

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., MICROSOFT CORPORATION,
MICROSOFT MOBILE OY, and
MICROSOFT MOBILE INC. (F/K/A/ NOKIA INC.),
Petitioner,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2016-01228
Patent 7,881,236 B2

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

BOUCHER, *Administrative Patent Judge*.

DECISION

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

Patent Owner requests rehearing of our Final Written Decision holding claims 1–10, 12, and 13 of U.S. Patent No. 7,881,236 (“the ’236 patent”) unpatentable. Paper 28 (“Req. Reh’g”). Pursuant to our authorization, Petitioner filed an Opposition (Paper 30) and Patent Owner filed a Reply (Paper 31). By email correspondence, we denied Petitioner’s requests either to expunge Patent Owner’s Reply from the record as advancing new arguments or to authorize Petitioner to file a sur-reply.

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

I. BACKGROUND

“The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). When requesting rehearing of a decision, the party must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in the record. *Id.*

Patent Owner’s Request for Rehearing focuses on the “transmitting” limitations of independent method claim 1 and the corresponding limitations of independent apparatus claim 7. 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 correspondenc 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, col. 16, l. 59–col. 17, l. 3 (emphases added). In the Final Written Decision, we agreed with Patent Owner that, under the broadest reasonable interpretation, the recitation of “if” in these limitations introduces necessary conditions rather than sufficient conditions. Paper 27 (“Dec.”), 12–17. That is, the operation of the 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.” . . . “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. at 12 (citations omitted). This construction is frequently referred to by the parties as the “only when” construction.

Although Petitioner advocated for a broader construction in which the recitation of “if” more broadly introduces *sufficient* conditions, the Petition also addressed the construction we adopted. Paper 2, 42–44; *see* Dec. 32 (noting Petitioner’s alternative argument). In addition to the documentary prior art cited by the Petition, Petitioner also relied on a Declaration by Jonathan Wells, Ph.D., which we accorded evidentiary weight. Ex. 1003; *see* Dec. 32–34. In contrast, we did not accord weight to a Declaration by Todor Cooklev, Ph.D., proffered by Patent Owner, because that declaration

was unsworn and therefore defective.¹ Ex. 2009; Dec. 10–11. 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.

Weighing that evidence—even adopting the construction of the “transmitting” limitations advocated by Patent Owner—we concluded that Petitioner demonstrated sufficiently that both “transmitting” limitations are disclosed by Kitazoe. Dec. 32–34. Ultimately, we concluded that Petitioner demonstrated, by a preponderance of the evidence, that both independent claims 1 and 7 are unpatentable over the combination of art considered, and that the claims that depend therefrom are also unpatentable. *Id.* at 41.

In its Request for Rehearing, Patent Owner contends that “[t]he Board should reconsider its Final Written Decision . . . for two independent reasons.” Req. Reh’g 1. First, Patent Owner contends that we “overlooked the Patent Owner’s argument about why the additional UL Grant it discussed in the Response is not a ‘contrived hypothetical’ but is instead grounded in the ’236 patent’s specification.” *Id.* Second, “and more importantly,” Patent Owner contends that we overlooked an argument advanced by Patent Owner in its response that the prior art relied on by Petitioner “does not create the conditions that test” the adopted construction. *Id.*

¹ In the 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. 11. Patent Owner did not request leave to cure the defect in the Cooklev Declaration with its Request for Rehearing or otherwise.

II. ANALYSIS

Both of Patent Owner's contentions are grounded in its position that that Kitazoe did not consider conditions that could test whether the Msg3 buffer data are transmitted if the conditions recited in the claims are not met.² Req. Reh'g 6. That is, Patent Owner does not dispute in its Request for Rehearing that transmission occurs when the conditions *are* met. *Id.*; *see also* Paper 14, 39 ("Patent Owner does not dispute that [Kitazoe] shows transmission of the Msg3 buffer data . . . taking place after receipt of a random access response."). Instead, Patent Owner bases its request on an argument that Kitazoe insufficiently addresses the circumstance of what behavior results when the conditions are *not* met.

In addressing the "transmitting" limitations, the Final Written Decision considered and addressed this circumstance, i.e. "when at least one of the recited conditions is not met." Dec. 33. In addressing that circumstance, we cited disclosure by Kitazoe identified by Petitioner that "teach that the encrypted scheduled transmission message, i.e., the 'new data,' is transmitted only after the random access procedure is complete." *Id.*

In its Request for Rehearing, Patent Owner reiterates its argument that "Kitazoe 'takes a narrow view of what can occur during a random access procedure.'" Req. Reh'g 9 (quoting Paper 14, 40). Instead, as it did in its Response, Patent Owner "illustrate[s] a more complex case of UL Grant

² There appears to be an important omission of the word "not" in the following sentence of the Request for Rehearing: "And fatal to Petitioner's argument, the one place they looked—Kitazoe—admittedly did not consider conditions that could test the [*sic*] whether the Msg3 buffer data is transmitted if Condition X is [*not*] met." Req. Reh'g 6.

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