UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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ZTE (USA) INC., HTC CORPORATION, HTC AMERICA, INC.,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

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Case IPR2016-00757[1]
Patent 7,881,236 B2

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Before WILLIAM V. SAINDON, PATRICK M. BOUCHER, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*

McMILLIN, *Administrative Patent Judge*

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

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[1] IPR2016-01345 has been consolidated with this proceeding.

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(d), Evolved Wireless, LLC ("Patent Owner") requests rehearing of our Final Written Decision (Paper 42, "Dec."). Paper 43 ("Req. Reh'g"). As authorized by the Board (Paper 44, 2–3), Petitioners filed an opposition to Patent Owner's rehearing request (Paper 45) and Patent Owner filed a reply in support of its request for rehearing (Paper 46).

For the reasons set forth below, Patent Owner's Request for Rehearing is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing that the decision should be modified. 37 C.F.R. § 42.71(d). The party must identify specifically all matters we misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. *Id.* With this in mind, we address the arguments presented by Patent Owner.

III. ANALYSIS

Patent Owner submits that we (1) "overlooked the Patent Owner's argument that Petitioner has made a general conclusion that its prior art behaves according to the Board's narrow *only if* construction for the first transmitting limitation, even though that prior art does not create the conditions that test the *only if* behavior;" (2) "overlooked the Patent Owner's argument that the 321 reference taught the only if behavior only in hindsight;" and (3) "misapprehended" and "improperly modified the Patent Owner's argument that the 321 reference made the *only if* behavior obvious into one that the 321 reference disclosed that behavior." Req. Reh'g 1–2.

We have fully reviewed and considered all of Patent Owner's arguments in the rehearing request and are not persuaded that any changes to our Final Written Decision are necessary or appropriate.

In the Final Written Decision, with regard to claim construction, the Board concluded, "we agree with Patent Owner that 'if' in the 'transmitting' limitations of independent claims 1 and 7 is properly construed, under the broadest reasonable interpretation standard, as introducing necessary conditions, rather than sufficient conditions." Dec. 15. The transmitting limitations of claim 1 recite:

> transmitting the data stored in the Msg3 buffer to the base station using the UL Grant signal received on the specific message, *if* there is data stored in the Msg3 buffer when receiving the UL Grant signal on the specific message and the specific message is the random access response message; and
> transmitting new data to the base station in correspondence with the UL Grant signal received on the specific message, *if* there is no data stored in the Msg3 buffer when receiving the UL Grant signal on the specific message or the specific message is not the random access response message.

Ex. 1001, 16:59–17:3 (emphasis added). Independent claim 7 contains commensurate limitations. *Id.* at 17:30–18:7. The operation of these two transmitting limitations can be described as follows:

> Those limitations implicate two conditions, resulting in different data being transmitted depending on whether both conditions are satisfied or not. The first condition is whether "there is data stored in the Msg3 buffer when receiving the UL Grant signal on the specific message," and the second condition is whether "the specific message is the random access response message." Ex. 1001, col. 16, l. 59 – col. 17, l. 3; col. 17, l. 38 – col. 18, l. 7. "If" both conditions are satisfied, the "data stored in the Msg3 buffer"

> are transmitted to the base station; and "if" either condition is not satisfied, "new data" are transmitted to the base station. *Id.*

Dec. 10–11. The Patent Owner refers to these operations, in light of the claim construction adopted by the Board, as the "'only if' behavior" in the rehearing request. Req. Reh'g *passim*. In the Final Written Decision, the Board found that the 321 reference[2] and the 300 reference[3] taught the first "transmitting" limitation and the 321 reference taught the second "transmitting" limitation under a proper claim construction. Dec. 28.

Pursuant to 35 U.S.C. §316(e), the Petitioner had "the burden of proving a proposition of unpatentability by a preponderance of the evidence." In support of its arguments in the Response, Patent Owner relied on the Declaration of Todor Cooklev, Ph. D. (Ex. 2006) which was unsigned and to which we gave no evidentiary weight.[4] *See* Dec. 23–25. In contrast, Petitioner's case was supported by the Declaration of Paul S. Min, Ph. D. (Ex. 1006) to which we gave appropriate evidentiary weight. Dec. *passim*. Petitioner's evidence cannot be rebutted by Patent Owner's unsworn attorney argument. *See Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) ("[U]nsworn attorney argument . . . is not evidence and cannot rebut . . . evidence."). Thus, the weight of the evidence greatly favored Petitioner.

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[2] 3GPP TS 36.321 v8.2.0 (2008) (Ex. 1003, "3GPP TS 321").
[3] 3GPP TS 36.300 v8.4.0 (2008) (Ex. 1002, "3GPP TS 300").
[4] In our Final Written Decision, we noted that, despite having notice of the defect with the Cooklev Declaration, Patent Owner took no affirmative steps to cure the defect. Dec. 23–25. Patent Owner did not request leave to cure the defect in the Cooklev Delcaration in connection with the rehearing request or otherwise.

Patent Owner first argues that the Board failed to consider a "more complex case of UL Grant reception" based on an annotated Figure 7 of the 300 reference to which Patent Owner added a second UL Grant. Req. Reh'g. 9. Patent Owner argued that this "more complex case" showed that the data in the Msg3 buffer could be transmitted based on a UL Grant not in a random access response. *Id*. at 10. The fact that Patent Owner can hypothesize a system that is more complex than the cited references teach does not negate the teachings of the cited references.[5]

Patent Owner next argues, "[t]he Board overlooked . . . the Patent Owner's argument concerning the 321 reference relied on hindsight." Req. Reh'g. 11. Specifically, Patent Owner argues:

> The Petitioner argued that the 321 reference rendered the *only if* behavior obvious. (Pet. at 29-31.) The Patent Owner argued that the 321 reference rendered the *only if* feature of the claim obvious only in hindsight. (Response at 42-43.) The Patent Owner pointed out that the Petitioner's argument hinges on the recognition that "erroneous grants" were known at the time of the invention. (*Id*. at 42.) The Patent Owner pointed out that recognition of any grant as being problematic only first appeared in the '236 patent. (*Id*.) Accordingly, the Patent Owner argued that the Petitioner's argument with respect to the 321 reference relies on improper hindsight. (*Id. at 42-43*.)

Req. Reh'g. 11–12. In the Response, Patent Owner's hindsight argument was presented as part of its argument that "[n]one of the prior art teaches the

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[5] Patent Owner's hypothetical case was discussed and found not to be persuasive in the Final Written Decisions in IPR2016-01228 (Paper 27, 33–34) and IPR2016-01229 (Paper 27, 35) in which independent claims 1 and 7 of the '236 patent were held to be unpatentable in view of combinations of references not asserted in this proceeding. IPR2016-01228 Paper 27, 40–41; IPR2016-01229 Paper 27, 41–42.

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