Trials@uspto.gov
571-272-7822

Paper 9
Entered: April 17, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., MICROSOFT CORPORATION,
MICROSOFT MOBILE OY, and MICROSOFT MOBILE INC.,
Petitioner,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2016-01185
Patent 7,809,373 B2

Before WILLIAM V. SAINDON, CHRISTOPHER L. CRUMBLEY, and PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. § 42.71(d)

Petitioner requests rehearing of our Decision (Paper 7, "Institution Decision" or "Dec.") denying institution of an *inter partes* review of U.S. Patent No. 7,809,373 B2 (Ex. 1001, "the '373 patent"), contending that "the Decision misapprehends or overlooks the Petition's application of the prior art to the language of independent claims 15 and 24." Paper 8 ("Req. Reh'g"), 1. When rehearing a decision by the Board on whether to institute a trial, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The burden of showing that our Institution Decision should be modified lies with Petitioner, the party challenging the decision. *See* 37 C.F.R. § 42.71(d). In addition, "[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." *Id.*

Petitioner requests rehearing on the following bases: (1) "the Decision does not address the portion of Son's teaching cited in the Petition as disclosing [the *dedicated preamble*] limitation," Req. Reh'g, 1; (2) the Decision "incorrectly assumes that Etemad teaches only the use of a physical ranging channel, not a ranging code," *id.* at 2; (3) "[t]he Decision also misapprehends or overlooks a critical statement and two pieces of supporting evidence establishing that a [person of ordinary skill in the art] would have understood the combination of Etemad and Son to teach the

dedicated preamble limitation," *id.* at 3; and (4) Patent Owner mischaracterizes Son in its Preliminary Response in a way that may "have influenced the Decision and perhaps led to its misapprehension or oversight with respect to the disclosures of Etemad and Son, and Petitioner's argument regarding the obviousness of the 'dedicated preamble' limitation in light of the combination of Etemad and Son," *id.* at 4. In light of these assertions, we have again reviewed the record, particularly the Petition (Paper 2, "Pet.") and supporting evidence, as well as the Preliminary Response (Paper 6, "Prelim. Resp."). Our conclusion that the Petition does not demonstrate a reasonable likelihood of prevailing on any of the challenges set forth is unchanged.

First, Petitioner relies heavily in its Rehearing Request on the Petition's citation of column 17, lines 45–50 of Son. *Id.* at 6 (citing Pet. 36, 37, 38, 39, 41, 42, 43, 44, 45, 46, 52, 54, 58, 59). The relevant portion of Son states:

> When the second neighbor base station 630 receives the HO_notification_confirm message, the second neighbor base station 630 may assign a frequency band or/and a ranging code to the MSS 600 to enable the MSS 600 to transmit the RNG_REQ message through an UL_MAP message for a predetermined period of time so that the MSS 600 can perform a fast handover to the second neighbor base station 630. Assigning a frequency band or/and a ranging code so that the MSS 600 can transmit the RNG_REQ message is defined as assigning 'Fast Ranging_IE'.

Ex. 1006, col. 17, ll. 41–50. The Petition relies on this disclosure to contend that a person of ordinary skill in the art "would understand that the assigned ranging code . . . is a dedicated preamble used only for a specific terminal." Pet. 45–46.

But this contention, set forth in the Petition, is too conclusory to satisfy Petitioner's burden. In particular, we agree with Patent Owner that "[t]his disclosure makes no reference to or explanation of a dedicated preamble, and Son provides no detail on how the code is assigned or how it is used by the terminal." Prelim. Resp. 18. Although the Petition cites to testimony by Petitioner's expert, Jonathan Wells, Ph.D., to support its contention, the cited portion of the expert testimony merely repeats the contention without adequate elaboration or explanation and is, therefore, similarly conclusory. Ex. 1003 ¶ 99; *see* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight"). Nor is the Petition's additional citation of portions of U.S. Pat. Publ. No. 2005/0041573 ("Eom") sufficient to support its contention. The Petition does not adequately explain how the cited portions of Eom—which are not applied directly in any ground asserted by Petitioner—inform an understanding of Son's disclosure to reach the conclusion Petitioner advocates.

We disagree with Petitioner's characterization in the Rehearing Request that "this argument and the supporting evidence stand uncontroverted." Req. Reh'g 9. Indeed, Patent Owner addresses the argument at length in its Preliminary Response by comparing the limited disclosure of Son with the more detailed disclosure of Koo (considered by the Examiner during prosecution). Prelim. Resp. 13–19. Guided by the statutory authorization of 35 U.S.C. § 325(d) to take into account that "substantially the same prior art" was previously presented to the office, we have reviewed Patent Owner's rebuttal analysis in light of the Examiner's

prior consideration of Koo and find it sufficiently persuasive to establish that the Petition makes an inadequate showing. *See* Dec. 16–17.

In particular, Petitioner contends in its Rehearing Request that Patent Owner improperly focuses on the background section of Son and that the portions of Son relied on by Petitioner are not substantially similar to disclosures by Koo that were distinguished during prosecution. Req. Reh'g 9–12, 12–14. We are not persuaded by such contentions. Patent Owner accurately characterizes Koo and Son as relating to the WiMax protocol, with Koo providing more explanation of the assignment of ranging codes according to different types of ranging. Req. Reh'g 9–12; Prelim. Resp. 13–19. The Examiner's consideration of Koo during prosecution of the '373 patent is relevant, and, as explained above, the limited disclosure of Son identified by Petitioner is insufficient to support Petitioner's conclusion because it provides insufficient detail on how the code is assigned or how it is used by the terminal.

Second, and more significant, even if Son, in isolation, disclosed a "dedicated preamble," the Petition insufficiently articulates a compelling argument that the combined disclosures of Son and Etemad meet the specific combination of limitations recited in the challenged claims. In its argument, the Petition contends that the combination of Etemad and Son "teaches that the target base station '<u>assigns</u> . . . a ranging code' to the mobile station for use during the handover" and that "[t]he mobile station uses this assigned ranging code to perform a 'contention-free' initial ranging procedure with the target base station." Pet. 45 (citing Ex. 1005, col. 5, ll. 43–46, Fig. 2) (alterations by Petitioner). The portion of Etemad cited by the Petition to support this contention is:

> Moreover, the mobile station transmits a message to the target base station on a reserved and contention-free ranging channel allowing the target base station to perform initial ranging.

Ex. 1005, col. 5, ll. 43–46.

As determined in the Institution Decision, the Petition's reliance on this disclosure does not sufficiently support its contention that "[i]n order for 'contention free' ranging to be performed, two mobile stations cannot transmit the same ranging code at the same time," nor its conclusion that, "[a]ccordingly, in a contention free ranging procedure, only one mobile station is allowed to send the ranging code during a particular time." Dec. 15; Pet. 46 (citing Ex. 1003 ¶ 108; Ex. 1018 ¶¶ 98, 105, 129). As indicated expressly in the cited passage of Etemad, it is also possible for contention-free ranging to be achieved through channel reservation rather than with a dedicated preamble. "Notably, this is different from the problem addressed by the '373 patent, which seeks to avoid collisions when two mobile terminals simultaneously attempt to use the *same* random access channel to effect handovers." Dec. 16 (citing Ex. 1001, col. 4, l. 66–col. 5, l. 7).

In its Rehearing Request, Petitioner contends that the Institution Decision "incorrectly assumes that Etemad teaches only the use of a physical ranging channel, not a ranging code." Req. Reh'g 2. The Rehearing Request observes that "[t]o the contrary, Etemad expressly teaches that '[t]he reserved ranging channel can be a physical channel <u>or a logical channel defined by a code</u>.'" *Id.* (citing Ex. 1005, col. 3, ll. 13–14). But Petitioner did not make this argument in its Petition when addressing the combination of Etemad and Son as related to the limitation in independent claims 15 and 24 that "the preamble information is a dedicated preamble

used only for a specific terminal." Although the Rehearing Request observes that the disclosure now relied on by Petitioner is cited at page 54 of the Petition, that citation is presented in the context of addressing the limitation of dependent claim 20. The bare citation is too divorced from the argument Petitioner now wishes to rely on it for, and its context and relevance to that argument are not explained in the Petition.

Fundamentally, the Petition remains deficient because it fails to articulate sufficient rational underpinning to support its obviousness argument over Etemad and Son, even under the "reasonable likelihood" standard applicable at this stage. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). The argument presented in the Petition for the limitation that "the preamble information is a dedicated preamble used only for a specific terminal," recited in independent claims 15 and 24, is insufficiently supported by the cited portions of the prior art and relies on a conclusory non sequitur.

Accordingly, we deny the Rehearing Request.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *denied*.

PETITIONER

W. Karl Renner
Roberto Devoto
Daniel Smith
FISH & RICHARDSON P.C.
IPR00035-0008IP1@fr.com
PTABInbound@fr.com

PATENT OWNER

Ryan M. Schultz
Cyrus Morton
ROBINS KAPLAN LLP
cmorton@robinskaplan.com
rschultz@robinskaplan.com