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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC., HTC CORPORATION, HTC AMERICA, INC., SAMSUNG ELECTRONICS CO., LTD., AND SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioners,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

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

PATENT OWNER'S REQUEST FOR REHEARING

PURSUANT TO 37 C.F.R. § 42.71(d)

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

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The Patent Owner, Evolved Wireless LLC, respectfully asks the Board to reconsider its Final Written Decision in this proceeding, pursuant to 37 C.F.R. § 42.71(d)(2).

I. Introduction

The Board should reconsider its Final Written Decision in this matter for three independent reasons.

First, the Board overlooked the Patent Owner's argument that Petitioner had 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. The Petitioner's position is analogous to an argument that an observation that every one of a company's employees who flew first class last week used a company-issued voucher confirms that the company has a rule: "Employees may fly first class *only if* they have a voucher." The evidence presented is certainly inadequate if the company's CEO always flies first class, but did not travel last week.

Separately, the Board overlooked the Patent Owner's argument that the 321 reference taught the *only if* behavior only in hindsight. Neither the Board nor the Petitioner suggested that anyone other than the inventors appreciated the problems that reception of additional UL Grants could cause, much less disclosed the

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claimed solution in the ’236 patent, and so to solve those problems in making the proposed combination is to use impermissible hindsight.

Finally, the Board misapprehended the Patent Owner’s argument about the 321 reference. The Board 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.

II. Background

The Board determined that the challenged claims of U.S. Patent No. 7,881,236 (“the ’236 patent”) are unpatentable as obvious. (Final Written Decision (“FWD”), Paper 42, at 39.)

A. The ’236 patent

The ’236 patent is directed to mobile communication technology. (FWD at 2.) It relates to communication between user equipment (UE) and base stations. *Id.* The UE includes cell phones. (*See* ’236 patent (Ex. 1001) at 1:22-25; FWD at 2-3.) The ’236 patent is focused on random access procedures. (*Id.* at 2.) Cell phones and base stations perform random access procedures at various times, for example when the cell phone initially accesses the base station. (*Id.* at 3-4.)

In the prior art and the claims of the ’236 patent, the cell phone transmits three types of data to the base station. *Id.* at 4-5. These are 1.) a preamble, 2.) Message 3 buffer data (“Msg3 buffer data”), and 3.) New data. (*Id.*) The cell phone

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