

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

Case No. IPR2021-01157

U.S. Patent No. 7,274,933

**DECLARATION OF DR. APOSTOLOS K. KAKAES
IN SUPPORT OF PETITIONER'S OPPOSITION TO
PATENT OWNER'S REVISED MOTION TO AMEND**

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION AND QUALIFICATIONS	1
II. MATERIALS CONSIDERED	2
III. OVERVIEW OF CONCLUSIONS	3
IV. SUMMARY OF THE PROPOSED AMENDMENTS	4
V. ANALYSIS OF PROPOSED AMENDMENTS	10
A. The Proposed Substitute Claims Lack Written Description	10
1. The Testing Limitation Is Not Supported in the Specification.....	11
2. The Timing Limitations Are Not Supported in the Specification.....	12
B. The Proposed Substitute Claims Are Indefinite	14
1. Limitation (2a) Renders Claims 20–24 Indefinite	15
2. Limitation (2b) Renders Claims 25–29 Indefinite.....	17
C. The Proposed Amended Claims Would Have Been Obvious Based on the Grounds Discussed in My Prior Declaration.....	18
1. Elements 20[b] and 25[c] (Limitation 1) Are Obvious in Light of McElwain	19
2. Elements 20[c] and 25[d] (Limitations 2a, 2b) Are Obvious in Light of McElwain.....	22
3. Elements 20[d] and 25[e] Are Obvious in Light of McElwain.....	24
VI. ADDITIONAL REMARKS	25
APPENDIX A: TEXT OF PROPOSED SUBSTITUTE CLAIMS	27

TABLE OF APPENDICES

Document	Description
Appendix A	Text of Proposed Substitute Claims

TABLE OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 7,274,933 (“the ’933 patent”)
1002	Copy of Prosecution History of the ’933 patent
1004	U.S. Patent Appl. Publ. No. 2003/0022689 (“McElwain”)
1005	U.S. Patent Appl. Publ. No. 2004/0204136 (“Uchida”)
1006	U.S. Patent No. 7,027,813 (“Hicks”)
1007	3rd Generation Partnership Project; Technical Specification Group Core Network; NAS Functions related to Mobile Station (MS) in idle mode (Release 5) (3GPP TS 23.122 V5.2.0) (“TS-23.122”)
1008	3rd Generation Partnership Project; Technical Specification Group Services and System Aspects – Service aspects; Service principles (Release 5) (3GPP TS 22.101 V5.8.0) (“TS-22.101”)
1009	3rd Generation Partnership Project; Technical Specification Group Terminals; Characteristics of the USIM Application (Release 5) (3GPP TS 31.102 V5.3.0) (“TS-31.102”)
1010	Declaration of Craig Bishop
1011	Complaint for Patent Infringement, No. 1:19-cv-01247-LPS (D. Del. July 1, 2019)
1012	Complaint for Patent Infringement, No. 3:19-cv-01694 (N.D. Tex. July 15, 2019)
1013	Complaint for Patent Infringement, No. 1:19-cv-01140-MN (D. Del. June 20, 2019)
1014	Complaint for Patent Infringement, No. 1:19-cv-01144-MN (D. Del. June 20, 2019)
1015	Amended Complaint for Patent Infringement, No. 1:20-cv-20813 (S.D. Fl. Feb. 25, 2020)

Exhibit	Description
1016	EIA/TIA-553 Standard (AMPS)
1017	Excerpts from EIA/TIA/IS-54 Standard (Digital AMPS)
1018	Excerpts from TIA/EIA/136.1 Standard
1019	Excerpts from TIA/EIA/IS-136.2-A Standard
1020	Excerpts from TIA/EIA/IS-95 Standard
1021	Excerpts from T. Halonen et al., “GSM, GPRS and EDGE Performance: Evolution Towards 3G/UMTS” (2d ed. Wiley 2003)
1022	3rd Generation Partnership Project; Technical Specification Group Terminals Specification of the Subscriber Identity Module – Mobile Equipment (SIM - ME) interface (Release 1999) (3GPP TS 11.11 V8.6.0) (“TS-11.11”)
1023	Excerpts from A. Mehrotra, “GSM System Engineering” (Artech House 1997)
1024	U.S. Patent No. 5,950,130 (“the ’130 patent”)
1025	U.S. Patent No. 5,862,471 (“the ’471 patent”)
1026	U.S. Patent No. 6,195,532 (“Bamburak”)
1027	U.S. Patent Appl. Publ. No. 2001/0001875 (“Hirsch”)
1028	U.S. Patent Appl. Publ. No. 2002/0111180 (“Hogan”)
1030	3rd Generation Partnership Project; Technical Specification Group Terminals; Test Specification for ‘C’-language binding to (U)SIM API (Release 6) (3GPP TS 34.131 V6.0.0) (“TS-34.131”)
1031	Deposition of Dr. Apostolos Kakaes
1032	Third Declaration of Dr. Apostolos Kakaes

I, Dr. Apostolos K. “Paul” Kakaes, hereby declare as follows:

I. INTRODUCTION AND QUALIFICATIONS

1. I understand that the Patent Trial and Appeal Board (“PTAB” or “Board”) has instituted an *inter partes* review (“IPR”) of U.S. Patent No. 7,274,933 (“the ’933 patent”) (Ex. 1001) and that the Patent Owner, 3G Licensing S.A., has filed a revised motion to amend claims 1–10 of the ’933 patent. I have been asked to offer opinions regarding the patentability of the proposed substitute claims 20 through 29.

2. I am not, and never have been, an employee of Petitioner in this IPR. I received no compensation for this Declaration beyond my normal hourly compensation based on my time actually spent on the assignment described above, and I will not receive any added compensation based on the outcome of any IPR or other proceeding involving the ’933 patent.

3. My qualifications and experience to provide the opinions in this Declaration were previously provided in the first declaration I prepared in support of the Petition in this IPR, and are incorporated by reference here.

4. My understandings of the legal principles as outlined in the first declaration that I prepared in support of the Petition in this IPR have not changed, and are incorporated by reference here.

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.