

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCT MOBILE, INC. AND TCT MOBILE (US) INC.,
Petitioners,

v.

WIRELESS PROTOCOL INNOVATIONS, INC.,
Patent Owner.

Case IPR2016-01492
Patent 6,381,211 C1

Before KEVIN F. TURNER, MITCHELL G. WEATHERLY, and
KAMRAN JIVANI, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION

Granting-in-Part and Denying-in-Part Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

A. BACKGROUND

TCT Mobile, Inc. and TCT Mobile (US) Inc. (collectively “TCT”) filed a petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 11, 13–15, 19–24, and 26–28 (the “challenged claims”) of U.S. Patent

No. 6,381,211 C1 (Ex. 1001, “the ’211 patent”).¹ 35 U.S.C. § 311. TCT supported the Petition with evidence including the Declaration of Mark R. Lanning (Ex. 1008). Wireless Protocol Innovations, Inc. (“WPI”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). WPI supported its Preliminary Response with evidence including the Declaration of Gary Lomp, Ph.D. (Ex. 2001). We instituted review on all challenges to all claims. Paper 7, 14–15 (“Dec.” or “Institution Decision”).

WPI timely filed a Request for Rehearing in which it asks that we reconsider and withdraw aspects of our Institution Decision. Paper 9 (“Reh’g Req.” or “Request for Rehearing”). For the reasons expressed below, the Request for Rehearing is granted-in-part and denied-in-part. Additionally, *inter partes* review shall continue on all grounds challenging all claims addressed in the Petition.

B. STANDARD FOR RECONSIDERATION

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined 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 Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). The party challenging the decision has the burden of showing a decision should be modified, and the request for rehearing must specifically

¹ When citing portions of the Reexamination Certificate we will signal such citations by designating them with “C1” preceding the column and line numbers. When citing original material in the ’211 patent, we will not use the “C1” designation.

identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed in its papers. 37 C.F.R. § 42.71(d).

II. ANALYSIS

WPI asks that we alter our Institution Decision in two respects. First, WPI asks that we deny institution on TCT's challenges to claims 13–15 as anticipated by Eizenhöfer or Miller. *See* Reh'g Req. 2–5 (identifying prior argument at pages 23–27 of Preliminary Response). Second, WPI asks that we exercise our discretion under 35 U.S.C. § 325(d) and deny institution regarding TCT's challenge that Miller anticipates claims 11, 13–15, 19–24, and 26–28. *See id.* at 6–8 (identifying prior argument at pages 29–30 of Preliminary Response). We address each argument below.

A. ALLEGED MISAPPREHENSION OF ARGUMENTS REGARDING CLAIMS 13–15

WPI contends that it previously argued that Eizenhöfer failed to describe limitations introduced in each of claims 13–15 and that Miller failed to describe limitations introduced in claim 13. *See id.* at 2–5 (identifying prior argument at pages 23–27 of Preliminary Response). Because we did not expressly address these arguments in the Institution Decision, we grant-in-part the Request for Rehearing and address them now.

Each of claims 13–15 depends directly from claim 11 and refines the manner in which the time slot is allocated. Ex. 1001, C1, 1:47–54. For reasons expressed below, we remain persuaded that TCT has demonstrated a reasonable likelihood of establishing that Eizenhöfer anticipates claims 13–15 and Miller anticipates claim 13.

1. *Eizenhöfer*

a) Claim 13: “allocated based on subscriber terminal demand”

Claim 13 depends directly from claim 11 and further recites that the time slot is “allocated based on subscriber terminal demand.” *Id.* at C1, 1:47–49. In the Preliminary Response, WPI contends that Eizenhöfer fails to describe a reception controller configured so that time slots are “allocated based on subscriber terminal demand.” Prelim. Resp. 23–24. WPI contends that “subscriber terminal demand” is a “well-understood term of art in the field of communications systems” that refers to “an aggregate need for communication resources” by the entire group of subscriber terminals that are communicating with a central terminal. *Id.* WPI contends that Eizenhöfer discloses assigning “time slots without consideration for any aggregate need for communication resources” and relies solely upon Dr. Lomp’s testimony to support its contention. *Id.* at 24 (citing Ex. 2001 ¶¶ 59–61).

WPI also explicitly argues for its proffered meaning of “subscriber terminal demand” in a single sentence supported by citations to portions of the Specification and testimony from Dr. Lomp. *Id.* at 15–16 (citing Ex. 1001, 7:8–11, 18:50–54, 19:1–4, Figure 15A; Ex. 2001 ¶¶ 7, 16, 19–21). Based on our review of the cited portions of the Specification, it is not apparent how those sections support WPI’s proffered meaning of “subscriber terminal demand.” None of the cited portions explicitly defines “subscriber terminal demand” or uses the term, and WPI does not explain why those cited portions are relevant to the inquiry. The cited testimony from Dr. Lomp reflects his opinion but is not supported by any citations to other evidence, including the Specification itself. To the extent that WPI’s

argument regarding the meaning of “subscriber terminal demand” relies upon Dr. Lomp’s testimony, we currently find that argument unpersuasive because it is unsupported by other evidence.

TCT has not expressly argued the meaning of “subscriber terminal demand” but instead implies a meaning by identifying specific portions of Eizenhöfer that allegedly teach this limitation. Pet. 31–32 (citing Ex. 1004, 3:7–10, Abstract). Absent briefing with citations to relevant evidence, we decline to offer our own express interpretation of “subscriber terminal demand.” Rather, we determine that TCT’s implied interpretation and its argument based on that interpretation demonstrates a reasonable likelihood of establishing that Eizenhöfer describes the recited limitation. Because resolution of the dispute may require an express interpretation of “subscriber terminal demand,” we also direct the parties to address explicitly the meaning of this phrase at trial and cite relevant evidence from among at least other claims, the Specification, and the prosecution history.

b) Claim 14: “flexibly allocated”

Claim 14 depends directly from claim 11 and further recites that the time slot is “flexibly allocated as part of the predetermined frame period.” Ex. 1001, C1, 1:50–52. In the Preliminary Response, WPI contends that Eizenhöfer fails to describe time slots that are “flexibly allocated” because this phrase requires allocation in a manner that “permits variation over time” and “Eizenhöfer expressly forbids any variation in successive frames.” Prelim. Resp. 24–26 (citing Ex. 1004, 10:3–5; Ex. 2001 ¶¶ 60, 61). WPI does not explain the meaning of “permits variation over time” or why Eizenhöfer, which can change the allocation of bandwidth during at least some time period, fails to meet this alleged requirement. Additionally, WPI

explicitly argues for its proffered meaning of “flexibly allocated” in a single sentence supported solely by testimony from Dr. Lomp, *id.* at 16 (citing Ex. 2001 ¶ 22), who fails to cite any evidence to support his conclusion about the meaning of “flexibly allocated,” *see* Ex. 2001 ¶ 22 (failing to cite evidence). WPI’s argument regarding the meaning of “flexibly allocated” is unpersuasive because it is currently unsupported by evidence.

TCT has not argued an express interpretation of “flexibly allocated” but instead implies an interpretation by identifying specific portions of Eizenhöfer that allegedly teach this limitation. Pet. 32–33 (incorporating argument citing Ex. 1004, 3:7–10, Abstract). Absent briefing with citations to relevant evidence, we decline to offer our own express interpretation of this phrase. Rather, we determine that TCT’s implied interpretation and its argument based on that interpretation demonstrates a reasonable likelihood of establishing that Eizenhöfer describes the recited limitation. Because resolution of the dispute may require an express interpretation of “flexibly allocated,” we also direct the parties to address explicitly the meaning of this phrase at trial and cite relevant evidence from among at least other claims, the Specification, and the prosecution history.

c) Claim 15: “allocated based on the data item”

Claim 15 depends directly from claim 11 and further recites that the time slot is “allocated based on the data item.” Ex. 1001, C1, 1:53–54. In the Preliminary Response, WPI argues that Eizenhöfer fails to describe this requirement for the same reasons identified in connection with the requirement in claim 11 that “the predetermined time slot is allocated based on a type of data of the data item.” *Compare* Prelim. Resp. 19–22 (arguing for patentability of claim 11), *with id.* at 26–27 (arguing for patentability of

claim 15). TCT does much the same when it argues that “[a]llocation based on a type of data of the data item is one form of allocation based on the data item.” Pet. 33. Neither party expressly identifies any difference in scope between the two limitations. For the reasons expressed in Section II.B.1 of the Institution Decision, we determine that TCT demonstrates a reasonable likelihood of establishing that Eizenhöfer describes the recited limitation. We also instruct the parties to submit briefing and evidence relating to their respective interpretations of “allocated based on the data item” and the extent to which this phrase differs from “allocated based on a type of data of the data item” as recited in claim 11.

d) Conclusion

We grant-in-part WPI’s Request for Rehearing as it relates to the challenge that Eizenhöfer anticipates claims 13–15 for two reasons. First, we further explain as set forth above why we are persuaded that TCT has demonstrated a reasonable likelihood of establishing that Eizenhöfer anticipates claims 13–15. Second, we instruct the parties to brief the claim interpretation issues described above in the manner set forth in Section IV below.

2. *Miller*

WPI contends that we misapprehended and overlooked its argument that Miller fails to anticipate claim 13 because Miller fails to describe allocating the time slot “based on subscriber terminal demand.” Reh’g Req. 3–4. In the Preliminary Response, WPI distinguished Miller from claim 13 based on its proffered interpretation of “subscriber terminal demand.” Prelim. Resp. 36. WPI also argued that “[a]t best, Miller discloses allocating single or multiple time slots according to the

requirements of the traffic of a particular subscriber. Each subscriber is assigned time slots without consideration for any need of any other subscriber.” *Id.* TCT implies a meaning of “based on subscriber terminal demand” by identifying specific portions of Miller that allegedly teach this limitation. Pet. 51–52 (citing Ex. 1005, 5:10–15, 13:30–35). Absent briefing with citations to relevant evidence, we decline to offer our own express interpretation of “allocated based on subscriber terminal demand.” Rather, we determine that TCT’s implied interpretation and its argument based on that interpretation demonstrates a reasonable likelihood of establishing that Miller describes the recited limitation. We also reiterate our instruction to the parties that they submit briefing and evidence regarding the meaning of “allocated based on subscriber terminal demand.”

B. ALLEGED VIOLATION OF DUE PROCESS

WPI argues that we “violated Patent Owner’s right to due process by instituting the *Inter Partes* Review on claims 13–15 without performing a claim-by-claim analysis of claims 13–15.” Reh’g Req. 4–5. WPI contends that the Institution Decision deprived it of “notice and an opportunity to be heard.” *Id.* Because we have granted-in-part the Request for Rehearing to explain further the reasons for instituting *inter partes* review of claims 13–15 and to provide WPI with an opportunity to be heard at trial on the merits of the challenges to these claims, WPI’s argument that due process requires a claim-by-claim analysis at this stage of the proceeding is moot.

C. ALLEGED ERROR IN NOT EXERCISING DISCRETION TO DENY *INTER PARTES* REVIEW UNDER 35 U.S.C. § 325(D)

We rejected WPI’s argument that we should exercise discretion under 35 U.S.C. § 325(d) and not institute an *inter partes* review of claims 11, 13–15, 19–24, and 26–28 as being anticipated by Miller. Dec. 10–11. WPI

contends that we “overlooked the claim comparison provided on pages 2 and 29–30” of the Preliminary Response. Reh’g Req. 6–8. WPI further argues that “the Board’s decision to not exercise its discretion . . . is unreasonable.” *Id.* at 6.

We deny WPI’s Request for Rehearing on this issue for at least three reasons. First, WPI has failed, as required under Rule 42.71(c), to identify an abuse of discretion stemming from our allegedly “unreasonable” failure to exercise discretion under § 325(d) and deny institution of challenges based on Miller.

Second, WPI merely reiterates an argument already considered and rejected, and thus fails to meet its obligation under Rule 42.71(d) to “identify all matters . . . misapprehended or overlooked.” We disagree that WPI offered a “clear comparison” of the entirety of the claims that were allegedly previously considered by the Office during reexamination of the ’326 patent to the claims at issue in this proceeding. Describing claims in the ’326 patent as “closely related” or reciting “similar features” without providing the actual text of those claims fails to provide an adequate basis for comparing those claims to the claims at issue in this proceeding. The paraphrased comparison of claims in the ’326 patent to the claims here is similarly lacking in clarity.

Third, even if we were to determine that WPI sufficiently compared the “orthogonal code generator” recited in claims of the ’326 patent to the one recited in the claims at issue, such a comparison fails to demonstrate enough similarity in the claims overall to justify a discretionary denial of TCT’s challenge based on Miller.

III. SUMMARY

As explained above, the Request for Rehearing is granted-in-part and denied-in-part.

IV. ORDER

It is:

ORDERED that WPI's Request for Rehearing is *granted* to the extent that we provide additional reasons why we instituted an *inter partes* review on the grounds that each of Eizenhöfer and Miller anticipate claims 13–15;

FURTHER ORDERED that WPI's Request for Rehearing is *granted* to the extent necessary to require that both parties shall:

(a) expressly address in their papers filed at trial the meaning of the following phrases recited in various claims:

(1) allocated “based on subscriber terminal demand” as recited in claim 13;

(2) “flexibly allocated” as recited in claim 14; and

(3) “allocated based on the data item” as recited in claim 15;

and

(b) cite any relevant evidence that supports their respective positions including at least evidence found in other claims, the Specification, and the prosecution history of the '211 patent;

FURTHER ORDERED that WPI shall address the claim interpretation issues described immediately above in its Patent Owner Response, and TCT shall address these issues in its Reply in Support of the Petition; and

FURTHER ORDERED that WPI's Request for Rehearing is *denied* in all other respects.

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