

Filed on behalf of TQ Delta LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC., DISH NETWORK, LLC,
COMCAST CABLE COMMUNICATIONS, LLC,
COX COMMUNICATIONS, INC.,
TIME WARNER CABLE ENTERPRISES LLC,
VERIZON SERVICES CORP., and ARRIS GROUP, INC.,
Petitioner,

v.

TQ DELTA, LLC,
Patent Owner.

Case IPR2016-01006¹
Patent No. 7,835,430 B2

**PATENT OWNER'S REQUEST FOR REHEARING
UNDER 37 C.F.R. §42.71(d)**

¹ DISH Network, L.L.C., who filed a Petition in IPR2017-00251, and Comcast Cable Communications, L.L.C., Cox Communications, Inc., Time Warner Cable Enterprises L.L.C., Verizon Services Corp., and ARRIS Group, Inc., who filed a Petition in IPR2017-00420, have been joined in this proceeding.

Table of Contents

I.	INTRODUCTION.....	1
II.	ARGUMENT	2
A.	The Board Misapprehended Patent Owner’s Arguments Regarding the Combination of Chang and Milbrandt.....	2
B.	The Board Misapprehended the Law Regarding a “ <i>Teaching Away</i> ”	5
C.	The Board Misapprehended or Misapplied the Law Regarding Proper Reply Evidence or Argument	7
i.	The Board Improperly Relied on New Reply Evidence of a “Reasonable Expectation of Success” Necessary to Make A <i>Prima Facie</i> Obviousness Case	8
ii.	The Board Abused Its Discretion in Its Procedure For Raising, Considering, and Ruling Upon Objections to New Reply Evidence.....	12
III.	CONCLUSION	15

I. INTRODUCTION

Patent Owner TQ Delta, LLC (“Patent Owner”) respectfully requests a rehearing pursuant to 37 C.F.R. §42.71(d) of the Board’s Final Written Decision (Paper 41) (“Final Decision”) as to claims 1-6 of U.S. Pat. No. 7,835,430 (“the ’430 patent”). In particular, 37 C.F.R. § 42.71(d) provides that rehearing by the Board is appropriate where the Board “misapprehended or overlooked” matters.

While Patent Owner believes the Board made other errors in its Final Decision and does not waive its right to appeal, Patent Owner submits that the Board misapprehended or overlooked at least the following matters:

(1) The Board misapprehended Patent Owner’s arguments regarding the insufficiency of the asserted prior art for purposes of obviousness. The Board misapprehended that Patent Owner was proposing “physically incorporating the entirety” of the prior art references. (Paper 40 at 19 (emphasis added).)

(2) The Board misapprehended the law regarding a permissible Petitioners’ Reply. The Board relied on arguments or items of evidence found only in Petitioners’ Reply necessary to make out a *prima facie* case of obviousness. Moreover, the Board abused its discretion in its procedures for considering objections to such new Reply arguments and the manner in which it addressed such objections in its Final Written Decision.

II. ARGUMENT

A. The Board Misapprehended Patent Owner's Arguments Regarding the Combination of Chang and Milbrandt

Each of claims 1-6 of the '430 patent requires transmitting test information that includes “*an array representing frequency domain received idle channel noise information.*” See Paper 14 at 8; Ex. 1001, at claims 1-6. In order to satisfy this limitation, Petitioners alleged that it would have been obvious to combine (a) Milbrandt's alleged disclosure of transmitting test information with (b) Chang's alleged disclosure of measuring “background noise.” See Paper 1 at 14-20.

But there is a problem with that theory—Chang only discloses one way of measuring background noise—not *all* ways of measuring background noise. See Paper 14 at 12. That one and only method for measuring background noise in Chang used external test equipment (not equipment built into the modems), required a “truck roll” (i.e., sending out a technician), and required “terminating” the transmission line. See *id.* at 12-19. Chang did not disclose any other ways of measuring background noise that would avoid using external test equipment, a truck roll, or terminating the line. See *id.* Nor did the Petition allege that Chang disclosed any ways of measuring background noise other than its one “known method,” or point to any other ways. See *id.* at 19, citing Pet. at 16.

Where a prior art patent only discloses one method or one type of apparatus

in a broader category, however, it is not a disclosure of all methods or apparatuses in that category. *See id.* at 12. Put another way, just having the phrase “background noise” in Chang is not a disclosure of every possible way of measuring background noise—Chang is limited to its actual disclosure of a single method for measuring background noise. *See, e.g., Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006) (“It is well established that the disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of that genus. There may be many species encompassed within a genus that are not disclosed by a mere disclosure of the genus.” (internal citation omitted)); *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 886-87 (Fed. Cir. 1988) (Claims required a built-in control with both a positive and negative monitor. Friend’s disclosure of a “positive monitor” did not render obvious all “monitors”); *In re Benno*, 768 F.2d 1340, 1346 (Fed. Cir. 1985) (“A patent discloses only that which it describes, whether specifically or in general terms, so as to convey intelligence to one capable of understanding.”).

Patent Owner, however, explained that the single disclosed method for measuring background noise in Chang is incompatible with Milbrandt and taught away from by Milbrandt. *See Paper 14* at 11-15. And any test method that requires terminating the line would not work in Milbrandt. *See id.* at 19-22.

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