

UNITED STATES PATENT & TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILE TECH, INC.,
Petitioner,

v.

SENNCO SOLUTIONS INC.,
Patent Owner.

Case IPR2018-01218
U.S. Patent 9,664,336

**PETITIONER'S RESPONSE IN OPPOSITION TO
PATENT OWNER'S CONTINGENT MOTION TO AMEND**

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PETITIONER'S EXHIBIT LIST

<i>MTI Exhibit No.</i>	<i>Document</i>
1001	U.S. Patent No. 9,664,336 to Ewen <i>et al.</i> (“the ’336 Patent”)
1002	WIPO Publication No. 2012/069816 to Seabrook (“Seabrook”)
1003	U.S. Patent No. 7,327,276 to Deconinck <i>et al.</i> (“Deconinck”)
1004	U.S. Patent No. 7,667,601 to Rabinowitz (“Rabinowitz”)
1005	Freedom ONE Product Manual (“FOPM”)
1006	U.S. Patent Application Publication No. 2011/0047844 (“Fawcett”)
1007	“Spring,” A Dictionary of Mechanical Engineering 344 (1 st ed. 2013)
1008	U.S. Patent No. 7,710,266 to Belden (“Belden”)
1009	U.S. Patent Publication 2005/0073413 to Sedon <i>et al.</i> (“Sedon”)
1010	U.S. Patent Publication 2011/0068920 to Yeager (“Yeager”)
1011	U.S. Patent Publication 2009/0173868 (“’868 Fawcett”)
1012	Declaration of Dr. Kimberly K. Cameron
1013	Definition of “On” from Dictionary.com (http://www.dictionary.com/browse/on?s=t)
1014	Declaration of Wade Wheeler

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1015	Sales Data for Freedom ONE
1016	Wayback Machine Archive of Freedom ONE Online Landing Page on September 25, 2011
1017	Wayback Machine Archive of MTI Library Landing Page on January 26, 2012
1018	U.S. Patent No. 9,303,809 to Reynolds <i>et al.</i> (“the ’809 Patent”)
1019	Cross-Examination of Mr. Robert Mizek (June 24, 2019)
1020	Supplemental Declaration of Dr. Kimberly K. Cameron
1021	Excerpts from Michael J. Troughton (editor), Handbook of Plastics Joining: A Practical Guide (2nd ed. 2008)
1022	Mustafa Aydin (2010) Effects of Welding Parameters and Pre-Heating on the Friction Stir Welding of UHMW-Polyethylene, Polymer-Plastics Technology and Engineering, 49:6, 595-601, DOI: 10.1080/03602551003664503

PETITIONER’S RESPONSE TO CONTINGENT MOTION TO AMEND

Sennco’s Contingent Motion to Amend (Paper 16) should be denied for at least the below reasons. Sennco’s substitute claims do not overcome MTI’s invalidity arguments, and, in fact, only raise additional validity defects. Simply put, they would be invalid if allowed.

I. THE SUBSTITUTE CLAIMS ARE INDEFINITE AND/OR LACK WRITTEN DESCRIPTION

A. Legal Standards for Indefiniteness in Motions to Amend

A claim does not comply with 35 U.S.C. § 112(b) “when it contains words or phrases whose meaning is unclear.” *In re Packard*, 751 F.3d 1307, 1310, 1314 (Fed. Cir. 2014) (approving, for pre-issuance claims, the standard from MPEP § 2173.05(e)); *see also Ex parte McAward*, Appeal 2015-006416, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (precedential) (adopting the *Packard* approach for assessing indefiniteness in prosecution). In other words, “claims are required to be cast in clear—as opposed to ambiguous, vague, indefinite—terms.” *Packard*, 751 F.3d at 1313. A claim is also indefinite if it is “amenable to two or more plausible claim constructions.” *Ex parte Miyazaki*, Appeal 2007-3300, 2008 WL 5105055, at *5 (BPAI Nov. 19, 2008) (precedential).

While the Federal Circuit has not yet addressed the issue, the Board applies the *Packard* standard when reviewing the patentability of original claims in AIA

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