

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

HERA WIRELESS S.A.,
Patent Owner.

Case IPR2018-01686
Patent 8,737,377 B2

Before THOMAS L. GIANNETTI, ROBERT L. KINDER, and
JACQUELINE T. HARLOW, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision Denying Institution
37 C.F.R. § 42.71(d)

Petitioner, Intel Corporation requests rehearing of our Decision (Paper 8) (“Decision”) declining to institute *inter partes* review of claims 1–6 of U.S. Patent No. 8,737,377 B2 (Ex. 1001, “the ’377 patent”) as obvious over the combination of Hansen¹ and Maltsev,² and the combination of TGn-Sync³ and Maltsev. Paper 9 (“Rehearing Request” or “Req. Reh’g”). For the reasons that follow, Petitioner’s Rehearing Request is *denied*.

ANALYSIS

Pursuant to 37 C.F.R. § 42.71(d):

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion exists where a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988).

¹ Hansen, US 8,737,189 B2, issued May 27, 2014 (Ex. 1014).

² Maltsev, US 2004/0120428 A1, published June 24, 2004 (Ex. 1007).

³ IEEE 802.11-04/889r1, *TGn-Sync Proposal Technical Specification* (Nov. 4, 2004) (Ex. 1005).

Petitioner contends that our Decision misapplied the obviousness standard, failed to view disputed evidence in the light most favorable to Petitioner, and misapprehended Petitioner's evidentiary arguments. Req. Reh'g 1–15. For the reasons stated below, we do not agree that we misapprehended or overlooked matters raised in the Petition in our Decision, and, therefore, *deny* Petitioner's Rehearing Request.

Petitioner first argues that we adopted an “overly narrow” standard for obviousness. Req. Reh'g, 3–7. Specifically, Petitioner asserts that we “overlooked the broad obviousness standard described in *KSR* and gave short shrift to Intel's arguments about predictable variations of the prior art and supporting expert testimony based on a skilled person's knowledge, creativity, and common sense.” *Id.* at 7 (citing *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007)).

We disagree that *KSR* was “overlooked.” Contrary to Petitioner's contention, rather than ignoring or misapprehending the obviousness standard set forth in *KSR*, the Decision discusses *KSR* throughout as a basis for our determination that Petitioner had failed to demonstrate a reasonable likelihood of prevailing on its obviousness challenge. *See, e.g.*, Dec. 11, 24, 25, 28. Indeed, the Decision properly applies *KSR*, including its instruction that the factfinder should be mindful “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning,” *KSR*, 550 U.S. at 421, in finding that the Petition relies improperly on hindsight in its obviousness arguments. Dec. 24–25, 28. Petitioner's argument that *KSR* was “overlooked” is merely an attempt to reargue its case, which is not a proper ground for rehearing.

Furthermore, the Decision (Dec. 18–28), does not overlook the purported evidence that the claimed invention was one of two obvious design choices, or that Petitioner’s proposed combinations are merely predictable variations of the prior art (Req. Reh’g 5–8). Rather, the Decision does not find those arguments persuasive, explaining that

the proposed combination of Hansen and Maltsev manifests hindsight reasoning, as it would abandon the *receiver-based channel estimation* techniques essential to Maltsev in favor of an incompatible *transmitter-based threshold control* system that mirrors the disclosures of the challenged patent, but is neither suggested by the prior art, nor supported by the background knowledge possessed by a person having ordinary skill in the art.

Id. at 19; *see also id.* at 27–28 (explaining that the same reasoning applies to the combination of TGn-Sync and Maltsev). More particularly, the Decision finds that

Petitioner discounts the core disclosures of Maltsev, and argues instead that an ordinarily skilled artisan would have been motivated, based on the problem identified by Maltsev, to pursue an undisclosed solution wholly incompatible with the solution Maltsev proposes. In view of Maltsev’s teachings concerning the advantages of the disclosed receiver-based channel estimation system and method, and Hansen’s silence regarding smoothing, we are not persuaded by Petitioner’s argument.

Id. at 22; *see also id.* at 27–28 (explaining that the same reasoning applies to the combination of TGn-Sync and Maltsev). Petitioner’s expressed disagreement with these findings is not a proper basis for granting rehearing.

Petitioner’s contention that our Decision was predicated on a finding that Petitioner failed to establish that Maltsev could have been “bodily incorporated” into either Hansen or TGn-Sync (Req. Reh’g. 8–9) is likewise

unavailing. In framing its argument, Petitioner selectively quotes from the Decision, and ignores our determination that “[n]othing in Hansen (or Maltsev) suggests it would have been obvious to redesign Hansen’s transmitter so that it performs a CDD time-shift threshold determination, and communicates that determination to a receiver via the unused bit in HT-SIG.” Dec. 24. As the Decision goes on to explain,

[t]hus, although Petitioner is correct that there are only two possible loci for control of the receiver (Pet. 43), because Maltsev’s smoothing control cannot simply be ported into Hansen’s receiver, *and because Petitioner does not provide evidence or argument sufficient to show how (or why) smoothing control might be implemented in Hansen’s receiver*, we are not persuaded that “[b]oth approaches were obvious as known solutions to the problem of managing receiver operation” ([Pet. 43]). To the contrary, transmitter-based smoothing control is a solution disclosed by the ’377 patent, and Petitioner has not persuasively established that such smoothing control was known in the prior art.

Id. (emphasis added); *see also id.* at 27–28 (explaining that the same reasoning applies to the combination of TGn-Sync and Maltsev).

Neither do we agree with Petitioner’s assertion that “[i]n several instances,” we improperly “adopted Dr. Sharony’s factual position despite conflicting testimony from Dr. Wicker” (Req. Reh’g. 9). In deciding whether to institute, we are required by our rules to view testimonial evidence “in the light most favorable to the petitioner” only where there is a genuine issue of material fact created by the testimony. *See* 37 C.F.R. § 42.108 (c). The rule, however, does not require us to accept the testimony of any expert. The Board has broad discretion to assign weight to be accorded expert testimony. *Yorkey v. Diab*, 601 F.3d 1279, 1284 (Fed. Cir.

2010). Aside from identifying the evidence relied upon by the parties, and describing their positions regarding the level of ordinary skill in the art, our Decision does not refer to Drs. Wicker or Sharony or discuss, much less rely on, their testimony. *See* Dec. 7–9. Our determination that Petitioner failed to carry its burden to demonstrate a reasonable likelihood of establishing the unpatentability of at least one claim of the '377 patent is premised on the inadequacy of Petitioner's showing, and our finding that Petitioner's proposed obviousness combinations reflect improper hindsight bias. *See* Dec. 18–28. Moreover, acceptance of Petitioner's contention that the Board must automatically adopt the reasoning of a petitioner's expert in deciding whether to institute *inter partes* review—irrespective of the sufficiency of that testimony—would compel institution in every case where expert testimony is presented. Petitioner's argument is another instance of a disagreement with our Decision and not a proper basis for rehearing.

Finally, Petitioner argues that we “misapprehended evidence” in denying institution. *Reh'g* Req. 13. Specifically, Petitioner contends we misapprehended an argument based on an IEEE publication describing a “steering matrix.” *Id.* at 15. According to Petitioner, “a steering matrix used for beamforming at the transmitter might create a smoothing problem, which would have motivated a skilled person to use the transmitter to send a smoothing instruction to the receiver for the reasons Intel and Dr. Wicker explained.” *Id.*

We did not “misapprehend” this argument. Petitioner takes issue with our characterization—in a footnote (Dec. 26 n.4)—of a presentation by the author of TGn-Sync (Ex. 1006) that is not included in the asserted

obviousness combinations. Req. Reh’g 13–15. But our finding that neither TGn-Sync nor Hansen contemplates transmitter-based control over smoothing at the receiver (Dec. 26) turns on the disclosures of those references, not the footnote. Furthermore, even if we were to accept Petitioner’s contention that an ordinarily skilled artisan would have sought to resolve the smoothing challenges highlighted in Exhibit 1006, Petitioner’s unpatentability arguments would still fail because they are rooted in hindsight. Specifically, Petitioner’s improper reliance on hindsight is evident from the fact that the asserted grounds of unpatentability “would abandon the *receiver-based channel estimation* techniques essential to Maltsev in favor of an incompatible *transmitter-based threshold control* system” not contemplated by the cited references. *Id.* at 28.

CONCLUSION

For the reasons given, Petitioner has not demonstrated that we abused our discretion in denying institution of *inter partes* review of claims 1–6 of the ’377 patent as obvious over the combination of Hansen and Maltsev, and the combination of TGn-Sync and Maltsev. Neither has Petitioner shown that we misapprehended or overlooked matters raised in the Petition in our Decision.

In summary

Claims	35 U.S.C §	References/Basis	Denied	Granted
1–6	103	Hansen, Maltsev	1–6	
1–6	103	TGn-Sync, Maltsev	1–6	
Overall Outcome			1–6	

IPR2018-01686
Patent 8,737,377 B2

ORDER

Accordingly, it is

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

IPR2018-01686
Patent 8,737,377 B2

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