

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

CARUCEL INVESTMENTS, L.P.,
Patent Owner.

IPR2019-01404
Patent 7,979,023 B2

Before THOMAS L. GIANNETTI, DANIEL J. GALLIGAN, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request on Rehearing of Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner Carucel Investments, L.P. requests reconsideration of our Final Written Decision (Paper 38, “Final Dec.”) regarding claims 1, 4–11, and 14–23 (the “challenged claims”) of U.S. Patent No. 7,979,023 B2 (Ex. 1001, the “’023 patent”). Paper 39 (“Req. Reh’g”). Patent Owner’s grounds for seeking rehearing are that the Final Written Decision

misapprehends and overlooks (1) the proper scope of the term “mobile device” . . . ; (2) the substantial evidence set forth by Patent Owner regarding the lack of compatibility between CDMA & TDMA; and (3) under the proper construction of “mobile device” that each of Petitioner’s prior art references do not disclose the limitation of “mobile device” as required by the Challenged Claims of the ’023 Patent.”

Req. Reh’g 1 (footnote omitted).

For the reasons that follow, Patent Owner’s request for rehearing is *denied*.

II. BACKGROUND

Mercedes-Benz USA, LLC (“Petitioner”) filed a Petition requesting *inter partes* review of the challenged claims. Paper 3 (“Pet.”). Under 35 U.S.C. § 314, we instituted this *inter partes* review as to all of the challenged claims and all grounds raised in the Petition. Paper 12.

Following institution, Patent Owner filed a Response. Paper 19 (“PO Resp.”). Subsequently, Petitioner filed a Reply to Patent Owner’s Response (Paper 28), and Patent Owner filed a Sur-reply (Paper 34, “PO Sur-reply”).

In our Final Written Decision, we determined Petitioner has shown by a preponderance of the evidence that all challenged claims of the ’023 patent are unpatentable. Final Dec. 2.

III. ANALYSIS

A. Applicable Legal Standard

The standard for a request for rehearing of a Final Written Decision is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

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.

A rehearing request is not an opportunity for the requesting party to reargue its case or merely to express disagreement with the Final Written Decision. Nor is it an opportunity for the moving party to present new arguments that were not in its original submissions.

B. The Interpretation of “Mobile Device”

The Rehearing Request focuses primarily on the proper construction of “mobile device,” a term that appears in all of the challenged claims. Req. Reh’g 1. Patent Owner requests that the “plain and ordinary meaning” of the term “mobile device” be applied, which is, according to Patent Owner, “a device that must register with and be able to directly communicate with the cellular network.” PO Resp. 13; Req. Reh’g 1 n.1. Patent Owner argues that our Final Written Decision “misapprehends and overlooks the proper scope of the term ‘mobile device’ by improperly disregarding at least Patent Owner’s proposed construction of ‘mobile device’ and the ’023 Patent’s explicit support for this proposed construction.” Req. Reh’g 3 (footnote omitted).

We disagree that we misapprehended or overlooked any matters in addressing Patent Owner’s proposed construction for “mobile device.” Rather, we provided a comprehensive analysis of the term “mobile device.”

Final Dec. 10–21. Patent Owner fails to point out with particularity anything that was overlooked or misapprehended in this analysis, as required by 37 C.F.R. § 42.71(d). Instead, Patent Owner merely expresses its disagreement with our conclusions and proceeds to reargue points and evidence already considered and rejected in the Final Written Decision. This approach is not proper in a rehearing request.

Furthermore, Patent Owner’s own arguments show the error in its proposed construction. For example, Patent Owner argues that the recited “mobile device” “must register with and be able to directly communicate with the cellular network.” PO Resp. 13; Req. Reh’g 1 n.1. Yet, Patent Owner acknowledges that “the claims of the ’023 Patent require the apparatus/movable base station to communicate directly with the cellular network (and *not the ‘mobile device’*).” Req. Reh’g 3 (emphasis added). As we pointed out in the Final Decision, the only claimed communication involving the mobile device is between the claimed “apparatus” (the mobile base station) and the mobile device, and Patent Owner acknowledges that this communication need not be cellular. Final Dec. 14 (citing PO Sur-reply 9). Thus, Patent Owner’s arguments undermine its proposed construction.

On rehearing, Patent Owner reprises the arguments it made during trial that the Specification of the ’023 patent requires the recited “mobile device” to have the proposed cellular capability. Req. Reh’g 5–13; PO Resp. 13–15; PO Sur-reply 1–14. These arguments cite various disclosures in the ’023 patent and assert that these disclosures should be required in the claims. Req. Reh’g 5–13. These arguments ignore that the claims are directed to the mobile base station, not the “mobile device.” This point is not in dispute. *See* PO Resp. 2 (“The asserted claims of the ’023 Patent

cover a movable base station or apparatus configured to provide important benefits to mobile devices, such as smartphone, tablet and laptop users.”), 3 (The “movable base station is a mobile wireless device that acts as an intermediary and provides connectivity between a cellular network and one or more mobile devices.”); Tr. 52:25–53:1 (When asked if “any of [the challenged patents] claim the mobile device,” Patent Owner answered “No.”). Thus, Patent Owner’s arguments on rehearing are no more persuasive than they were during trial.

As one example, Patent Owner argues that the ’023 patent’s disclosures of direct communication between a mobile device and a cellular network “requir[e] the ‘mobile device’ to be capable of directly communicating with a cellular network.” Req. Reh’g 6–9. We do not dispute that the ’023 patent contains such disclosures. Indeed, in our Final Decision, we agreed with Patent Owner that “the ’023 patent describes communication between a fixed base station [such as in a cellular network] and the mobile device in certain special situations, i.e., slow moving traffic.” Final Dec. 16–17. We pointed out, however, that the claims are not directed to this communication but, instead, are directed to what Patent Owner describes as “indirect[]” communication with the cellular network via the mobile base station. Final Dec. 17 (citing PO Resp. 8); *see* PO Resp. 8 (“The ’023 Patent discloses that a mobile device can either directly communicate with the cellular network via a ‘fixed port’ (conventional base station) or it can communicate with the cellular network indirectly by communicating with a ‘moving base station’ that communicates with the ‘fixed ports.’”). On rehearing, Patent Owner argues that “the **advantage** of the ’023 Patent is the improvement of the wireless connections **for ‘mobile units’** by providing **these ‘mobile units’** with higher bandwidths and

improved service quality in all locations and situations.” Req. Reh’g 3 n.6 (citing PO Resp. 3–5; PO Sur-reply 1–14). The claims, however, are not directed to “all locations and situations” but, rather, to the communication scenario involving the intermediary mobile base station. Thus, any ability of a mobile device to communicate directly with a cellular network and not through the mobile base station is irrelevant to the challenged claims.

We are not persuaded that we misapprehended or overlooked any matters when we addressed Patent Owner’s proposed construction of “mobile device.”

On rehearing, Patent Owner also argues that, “[u]nder the proper construction of the term ‘mobile device’ proposed by Patent Owner, the record establishes that Petitioner failed to show by a preponderance of the evidence that the prior art references disclose or render obvious the ‘mobile device’ limitation of the Challenged Claims.” Req. Reh’g 15. Patent Owner, however, ignores our detailed findings showing how the asserted prior art teaches a “mobile device” under Patent Owner’s construction. Final Dec. 33–36, 65–66. Thus, even if we modified our claim construction on rehearing and adopted Patent Owner’s construction, the challenged claims would still be unpatentable.

C. Alleged Incompatibility of CDMA and TDMA

Patent Owner’s Rehearing Request, in one sentence, contends that “[t]he Board erred in finding that that ‘CDMA and TDMA are not incompatible’ by improperly disregarding substantial evidence set forth by Patent Owner and its expert—that undermines any expectation of success and would have discouraged a [person of ordinary skill in the art] from attempting Petitioner’s combinations.” Req. Reh’g 14 (citing Final Dec. 79). Patent Owner does not attempt to identify any specific errors in

our reasoning. Instead, Patent Owner provides a single footnote, string-citing pages from Patent Owner's written submissions and testimony from its declarant. Req. Reh'g 14 n.31.

We disagree that we misapprehended or overlooked any matters in this regard. Rather, we considered Patent Owner's submissions and disagreed with them, finding instead that the record demonstrated that CDMA and TDMA can be combined, and we relied on, among other evidence, a prior art reference that expressly discloses a combination of CDMA and TDMA. Final Dec. 56–57 (citing Ex. 1033), 79. We further found that a person of ordinary skill in the art would have had reason to make the proposed combinations and would have had a reasonable expectation of success in doing so. Final Dec. 57–58, 79–81.

Thus, we did not “improperly disregard[],” misapprehend, or overlook Patent Owner's arguments and evidence.

IV. CONCLUSION

As explained above, we did not misapprehend or overlook any matters in our analysis of Patent Owner's proposed construction of “mobile device” or in our analysis of the combinability of CDMA and TDMA. Thus, we deny Patent Owner's Rehearing Request.

V. ORDER

In view of the foregoing, it is:

ORDERED THAT Patent Owner's Request for Rehearing of the Board's Final Written Decision is *denied*.

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Patent 7,979,023 B2

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