

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., HTC CORPORATION, HTC AMERICA, INC., MICROSOFT CORPORATION, MICROSOFT MOBILE OY, MICROSOFT MOBILE INC., SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., AND ZTE (USA) INC.,

Petitioner,

V.

EVOLVED WIRELESS, LLC,

Patent Owner

Case IPR2016-00758¹
Patent 8,218,481

PATENT OWNER'S RESPONSE

¹ IPR2016-01342 and IPR2016-01349 have been consolidated with this proceeding. IPR2017-00068 and IPR2017-00106 have been joined with IPR2016-00758. IPR2016-00981 has been joined with IPR2016-01349.

I. PATENT OWNER'S OPPOSITION TO INSTITUTED GROUNDS

Patent Owner, Evolved Wireless, LLC (“Evolved Wireless”), submits this Patent Owner’s Response to the instituted grounds in the above-captioned consolidated case.

The ’481 Patent, based on an international application filed June 8, 2007 and claiming priority to a Korean application filed June 9, 2006, relates to cellular phone technology that is part of the Long Term Evolution (“LTE”) standard, sometimes referred to as 4G. The specific contribution of the ’481 patent is improved methods and structures for generating a preamble sequence for transmission on the random access channel (“RACH”). The RACH is the channel that all cellular phones must use to synchronize with a base station, or cell tower, to obtain initial network access when, for example, the phone is first powered on or is coming out of an idle state. The performance of the RACH is therefore a critical element of the LTE network, and the improved preamble sequences of the ’481 patent are a key driver of that RACH performance.

The instituted grounds fall into two categories, those for which the primary art consists of earlier proposals submitted to the Third Generation Partnership Project (“3GPP”) during the process leading up to adoption of the LTE standard (Panasonic 792, Panasonic 114, and Panasonic 700) and those for which the primary reference is an earlier versions of an alternative standard (IEEE802.16-

2004). The earlier 3GPP proposals disclose preamble structures that are inferior to the preamble sequence disclosed and claimed in the '481 patent. Accordingly, the earlier proposals were not adopted as part of the LTE standard. The alternative standard, IEEE 802.16, also known as WiMAX, and its preamble structure lost out in marketplace competition with LTE, which uses the preamble structure of the '481 patent, as LTE has become the United States' 4G mobile communications network of choice.

The Patent Trial and Appeal Board (the "Board") nevertheless instituted *inter partes* review, and consolidated these proceedings for trial on the following grounds:

1. **Claims 1, 2, 8, and 9** as anticipated by Panasonic 792;
2. **Claims 3 and 10** as obvious over Panasonic 792 and Panasonic 114;
3. **Claims 6 and 13** as obvious over Panasonic 792, Panasonic 114, and Chu;
4. **Claims 1 and 2** as anticipated by Panasonic 700;
5. **Claim 3** as obvious over Panasonic 700 and Panasonic 114;
6. **Claims 4 and 6** as obvious over Panasonic 700, Panasonic 114, and Chu;
7. **Claims 8 and 9** as obvious over Panasonic 700 and Motorola 595;

8. **Claim 10** as obvious over Panasonic 700, Panasonic 114, and Motorola 595;
9. **Claims 11 and 13** as obvious over Panasonic 700, Panasonic 114, and Motorola 595;
10. **Claims 1 and 15** as anticipated by IEEE802.16-2004;
11. **Claims 1 and 15** as obvious over IEEE802.16-2004 and IEEE802.16-2005;
12. **Claims 2-4 and 6** as obvious over IEEE802.16-2004 and Tan;
13. **Claims 2-4 and 6** as obvious over IEEE802.16-2004, IEEE802.16-2005, and Tan;
14. **Claims 8 and 16** as obvious over IEEE802.16-2004 and Chou;
15. **Claims 8 and 16** as obvious over IEEE802.16-2004, IEEE802.16-2005, and Chou;
16. **Claims 9-11 and 13** as obvious over IEEE802.16-2004, Chou and Tan; and
17. **Claims 9-11 and 13** as obvious over IEEE802.16-2004, IEEE802.16-2005, Chou, and Tan.

The above grounds were originally presented in three different petitions, which have been consolidated. Grounds 1-3 were presented in the Petition in IPR2016-00758 (“the 758 Petition” or “758 Pet.”), grounds 4-9 were presented in

the Petition in IPR2016-01342 (“the 1342 Petition” or “1342 Pet.”), and grounds 10-17 were presented in IPR2016-01349 (“the 1349 Petition” or “1349 Pet.”).

Patent Owner is no longer contesting the validity of claims 1-2, 8-9, and 15-16 and therefore addresses only grounds 2-3, 5-6, 8-9, 12-13, and 16-17 and only with respect to claims 3-4, 6, 10-11, and 13 in this Patent Owner Response.

Petitioners bear “the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. § 316(e). For the reasons set forth herein, Petitioners have failed to meet their burden on the instituted grounds which rely upon a combination of either Panasonic 792 or Panasonic 700 and Panasonic 114 (specifically, grounds 2-3, 5-6, and 8-9). The ’481 patent claims methods and apparatuses that use and generate novel preamble structures for transmission on a random access channel. Panasonic 792 and Panasonic 114 disclose two distinct structures, but Petitioners and their expert fail to explain how a person of ordinary skill in the art would modify Panasonic 792 in light of Panasonic 114. Moreover, Panasonic 114 specifically rejects the structure disclosed by Panasonic 792, and Petitioners and their expert fail to even acknowledge Panasonic 114’s teaching that its proposed structure will not work with that of Panasonic 792. Petitioners therefore necessarily fail to establish that a person of ordinary skill in the art would have combined those two references to derive the structure claimed by the ’481 patent. Panasonic 700 discloses a preamble structure that is identical to that of

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