

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

NORTHSTAR SYSTEMS LLC,
Patent Owner.

Case IPR2023-01190
Patent No. 6,898,432

**PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

On November 15, 2023, the Board authorized Petitioner to submit a two-page reply to (1) submit its *Sotera* stipulation and address and (2) address Patent Owner's claim construction of "wireless communications options." Ex-3001.

I. PETITIONERS' *SOTERA* STIPULATION REMOVES OVERLAP

Patent Owner concedes Petitioner's *Sotera* stipulation moots Patent Owner's *Fintiv* arguments. Petitioner submits its stipulation herewith. Ex-1012; Ex-3001.

II. THE BOARD SHOULD REJECT PATENT OWNER'S NEW, INCORRECT CLAIM CONSTRUCTION ARGUMENTS

Patent Owner does not raise an affirmative construction of "plurality of wireless communications options," only alleging it cannot be frequency hopping and base station hopping. Prelim. Reply at 6. Patent Owner refers, without specific citation, to the prosecution history as limiting this term. But the prosecution history tells a different story. There, the Examiner rejected Applicant's arguments that "wireless communications options" should be construed narrowly. Indeed, in the final office action, the Examiner rejected the claims because the claimed "wireless communication options" were disclosed by five distinct disclosures by the Liu reference. Ex-1002 at 299. In the RCE non-final office action, the Examiner allowed some claims exclusively directed to certain steps of updating information but continued to reject the Applicant's construction. *Id.* at 336-38, 344; *see id.* 315-18. Nevertheless, the Applicant continued to argue that wireless communication options do not equate to "handing off." *Id.* at 359-61, n. 1. Despite this, in a RCE

final office action, the Examiner maintained the rejections, stating that

“suitable/preferred communication links/options to a user . . . read[] on the claim.”

Id. at 371. In an after-final amendment, the Applicant added the allowed subject matter into independent claims, but those claims remained otherwise rejected as obvious over grounds based on Liu including over Liu’s “wireless communication options.” *Id.* at 382-390. Thereafter, the Applicant made no further argument about the construction of “wireless communication options.” *Id.* at 391. Thus, this record establishes that the Applicant was unsuccessful in construing the term “wireless communication options.” Patent Owner’s argument to the contrary is untrue.

The patent itself confirms the term “wireless communications options” should be construed broadly: “By wireless communication options, it is meant the various wireless communication networks available, discussed below, the various levels of service that each type of wireless communication network has available (i.e. transmission power level), as well as any other option that may now be available or will be available in the future for wireless communication.” ’ 432 patent, 1:45-51 (emphasis added). This broad statement is consistent with the plain and ordinary meaning of the term and the Examiner’s understanding.

Date: November 21, 2023

Respectfully Submitted,

/Kara A. Specht/

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Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Petitioner's Reply to Patent Owner's Preliminary Response** was served electronically via email on November 21, 2023, in its entirety on the following:

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Patent Owner has consented to service by email.

Date: November 21, 2023

By: /Lisa C. Hines/
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