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Paper 11
Entered: December 2, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) Inc., HTC CORPORATION, and HTC AMERICA, INC.,
Petitioner,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2016-00757
Patent 7,881,236 B2

Before WILLIAM V. SAINDON, PETER P. CHEN, and TERRENCE W. McMILLIN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

ZTE (USA) Inc., HTC Corporation, and HTC America, Inc. (collectively, "Petitioner"), filed a Petition for *inter partes* review of claims 1–10 and 12–13 of U.S. Patent No. 7,881,236 B2 (Ex. 1001, "the '236 patent"). Paper 3 ("Pet."). Patent Owner, Evolved Wireless LLC, filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . 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." 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108.

Upon consideration of the Petition and the Preliminary Response, we are persuaded Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1–10 and 12–13 of the '236 patent. Accordingly, we institute an *inter partes* review.

A. Related Matters

The '236 patent is the subject of several litigations, captioned *Evolved Wireless, LLC v. Apple, Inc.*, C.A. 15-cv-542 (D. Del.); *Evolved Wireless, LLC v. HTC Corp.*, C.A. 15-cv-543 (D. Del.); *Evolved Wireless, LLC v. Lenovo Group Ltd.*, C.A. 15-cv-544 (D. Del.); *Evolved Wireless, LLC v. Samsung Electronics Co. Ltd.*, C.A. 15-cv-545 (D. Del.); *Evolved Wireless, LLC v. ZTE Corp.*, C.A. 15-cv-546 (D. Del.); and *Evolved Wireless, LLC v. Microsoft Corp.*, C.A. 15-cv-547 (D. Del.). Pet. 3. The '236 patent is also the subject of IPR2016–00981, IPR2016-01228, IPR2016-01229, and IPR2016-01345, in which decisions regarding whether to institute trial have not yet been rendered. Petitioner has filed petitions requesting *inter partes* review of other patents owned by Patent Owner.

B. The '236 Patent

The '236 patent is titled, "Data Transmission Method and User Equipment for the Same" and generally describes a method "for efficiently transmitting data stored in a message 3 (Msg3) buffer and a user equipment" in a mobile communication system such as the Evolved Universal Mobile Telecommunication System ("E-UMTS"), which is a Long Term Evolution ("LTE") system developed and standardized in the 3rd Generation Partnership Project ("3GPP"). Ex. 1001, Abstract, (54), 1:17–32. In particular, the '236 patent describes a random access procedure for a user equipment (UE) and a base station in such a telecommunication system. *Id.* at 3:42–59. Figure 1 of the '236 patent is reproduced below.

FIG. 1

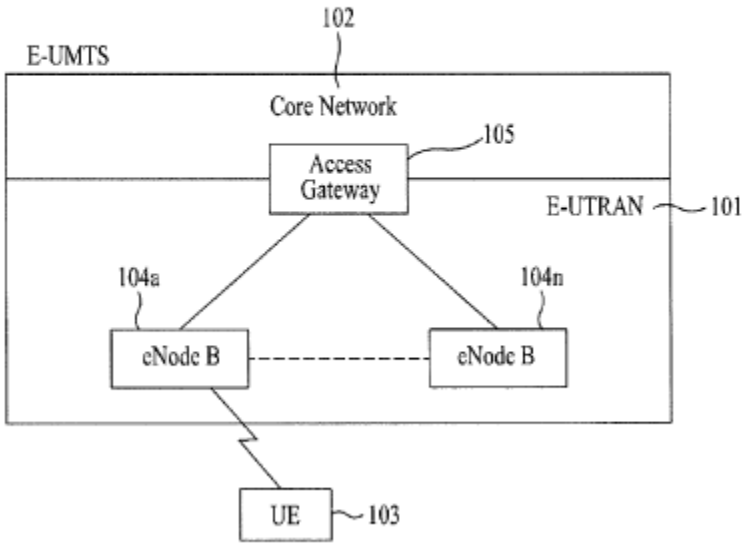

Figure 1 is a schematic view of an E-UMTS system with core network 102 and Evolved UMTS Terrestrial Radio Network (E-UTRAN) 101 including

User Equipment (UE) 103, base stations eNode B 104a-n, and access gateway 105. Ex. 1001, 1:33–37. In its "Discussion of the Related Art," the '236 patent describes a random access procedure for a UE to gain access to an LTE system, where the UE stores data to be transmitted in a message 3 (Msg3) buffer and transmits the data "in correspondence with" receipt from the base station of an uplink (UL) grant signal that contains information about radio resources. *Id*. at 3:42–44, 4:18–26. According to the '236 patent, then current LTE system standards provided that data stored in the Msg3 buffer of the UE would be transmitted to the base station "*regardless of* the reception mode of the UL Grant signal" and that "if the data stored in the Msg3 buffer is transmitted in correspondence with the reception of *all* UL Grant signals, problems may occur." *Id*. at 4:26–32 (emphasis added). The '236 patent purports to solve such problems. *Id*. at 4:33–34. Figure 9 of the '236 patent is reproduced below.

FIG. 9

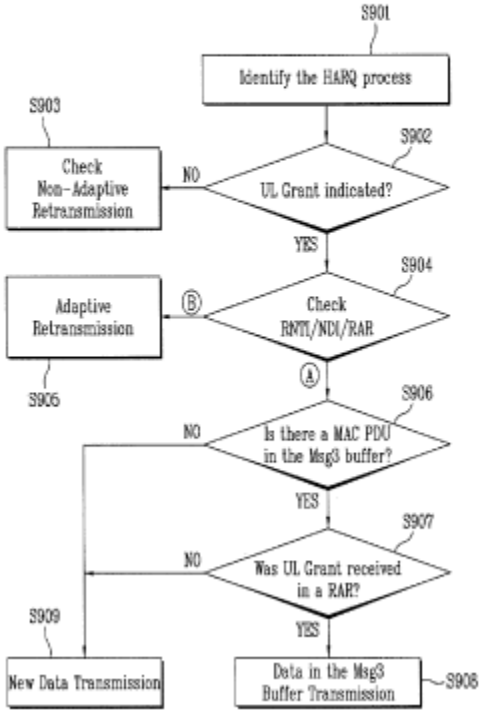

Figure 9 is a flowchart of the method of the '236 patent showing the operation of a Hybrid Automatic Repeat Request (HARQ) entity in a UE. *Id.* at 13:35–39. After a UL grant signal is received from the base station eNode B in step 902, the UE determines in step 906 whether there is data in the Msg3 buffer. *Id.* at 13:42–44. The data stored in the Msg3 buffer may be a Medium Access Control Protocol Data Unit (MAC PDU), including a user equipment identifier. *Id.* at 5:23–25.

In step 907, the UE determines whether the received UL grant signal is on a random access response (RAR) message. *Id.* at 13:66–14:3. The UE transmits to the base station the data in the Msg3 buffer "only when" there is

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