UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUAWEI DEVICE USA, INC. and ZTE (USA), INC.,
Petitioner,

v.

SPH AMERICA, LLC and ELECTRONICS AND
TELECOMMUNICATIONS
RESEARCH INSTITUTE,
Patent Owner.

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Case IPR2015-00203
Patent 8,532,231 B2

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Before SALLY C. MEDLEY, BARBARA A. BENOIT, and
BETH Z. SHAW, *Administrative Patent Judges.*

MEDLEY, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Huawei Device USA, Inc. and ZTE (USA), Inc. (collectively, "Petitioner"), filed a Petition requesting an *inter partes* review of claims 16, 20, 35, 40, 47–51, and 54–57 of U.S. Patent No. 8,532,231 B2 (Ex. 1001, "the '231 patent"). Paper 4 ("Pet."). In response, Electronics and Telecommunications Research Institute and SPH America, LLC (collectively, "Patent Owner"), filed a Preliminary Response. Paper 10 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

For the reasons set forth below, we deny institution of an *inter partes* review of the '231 patent.

A. Related Matter

The '231 patent is involved in at least the following lawsuits: *SPH v. Huawei Technologies, Co., LTD et al.,* No. 3:13-cv-02323-CAB (S.D. Cal.); and *SPH v. ZTE (USA), Inc.,* No. 3:13-cv-02326-CAB (S.D. Cal.). Pet. 1–2.

B. The '231 Patent

The '231 patent relates generally to an apparatus compatible with a conventional wireless local area network communication system, for transmitting and receiving data in high-speed. Ex. 1001, 1:24–29. Specifically, the described apparatus is used for transmitting and receiving

data using multiple antennas while being compatible with conventional IEEE 802.11a orthogonal frequency division multiplexing (OFDM). *Id.* at 1:35–47.

C. Illustrative Claim

Of the challenged claims, claims 16, 35, 47, and 54 are the only independent claims. Claim 20 depends directly from claim 16; claim 40 depends directly from claim 35; claims 48–51 depend either directly or indirectly from claim 47; and claims 55–57 depend either directly or indirectly from claim 54.

Claim 16, reproduced below, is illustrative.

16. A receiving apparatus in a wireless communication system, the apparatus comprising:

a receiving unit configured to receive a frame comprising sequentially a short preamble, a first long preamble, a signal symbol, a second long preamble, and a data symbol, wherein the short preamble comprises a symbol for synchronization; and

a determination unit configured to determine, based on information in the signal symbol, whether the frame is transmitted using space time block coding.

Ex. 1001, 15:61–16:3.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Challenged Claims	Basis	References
16 and 47	§ 103(a)	Narasimhan[1] and Alamouti[2]
35, 48–50, 54, 55, and 56	§ 103(a)	Narasimhan, Alamouti, and IEEE 802.11a Standard[3]
20, 40, 51, and 57	§ 103(a)	Narasimhan, Alamouti, IEEE 802.11a Standard, and Aoki[4]
20, 40, 51, and 57	§ 103(a)	Narasimhan, Alamouti, IEEE 802.11a Standard, and Gummadi[5]

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[1] U.S. Patent No. 7,577,085 B1, issued Aug. 18, 2009, filed July 5, 2002 (Ex. 1009) ("Narasimhan"). The parties refer to this reference as "N'085."

[2] S. M. ALAMOUTI, "A Simple Transmit Diversity Technique for Wireless Communications," IEEE J. ON SELECT AREAS IN COMMUNICATIONS, Vol. 16, No. 8, October 1998 (Ex. 1003) ("Alamouti").

[3] IEEE Standard 802.11a (1999) (Ex. 1010).

[4] Aoki, et al., "New preamble structure for AGC in a MIMO-OFDM-system," IEEE 802.11-04/046r1, Jan. 2004 (Ex. 1008) ("Aoki"). Petitioner asserts this reference is "a presentation given by employees of [a particular corporation] . . . to the IEEE in January 2004." Pet. 8.

[5] U.S. Patent Application Publication No. 2005/0054313 A1, published Mar. 10, 2005, filed Mar. 29, 2004 (Ex. 1011) ("Gummadi").

Challenged Claims	Basis	References
16 and 47	§ 103(a)	Liu[6] and Jeon[7]
35, 48–50, 54, 55, and 56	§ 103(a)	Liu, Jeon, and IEEE 802.11a Standard
20, 40, 51, and 57	§ 103(a)	Liu, Jeon, IEEE 802.11a Standard, and Aoki

II.   ANALYSIS

A. Real Party-In-Interest

Section 312(a) of Title 35 of the United States Code provides that a petition for *inter partes* review under 35 U.S.C. § 311 may be considered only if, among other things, the petition identifies all real parties-in-interest. 35 U.S.C. § 312(a)(2). Whether a non-identified party is a real party-in-interest to a proceeding is a highly fact-dependent question. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) ("*Trial Practice Guide*") (citing *Taylor v. Sturgell*, 553 U.S. 880 (2008)). "Courts invoke the terms 'real party-in-interest' and 'privy' to describe relationships and considerations sufficient to justify applying conventional principles of

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[6] Liu & Li, "A MIMO System with Backwards Compatibility for OFDM based WLANs," 4th IEEE Workshop on Signal Processing Advances in Wireless Communications, 2003 (Ex. 1012) ("Liu").
[7] Jeon, et al., "Optimal Combining of STBC and Spatial Multiplexing for MIMO-OFDM," IEEE 802.11-03/0513r0, July 2003 (Ex. 1006) ("Jeon"). Petitioner asserts these slides were "submitted to IEEE on July 2003." Pet. 7.

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