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Paper 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

Case IPR2015-00203
Patent 8,532,231 B2

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]

[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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