

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.

Patent No. 6,898,432

Filing Date: November 21, 2000

Issue Date: May 24, 2005

Inventor: Xi Jiang

Title: ROUTE-BASED COMMUNICATION PLANNING ARCHITECTURE
AND METHOD FOR WIRELESS COMMUNICATION

PATENT OWNER'S SUR-REPLY

Case No. IPR2023-01190

On November 15, 2023, the Board authorized Patent Owner to submit a two-page reply to address Petitioner's arguments regarding the alleged "unforeseeable" claim construction dispute regarding the claimed wireless communication options. Ex-3001. Nothing in Petitioner's Reply identifies any unforeseeable arguments, instead, Petitioner's Reply analyzes the file history and specification *for the first time*. This discussion should have been in the Petition itself, and Petitioner's failure should be fatal—the Board should exercise its broad discretion to disregard Petitioner's supplemental arguments and to deny the Petition in its entirety.

Additionally, Petitioner's arguments are incorrect because they fail to consider the entire prosecution history, which is required under *Philips*. Petitioner now, for the first time, acknowledges that the file history sets forth an explicit definition of "wireless communications options"—a definition that Petitioner did not consider in the Petition. Petitioner attempts to disregard that definition by alleging "acquiescence." However, Petitioner also ignores that the applicant set forth an explicit definition in response to a 35 U.S.C. § 112 rejection and that the rejection was overcome in light of applicant's arguments. In response to the rejection, the Applicant stated: "[T]he Applicant at page 2 provides an express statement regarding what he means by this term: 'By wireless communication options, it is meant the various wireless communication networks available, ...' Application at 2:9-13. The Applicant provided specific examples: regional area wireless networks 10, wide area

networks 12, metropolitan area networks 14, and local area networks 16. Application at 3:19-21; see also Figure 1.” Ex. 1002 at 293. This definition overcame the 112 rejections. *Id.* at 299. Accordingly, Petitioner’s reliance on the RCE is incorrect.

Furthermore, even if the RCE amendment were relevant, the applicant did not acquiesce to the examiner’s definitions or characterizations, and the 8/13/2004 and 12/16/2004 amendments did not surrender prior arguments regarding the meaning of “wireless communication options.” Indeed, the Applicant maintained this position throughout prosecution including in an RCE where it stated: “As discussed above, to the extent Liu suggests conventional switching between cells of the same communications option, this is not a suggestion of switching between different communications options.” *Id.* at 363. The examiner then responded that Liu taught different *classes of service* (which is irrelevant to Petitioner’s arguments). *Id.* at 371. Finally, the Petitioner ignores the fact that claim construction arguments made during prosecution are considered under the Broadest Reasonable Interpretation standard, and not the *Philips* standard, which is applied in IPR. Under the *Philips* standard, one of ordinary skill in the art would understand that wireless communications options do not include the frequency-hopping of the Oh reference (Ex. 1005) and that the Petition should be denied.

Respectfully submitted,

Dated: November 27, 2023

By: /Vincent J. Rubino, III /

IPR2023-01190
PATENT NO. 8,898,432

Vincent J. Rubino, III (Reg. No. 68,594)
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796
Email: vrubino@fabricantllp.com

CERTIFICATE OF SERVICE

A copy of the foregoing Patent Owner's Sur-Reply has been served on

Petitioner's counsel of record as follows:

Lionel M. Lavenue
Email: lionel.lavenue@finnegan.com
Email: BMW-NorthStar-IPRs@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP**
1875 Explorer Street, Suite 800
Reston, VA 20190-6023

Kara A. Specht
Email: kara.specht@finnegan.com
R. Maxwell Mauldin
Email: r.maxwell.mauldin@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP**
271 17th Street, NW, Suite 1400
Atlanta, GA 30363-6209

Safiya Aguilar
Email: safiya.aguilar@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT, & DUNNER LLP**
901 New York Avenue, NW
Washington, D.C. 20001-4413
Attorneys for BMW of North America, LLC

November 27, 2023

By: /Vincent J Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797

IPR2023-01190
PATENT NO. 8,898,432

Fax. 212-257-5796