

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) Inc.,
Petitioner

v.

WSOU INVESTMENTS, LLC D/B/A BRAZOS LICENSING AND
DEVELOPMENT
Patent Owner

Case IPR2023-00497
U.S. Patent No. 8,149,776

PATENT OWNER'S PRELIMINARY RESPONSE TO THE PETITION

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	RELATED PROCEEDINGS	1
III.	LEVEL OF ORDINARY SKILL IN THE ART	1
IV.	CLAIM CONSTRUCTION	2
V.	DISCRETIONARY DENIAL IS WARRANTED HERE	2
VI.	PETITIONER HAS NOT MET ITS THRESHOLD BURDEN	4
	A. Petitioner’s assertion of Li overlooks limitations qualifying the access re-attempt.	5
	B. Petitioner’s assertion of Pelletier similarly overlooks limitations qualifying the access re-attempt.....	6
	C. Petitioner’s challenges of the dependent claims are all tainted by its deficient challenges of the independent claims.....	10
VII.	CONCLUSION.....	10

I. INTRODUCTION

WSOU Investments, LLC d/b/a/ Brazos Licensing and Development (the “Patent Owner” or “WSOU”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“Pet.” or “Petition”) of United States Patent No. 8,149,776 (“the ’776 Patent” or “Ex. 1001”) filed by ZTE (USA) Inc. (“Petitioner”). In view of the reasons presented herein, the Petition should be denied as failing to meet the threshold burden of proving there is a reasonable likelihood that at least one challenged claim is unpatentable.

II. RELATED PROCEEDINGS

The ’776 patent is involved in the following proceedings: (1) *WSOU Investments, LLC v. ZTE Corporation et al.*, 6:22-cv-00137 (Feb. 8, 2022 W.D. Tex.); and (2) *WSOU Investments, LLC v. Oneplus Technology (Shenzhen) Co., Ltd.*, 6:20-cv-00952 (Oct. 14, 2020 W.D. Tex.).

III. LEVEL OF ORDINARY SKILL IN THE ART

The Petition proposes a person of ordinary skill in the art at the time of the ’776 patent (a “POSITA”) “would have had at least a bachelor’s degree in electrical engineering, computer engineering, or a related engineering discipline and three or more years of industry experience in the field of telecommunications, or equivalent experience, education, or both.” Pet. 8 (citing Ex. 1003, 38-41). Patent Owner does not offer a competing definition at this stage because Petitioner has not met its burden to prove unpatentability of any challenged claim even if it were appropriate to apply Petitioner’s proposed definition for a POSITA.

IV. CLAIM CONSTRUCTION

The standard for claim construction applicable here is the “ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. §42.100(b) (effective November 13, 2018); 83 Fed. Reg. No. 197, 51340 (Oct. 11, 2018). This is the same standard applied by Article III courts. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). The Petition states that “[f]or the purposes of this IPR, the plain meaning of each claim term can be applied.” Pet. 8. Patent Owner submits that Petitioner fails to meet its evidentiary threshold burden under at least the tacit claim interpretations applied in the Petition. Consequently, the Board need not construe any particular term in order to reach a finding that the Petition should be denied as being deficient on the merits.

V. DISCRETIONARY DENIAL IS WARRANTED HERE

Discretionary denial is warranted because Petitioner failed to identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a). The PTAB has noted that “[t]he statutory requirement for particularity in a petition for IPR takes on heightened importance when considered in conjunction with SAS’s ‘all-or-nothing’ approach” and “[e]ven when a petitioner demonstrates a reasonable likelihood as to at least one claim, however, institution of an IPR remains discretionary.” *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 17 (PTAB March 6, 2019).

As shown in the table below, the Petition raises eighteen distinct and redundant grounds in purporting to challenge all twenty claims of the '776 patent, with each ground purporting to rely on a unique combination of references (with the only exceptions being the redundant single-reference challenges).

Ground	References	Basis	Challenged Claims
1	Li	§ 102	1, 10, and 19
2	Li	§ 103	1, 10, and 19
3	Li in view of Pelletier-750	§ 103	2, 5, 11, and 14
4	Li in view of Pelletier-750 and Kim	§ 103	3, 4, 12, and 13
5	Li in view of Vujcic and Kim	§ 103	6–9
6	Li in view of Vujcic and Pelletier-750	§ 103	15
7	Li in view of Vujcic, Pelletier-750, and Kim	§ 103	16-18
8	Li in view of Vujcic and Pelletier-750	§ 103	20
9	Pelletier	§ 102	1, 10, and 19
10	Pelletier	§ 103	1, 10, and 19
11	Pelletier in view of Pelletier-750	§ 103	2 and 11
12	Pelletier in view of Pelletier-750 and Kim	§ 103	3 and 12
13	Pelletier in view of Pelletier-750, Kim, and Li	§ 103	4, 5, 13, and 14
14	Pelletier in view of Vujcic	§ 103	6, 15, and 20
15	Pelletier in view of Vujcic and Kim	§ 103	7
16	Pelletier in view of Vujcic, Pelletier-750 and Kim	§ 103	16
17	Pelletier in view of Vujcic and Li	§ 103	8 and 17
18	Pelletier in view of Vujcic, Li, and Pelletier-750	§ 103	9 and 18

Compounding Petitioner's unjustified multiplicity of grounds, Petitioner further unnecessarily multiplies its challenges here by asserting redundant theories of anticipation and single-reference obviousness against all three independent claims (1, 10, and 19) and, still further, by raising redundant grounds based on distinct references. The unjustified redundancy applied in the Petition is plainly manifest, for example, where Petitioner makes no distinction between its redundant anticipation and obviousness challenges of claim 1 based exclusively on Li, apart from repeatedly stating "Li discloses or renders obvious" the claim language being addressed.

Under these unique circumstances, discretionary denial is warranted here due at least to the unnecessary redundancy in the Petition, the unnecessary and unjustified assertion of over a dozen unique combination of references, and the general failure of Petitioner to identify "with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim." 35 U.S.C. § 312(a).

VI. PETITIONER HAS NOT MET ITS THRESHOLD BURDEN

Petitioner has the burden of proof to establish entitlement to relief. "Review shall not be instituted unless the Board decides that the information presented in the petition demonstrates that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable." 37 CFR § 42.108(c). The Petition should be denied as failing to meet Petitioner's threshold evidentiary burden for institution.

A. Petitioner’s assertion of Li overlooks limitations qualifying the access re-attempt.

Regarding claim 1, Petitioner’s assertion of Li (Ex. 1005) at least failed to address claim limitations qualifying the initial access attempt and the re-attempt as necessarily using the *same* random access channel. Specifically, claim 1 qualifies its “re-attempting access” limitations, in part, by reciting “sending from the transmitter on *the random access channel*.” Ex. 1001, 14:1–2. The recitation “the random access channel” derives its antecedent basis from the initial access attempt, recited in claim 1 as “attempting access to a wireless network by sending from a transmitter on *a random access channel*.” *Id.*, 13:61–62. Thus, the re-attempt to access the same wireless network requires a transmission on the same random access channel of the initial attempt, albeit the re-attempt uses “a second transmit power” and “a second preamble comprising a signature sequence.” The other two independent claims (10 and 19) similarly qualify the re-attempt as reusing the same “random access channel” of the initial attempt. Ex. 1001, 15:3–14 (claim 10); 16:46–56 (claim 19).

The Petition lacks any argument or evidence even purporting to establish that Li anticipates or renders obvious the explicit requirement that the recited re-attempt must reuse the same access channel as the initial attempt. *See* Pet. 20–21. This explicit claim requirement simply is not addressed in the Petition. *Id.*

According to Petitioner, Li discloses a subsequent access attempt that allegedly involves a mobile station (MS) controlling any change in transmission power and that a “random-access signal includes [sic] preamble comprising a preamble code sequence.” *Id.* Even if one were to assume Petitioner’s

characterization of Li is technically accurate, which Patent Owner does not concede, Petitioner's curt characterization offers no argument or evidence even purporting to prove the explicit claim 1 requirement that the re-attempt must reuse *the same access channel* as the initial attempt (albeit at "a second transmit power" and "a second preamble comprising a signature sequence"). The Petition simply overlooks the requirement of reusing the same "random access channel" for the re-attempt.

Petitioner has not established it is more likely than not that it would prevail on either a theory of anticipation or obviousness in the absence of Petitioner addressing every requirement recited in the independent claims. Accordingly, Petitioner's redundant challenges of the independent claims based on Li alone should be denied as failing to meet the threshold evidentiary burden for institution. This deficiency taints every challenge purporting to rely on Li.

B. Petitioner's assertion of Pelletier similarly overlooks limitations qualifying the access re-attempt.

Petitioner repeats the same error in its single-reference assertion of Pelletier (Ex. 1006) under redundant theories of anticipation and obviousness. Once again, Petitioner failed to raise sufficient evidence to establish the explicit requirement (set forth in all challenged claims) that the re-attempt to access the same wireless network requires a transmission on the same random access channel of the initial attempt, albeit the re-attempt uses "a second transmit power" and "a second preamble comprising a signature sequence." See § VI.A, *supra*.

Petitioner purports to rely on Pelletier's description of FIG. 4. Pet. 61–62 (citing Ex. 1006). However, the partial quotations of Pelletier offered in the Petition

do not expressly state that the same random access channel is used in transmitting not only “a first power a first preamble comprising a signature sequence” in an initial access attempt, but also in transmitting a re-attempt having “a second preamble comprising a signature sequence” and “a second transmit power.”

Petitioner first characterizes Pelletier’s FIG. 4 as “show[ing], at a first trial, ‘a first preamble phase is transmitted by a WTRU.’” Pet. 61 (citing Ex. 1006, ¶ 6 and Ex. 1003, ¶ 240). Petitioner also characterizes Pelletier’s description of FIG. 4 as disclosing “that if ‘the Node B transmits a NACK,’ and the maximum number of attempts after the first NACK has not been reached, ‘the WTRU retries accessing the RACH with a different preamble in a subsequent access slot.’” *Id.*, 64 (citing Ex. 1006, ¶ 32 and Ex. 1003, ¶ 247).

Petitioner does not offer any argument or evidence sufficient to conclude that any of the partial quotations of Pelletier offered in the Petition disclose that the same random access channel must be used in transmitting not only “a first power a first preamble comprising a signature sequence” in an initial access attempt, but also in transmitting a re-attempt having “a second preamble comprising a signature sequence” and “a second transmit power.” The attached declaration is unavailing because the cited paragraphs merely repeat the partial quotations of the Petition, without offering any accompanying explanation or rational underpinning. *See, e.g.*, Ex. 1003, ¶¶ 240, 247.

The Petition should also be denied as failing to satisfy 35 U.S.C. §312(a), including the requirement to identify “with particularity, each claim challenged, the

grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” The Petition is ambiguous as to whether and how the partial quotations from Pelletier allegedly disclose the same random access channel is used in transmitting not only “a first power a first preamble comprising a signature sequence” in an initial access attempt, but also in transmitting a re-attempt having “a second preamble comprising a signature sequence” and “a second transmit power.”

While one can only speculate, given the ambiguity of the Petition, to the extent Petitioner is suggesting that Pelletier discloses an attempt to *access* E-RACH resources will necessarily involve repeating transmissions over the *same* E-RACH, such that access to a given E-RACH is somehow already granted, Petitioner failed to explain why this is so, much less with any evidentiary support and accompanying rational underpinning. Such an undefended interpretation of Pelletier also cannot be squared with Pelletier’s disclosure that each enhanced physical random access channel (E-PRACH) is “associated with more than one set of E-RACH resources.” Ex. 1006, ¶¶ 24–25. That multiple E-RACH resources are made available undermines the unstated and undefended premise that a wireless transmit/receive unit (WRTU) repeatedly transmits access attempts over the *same* E-RACH prior to even being granted access to any such resource.

Compounding its error, Petitioner relies on, and mischaracterizes, an expressly different embodiment of Pelletier as allegedly satisfying the additional requirements that the access re-attempt must involve a transmission (on the same

random access channel) having “a second preamble comprising a signature sequence” and “a second transmit power.” According to Petitioner, “Pelletier discloses that the second preamble can be “another preamble [sent] at the same transmission power,” (id., [0042]), or can be “the repeat preamble” having “a second signature. Ex-1006, [0043]; Ex-1003, 248.” Pet. 65.

The partial quotations from Pelletier appear in the written description of FIG. 5, which Pelletier describes as being “an alternative embodiment” and hence apart from Pelletier’s description of FIG. 4 relied upon elsewhere in the Petition. Ex. 1006, ¶ 41. Moreover, Petitioner overlooks that Pelletier’s description of FIG. 5 expressly pertains to what happens only “[a]fter the WTRU receives an acquisition indication” from Node B. *Id.*, ¶ 42. Petitioner fails to explain how a secondary preamble sent only after an acquisition (ACK) is sent to and received by a mobile station (MS), *thereby indicating successful acquisition of a resource*, satisfies the distinguishable claim 1 qualification of “re-attempting access” as necessarily being “responsive to determining that the access attempt from sending the first preamble was *unsuccessful*.”

Petitioner’s misplaced reliance on FIG. 5 of Pelletier suffers from additional fatal deficiencies. For example, for claim 1’s requirement that the “second preamble” must have a distinct “second signature,” Petitioner likewise relies exclusively on partial quotations from Pelletier further describing the distinguishable FIG. 5 embodiment. Pet. 65 (citing Ex-1006, ¶¶ 42-43 and Ex. 1003, ¶ 248). Specifically, Petitioner argues that “Pelletier discloses that the second preamble can

be ‘another preamble [sent] at the same transmission power,’ (*id.*, [0042]), or can be ‘the repeat preamble’ having ‘a second signature.’” *Id.* (alteration original). Once again, Petitioner fails to explain how the referenced “second signature” in a preamble sent only after an acquisition (ACK) is sent, *thereby indicating successful acquisition of a resource*, satisfies the distinguishable claim 1 requirement that “re-attempting access” must be “responsive to determining that the access attempt from sending the first preamble *was unsuccessful*.”

Accordingly, for each of the reasons discussed above, Petitioner’s redundant, single-reference assertion of Pelletier fails to meet the evidentiary threshold necessary for institution.

C. Petitioner’s challenges of the dependent claims are all tainted by its deficient challenges of the independent claims.

Because Petitioner has failed to meet its burden to prove a reasonable likelihood that any challenged independent claim would have been obvious, Petitioner likewise has failed to establish a reasonable likelihood that any challenged dependent claim is unpatentable.

VII. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Petition be denied in its entirety as failing to establish a reasonable likelihood that at least one of the claims challenged is unpatentable.

Date: July 12, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I certify that this Preliminary Response to Petition complies with the type-volume limitation of 37 C.F.R. § 42.24(b)(1) because it contains fewer than the limit of 14,000 words, as determined by the word-processing program used to prepare the brief, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a)(1).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), I certify that I caused to be served an electronic copy of the foregoing Patent Owner's Preliminary Response, along with any accompanying exhibits filed via the PTAB E2E system, to Petitioner's counsel at the following addresses identified in the Petition's consent to electronic service:

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