

Patent Owner's Reply to Petitioner's Opposition to Revised Motion to Amend

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL, INC.,

Petitioner

v.

3G LICENSING S.A.,

Patent Owner

Case IPR2020-1157
Patent No. 7,274,933

**PATENT OWNER'S REPLY TO PETITIONER'S
OPPOSITION TO REVISED MOTION TO AMEND**

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Patent Trial and Appeal Board
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TABLE OF CONTENTS

- I. INTRODUCTION1
- II. THE PROPOSED AMENDMENTS ARE APPROPRIATE1
 - A. The Specification Provides Sufficient Support for Testing1
 - B. The Specification Provides Sufficient Written Support for the Timing Limitations3
- III. THE PROPOSED AMENDMENTS DO NOT RENDER CLAIMS INDEFINITE7
- IV. THE PROPOSED SUBSTITUTE CLAIMS ARE NOT OBVIOUS9
 - A. Elements 20[b] and 25[c] Are not Obvious in Light of McElwain.....9
 - B. Elements 20[c] and 25[d] from Limitations (2a) and (2b) Are not Obvious in Light of McElwain.....10
 - C. Elements 20[d] and 25[e] Are not Obvious in Light of McElwain.....12
 - D. Petitioner Has Failed to Demonstrate a Motivation to Combine McElwain and/or Uchida with Hicks and the 3GPP Standards12
- V. CONCLUSION.....12

TABLE OF AUTHORITIES

Page(s)

Cases

Arendi S.A.R.L. v. Apple Inc.,
832 F.3d 1355 (Fed. Cir. 2016)10

Belden Inc. v. Berk-Tek LLC,
805 F.3d 1064 (Fed. Cir. 2015)12

In re Giannelli,
739 F.3d 1375 (Fed. Cir. 2014).....12

Markman v. Westview Instruments, Inc.,
52 F.3d 967 (Fed. Cir. 1995)6

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005)6

Synchronoss Techs., Inc. v. Dropbox Inc.,
389 F. Supp. 3d 703 (N.D. Cal. 2019).....8

Verify Smart Corp. v. Askeladden, L.L.C.,
824 F. App’x 1015 (Fed. Cir. 2020).....6

Virtual Sols., LLC v. Microsoft Corp.,
925 F. Supp. 2d 550 (S.D.N.Y. 2013)8

Statutes

35 U.S.C. § 316.....1

Regulations

37 C.F.R. § 42.1211

TABLE OF EXHIBITS

Exhibit	Description
2001	Declaration of Stu Lipoff in Support of Patent Owner
2002	Affidavit of Stephanie Berger
2003	Affidavit of Neil Benchell
2004	Affidavit of Andrew DeMarco
2005	Second Declaration of Stu Lipoff in Support of Patent Owner
2006	3rd Generation Partnership Project; Technical Specification Group Core Network; NAS Functions related to Mobile Station (MS) in idle mode (Release 7) (3GPP TS 23.122 V7.0.0) ("TS 23.122 V7.0.0")
2007	3rd Generation Partnership Project; Universal Mobile Telecommunications (UMTS); Characteristics of the USIM application (Release 6) (3GPP TS 31.102 V6.8.0) ("TS-31.102 V6.8.0")
2008	<i>"The North American Official Cellular User's Guide" Available to Help Cellular Telephone Users, Business Wire, December 18, 1990</i>
2009	Amy Zuckerman, <i>Those Black Holes in Your Mobile Phone Service</i> , New York Times, December 24, 2000
2010	Nancy Gohring, <i>Falling Short of Replacement: Wireless Carrier Plans Compete with Landline but Don't Cut it Out of the Equation</i> , Telephony, April 27, 2008
2011	Judy Strausbaugh, <i>Oh, Give me a Cell Phone Where the Signals Won't Roam</i> , Sunday News (Lancaster, PA), May 19, 2002
2012	Settlement Agreement dated August 4, 2021
2013	Third Declaration of Stu Lipoff in Support of Patent Owner
2014	Fourth Declaration of Stu Lipoff in Support of Patent Owner

I. INTRODUCTION

Contrary to Petitioner's contention, the proposed substitute claims 20 through 29 in Patent Owner's Revised Motion to Amend (the "Revised Motion") are patentable. (*See generally* Paper 37.) All of the amendments respond to Petitioner's grounds of unpatentability, none of the amendments seeks to enlarge the scope of the claims or to introduce new subject matter, and the original disclosure of the patent fully supports the requested changes in each substitute claim. *See* 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2). Further, the amendments sought in the Revised Motion reflect the Board's Preliminary Guidance. (*See generally* Paper 34.)

Petitioner's arguments in opposition to the Revised Motion rely on misrepresentations of the record, the law, and the Board's Preliminary Guidance. Thus, Petitioner has not met its burden to show that the revised proposed substitute claims are unpatentable. For these reasons and those detailed below, the Revised Motion should be granted.

II. THE PROPOSED AMENDMENTS ARE APPROPRIATE

A. The Specification Provides Sufficient Support for Testing

The Board's Preliminary Guidance found that:

[the original substitute claims 20 and 21] recite the possibility that the HPLMN list is stored in *neither* the SIM nor the mobile station memory, such that the steps of claim 1 are not performed, which is a possibility that is not described in the cited portions of the written description.

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