

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**

***Mail Stop: Patent Board***

Patent Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

<b>PETITIONER’S EXHIBIT LIST.....</b>	<b>iii</b>
<b>PETITIONER’S RESPONSE TO CONTINGENT MOTION TO AMEND ....</b>	<b>1</b>
<b>I. THE SUBSTITUTE CLAIMS ARE INDEFINITE AND/OR LACK WRITTEN DESCRIPTION .....</b>	<b>1</b>
<b>A. Legal Standards for Indefiniteness in Motions to Amend.....</b>	<b>1</b>
<b>B. Sennco’s Substitute Claims Are Indefinite and/or Lack Written-         Description Support .....</b>	<b>3</b>
<b>1. Substitute Claims 21-27 are Indefinite and/or Lack Written             Description .....</b>	<b>3</b>
<b>2. Substitute Claims 28-32 are Indefinite and/or Lack Written             Description .....</b>	<b>13</b>
<b>3. Substitute Claims 33-39 are Indefinite and/or Lack Written             Description .....</b>	<b>17</b>
<b>II. THE SUBSTITUTE CLAIMS ARE NOT PATENTABLE OVER THE     PRIOR ART .....</b>	<b>19</b>
<b>III. CONCLUSION .....</b>	<b>25</b>

**PETITIONER'S EXHIBIT LIST**

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

<b>1015</b>	Sales Data for Freedom ONE
<b>1016</b>	Wayback Machine Archive of Freedom ONE Online Landing Page on September 25, 2011
<b>1017</b>	Wayback Machine Archive of MTI Library Landing Page on January 26, 2012
<b>1018</b>	U.S. Patent No. 9,303,809 to Reynolds <i>et al.</i> (“the ’809 Patent”)
<b>1019</b>	Cross-Examination of Mr. Robert Mizek (June 24, 2019)
<b>1020</b>	Supplemental Declaration of Dr. Kimberly K. Cameron
<b>1021</b>	Excerpts from Michael J. Troughton (editor), Handbook of Plastics Joining: A Practical Guide (2nd ed. 2008)
<b>1022</b>	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

# 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.