	Ishiyama Discloses That The Correspondent Host (CN) Can Initiate Calls To The Mobile Computer, Which Is Further Proof That It Is Not A “Security Gateway”	55
6.	Petitioner’s Theory Of What Constitutes A “Security Gateway” Is Contradictory And Internally Inconsistent.....	57

B. The Ishiyama Combination Does Not Disclose The Request Or Reply
Message Limitations.....59

C. The Ishiyama Combination Does Not Disclose The “Other
Terminal”60

IV. CONCLUSION.....64

TABLE OF AUTHORITIES

Page(s)

CASES

Arendi S.A.R.L. v. Apple Inc.
832 F.3d 1355 (Fed. Cir. 2016) 61, 62

Credit Acceptance Corp. v. Westlake Servs.,
859 F.3d 1044 (Fed. Cir. 2017)4

DSS Tech. Mgmt., Inc. v. Apple Inc.,
885 F.3d 1367 (Fed. Cir. 2018) 61, 62

In re Stepan Co.,
868 F.3d 1342 (Fed. Cir. 2017)61

KSR Int’l Co. v. Teleflex Inc.,
82 USPQ2d 1385 (2007)..... 14, 19, 38, 62

ADMINISTRATIVE DECISIONS

Becton, Dickinson & Co. v. B. Braun Melsungen AG,
IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (informative)..... passim

Canon Inc. v. Papst Licensing GmbH & Co. KG,
IPR2016-01202, Paper 15 (PTAB Dec. 15, 2016)29

Cisco Systems, Inc., v. C-Cation Techs., LLC,
IPR2014-0454, Paper 12 (PTAB Aug. 29, 2014).....63

Cloud9 Techs. LLC v. IPC Systems, Inc.,
IPR2017-01615, Paper 8 (PTAB Jan. 10, 2018) 27, 28

Cosmax Co. Ltd. v. AmorePacific Corp.,
IPR2018-01516, Paper 8 (PTAB Feb. 20, 2019).....43

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.