

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUIZHOU TCL MOBILE COMMUNICATION CO. LTD., TCT MOBILE
(US) INC. and TCL MOBILE COMMUNICATION (HK) CO., LTD.,
Petitioner,

v.

WI-LAN INC,
Patent Owner.

IPR2020-00302
Patent 8,259,688 B2

Before DANIEL J. GALLIGAN, KAMRAN JIVANI, and SCOTT E. BAIN,
Administrative Patent Judges.

GALLIGAN, *Administrative Patent Judge.*

DECISION

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

I. INTRODUCTION

On December 24, 2019, Huizhou TCL Mobile Communication Co. Ltd., TCT Mobile (US) Inc., and TCL Mobile Communication (HK) Co., Ltd. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–16 of U.S. Patent No. 8,259,688 B2 (“the ’688 patent,” Ex. 1001). Paper 1 (“Pet.”). The Petition asserted the following four grounds of unpatentability:

Claims Challenged	35 U.S.C. § ¹	References/Basis
1–16	103(a)	Hong, ² Zhuang ³
1–5, 11, 12, 15	103(a)	Etemad, ⁴ Sung ⁵
6–10, 13, 14, 16	103(a)	Etemad, Sung, Pecen ⁶
1–14	103(a)	Laroia, ⁷ Dahlby ⁸

After considering the Petition and the Patent Owner Preliminary Response (Paper 6), we determined that Petitioner had not shown a reasonable likelihood of prevailing on any ground presented in the Petition, and, therefore, we denied institution. Paper 8 (“Dec.”), 20.

On September 2, 2020, Petitioner filed a Request for Rehearing of our Decision. Paper 9 (“Request” or “Req. Reh’g”). Petitioner requests rehearing only with respect to the ground based on the combination of Hong

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 103 that became effective after the filing of the application for the ’688 patent. Therefore, we apply the pre-AIA version of this section.

² Hong, US 2005/0192011 A1, published Sept. 1, 2005 (Ex. 1003).

³ Zhuang, US 2005/0286465 A1, published Dec. 29, 2005 (Ex. 1004).

⁴ Etemad, US 7,963,517 B2, issued Apr. 6, 2010 (Ex. 1005).

⁵ Sung, US 2005/0030931 A1, issued Feb. 10, 2005 (Ex. 1006).

⁶ Pecen, US 2005/0227691 A1, published Oct. 13, 2005 (Ex. 1009).

⁷ Laroia, US 2005/0124344 A1, published June 9, 2005 (Ex. 1007).

⁸ Dahlby, US 6,996,060 B1, issued Feb. 7, 2006 (Ex. 1008).

and Zhuang. *See* Req. Reh’g 2–3 (“Petitioner respectfully requests the Board grant rehearing to review the Petition with respect to Ground 1 . . .”).

For the reasons that follow, we deny Patent Owner’s request for rehearing.

II. ANALYSIS

A. Standard of Review

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

B. Alleged Obviousness over Hong and Zhuang

Claim 1 of the ’688 patent recites “transmitting, by the mobile station, the allocated random access identifier to the target base station over a random access channel,” and claim 6 similarly recites “a transmitter configured to transmit the allocated random access identifier to the target base station over a random access channel.”

In the Decision, we explained that Petitioner had not shown that Hong’s initial ranging procedure teaches transmission on a random access channel, and we explained that, although Zhuang uses the terms “random access” and “ranging” interchangeably (Ex. 1004 ¶ 2), “Petitioner fails to explain how Hong’s initial ranging procedure is a ‘random access’ in the sense described by Zhuang, and they appear to be significantly different.” Dec. 10–12.

On rehearing, Petitioner argues that our Decision indicates that we

misunderstood Petitioner's position to be "that the initial ranging channel and the random access channel must ***always have exactly*** the same meaning," which Petitioner argues "was not the position presented." Reg. Reh'g 1. According to Petitioner, "the Petition states that a [person of ordinary skill in the art] looking at Hong's initial ranging channel would have found a random access channel limitation ***obvious***." Req. Reh'g 5.

We disagree with Petitioner's assertion on rehearing that we misunderstood the contentions set forth in the Petition. For the relevant limitation, Petitioner first set forth Hong's disclosures of initial ranging. Pet. 27–28. Petitioner then stated: "In this regard, it was well-known that the terms 'initial ranging channel' and 'random access channel' were often used interchangeably; and similarly, the terms 'initial ranging process' and 'random access process' were often used interchangeably." Pet. 29. Petitioner then stated that the '688 patent uses the terms interchangeably. Pet. 29; see Dec. 5 (discussing the '688 patent's use of these terms). Petitioner then argued: "Therefore, Hong's disclosure of transmission of the temporary CID during initial ranging discloses the feature of transmitting the random access identifier over a random access channel." Pet. 29. The assertion in the Petition, therefore, is that the disclosure of initial ranging discloses a random access channel, not that the disclosure of initial ranging renders obvious a random access channel, as Petitioner now asserts on rehearing. See Req. Reh'g 5.

The Petition further states the following:

To further demonstrate that the equivalence between "random access" and "initial ranging" was well-known before the filing of the '688 Patent, Petitioner cites to Zhuang, a Motorola patent application in the related area of handoff in a wireless communication, which explains that ranging, access and

random access are synonymous terms in the context of the technology under IEEE 802.16. See TCL-1004 [0002]-[0003]; [0013]. Zhuang further discloses that ranging includes generating and transmitting random access signals. *Id.* [0023], [0071].

Therefore, the combined teaching of Hong and Zhuang renders obvious feature of Claim [1.C]. TCL-1010, [116]-[123].

Pet. 29.

We addressed this assertion in detail in the Decision denying institution as follows:

Petitioner also relies on Zhuang’s disclosure of using the terms “random access” and “ranging” “interchangeably.” Pet. 29 (citing Ex. 1004 ¶¶ 2–3, 13, 23, 71). Zhuang, however, discloses that “an access signal is often transmitted in an unsolicited manner” and, therefore, “is often referred to as a random access,” which is “[u]nlike ordinary data traffic that is sent using scheduled resources that are allocated by the [base station] to the [subscriber station].” Ex. 1004 ¶ 2. Although Petitioner cites Zhuang for the general proposition that “initial ranging” and “random access” are equivalent, Petitioner fails to explain how Hong’s initial ranging procedure is a “random access” in the sense described by Zhuang, and they appear to be significantly different. As an example, Hong discloses that a target base station sends a fast ranging information element (step 761) to the subscriber station, after which the subscriber station and the target base station “exchange an RNG-REQ message and an RNG-RSP message with each other in the method described in connection with FIG. 6 (Steps 763 and 765), perform initial ranging.” Ex. 1003 ¶ 86, *cited in* Pet. 27. The ranging request (RNG-REQ) message 763 does not appear to be “transmitted in an unsolicited manner,” as the “random access” signals are in Zhuang. See Ex. 1004 ¶ 2.

Dec. 10–11. Petitioner’s arguments on rehearing about the alleged interchangeability of the terms “initial ranging channel” and “random access channel” fail to show that we misapprehended or overlooked any matter

presented in the Petition.

On rehearing, Petitioner also argues that “Zhuang was relied upon to demonstrate that a [person of ordinary skill in the art] would have found the random access channel limitation obvious in view of the description of the initial ranging channel in Hong, based on the combined teaching of Hong and Zhuang.” Req. Reh’g 8. We also addressed Petitioner’s reasons to combine Hong and Zhuang in the Decision denying institution as follows:

Petitioner’s argument is based on Zhuang’s use of terms as equivalents without sufficiently explaining how Zhuang’s disclosures apply to Hong. Petitioner asserts that a person of ordinary skill in the art “would have combined the teaching of Zhuang that random access and ranging are equivalent terms with Hong’s teaching of fast handover in order to achieve fast handover in other wireless systems based on TDMA, FDMA or CDMA.” Pet. 23 (citing Ex. 1004 ¶ 13; Ex. 1010 ¶¶ 101–106). But Petitioner does not explain how the use of equivalent terms in Zhuang creates a fast handover in Hong, and, as discussed above, Petitioner does not explain how Hong’s ranging request messages are random access signals in the sense taught in Zhuang.

Dec. 11. Petitioner’s focus on the alleged interchangeability of, or equivalence between, terms is not persuasive given the differences between Hong and Zhuang, as discussed in the Decision. Dec. 10–11.

On rehearing, Petitioner also argues that we “relied on a single discussion of [Hong’s] FIG. 3 to exclude Petitioner’s substantial evidence in Hong’s FIG. 7, and did not review the prior art teaching of the embodiment of FIG. 7 on its merits.” Req. Reh’g 12. This is incorrect. In the Decision, we explained that Hong’s Figures 3 and 7, both of which Petitioner relies on, conflict in that Hong describes a competition-based transmission technique in Figure 3 and a non-competition-based transmission technique in Figure 7, and we stated that “Petitioner fails to reconcile these two conflicting

positions.” Dec. 9–10. We, however, did not ignore the disclosure of Figure 7. Rather, we explained in detail how Petitioner’s assertions based on Hong’s Figure 7 in view of Zhuang fall short. Dec. 10–11.

Petitioner further argues that “the ’688 Patent provides the initial ranging channel as written description support for the random access channel limitation. Consequently, prior art that teaches an initial ranging channel must necessarily, at a minimum, renders obvious the random access channel limitation.” Req. Reh’g 10. The passage from the ’688 patent to which Petitioner refers provides the following: “The subscriber station transmits an initial ranging signal over a ranging channel defined by the base station 200. The ranging channel can be, for example, the random access channel.” Ex. 1001, 6:47–50, *cited in* Req. Reh’g 11. On rehearing, Petitioner argues that this passage from the ’688 patent (Ex. 1001, 6:47–50) “reflects how those terms were used ‘interchangeably’ to provide support for obviousness,” and Petitioner further argues that, “no matter the interpretation of the random access channel limitation, its scope must also include an initial ranging channel due to the written description support for the random access channel limitation given in the ’688 Patent.” Req. Reh’g 11.

We addressed this disclosure of the ’688 patent in the Decision denying institution as follows:

This disclosure from the ’688 patent, however, does not equate a ranging channel with a random access channel by saying, for example, that a ranging channel is also called a random access channel. Rather, it states that the ranging channel can be the random access channel. The ranging channel could be some other channel as well. Petitioner does not explain why channels other than a random access channel would be excluded from being used as a ranging channel in the ’688 patent. Thus, the mere disclosure of a transmission on ranging channel does not

necessarily teach the claimed transmission on a “random access channel.”

Dec. 5.

Petitioner’s arguments on rehearing fail to show that we misapprehended or overlooked any matter presented in the Petition. Indeed, as discussed in the Decision, Hong’s initial ranging procedure does not appear to involve transmission in an unsolicited manner, which is a hallmark of Zhuang’s random access. Dec. 10–11; *see* Dec. 11 (“Petitioner fails to explain how Hong’s initial ranging procedure is a ‘random access’ in the sense described by Zhuang, and they appear to be significantly different.”).

III. CONCLUSION

Petitioner has not carried its burden of demonstrating we misapprehended or overlooked any matters in denying institution. 37 C.F.R. § 42.71(d).

For the foregoing reasons, Petitioner’s Request for Rehearing is *denied*.

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