

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

**PATENT OWNER'S RESPONSE TO PETITIONERS' PETITION FOR
INTER PARTES REVIEW OF UNITED STATES PATENT NO. 7,881,236**

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Patent Owner Evolved Wireless, LLC submits this Response to the above-captioned Petition for *Inter Partes* Review of U.S. Patent No. 7,811,236 (“Pet.,” Paper 2).

I. Introduction

The challenged claims of the ’236 patent are valid. Regardless of the claim construction the Board adopts, a thorough analysis of Petitioner’s amalgam of citations offered to support its contention that the claimed “determining whether there is data stored” limitations is in the prior art, reveals the opposite. That is, those citations do not disclose the “determining whether” limitation as recited in the ’236 claims. All Grounds therefore fail.

Moreover, the Board instituted trial in this matter using a claim construction at odds with the understanding a person of ordinary skill (“POSA”). Expert testimony confirms that the claims at issue are drafted in what a POSA would call a “if condition then action1 else action2” formulation. The testimony further establishes that the construction for such language forbids carrying out action2 when the stated condition calls for action1 to be occur. The Board’s initial construction, therefore, is too broad. Further underscoring POSA’s proper reading of the claims is the *expressio unius* principle, which, as discussed in more detail below, was recently confirmed, post-Institution, by the Office’s grant of a continuation patent of the ’236 patent.

In view of the proper “only if”/ “only when” construction, Petitioner has reached unfounded conclusions regarding the disclosure of Petitioners’ primary reference (Kitazoe reference, Exhibit 1005). While Kitazoe’s teachings are not

inconsistent with Petitioners' argument, an analysis of the problem the '236 patent inventors addressed demonstrates that Petitioners' conclusions about Kitazoe are unsupported.

Accordingly, pursuant to the proper claim construction, the Petition should be rejected and no challenged claims should be cancelled.

II. The State of the art

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 a Long Term Evolution ("LTE") system developed and standardized in the 3rd Generation Partnership Project ("3GPP"). Ex. 1001, Abstract, (54), 1:17-32.

Figure 1 below is an annotated version of the '236 patent's Fig. 5. Fig. 5 illustrates communication between a UE (*e.g.*, a mobile telephone) and a base station (*e.g.*, a cell phone tower). Cooklev at ¶ 35-37.¹ In particular, Fig. 5 illustrates a "random access procedure" between a UE and a base station used, for example, to enable the UE to obtain initial access to the base station. Ex. 1001 at 3:45-49. Fig. 5 (the basis for the annotated in Figures 1-3 herein) illustrates a contention-based random access procedure. *Id.* at 6:53-55. In Figures 1-3 below, time increases along the downwards direction.

¹ "Cooklev" refers to the Declaration of Dr. Todor Cooklev, Ex. 2009.

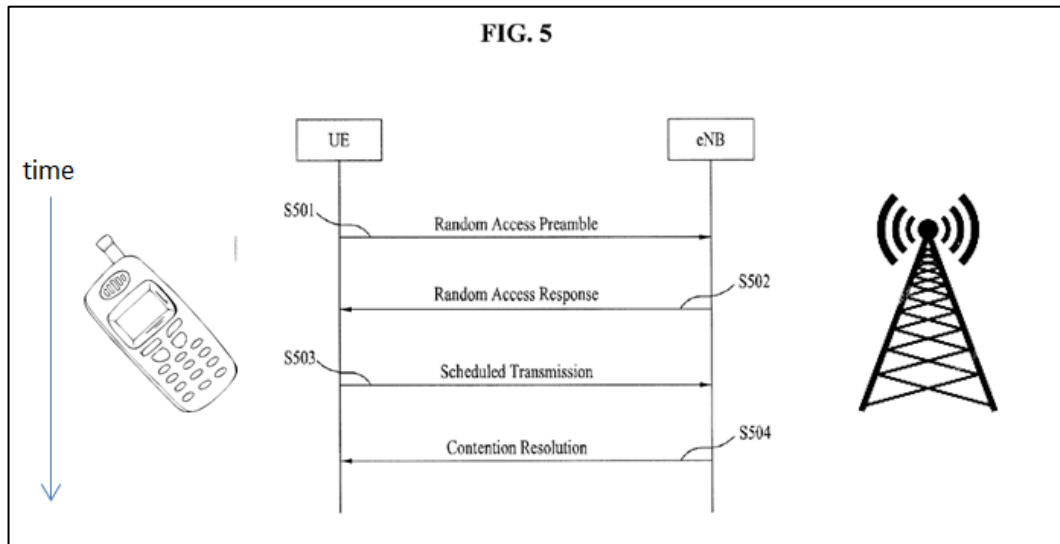


Figure 1

As the '236 patent describes, there are (at least in a simple case) four messages sent between the UE and the base station. They are identified in the following table:

Message	Synonym(s)	Direction
Random access preamble	Message 1	UE to base station
Random access response	Message 2	Base station to UE
Scheduled transmission	Message 3 (Msg3)	UE to base station
Contention resolution message	Message 4	Base station to UE

Id. at 4:3-17; Fig. 5; 8:38-9:48.

Figure 2 below is a further annotated version of the '236 patent's Fig. 5. This figure shows, in green, that the base station sends uplink grants ("UL Grants") to

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